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As the cold weather begins, life in Trade Marks is hotting up. Recently, there have been a series of epic clashes between well known and iconic brands such as: Rihanna v Topshop, Nestle v Cadbury and Lush v Amazon all of which are examined in this edition of boult.bites™. I would like to draw your attention to two articles in particular which explore international changes in the law that may directly affect you.

The first article reviews the significance of the recent changes in the **Chinese Trade Mark Law**, which will come into force on 1 May 2014, and the second announces the addition of another country to the **Madrid Protocol** due to take place this month.

As always, should you need further information please contact your usual Boult Wade Tennant advisor or why not attend one of our events? To register your contact details email: teaandtrademarks@boult.com and see [page 2](#) for details about our seminar in November.

Emma Pitcher, Partner and
Charlotte Duly, Trade Mark Attorney,
Editors

> Form and function: (have) a break from the norm?



The Trade Marks Registry of the United Kingdom Intellectual Property Office has recently issued a first-instance decision in an opposition relating to the shape shown above.

The application was filed by Nestle for various kinds of chocolate and confectionery products along with cakes and pastries, and successfully opposed by Cadbury. Although this is only a first-instance decision, the opposition was hard-fought with both sides using expert witnesses, and both sides requesting cross-examination of witnesses.

Two surveys were also presented by Nestle, showing the importance of the case. Allan James, the Hearing Officer for the Registry, is one of the Registry's most experienced and respected officers and is widely known for his learned and carefully-reasoned decisions. This is no exception, the decision coming in at nearly 40 pages long!

The objections raised by Cadbury can be separated into two groups: the first is the

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Boult Wade Tennant's Partner, **Emma Pitcher** will be attending the International Trademark Association's 2013 Leadership Meeting taking place in Miami this year.

distinctive character – or lack of it – of the shape as a trade mark, and the second is whether the shape is such as to be blocked by the exclusions from registration of functional shapes. One crucial difference between the two is that distinctiveness objections may be overcome by evidence of distinctiveness acquired through use, or secondary meaning. The functionality objections may not: they are an absolute bar and any evidence of acquired distinctiveness will not help.

Allan James first of all looked at the two surveys submitted by Nestle. The first, an omnibus survey, was given short shrift: the questions used were hopelessly leading and the

Mr James agreed with Cadbury that the bar shape was necessary to obtain a technical result.

results could not be relied upon. Nestle had, during the course of the opposition, been given permission to submit a second survey. Again, the Hearing Officer had difficulty extracting any useful conclusions and therefore went through all of the individual questionnaire response sheets. He did not accept Nestle's view that the survey showed unqualified trade mark recognition; rather, he found that at least half the respondents probably thought the shape shown was the product known as Kit Kat. However, later in the decision he discussed exactly what kind of recognition this was, and we shall come to this later.

Next, Mr James looked at the expert evidence that each side had submitted, and the cross-examination of those experts. Nestle's witness gave extensive technical information, the thrust of which was that the Kit Kat bar shape contained many arbitrary and non-functional features, but admitted that the design features did have a technical effect. Cadbury's witness went further, saying that there was no other "obvious, practical and economical way of producing such a product" in order to meet the technical, manufacturing and consumer requirements.

Mr James agreed with Cadbury that the bar shape was necessary to obtain a technical result. Although some aspects of the design were arbitrary, that alone was not enough to stop the bar applying, as the "essential features" were caught by the exclusion. The mark was barred from trade mark registration for the goods applied for, with the exception of cakes and pastries only.

That finding alone was enough to block the Nestle mark, but Mr James continued his decision to look at the trade mark distinctiveness arguments, in case he was on appeal found to be wrong about the functionality issue. He quickly found the mark to be prima facie devoid of distinctive character, and then turned to the evidence of acquired distinctiveness. Here Mr James's decision becomes more difficult to understand, with a careful dissection of the state of the case law on the points of use and recognition of a shape as a trade mark. The survey, as noted above, showed significant recognition of the shape as being a debranded Kit Kat bar: however, the Hearing Officer's distinction was that recognition of the mark did not constitute reliance on that mark for trade purposes. The trade mark was therefore devoid of distinctive character, and the evidence did not show acquired distinctiveness.

As we have said, this is only a Registry first-instance decision and is therefore not binding. It is also worth mentioning that both Nestle and Cadbury have a habit of filing appeals, and so we suspect that we have not heard the last of this trade mark application. Even so, Allan James's decisions are often approved by the appeal tribunals, and only rarely overturned, and so it is quite possible that his reasoning will find higher-level support and endorsement.

In any case, it serves as an excellent case study showing the problems of registering shape marks. Practically speaking, shapes are rarely the sole origin-indicator presented on a product, and so it is useful to try to separate out the recognition that arises from the shape rather than from other signs. Even if a survey is found to be acceptable and its questions not leading, the results may well show the wrong kind of recognition, as Mr James found here. In any case, even if the applicant does manage to make out its claim to acquired distinctiveness, the functionality objections can still deal a killer blow. The decision gives an overwhelming impression that registering shape marks is becoming more of a technical possibility than a practical one.

Author: Felicity Hide, Partner

Tea and Trademarks

Adwords – what do they, and should they, mean to me? A seminar about the often mysterious and much publicised: Adwords. Aimed at those that want to protect as well as enhance their online promotional capabilities, it will focus on case studies as well as specific issues participants face.

Wednesday 20 November, 5pm with drinks at 6pm

Invite only event. Join Boulton Wade Tennant's mailing list to be kept up-to-date on all Tea and Trademarks events, including Spring's seminar which will focus on social media. Email your contact details to: teaandtrademarks@boulton.com

> Rihanna v Topshop



In a recent showdown between fashion heavyweights Rihanna and Topshop, the High Court found in favour of the pop diva in an action for passing off. The decision in ***Fenty v Arcadia [2013] EWHC 2310 (Ch)*** concerned Topshop's use of a photograph of Rihanna on t-shirts sold in its stores and via its website in 2012. The photograph used by Topshop was taken during the video shoot for her single "We found love" and depicted the singer sporting the same hairstyle and headscarf as on the front of her album featuring the song. Whilst Topshop had licensed the use of the image from the photographer who took the photo, it had not obtained Rihanna's authorisation to do so. Rihanna claimed that Topshop's use of her image on its clothing without her consent constituted an act of passing off.

The basis of Rihanna's claim was that the use of her image would deceive members of the public into buying the goods because they believed that they were authorised by her when this was not the case. To successfully prove her case, Rihanna was required to demonstrate the three essential requirements of passing off, namely:

1. that she had goodwill and reputation amongst the relevant members of the public;
2. Topshop's conduct constituted a misrepresentation (i.e. deceiving the public into purchasing its goods because they believed them to be authorised by the singer); and
3. That this misrepresentation damaged her goodwill.

An important affirmation in this decision from the outset is that in England, there is no free standing right per se by

public figures to control the reproduction of their image. Mr Justice Birss stated that the mere sale of a garment bearing the image of a famous person, without more, is not in itself an act of passing off.

The English Courts have imposed limitations on the exploitation of "image rights" in today's celebrity business empires so that they are not absolute. The use of a celebrity's image can be prevented in certain instances, including a breach of privacy, but if an action for passing off is brought the claimant must overcome the first hurdle of demonstrating that he or she possesses goodwill in his or her image followed by the exploitation of this goodwill by a third party in a manner causing it damage.

In these particular circumstances, the Court recognised Rihanna's position as a global pop culture and fashion icon. The singer's fashion decisions were shown to be influential amongst young women in particular and that as a consequence, she had goodwill not just as a musical artist, but as a fashion leader.

Topshop is a major high street retailer who has engaged in high profile collaborations and publicity campaigns with celebrities in the past, including Rihanna. The Court observed that the relationship between retailers and celebrities was a symbiotic one where each needs the other to advance their own interests. Having said this, Mr Justice Birss remarked that customers are sophisticated enough not to assume that goods bearing an artist's image are necessarily authorised by that person.

The fundamental consideration in this instance was that Topshop's practice of emphasizing its links with famous

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people and its previous links to Rihanna in particular would enhance the likelihood in consumers' minds that the t-shirt bearing her image was authorised by her. Because the image used on the t-shirts was very similar to that which featured on the album cover released the year before, the Court held that Rihanna fans would associate the image with that album and therefore believe the t-shirt was authorised by Rihanna.

Consequently, the Court found that the likelihood of deception was damaging to Rihanna's goodwill in at least two aspects:

1. Rihanna would suffer lost sales to her merchandising business; and
2. There was a loss of control by the star of her reputation in the fashion sphere regardless of the quality of the Topshop garments.

Whilst this case may present a fresh interpretation of the tort of passing off, the requirement for any claimant to establish damage to its goodwill through misrepresentation remains unchanged.

Author: Anusha Arunasalam, Trade Mark Assistant

> Welcome changes afoot in China

The Chinese Government has now approved the third amendment of the Chinese Trade Mark Law, which will come into force on 1 May 2014.

There is much to appreciate in the new provisions, but more will be learnt when it is actually implemented. In brief, the early indications are that the new Chinese Trade Mark law will be much more similar to UK and Community Trade Mark law.

What will change?

- Sound marks and colour combination marks will now be registrable, though not single-colour marks at this time.
- Multi-Class applications will, at last, be accepted instead of single-Class.
- Oppositions can be raised by any party on any grounds, but henceforth only the owner of relative rights will be able to exercise them in an opposition – exactly as in the UK and CTM.
- In addition, time limits are being set for the Chinese Trade Marks Registry or Trade Mark Appeal Board to handle cases, so that long delays are less likely – but in balance to this, matters can be suspended if, for example, a mark is blocked by another mark which is itself under opposition or examination.

All these developments are welcome to professionals accustomed to UK and CTM practices, but the greatest interest is reserved for the revisions to third-party issues – whether counterfeiting, infringing, or filing applications for trade marks which are owned by other parties in other countries. The penalties for infringement and counterfeiting, and their scope, have increased again. However, it is the third-party “opportunistic” filings which have been popular in China and especially problematic to European and US brandowners, not least because these “opportunistic” filers have been able to act without contravening any law, in many circumstances.

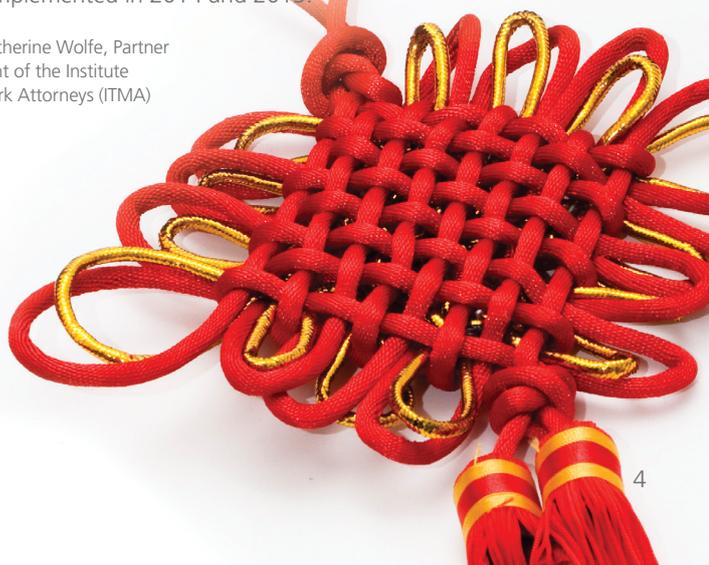
Filings in “bad faith” are now not permitted, i.e. by an agent, attorney or distributor of a trade mark owner, even if the mark has not been used in China first by its “true” owner. If the mark has been used in China before the “third-party” filing, then “bad faith” will extend to any party with knowledge of that brand – which does not necessarily mean a contract, but will require some form of commercial relationship.

Our opinion

In practice, whilst these changes are welcome, they do not affect the fundamental advice that it is still sensible for brand holders to apply to register their marks in China at a very early stage. Registration is still the simplest and least-costly way to limit third-party issues in that country. It is also prudent, when using a mark in China, to see what Chinese name is being used within the market and to register the Chinese name as well. Finally, it is advisable to monitor the use to see whether it changes over time and to keep good records of the use, since the new law maintains a short three-year non-use revocation period, rather than five years which prevails in the UK and CTM.

We shall review how matters progress and how the law is actually implemented in 2014 and 2015.

Author: Catherine Wolfe, Partner and President of the Institute of Trade Mark Attorneys (ITMA)



> Life's not so "lushious" for Amazon

Amazon is being pursued in the UK for trade mark infringement and passing-off by Lush the well-known cosmetics and toiletries retailer. The online retail arena has been a high profile battleground for major brands and this is not the first time Amazon has been involved in such a dispute.

Trademark infringement claims involving high profile companies include the dispute between Interflora and Marks & Spencer and most recently between Apple and Amazon over the "App Store" name have made the headlines. The Interflora case is a valuable precedent for this case with which it has many similarities. As with the Interflora case the dispute centres on the use of Lush Google AdWords. Lush objected to Amazon's use of terms like "Lush" and "Lush Bath Products" to generate results for Amazon, the result of which is that people are being redirected to Amazon's website and being shown non-Lush products. In many instances these products are very similar to Lush products.

Previously, the Court of Justice of the European Union clarified that the origin function of a trade mark is affected where a reasonably well informed and reasonably observant user cannot tell if the goods originate from the trade mark proprietor or a third party.

The judgement in favour of Interflora noted that *"the average reasonably well informed and reasonably observant internet user is not particularly technically literate, does not know precisely how AdWords operates and is not aware of the issues."*

A key difference between the disputes is the Interflora network – a large number of member florists, many of whom trade under their own names. In that case the use of Google AdWords could have led people to believe that the Marks & Spencer flower delivery service was part of the Interflora network, when in fact they were not.

There has already been a pre-trial hearing; Lush's request for a survey to identify levels of consumer confusion was rejected due to the judge believing it had no real value, but a passing-off claim was allowed. This again shows the UK court's reticence to allow survey evidence given the danger of participants being led "into making an answer whether they wanted to or not".

We await the Lush decision with interest. In the meantime, further information on AdWords can be found in our earlier bulletin: http://www.boult.com/includes/documents/cm_docs/2013/b/bulletin-adwords-in-a-nutshell-may-2013.pdf

Author: Emma Pitcher, Partner

> Confusion between skincare and nail care? Let us shed some LUMOS

Lumos Skincare Ltd - v - Sweet Squared Ltd & Others [2013] EWCA Civ 590

This recent Court of Appeal (CA) decision analysed a passing off claim where the marks at issue were identical. The mark LUMOS was used in relation to skincare products by the Claimant and nail care products by the Defendant. This case is of particular interest because it was decided by a majority of 2:1, with two of the CA Judges agreeing and the third dissenting.

The initial passing off action began in the High Court but was transferred to the Patents County Court. The appeal was heard at the CA and it should be borne in mind that whilst there is a costs cap on cases before the Patents County Court, the costs at appeal are not capped.

At the original trial, the trial judge held that the Claimant had established goodwill and that if the Defendants had made a misrepresentation it was likely there would be damage. However, the trial judge found that a misrepresentation had not been successfully made out and therefore dismissed the claim. The current appeal was brought to argue the misrepresentation point.

Background and the original decision

The Claimant's products were sold for between £40 to £100 per bottle since 2007. The Defendants launched their nail care products in October 2010. Both parties sold their products via beauty salons to trade customers. The products were then sold by the salons to their customers to use at home and as such the marks were also consumer facing. The Claimant further sold products in a retail establishment in London.

At first instance a finding of no misrepresentation was established for a number of reasons, including that the Claimant only had a very modest reputation and goodwill which were limited to high end anti-aging products in the skincare industry. Their small customer base meant that the number of people to whom the Defendants could present a misrepresentation was limited. The trial judge also found a distinction between the skincare industry and the nail care industries and was unsurprised by the lack of actual confusion due to the lack of side by side trading.

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The appeal

The misrepresentation point was discussed at length in the appeal decision which numbered 110 paragraphs. One key piece of evidence was an email from one of the Claimant's trade clients which enquired whether there was a connection between the skincare and nail care brands. The author of that email was not called as a witness and therefore little weight was given to the evidence at trial. In the appeal decision, it was found that *"the email speaks for itself"* as to the author's immediate reaction to discovering the LUMOS nail products, stating *"I doubt that for her to have made*

a witness statement, perhaps a year after the date of the email, and to be cross-examined fourteen months after sending the email, would be likely to have cast any more light on the nature of her reaction than could be obtained by reading the email in its

context". The email was found to be evidence that end users of the products may be misled and a likelihood of deception was shown by inference.

It was found that the products were in the same market as they are promoted, used and sold in the same salons, noting that *"even though skincare and nail care represent different sectors of the beauty industry, they are not entirely distinct"*.

Reviewing the original judgement, on appeal it was stated that *"...although he was applying the correct legal test, he wrongly applied it by reference to a view of the facts, as to the relevant class of people to whom the representation made by the Defendants' use of the mark would be addressed, which was inconsistent with the evidence and with his own findings elsewhere in the judgement"*.

The dissenting CA judge agreed with the trial judge and found that the evidential weight of the single email was small and that the author was not deceived. The dissenting judge considered that the small number of outlets that sold the relevant goods and the fact that most sales were to professional salons should have made it easy for the Claimant to obtain evidence of customer confusion from the trade purchasers of the products to prove that there was a misrepresentation.

One key piece of evidence was an email from one of the Claimant's trade clients which enquired whether there was a connection between the skincare and nail care brands.

As two of the judges agreed, the appeal was allowed and an injunction against the Defendants was granted.

The Defendant may well appeal this decision to the Supreme Court, where again costs will not be capped. Watch this space!

Author: Charlotte Duly, Trade Mark Attorney

> Tunisia joins the Madrid Protocol on 16 October 2013

Tunisia is to become the latest African country to join the Madrid Protocol concerning the International Registration of Trade Marks. From 16 October 2013, trade mark owners can designate Tunisia as part of a new Madrid Protocol international application.

Once Tunisia joins, 15 African countries will be members of the Protocol and the total number of contracting parties will be 91. The other African members are Botswana,

Ghana, Kenya, Lesotho, Liberia, Madagascar, Morocco, Mozambique, Namibia, Sierra Leone, Sudan, Swaziland, Zambia and Rwanda (which joined on 17 August 2013).

With the number of contracting parties of the Madrid Protocol increases, the system becomes an even more attractive method of protecting trade marks around the world.

Author: Charlotte Duly, Trade Mark Attorney



> Touching the parts other IP rights cannot reach – Design Rights the unsung heroes of the IP world

Design rights are often described as the forgotten IP rights. They may lack the glamour of other types of IP rights, but to forget them is unfair. Design rights can play an important role in any IP portfolio, providing an additional layer of protection. In a nutshell, they can touch the parts other IP rights cannot reach.

So what constitutes a design? The broadest definition can be found in the Community Design Regulation which describes a design as: *“the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”*. The breadth of this definition is due to the interpretation of what constitutes a product. Here the definition includes things which would not traditionally be seen as designs; from the more traditional physical items such as furniture through to the unexpected: product packaging, computer icons, logos, website layouts and even aircraft interiors.

With the shape of products the appeal of a design is obvious. Products cannot easily be protected by trade mark rights, if at all, and are not typically within the remit of patent protection. A design right therefore provides a degree of protection and fills this gap. Even with non-obvious designs (logos, website layouts etc) the advantages of a design right is that it provides an enforceable registered right often where other rights may not be available.

Furthermore, a design right can be a useful deterrent as it provides a tangible, registered right. This may aid in deterring others from attempting to appropriate as well as simplify enforcement and increase cost effectiveness. Rather than having to show copying, it is only necessary to demonstrate that the alleged infringement produces a similar overall impression on the informed user. This has wider applicability and in some cases is easier than showing that copying has occurred.

Design applications in the UK/EU are processed quickly. It is possible to receive a registration certificate within days of an application, giving instant protection. The cost of a design is also low. A benefit which is often overlooked is that multiple designs belonging to the same category can be included in a single application, making designs a cost effective option.

There are, however, limitations on design rights. Firstly, in order to secure a design it must be novel and have individual character. This means no identical designs can exist on the market and it must produce a different overall impression on the informed user to other designs already available. These are technical requirements and if there is any doubt we recommend discussing them with us first. The design in

question must also have been publically available for less than 12 months. It is therefore essential to put design protection in place as soon as possible and to undertake regular reviews of what you are producing in to identify potential design applications before this period expires. Finally, designs are limited in time. They can be renewed every five years up to a total of 25 years after which point the design lapses and becomes available to all. However, during this period, for some products, it may have been possible to secure evidence of distinctiveness through use in trade which may allowing trade mark rights to be obtained through registration. Despite these limitations design rights have a valuable role to play in any IP portfolio, supporting other IP rights such as trade marks and providing protection for elements which would not otherwise be protectable. They can have a deterrent effect. Overall, they are solid, dependable, low cost and rapidly acquired IP rights. Design rights may not be all that glamorous like their trade mark and copyright cousins, but they certainly deserve more recognition.

Author: Peter Vaughan, Trade Mark Assistant

> Vienna Agreement on Figurative Marks entered into force in the UK on 11 September 2013

The UK has acceded to the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, thereby adopting the common classification for the figurative elements of trade marks. This affects how device marks are classified on the UK Register and therefore impacts on the searching of logos. When conducting searches for such marks our team will determine the best Vienna Codes to be covered.

The instrument of accession contains a declaration that the UK intends to avail itself of the provisions of Article 4(5) of the Agreement which states “Any country may, at the time of its signature or of the deposit of its instrument of ratification or accession, declare that it does not undertake to include the numbers of all or some of the sections in official documents and publications relating to registrations and renewals of marks.”

Author: Charlotte Duly, Trade Mark Attorney

> In the inside lane – UKIPO new fastrack opposition procedure

The United Kingdom Intellectual Property Office (UKIPO) has this week launched a new Fast Track opposition procedure. In a move aimed at making oppositions less time consuming and more cost-effective for SME's, the fast track system should offer a cheaper, quicker, front-loaded procedure for the owners of earlier UK Trade Mark registrations where a conflict is perceived.

Aside from providing easier "access to justice", the aim of this new procedure, as stated by the UKIPO, is "to benefit business by improving access to opposition proceedings at a cost proportionate to the complexity and value of the matter at stake".

The new system can only be used by parties wishing to oppose registration of United Kingdom trade mark applications that are either identical or similar to their earlier trademarks, and which cover identical or similar goods and services (e.g. solely on the basis of double identity or likelihood of confusion).

Unlike the UKIPO's standard opposition procedure, other bases of opposition such as "passing off" and reputation cannot be claimed under the Fast Track system, and a maximum of only three earlier marks can be relied upon.

The official fee for Fast Track oppositions has also been reduced by 50% compared to the standard procedure.

Procedure

Fast Track oppositions will have to be front loaded: a Statement of Grounds, along with full evidence of use if any earlier mark relied upon is more than 5 years old, must be filed with the official Fast Track Notice of Opposition (Form TM7F).

Once filed, a Fast Track opposition will be served by the UKIPO on the applicant, who is then set a usual two-month deadline

to file a TM8 defence counterstatement (if no counterstatement is filed then the opponent automatically succeeds). The UKIPO will then decide on the opposition based on the papers before it, with the aim being that a decision will issue within 6 months, rather than 9-18 months typical in normal oppositions.

It appears very unlikely that further evidence rounds or oral hearings will be granted by the UKIPO in Fast Track oppositions; however, in order to explore settlement negotiations, the parties may enter into a cooling-off period for up to 18 months before a decision is made by the UKIPO, as provided under the normal procedure.

Fast Track opposition decisions will also still be appealable, up to the Court of Appeal or Appointed Person, as is the case with normal oppositions.

Aim and Effect

Fast Track oppositions are geared towards disputes wherein there is no issue regarding the validity of earlier registration(s), with legal argument and paper-based comparison of the marks, rather than factual evidence, being important.

Fast Track oppositions should provide a quicker and lower-cost option for trade mark proprietors in a number of circumstances.

Interestingly, not only will the Fast Track assist SME's in enforcing their trade mark registrations quicker and more cost-effectively, the new system may also be useful for larger entities, for whom receiving an opposition decision within 6 months may be very useful if they have many sub-brands evolving within fast-moving industry sectors.

Author: Luke Portnow, Trade Mark Assistant

> Goodbye Patents County Court, hello Intellectual Property Enterprise Court

The Patents County Court has been renamed the Intellectual Property Enterprise Court (IPEC). The change of name clarifies that the Court deals with all forms of IP, not just patents. The IPEC sits within the Chancery Division of the High Court and the change of name marks the end of a range of reforms brought in to assist business in protecting their intellectual property.

Catherine Wolfe, partner at Boulton Wade Tennant praised the move, stating "At last the name of the Court reflects the areas of activity of the Court. The implication that only patents were discussed in the Patents County Court was always misleading. Now that the Patents County Court has been renamed the Intellectual Property Enterprise Court, it is clear to all that its interest lies in all Intellectual Property".

We believe the IPEC provides better access for SMEs and individuals to a streamlined process for lower value claims, with capped costs and damages. However, users should be aware that the IPEC is not the only forum available. Even when a case begins in the IPEC there is still the possibility of transfer to the High Court and appeals can go up to the Court of Appeal and Supreme Court. Legal issue can also be subject to referrals to the Court of Justice of the European Union. These possibilities come with associated (much) higher price tags in terms of cost.

For more information on the IPEC please speak to your usual advisor.

Author: Charlotte Duly, Trade Mark Attorney



> Case C 252/12 Specsavers International Healthcare Ltd v Asda Stores Ltd

The Court of Justice of the European Union (CJEU) has recently handed down guidance in this case, following a request by the Court of Appeal (CA) for clarification of the law relating to genuine use of a trade mark and the relevance of a reputation in colour.

The dispute concerned a 2009 marketing campaign launched by Asda to promote its line of opticians. Asda made use of a variety of advertising slogans, such as “Be a real spec saver at Asda” and logos including two adjacent ovals on a green background with the words “ASDA Opticians” superimposed over the top, which were alleged to infringe registered Community trade marks (CTMs) owned by Specsavers.

The CA, reversing the first instance decision of Mr Justice Mann in the High Court, found no confusion but that Asda had nonetheless infringed the registered trade marks belonging to Specsavers by taking unfair advantage of Specsavers’ reputation in their trade marks. However there was also a question of whether the so called “wordless logo mark”, a CTM owned by Specsavers consisting of a logo of two overlapping ovals, was liable to be revoked for non-use, since it had only ever been used on its own, without the superimposed words “Specsavers” on top. If the mark was found valid it would need to be decided whether it too had been infringed.

In order to decide on this point the CA found it necessary to ask the CJEU whether use of the composite mark, namely the overlapping ovals superimposed with the words

“Specsavers”, can constitute use of the wordless logo mark for the purposes of maintaining that registration. Secondly the CA also took the opportunity to ask whether the enhanced reputation of Specsavers in the colour green, through their longstanding use of this colour, could be taken into account in the assessment of infringement, given that the trade mark was registered in black and white.

In answer to the first question, the CJEU stated that use of a composite mark could be genuine use of the wordless logo, as long as the underlying wordless logo was recognised by consumers as having an independent distinctive role in denoting the goods of Specsavers.

The ruling of the CJEU is unsurprising, in view of the recent decision in *Colloseum Holding v Levi Strauss AG*, where the referring Court asked for guidance on a very similar question. However since that case concerned a trade mark which had been registered on the basis of distinctiveness acquired through use, Specsavers appears to create a significant extension to this principle and almost appears to open the doors for quasi-defensive registrations.

Brand owners who have registered individual components of their composite trade marks as separate trade marks would be well advised to consider whether it is possible to make some use of each element on its own, in order to avoid the tricky question of whether the element in question would be recognised by consumers in isolation as referring to their goods.

The CJEU, making short work of the second question, answered that consistent use of a black and white registered trade mark in a particular colour is a relevant factor to be taken into account in the assessment of infringement. However the fact that Asda also had a reputation in the colour green was a factor which, in this case, must also be taken into account.

The portion of the ruling relating to the question of colour is uncontroversial and is good news for brand owners who have pursued the well-established filing strategy of registering a trade mark in black and white to obtain protection for use of the trade mark in all colours, especially where the trade mark has been consistently used in a particular colour or combination of colours.

Author: Donna Trysburg, Trade Mark Assistant

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