

May 2008

Brands Update



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Main news

Modernisation and consolidation of the UK Trade Mark Rules

The UK Intellectual Property Office ("UKIPO") has undertaken a wholesale modernisation and consolidation of the Trade Mark Rules in part prompted by the UK's obligation to ratify the Singapore Treaty concerning the harmonisation of international trade mark procedures. Another aim is to increase the speed and efficiency of registration complementing the separate introduction on 6 April 2008 of "fast track" (a new service that will examine a trade mark application within 10 business days on payment of an additional official fee of £300).

Proposed changes to the Rules include:

1. Reduction of the opposition period to six weeks extendible to three months provided an electronic request is filed before the end of the initial six weeks. Alternatively a two month non-extendible opposition period is suggested. Presently notice of opposition must be filed within a non-extendible period of three months of publication of an application.
2. Following notification of opposition, a cooling off period of nine months extendible to a maximum of 18 months provided the parties are in settlement negotiations. The current cooling off period is 12 months.
3. A tidying up of the Preliminary Indication procedure on oppositions and generally more extensive case management powers for the Registry.
4. A tightening up of the evidence rounds in opposition, revocation and invalidation proceedings.
5. A right to reinstatement in ex parte proceedings. Where an applicant or a proprietor misses a deadline, a retrospective extension of time will be available on payment of £50.
6. Interim decisions (e.g., regarding an extension of time in inter partes proceedings) in future to be capable of appeal only when the final decision in the substantive case is issued.

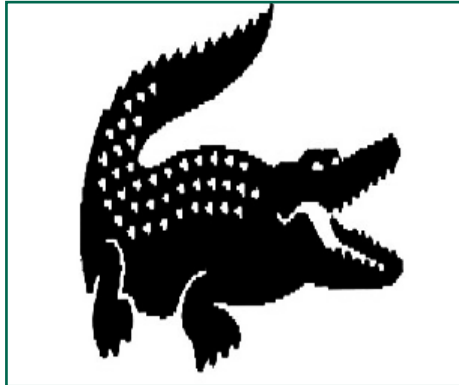
The UKIPO is seeking views on its proposals by 26 May 2008. The consultation can be viewed at <http://www.ipo.gov.uk/consult-tmrules.htm>.

We shall keep readers informed on the progress of the new Rules.

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Other news

A snap decision?



Two dentists applied to register the mark set out above left for dentistry services. The mark was opposed by Lacoste on various grounds. In support of its opposition, the opponent relied on a number of Community and UK registrations and unregistered marks, which all concern crocodile devices including the Community mark for the crocodile device set out above right covering a wide range of goods and services including medical services. The Hearing Officer held that the applicant's dentistry services fell within the opponent's wider specification for medical services.

The Hearing Officer found a degree of visual similarity between the marks because they both show a reptile device but that was the extent of the similarities. She also found the marks to be conceptually very different because the applicant's mark is bound to bring to mind a dental practice while the earlier mark brings to mind a reptile. The Hearing Officer decided that even considered in relation to identical services, there is no likelihood of confusion between the marks. The visual, aural and conceptual differences between the two marks outweigh the similarities. The possibility of confusion arising from imperfect recollection was taken into account - the average consumer will take great care in trying to find a suitable dental practitioner.

On appeal, the opponent argued that in comparing the marks the Hearing Officer attributed too much importance to the words THE DENTAL PRACTICE. The opponent argued that these words are wholly descriptive and non-distinctive for dental services and would have no trade mark significance for the average consumer. They should have been ignored in the comparison of the marks.

The Appointed Person, however, agreed with the Hearing Officer's decision that in determining a comparison of marks the degree of similarity must be assessed by an overall comparison of the respective marks. All elements of the mark must be taken into account unless they are merely negligible. Examination must extend to the phonetic and conceptual as well as the visual features. The words THE DENTAL PRACTICE are, on their own, descriptive of the services applied for. Generally speaking, the public will not consider such an element to be dominant but it could not be ignored. There were clear differences between the reptile devices including that the reptile in the applicant's mark was facing front/right, had just one eye and its mouth was closed. Overall the visual, oral and conceptual differences between the marks would have been apparent to the average consumer of dentistry services such that there is no likelihood of confusion. The appeal failed.

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I'm not just here for decoration

D Jacobson v. Globe

This case, which is of particular relevance to the fashion industry, considers the circumstances in which the design features of a product can be validly registered as a trade mark, and then be infringed by the use of a rival design. Whether such designs fall within trade mark law can be critical, in particular, where the brand owner's design rights or copyright have expired or are not otherwise available.

Jacobson (trading as Gola), a sportswear company, owns the UK and CTM trade mark registrations below for the logo that is featured on the sides of its sports shoes. Known as the "Wing Flash" logo, it consists of two vertical bands with a tapered horizontal band. Globe, another sporting goods business, launched a range of shoes also bearing a stripe design on the sides, including the "Globe Wedge" shown below.

Gola's trade mark registrations



Globe's shoe



Gola sued Globe in the English High Court for registered trade mark infringement and passing off, claiming that their respective stripes were confusingly similar. Globe counterclaimed that Gola's trade mark registrations were invalid for being non-distinctive and customary in the trade, and that the stripes were not confusingly similar in any event.

The main question in the proceedings - relevant to both the validity of Gola's registrations and the infringement by Globe - was: were the logos used as mere designs? - in which case there was no trade mark infringement; or as badges of origin? - in which case there was infringement.

Gola produced a market research survey and statements from a number of witnesses who participated in the survey. These included a self-styled "sneakerologist" - who owned some 50 pairs of trainers - and other, more average, consumers. Expert evidence in the field of footwear branding was given on behalf of both parties.

Globe claimed that Gola's trade mark registrations were invalid because - unlike other stripe logos including the Nike "swoosh" - Gola had not educated the public that its stripe arrangement was a trade mark. Further, unlike, for instance, the non-stripe Lacoste logo, Globe claimed that Gola's stripes were part of the general structural design of its shoes.

The Judge, siding with Gola's expert, found that the Wing Flash logo was unusual and inherently distinctive, and that typical buyers of trainers are accustomed to seeing logos on the sides of shoes as brand identifiers, rather than serving as mere decoration. The fact that 31% of the participants in Gola's survey recognised the stripes on the side of both parties' shoes as branding strongly supported this conclusion. Gola's registrations were therefore valid.

On the same basis, the Judge held that the average consumer would also regard Globe's stripes as trade mark use, and not pure decoration.

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For the purposes of determining the likelihood of confusion, the proper comparison was between the respective logos, as opposed to between the Wing Flash logo and the whole Globe shoe or any other features on it (including the Globe brand name). Globe's logo was held to be confusingly similar to Gola's, and therefore infringed. Even though Gola's survey only indicated confusion of 2% between the brands (or 18% of those who recognised the Gola brand), this was held not to be inconsiderable, and the absence of any evidence of actual confusion was not determinative. Passing off was also established for the same reasons.

An important aspect of this case was the central role played by the expert evidence. Gola's expert was held to have far more knowledge than Globe's expert in the footwear market, and his evidence that such logos are perceived as brands rather than just decoration appears to have been pivotal in establishing validity and infringement. Depending on the circumstances of each case, producing admissible and relevant expert evidence in this type of dispute could therefore be critical.

This could add to the complexity and expense of these cases, and can be contrasted with the view recently expressed by Lord Justice Jacob in the *Proctor & Gamble v. Reckitt* air freshener case, that the place for such evidence in registered design proceedings is very limited.

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Advocate General pops O2's bubble

The Advocate General of the European Court of Justice ("ECJ") considers that use of a competitor's trade mark (or a similar mark) for the purpose of making a product comparison in an advertisement is not trade mark infringement. Instead, it must be dealt with under the Comparative Advertising Directive. It remains to be seen whether the Court will follow this opinion.

Facts

In March 2004, Hutchinson 3G ("H3G"), owner of the '3' mobile phone brand, ran a TV advertisement to promote its new mobile phone services that compared its products with those of various competitors. One advertisement featured the word "O2" and moving pictures of bubbles, contrasted with an animated picture of a '3' and the overall message that the H3G services were cheaper than those of O2. O2 brought an action for trade mark infringement of their 'static bubbles' registered trade marks. At trial, O2 accepted that the price comparison was true overall and not misleading, but maintained that the use of the bubbles constituted trade mark infringement.

H3G was successful at first instance. In the Court of Appeal, Lord Justice Jacob considered that there was no need for trade mark law to get involved in comparative advertising since a defendant does not use the competitor's mark to indicate the trade origin of the defendant's mark. However, he referred the matter to the ECJ for clarification on how far EU law permits signs, which are identical or similar to the trade mark registrations of third parties, to be used in comparative advertisements.

Opinion

In his opinion, the Advocate General considered that the Comparative Advertising Directive "*specifically and exhaustively*" covered the situation where a competitor was using a rival's mark or similar mark for the purpose of comparative advertising. Such use did not fall within the domain of Article 5 of the Trade Marks Directive as its permissibility is "*to be assessed solely in the light of the criteria laid down in the [Comparative Advertising] Directive*".

Further, the Advocate General considered that there is no requirement that the use of a competitor's mark or a similar mark be "indispensable" for comparative advertising to be permissible in Europe. The test is whether or not the advertisement complies with the eight criteria under the Comparative Advertising Directive.

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Practical implications

Unlike many decisions and opinions from the ECJ, the Advocate General's opinion has the benefit of certainty and clarity. If the ECJ follows this opinion, trade mark owners will not be able to sue for *trade mark infringement* when their mark or a similar mark is used by an advertiser in a comparative advertisement. However, they can of course object under the provisions of their national law which implements the Comparative Advertising Directive.

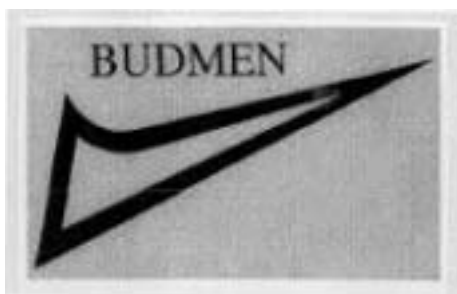
In the UK, this is currently through a complaint to the OFT and/or the Advertising Standards Authority. These bodies do not have as much teeth as the court has in a trade mark infringement claim where damages and costs can be awarded. In other European countries, such as Germany, a competitor can sue for unfair competition for breach of the eight criteria. It appears that the UK does not accord as much importance to non-compliant comparative advertising as other countries. Having said that, the UK law in this area will change following the implementation of the Unfair Commercial Business-To-Consumer Practices Directive. It will be interesting to see how the UK deals with this issue. In any event, the position depends on the ECJ adopting the opinion of the Advocate General.

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No victory for the Goddess

Budmen and *Atom* – Oppositions by the Nike Swoosh

The UKIPO has recently seen two oppositions brought by Nike, each based on earlier registrations depicting the Nike "swoosh". The first was Nike's opposition to an application for an international registration for the mark BUDMEN and device (see fig. 1). The second was Nike's opposition to an application for a UK registration for the logo mark A ATOM (see fig. 2).



(Fig. 1)



(Fig. 2)

In both cases, Nike opposed the applications on the grounds the marks were similar to their earlier marks and there was a likelihood of confusion, the earlier marks had a reputation and passing off.

Despite the Hearing Officer finding Nike to have a strong reputation in respect of its "swoosh" mark, Nike failed on all grounds in both cases and the oppositions were dismissed.

The marks were held not to be similar enough to give rise to a likelihood of confusion under section 5(2)(b). Even though the respective goods of the applications were found to be either identical or highly similar, this did not help Nike in establishing a likelihood of confusion given the differences between the marks.

In the *Budmen* case, the evidence suggested that the public would perceive Nike's mark as a "tick", but the Hearing Officer did not regard the BUDMEN mark to have the appearance of a tick. He thought that any similarity between the marks was very limited. In *A Atom*, the Officer noted that the alleged similarity resided in one of several elements of the composite mark: the "cross-bar" in the letter "A", which did have the appearance of a tick. However, he was of the view that the mark was likely to be seen by consumers as an "A ATOM" or "ATOM" mark rather than a "tick" or "swoosh" mark and so from a conceptual viewpoint the respective marks said different things.

The differences between the marks also led to Nike's downfall in its claims based on section 5(3).

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An opposition based on section 5(4) requires the opponent to show a misrepresentation by the applicant leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent. Again, as the marks were not held to be similar, Nike failed on this element.

Nike's failures mean that these two device marks may proceed to registration for similar, if not identical, goods to those on which Nike uses the famous "swoosh". The Hearing Officers were of the opinion that the marks are different enough to avoid any confusion on the part of the consumers. There were references in Nike's evidence to the swoosh being among the most easily recognised brand symbols in the world. Therefore, it seems unlikely that the losses will do much to harm the distinctiveness of the swoosh, or otherwise affect the reputation of Nike. After all, this is a company named after, "Nike", the Greek mythological goddess of victory!

Applicants for device marks should bear in mind that it may be easier to defend an opposition brought on the basis of a similar device where the mark sought composes additional elements, such as the words BUDMEN and A ATOM in these cases. On the flip-side, owners of registered trade marks for devices should be cautious in bringing opposition proceedings against composite marks, especially where only one of the elements of the mark is similar to the earlier mark.

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SAFETY 1ST

In the recent case of *Dorel Juvenile Group*, the Court of First Instance ("CFI") addressed the question of whether an advertising slogan is sufficiently distinctive to be registrable as a trade mark.

The applicant had applied to register the word sign SAFETY 1ST as a Community trade mark for a range of goods intended for use for or by children. The applicant did not submit that the mark had acquired distinctiveness through use.

The Examiner and the Board of Appeal refused the application on the basis that the mark applied for was devoid of any distinctive character. The applicant appealed to the CFI on three main grounds.

- First, the applicant submitted that "1ST", being a combination of figures and letters, is distinctive and requires a degree of intellectual effort on the part of the relevant public to be understood as a synonym for "first". The CFI was not persuaded by this argument. It considered that "1ST" is well-known and commonly used in English, and requires no particular intellectual effort to be read as "first".
- Secondly, the applicant submitted that the mark SAFETY 1ST looks like a fanciful street name or address, and so the relevant public would not perceive it as meaning "safety first". The CFI also rejected this argument. It noted that English postal addresses and street names do not contain numbers such as 1ST or 2ND. While such numbers may feature in street names in other English-speaking countries such as the US, such numbers come first and are followed by a word such as "street" or "avenue" (for example, "5TH Avenue").
- Thirdly, as evidence of the sign's distinctive character, the applicant sought to rely on the fact that the US Patents and Trademarks Office had permitted registration of the mark. Again, the CFI did not accept this argument. As stated on previous occasions, it held that the registrability of a sign as a CTM is to be assessed purely on the basis of the relevant Community legislation.

The CFI considered that the relevant public (who are the parents, family or friends of children, for whom safety considerations would be especially relevant) will immediately perceive SAFETY 1ST, taken as a whole, in the same way as "safety first" – namely, as an advertising slogan indicating that safety considerations played a dominant role in the goods' design and manufacture.

The CFI noted that an advertising slogan can only be registered as a trade mark if it may be perceived immediately as an indication of the commercial origin of the goods or services in question. In this instance, the CFI decided that the relevant English-speaking consumer will perceive SAFETY 1ST as information relating to a quality or characteristic of the goods, and not as an indication of the commercial origin of the goods. The CFI therefore agreed with the Board of Appeal's finding, and held that the sign was devoid of any distinctive character in respect of the goods applied for.

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This case highlights that, unless the applicant can prove acquired distinctiveness, an advertising slogan will only be registrable as a trade mark if the relevant public would immediately perceive it as functioning in a "trade mark way" – namely, as indicating the commercial origin of the goods or services in question.

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RXWorks v Hunter

In the recent case of *RXWorks v. Hunter*, the High Court in a summary judgement application applied the test for trade mark infringement previously set out by the ECJ in *Celine* and other cases.

The case involved the use of the trade mark VET.LOCAL, registered by Dr Hunter for computer hardware and software, in computer systems for use in veterinary practices. The mark had been used by RXWorks as the name of a domain and directory folders in the computer system.

The court confirmed that in order for there to be infringement, four conditions must be met, which it called the *Celine* conditions. The trade mark must have been used: (i) in the course of a trade, (ii) without the consent of the trade mark owner, (iii) in respect of identical/similar goods or services and (iv) in such a way as to be liable to affect the functions of the trade mark in particular its essential function as a guarantee of origin.

The key issue in this case was whether the fourth *Celine* condition was satisfied. In considering the issue, the judge made a number of useful points:

- There is nothing in the EC Council Directive on trade marks expressly requiring that for infringement use by the Defendant must affect the function of the trade mark. This requirement comes out of the ECJ's interpretation of the concept of use.
- The absolute protection the Directive gives where an identical mark is used in relation to identical goods/services is absolute only to the extent that the guarantee of origin must be protected.
- The criteria do not look at the nature of the use (e.g. whether use is in a trade mark sense) but the impact of the use.
- Descriptive use is permitted because such use does not affect the functions of the trade mark.
- Whether the legitimate interests criteria is satisfied is a question of fact for the national courts to decide bearing in mind such factors as the nature of the mark, its meaning, the context of the use and possibly also the scale of the use.
- The question is to be addressed from the viewpoint of the average consumer of the relevant goods/services.

Applying these criteria, the court concluded that RXWorks' use of the mark did not prejudice the function of the trade mark. Of particular importance was the fact that it was a convention in the software industry to name certain domains and directory folders "x.local". This, together with the fact that the mark was buried within the computer system such that vet users were "*likely only to stumble upon it by chance and knowledgeable system administrators would know what it refers to*", the fact that the sign was not intended to indicate trade origin and consumers would not view it as such all indicated that the use complained of did not prejudice the legitimate interests of the trade mark owner. Accordingly, there was no infringement and no prospect that further evidence was likely to emerge which would lead to a different view if the matter went to full trial.

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PLAYBOY: A mark with no reputation

This seems an extraordinary conclusion but was in fact the outcome of a recent opposition filed by Playboy Enterprises International Inc ("PEI") based upon their prior marks for the word PLAYBOY against the following international registration in the name of Hot Sheyt Management.



As well as claiming confusion under section 5(2)(b) of the Trade Marks Act 1994, PEI also claimed that PLAYBOYSKOOL would take unfair advantage of and be detrimental to the reputation in their PLAYBOY marks under section 5(3).

Two witness statements by the Senior Director of Business Management at PEI were filed along with 600 pages of evidence to support the case. However, this evidence "suffered from several flaws".

Dates

PEI had to illustrate that they had a reputation in the PLAYBOY marks before the date of the PLAYBOYSKOOL mark. Much of the evidence filed was undated, therefore making it worthless. Some evidence, for example, the worldwide market information about the company, only showed the date on which it was printed to put in as evidence. Many of the exhibits were of such poor quality that dates or trade marks could not be deciphered and two documents illustrating merchandise available in the UK were totally illegible. All but one of the invoices post-dated the priority date claimed by the PLAYBOYSKOOL mark.

Not focused on UK or EU

Another flaw in the evidence was the lack of focus on the UK or EU market. For example, a booklet aimed at advertisers about the PLAYBOY brand filed as evidence of reputation in the UK and Community marks referred only to US and global use of PLAYBOY. Turnover figures during the relevant period were given in one of the witness statements but there was no breakdown as to the goods and services and although impressive, running into hundreds of millions of US dollars, there was no indication as to the proportion of that revenue gained from trading within the UK.

Focus on wrong mark

Some documents filed did not bear the PLAYBOY mark but showed the rabbit head logo instead. Use of the rabbit head logo was entirely irrelevant to this opposition.

PEI were successful under section 5(2)(b) in relation to confusion between the two marks for the majority of the goods and services applied for. In relation to section 5(3) it was held that the evidence filed by the opponent did not establish a reputation in the European Community at the relevant date. The clear message from this decision is that the quality of evidence filed is vitally important and even owners of very well known brands cannot be complacent.

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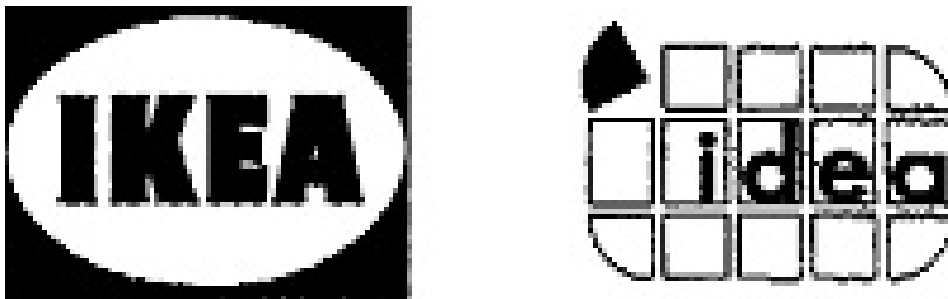
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Whose idea is it anyway?

Ikea brought an invalidity action against Community trade mark IDEA & device in classes 16, 20 and 42 in the name of Walter Waibel based on the likelihood of confusion with Community trade mark IKEA & device and several national European marks for the word IKEA in classes 16, 20 and 42. IKEA was initially successful in support of its application that IDEA created a likelihood of confusion with its figurative and word mark IKEA and the Cancellation Division declared that IDEA was invalid. Walter Waibel appealed and the First Board of Appeal upheld the appeal. Ikea brought an action requesting that the CFI annul the decision of the First Board of Appeal.

The CFI held that the likelihood of confusion must be assessed globally, according to the perception that the relevant public has of the marks and the goods or services. It discussed the relevant public and the sophistication of purchasers of furniture. The CFI stated that purchasers of furniture will rarely order it orally but will make their choice on the basis of a number of functional and aesthetic considerations, in order to ensure that it is in keeping with other furniture already in their possession. It concluded that the process of comparison and reflection before the choice is made requires a higher than normal level of attention. Their purchasing decision is not primarily based on a comparison of the marks alone but is based on a deep understanding of the products and their manufacturers.

The CFI went on to compare the appearance, pronunciation and meaning of



In terms of visual comparison of the marks the CFI held that the representation of IDEA is unusual and that it possesses a relatively high degree of intrinsic distinctiveness. When marks are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them. The presence in IDEA of a figurative element set out in a specific and original way has the effect that the overall visual impression of the marks is different.

The CFI also concluded that there is a low degree of aural similarity between IDEA and IKEA because the sound of the consonants "d" and "k" is very different.

Finally, the CFI held that the conceptual content of the marks was different as the expression idea is a word generally understood by the European public, whereas the expression "ikea" is an invented word. According to case law, there cannot be conceptual similarity between a mark that conveys no clear meaning in any of the official languages of the EU and another that does.

In summary, the CFI concluded that the Board of Appeal was right when deciding that there was no likelihood of confusion between IDEA and IKEA and the reputation of IKEA in Sweden had no bearing on the assessment as the marks are globally different.

The case illustrates that no one factor is determinative in finding a likelihood of confusion, but instead, all relevant elements must be carefully weighed before determining whether a likelihood of confusion exists.

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What's in a title?

Red Hot Chili Peppers -v- Showtime

A recent legal action in the US concerning the title 'Californication' raises some interesting questions about the extent to which it is possible to protect the titles of works under UK law.

The US rock band the Red Hot Chili Peppers, commenced proceedings against Showtime Networks in California over the name of its television series 'Californication', which was previously the name of a successful 1999 album and single by the band.

Showtime began airing the television series 'Californication' in 2007. The series features a recurring character named 'Dani California', which is also the name of one of the band's singles and a character referred to in three Chili Peppers songs, including 'Californication' itself.

The band is claiming unfair competition, dilution and unjust enrichment. They contend that the use of 'Californication' by Showtime "*constitutes a false designation of origin, and has caused and continues to cause, a likelihood of confusion, mistake, and deception as to source, sponsorship, affiliation, and/or connection in the minds of the public*". They are seeking a permanent injunction preventing Showtime from using the title 'Californication' (or anything confusingly similar), as well as financial remedies.

While this legal action is under Californian law, it poses interesting questions about how such a title might be protected under English law. The three main options to consider are copyright, registered trade mark and passing off.

- **Copyright.** It is well established in English law that there is usually no copyright protection for a title on its own.
- **Registered trade mark.** The title of an album, song or television series could be registered as a trade mark in, for example, class 41 (entertainment service). However, the main difficulty is that using the mark solely as the title of an album, song or even television series may not amount to trade mark use – namely, to distinguish goods or services of one undertaking from those of other undertakings. Unless there is trade mark use of a registered trade mark, the mark would be vulnerable to revocation five years after registration. If the mark is used as, for example, the name of a tour, then this would probably be sufficient to qualify as trade mark use in class 41. It appears that the band has not registered 'Californication' as a trade mark in the US, although Showtime Networks applied to register it in April 2007. Under English law, the band could seek to oppose Showtime's application, for example on the basis that the application infringes the band's passing off rights.
- **Passing off.** In the UK, the band's strongest claim would be in passing off (this is similar to unfair competition in the US). A passing off claim would be less dependant on showing that the title has been used as a trade mark. Given the success of the Chili Peppers' album and song, the band could argue there is goodwill in the title 'Californication', although this would be more difficult to establish for a less well-known band where the album or song has had relatively low sales. The Chili Peppers would also need to show misrepresentation – in other words, that Showtime's use of the title suggests that the band has endorsed the television series or is in some other way connected to it. In addition to the use of the title, the band could rely on Showtime's use of the Dani California character as evidence of this.

In summary, while protecting a song or album title on its own is not necessarily straightforward under English law, it is possible in certain circumstances. A registered trade mark would potentially give protection if the title is being used as a trade mark. If the song or album has been successful, there may be sufficient goodwill in the title to rely on passing off. The originality of the title will also be a relevant consideration, as a commonplace title would probably prove harder to protect than, for example, a newly coined word.

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Tip of the month

No more searching

From 10 March 2008 there has been a change in the searches carried out for Community Trade Mark ("CTM") applications.

Previously, Community searches and national searches in a number of EC countries were carried out in all CTM applications without an obligation to pay a specific search fee. These searches were sent to the applicant for information purposes only, to allow him to decide whether to continue with a Community application if conflicting marks were revealed. However, national search reports were often of limited use. The search criteria vary between Member States, no searches were conducted in certain countries (e.g. Germany, France and Italy), and no representations of the earlier marks were produced for trade marks containing figurative or device elements. Given that only 4% of CTM applications were withdrawn before publication it seemed that few people, if any, were concerned by the search results; preferring instead to proceed with their application and allow others to oppose their mark.

CTM applications filed from 10 March 2008 onwards will continue to receive the Community search report. However, national search reports will only be produced if requested and paid for at the time of filing the application. If national searches are requested they will be carried out in all Member States that are participating in the new system. It will not be possible to select some countries for searches and leave out others. The period for producing the national search reports will also be reduced from three months to two and the format of the reports harmonized. These changes will also apply to applications for International Registrations designating the EC.

The fee for obtaining national searches is 192 Euros.

STOP PRESS – ECJ gives ruling in *adidas* three-stripe trade mark case

The ECJ has ruled in *adidas* that the mere fact that two-stripe designs are used as decoration on garments does not prevent infringement of the reputed three-stripe adidas trade mark. The question for the courts is whether, because of the similarity between the two-stripe sign and three-stripe trade mark, the public would mistakenly believe that the garments come from the same or an economically linked source. Alternatively, for the extended form of protection afforded to marks with reputation (like the adidas three-stripe design), will the public make a connection between the two-stripe design and the reputed mark that allows unfair advantage to be taken or causes damage to the distinctiveness of the reputed mark? If there is infringement under either form of protection, it is no defence to say that a design is being used as decoration on the garment. Decoration is not an indication of any characteristic of a garment.

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