

TaylorWessing

Brands Forum
2021

In case you missed it!

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Contents

1. Importance of Registration
2. Descriptiveness and inherent distinctiveness
3. Acquired distinctiveness - Importance of use
4. Enforcement - Registering the 'right' mark
5. What counts as genuine use?
6. Quiz Time



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Importance of registration



Passing off

Original Beauty Technology & Ors v G4K Fashion Ltd & Ors [2021] EWHC 294 (Ch)

Philip Warren & Son Ltd v Lidl Great Britain Ltd & Ors [2021] EWHC 1097 (Ch)

Freddy SPA v Hugz Clothing Ltd [2020] EWHC 3032 (IPEC)

Unregistered Community Design

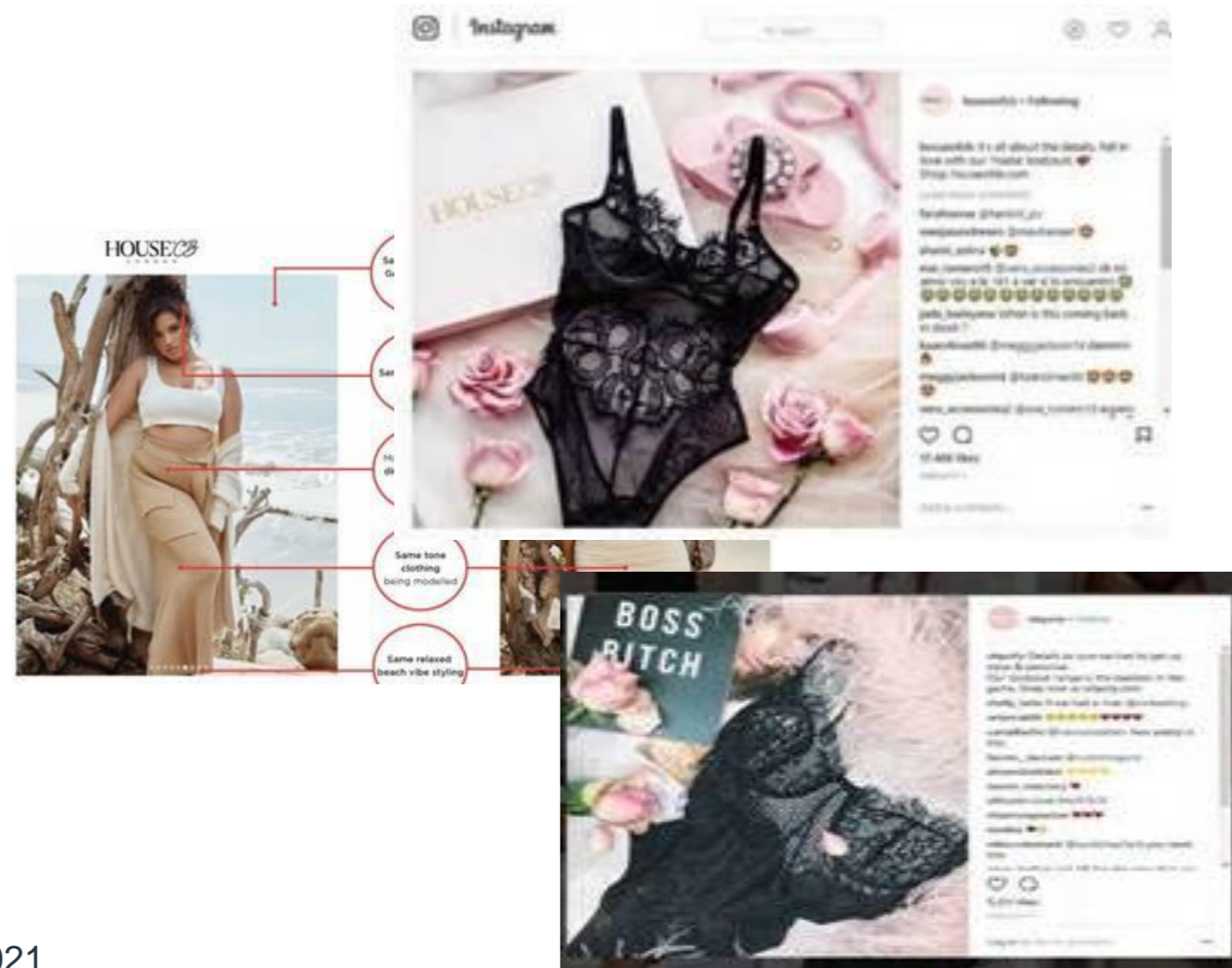
Rothy's Inc v Giesswein Walkwaren AG [2020] EWHC 3391 (IPEC) (16 December 2020)

Original Beauty v G4K Fashion

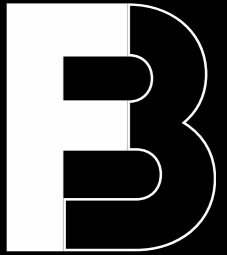


- Claimant: sells bodycon and bandage garments under the main brand **House of CB**
- Defendant: competitor, sells bodycon and bandage garments under the brand **Oh Polly**
- Claim: infringement of UK/EU unregistered designs and **passing off**

Original Beauty v G4K Fashion



Original Beauty v G4K Fashion



- Clear evidence that defendants had intended to emulate the claimant's business and *"obtained an advantage by copying a successful competitor"*
- BUT – no misrepresentation, no passing off
- Not enough evidence that consumers were deceived
- Consumers did not consider the two businesses to be sister brands or share a trade connection
- Judge reached conclusion with reluctance

"passing off is not a tort of unfair competition"

Philip Warren & Son v Lidl



- Claimant: family-run butchers, operating under the name Philip Warren & Son since the 1980s
- Defendant: Lidl used brand Warren & Sons nationwide for fresh meat products between 2015-2020



Philip Warren v Lidl



- Clear from the evidence that Lidl had not chosen the brand to make a connection with PWS
- Lidl did not dispute that PWS had generated goodwill in Launceston and the surrounding area and in relation to PWS' wholesale business
- Parties operated at different ends of the market, limited customer overlap (except in Launceston)
- Failed to show enough "*evidence of a significant level of operative misrepresentation to any category of its customers*"
- Lidl had strong reputation for selling Lidl and other house-branded products
- Limited instances of actual confusion
- No significant damage to PWS' business

Philip Warren v Lidl



"It must have been annoying for PWS [...] However, the law of passing off [...] requires the court to find, on clear and solid evidence, that Lidl's conduct gave rise to sufficient operative misrepresentation to have caused material damage to PWS's goodwill [...] the evidence is not sufficient to show that it did"

Freddy v Hugz Clothing



Claimant (Freddy)

Defendant (Hugz)

"WR.UP"



Freddy v Hugz Clothing



Conventional passing off

- Goodwill in the claimant's get-up was particularly strong
- Consumers would recognise it as an indication of the origin of the products
- Clear from the similarities between the get-ups that the defendant had intended to misrepresent that it was connected to the claimant

Post-sale confusion

- Consumers can continue to be deceived as to the origin of the product after purchase

"...the owner of goodwill in a product is entitled to have this goodwill protected throughout the life of the product, not just at the point of sale"

Rothy's v Giesswin Walkware



- Claimant: California-based ballerina shoe company, owner of valid RCD and UCD in its "pointed loafer" shoe
- Defendant: Austrian shoe company selling ballerina shoe known as the "pointy flat"
- Claim: infringement of RCD and UCD



Rothy's v Giesswin Walkware



- Evidence showed that defendant had purchased and taken inspiration from other similar shoe designs owned by claimant
- But, defendant had not purchased pointy loafer in issue
- No evidence that defendant had copied the UCD (i.e. the pointed loafer)
- Evidence suggested independent creation (designer's attendance at design meetings, independent research, disclosure of design sketches and prototypes)

Descriptiveness and inherent distinctiveness



Class 3 – cosmetics and fragrances;
Class 9 – glasses, sunglasses and cell phone covers;
Class 14 – jewellery, watches and wall clocks; and
Class 20 – pillows; cushions; beds; mattresses; furniture.

- Consider whether this is a descriptive indication of the goods specified
- Consider whether the element is a characteristic objective and inherent, intrinsic and permanent to the nature of the goods in question

Inherent distinctiveness



IT'S LIKE MILK BUT MADE FOR HUMANS

Class 18 – Luggage

Class 25 – Clothing

Class 29 – Milk substitute products

Class 30 – Processed food products

Class 32 – Non-alcoholic beverages

- Consider whether this is an indication that products are "apt for human consumption" – a promotional, laudatory slogan?
- Or a controversial proposition which challenges societal norms and provokes a cognitive process?

Get ahead of competitors by using non-traditional trade marks?



Class 6 – containers

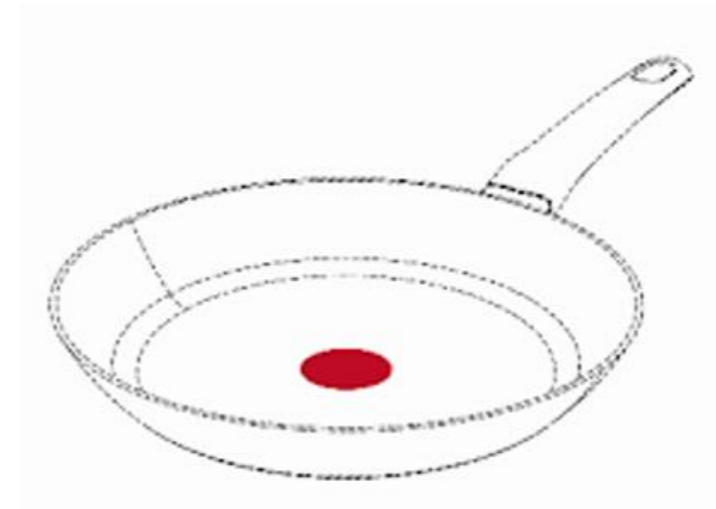
Classes 29, 30, 32, 33 – various beverage products

- Consider whether a purely technical and functional element of the goods for which protection is sought
- Consider whether this element is connected with the goods either prior to purchase, or upon consumptions of the goods

Acquired distinctiveness: Importance of use



- Acquired distinctiveness: *the mark has acquired a distinctive character through the use made of it*
- Badge of origin
- Exposure is not enough!
- *Tefal's UKTM application for a 'red dot'*
- Inherent distinctiveness argument: failed
- Acquired distinctiveness: failed



Tefal's red dot UKTM application



Perfect Non-stick Cooking Tefal®
www.tefal.co.uk

Thermo-Spot™
Tefal's unique heat indicator lets you know when your pan is perfectly pre-heated and ready to cook.

Lifetime guarantee
All Tefal non-stick coatings are guaranteed for life.

Dishwasher safe
All products are dishwasher safe.

1 | Tefal Easycare Set 9-Piece Pan Set
Tefal's easy care 9-piece set is the perfect cookware set with value added extras. It has Tefal's unique ThermoSpot technology that lets you know when the pan has reached the optimum cooking temperature and non-stick coating that promises durable non-stick cooking performance. The glass lids are ideal for keeping an eye on what you are cooking. Aluminium pots and pans are ideal for heat distribution, therefore no heat spots. Set consists: 14cm milkpan, 16 & 18cm covered saucepans, one egg wonder, 20 & 24cm frying pans, wide spatula, slotted spoon & large spoon. Dishwasher safe. Suitable for Gas and Electric hobs.
RRP £80.00 20wks \$4.00
960 797 4

2 | Tefal Volupté 5-Piece Pan Set
Volupté is a stylish and sturdy cookset. The frypans have non-stick coating for easy cooking. The riveted stainless steel handles are sturdy and comfortable, and are engraved with the logo. The saucepans come with measure markings on the inside of the pans, making it easier to measure liquids directly into the pan. Glass lids are ideal for keeping a close eye on your cooking. Set consists: 16, 18, 20cm covered saucepans & 20, 24cm frying pans. Dishwasher safe, suitable for all hobs including induction.
RRP £120.00 20wks \$6.00
104wks \$1.53
APR 32.9% VARIABLE
Total Price £159.12

3 | Tefal Banquet 5-Piece Stainless Steel Pan Set
Save £40 on Tefal RRP. Set consists: 14cm, 16cm and 18cm Saucepans with glass lids, 20cm and 24cm Frypans. Stainless steel for optimum heat conductivity. Induction compatible. Non-stick coating on frypans is durable and resistant. Dishwasher safe. Suitable for all hobs including induction.
RRP £120
New £80.00 20wks \$4.00
440 475 4

4 | Tefal Supra Frypan Twin Pack
Tefal's Supra twin pack has PTFE coating for easy cleaning. Tefal's unique ThermoSpot technology lets the consumer know when the pan has reached its optimum cooking temperature. Dishwasher safe and suitable for gas and electric hobs. Lifetime guarantee on non-stick. Set consists: 20cm and 24cm Frying pans.
RRP £27.00 20wks \$1.35
340 625 4

5 | Tefal Mini Chef Pan
16cm, multi purpose mini chef pan with ThermoSpot. Best Plus interior coating that

1 | Easycare Set 9-Piece Pan Set
\$80

2 | Volupté 5-Piece Pan Set
\$120

3 | Banquet 5-Piece Pan Set
Save on RRP \$40 off
Only \$80

4 | Supra Frypan Twin Set
\$27

5 | Mini Chef Pan
\$22

6 | Mini Steakpan
\$27

7 | One Egg Wonder
\$15



Tefal's red dot UKTM application



What went wrong?

Evidence: high turnover, significant period of use of the mark and survey evidence

"How, and in what manner, the applicant had used or promoted the sign...over and above what would be seen as a mere feature of the product itself"

1. Badge of origin: *indication vs. association, criticism of survey evidence*
2. Exposure: *spent +£20 million in promotion in the UK over the last 10 years, acceptable variants*
3. Indicator of heat: *"used to achieve a technical effect"*
4. Promotional material references: *not as a simple or technical feature*

Registering the *right* trade mark for enforcement



DECATHLON in classes 25 and 28



in classes 25 and 28

- Consider the inherent distinctiveness of the earlier mark
- Consider the evidence of enhanced distinctiveness of the earlier mark
- Consider the stylisation of the later-filed trade mark, its device elements and descriptive additions

Registering the *right* trade mark for enforcement

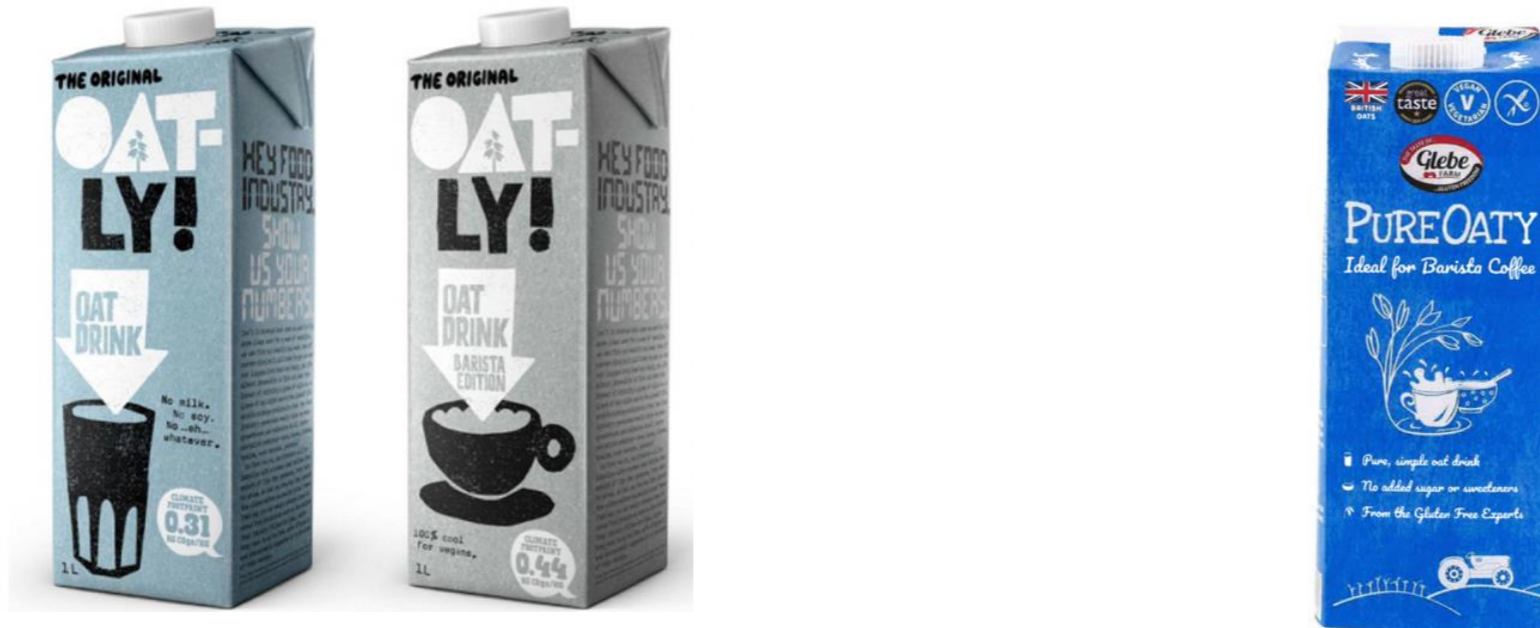


MEA (German TM) in classes 3 and 5

 in classes 3 and 5

- Consider the elements common to both trade marks, and their respective lengths
- Consider which parts attract the attention of the relevant public more
- Consider whether the figurative element of the sign is secondary to the verbal element

Registering the *right* trade mark for enforcement



- Consider the similarities between the marks, including the use of colour
- Consider the risk of damage in use of the later-filed trade mark

Registering the *right* trade mark for enforcement



in classes 9, 16 and 28

GT RACING in class 18

- Consider the stylisation of the earlier trade mark
- Consider whether the stylisation affects the visual, phonetic and conceptual similarity between the signs
- Consider the similarity of the goods at issue

Registering the *right* trade mark for enforcement



in classes 29, 30 and 32



in, amongst others, classes 29, 30 and 32

- Consider the identity between the trade marks
- Consider the overriding impression of the earlier mark on the average consumer
- Consider the visual aspect of the average consumer's purchasing decisions

Registering the *right* trade mark for enforcement



- Consider the orientation of the earlier marks, as registered
- Consider *how* the earlier mark is used – is ancillary protection necessary?

What counts as genuine use?



Genuine use - Recap

(Summary: London Taxi Corporation Ltd v Frazer-Nash Research Ltd [2016] FSR 579)

Sale of secondhand goods

Aiwa Co. Ltd V Aiwa Corp [2019] EWHC 3468 (Ch)

1. Secondhand sales can equate use
2. Thin evidence

"No relevant market share to maintain any more"



Ferrari SpA v DU, C–720/18 and C–721/18



Resale of vehicles and replacement cars

- 1. Is a trade mark which is registered not only in respect of a product, but also in respect of parts of that product also used in a right-maintaining manner in respect of the product if that product is no longer sold, but there are still sales of trademarked accessory and replacement parts for the trademarked product sold in the past?*
- 2. Does the sale of used goods which have already been released onto the market by the trade mark proprietor in the European Economic Area constitute use of the mark?*

What counts as genuine use? Contin...



- The registered goods and services
- How has the product/ service been promoted to consumers?

Sony Interactive Entertainment Europe v EUIPO - Vieta Audio (Vita) Case T-561/20

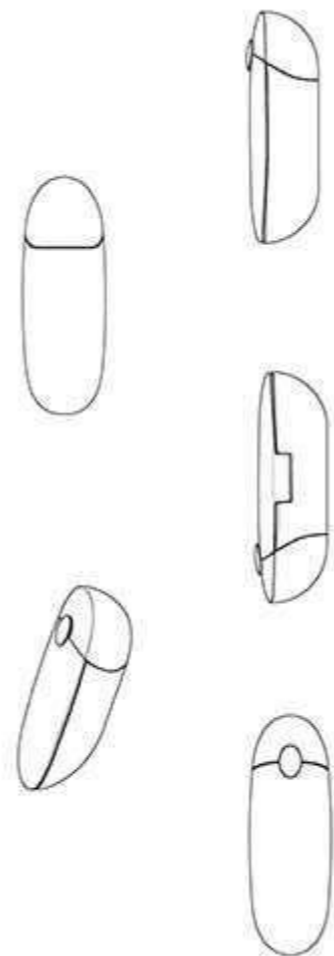
Sony's EUTM registration for VITA (word)

1. The registered goods: *"data carriers containing programs", "audio and/or image carriers (not of paper)"*
2. Promotion of the gaming experience: *"Playstation Vita console is 'a powerful next generation gaming system'"*
3. Purpose or intended use: the multi-functionality of the device was irrelevant
4. Fame doesn't get you everything!

| Guerlain/ EUIPO

Registrable?

YES!



| Jaguar Land Rover v Ineos

Registrable?



Partially

| **Messi**

Confusingly
similar?

YES!



MILEY CYRUS

Confusingly
similar?

YES!



Hendrick's v Lidl

Infringing?



Pending

Colin v Cuthbert

Infringing?



Pending

