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Trade Mark Assistant Luke Portnow has recently been published in respected industry magazine TBO, which is part of the World Intellectual Property Review (WIPR) family. [Read his article in full in this newsletter](#). The exploitation of counterfeit products now on offer is a real problem our clients face. Suzanna Skier tackles the issues in her article: **A chip off the old block...ing injunction**. Learn about the outcome of the entrenched and long running battle between Asda and Specsavers on **page 4** and find out about how important **evidence** is when trying to allege passing-off.

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## > A chip off the old block...ing injunction

It's another website blocking injunction, but this time in the trade mark world.

*Cartier and Others v BskyB and Others [2014] EWHC 3354 (Ch)*

The Internet is an enticing outlet for suppliers of counterfeit goods and recently there has been an explosion in the sale of such goods online. From a brand owner's perspective, this is obviously a big problem, especially for premium brands such as Cartier who rely on an air of exclusivity and prestige surrounding their high quality brands. Moreover, in the non-cyber world, consumers can often tell they are getting a cheap imitation by simply picking up the branded merchandise and holding it in their hands; but over the web, this is not so easy.

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Editors: Emma Pitcher, Partner and Charlotte Duly, Partner

### Emma Pitcher

Partner, Trade Mark and Domain Names Group

Emma Pitcher, trade mark Partner and Chair of the Europe & Central Asia Subcommittee of the INTA Non-Traditional Marks Committee (INTA), will be speaking at the International Trademark Association's conference in New Delhi on Friday, 6 February 2015.

The conference titled: 'India Emerged, protecting your brand in India's evolving economy' will address numerous topics including: the Madrid Protocol, ICANN: new gTLDs and parallel imports.

Emma will speak on the topic of 'Parallel Imports: The Many Shades of Gray!', exploring the difficult issues associated with the regulation of the grey market goods and the problems they create for trade mark owners in Europe. She will be highlighting ways to protect against infringement as well as available remedies.

For more information and to register for this conference, go to [INTA's website](#).



Richemont, the owners of a large number of trade marks in the UK such as Cartier, Montblanc and IWC, know all too well that to track down the manufacturers and marketers of the thousands of imitation goods sold via e-commerce is near impossible. Offending websites will likely be registered abroad in places such as China, making their activity difficult to curtail. Despite Richemont sending cease and desist letters to the operators of the six infringing websites in question, they were predictably ignored leaving them with no recourse other than to take Court action.

### The questions for the Court

Richemont sought an order to force the five main UK Internet service providers (ISPs) Sky, BT, EE, Talk Talk and Virgin, to block subscribers' access to six websites which advertised and sold counterfeits of Cartier, IWC, and Montblanc. The six infringing websites were: [www.cartierloveonline.com](http://www.cartierloveonline.com), [www.iwcwatchtop.com](http://www.iwcwatchtop.com), [www.montblancpensonline.co.uk](http://www.montblancpensonline.co.uk), [www.hotcartierwatch.com](http://www.hotcartierwatch.com), (this website went offline during proceedings) [www.replicawatchesiwc.com](http://www.replicawatchesiwc.com), [www.iwc.com](http://www.iwc.com) and [www.ukmontblancoutlet.co.uk](http://www.ukmontblancoutlet.co.uk). Richemont stated that these were merely the first in a line-up of 239,000 potentially infringing sites it had become aware of. This corroborates the extent of a problem currently forecasted to cost the economy \$960 billion a year by 2015, according to an OECD study.

In assessing whether Richemont should be granted a blocking injunction against the ISPs, Mr Justice Arnold addressed five overarching issues in his meticulous 266 paragraph judgment, namely:

1. Does the High Court have jurisdiction to make an Order of the kind sought?
2. If the Court has jurisdiction, what are the threshold conditions, if any, which must be satisfied if the Court is to make an Order?
3. Are those conditions satisfied in the present case?
4. If those conditions are satisfied, what are the principles to be applied in deciding whether or not to make such an Order?

5. Applying those principles, should such Orders be made in the present case?

Arnold J took heed of case law that has developed over the last three years relating to blocking injunctions for ISPs where they have hosted websites infringing copyrighted music and films pursuant to s97A CDPA 1988. However, this was the first case of its kind in the trade mark world, as no express statutory equivalent to s.97A exists for trade marks.

### Jurisdiction of the Court

The UK Government implemented Article 8(3) of the Information Society Directive 2001/29/EC allowing website blocking injunctions based on copyright infringement but the Government did not implement part of Article 11 of the Enforcement Directive 2004/48/EC. The unimplemented part states that:

*"...Member States shall also ensure that right holders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an **intellectual property** right..."* [emphasis added]

As a result, the defendant ISPs contended that the Court had no jurisdiction to make Orders such as those sought by Richemont, as the relevant provision had not been implemented into UK national law.

**"...Member States shall also ensure that right holders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an **intellectual property** right..."**

s.37(1) which did not support any legal or equitable right, and was not the result of any unconscionable conduct by Apple. Arnold J concluded that this confirmed the Court has unlimited power to grant injunctions under s.37(1) and that such injunctions can be employed in new ways.

Arnold J then contemplated the idea that if the Court did not in fact have power to grant the injunction sought upon a purely domestic interpretation of s.37(1), European

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Law could instead confer the requisite power. Arnold J stated at paragraph 132 of his judgement that s.37(1) can and should be interpreted in compliance with the third sentence of Article 11, thereby confirming that Article 11 should have indirect effect in UK Law.

Much to Richemont's delight, having provided a thorough analysis of the relevant legislation and scrutinising further case law, Arnold J added that not only did the High Court have jurisdiction in accordance with a purely domestic interpretation, but the Court also had jurisdiction by virtue of EU Law.

### Threshold conditions

Pursuant to arguments made in cases such as *L'Oreal v eBay*, Arnold J stated that the Court did not have unfettered discretion to grant s.37(1) injunctions. On the contrary, it was adjudged that despite the Courts unlimited power to grant injunctions, similar threshold conditions must be satisfied for a website blocking injunction in a trade mark case, as those in the previous copyright cases. The four conditions to be satisfied are:

1. The defendants must be intermediaries within the meaning of Art 11 (this was not disputed)
2. The operator of the website must infringe Richemont's trade marks (this was not disputed)
3. The users and/or operators of the website must use the defendant's services to carry out the infringement (since the infringement was via the ISPs' services who supply to 95% of broadband users in the UK, the Judge held the ISPs had an essential role in the infringements)
4. The defendant must have actual knowledge of the infringement (Richemont sent the ISPs emails regarding infringement that had arisen following test purchases they had made.)

The second threshold condition, although not at issue in this case, is likely to be a restraining factor in future proceedings as not all uses of a trade mark will constitute infringement. For example, the inclusion of a trade mark may be permitted for the purpose of description or comparison; therefore, care will have to be taken to avoid closure of websites that merely use trade marks to, inter alia, review products. Such closures could be considered an unethical restriction on freedom of speech.

In relation to the last point, if an ISP could be required to block websites *without* having actual knowledge of infringing activity, that would be tantamount to a general obligation to monitor which is precluded by Article 15 of the E-Commerce Directive. These threshold conditions will

hopefully serve as a valuable aid in keeping further case law in line with the European Directives.

In addition to the threshold conditions pertinent for the grant of an injunction, Articles 3(1) and 3(2) of the Enforcement Directive require the relief to be (1) necessary (2) effective (3) dissuasive (4) not unnecessarily complicated or costly (5) avoiding barriers to legitimate trade (6) fair and equitable and (6) proportionate. Arnold J considered these principles one by one.

### Necessary

Arnold J considered that no alternative remedy would be as effective as granting a website blocking injunction. On this topic, paragraph 197 of his judgement contains an enlightened assessment of blocking Orders and the availability of alternative measures such as custom seizure, de-indexing of websites, suspension of merchant accounts by payment processors, notice-and-takedown by hosts and direct action against the website operators.

As well as the legitimate interests of the claimants in curtailing the infringing websites' activities, there is also a degree of public interest in preventing infringement and counterfeiting, all of which led him to conclude that the Order was necessary and proportionate.

### Effectiveness of the measures

In previous s.97A cases, verification of declining consumer interest in sites that were blocked was provided and Arnold J considered that this was a worthwhile outcome of the Orders. He noted that in the context of trade mark infringement, the outcome of blocking such websites may even be more effective than the blocking of copyright infringing sites had been, as the counterfeit sites enjoyed less brand loyalty amongst consumers than sites like the Pirate Bay. There was no doubt that such measures would at least be somewhat effective.

### Dissuasiveness

Arnold J concluded that the blocks would have some dissuasive significance. The criterion was not fulfilled by the blocking Order as such, but by the information that would be displayed to users who tried to access the websites informing them of reasons why they had been blocked.

### Costs

Arnold J held that trade mark proprietors should bear the cost of the blocking injunction application, whereas

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ISPs will bear the costs of implementation. The court also needed to take into account the possible wider economic costs that would be incurred should the decision to grant an Order in this case open the floodgates to large numbers of other applications. Arnold J considered it was more appropriate for the costs to be borne in this way, than for the brand owners to pursue each infringer separately without the ISPs.

### Safeguards against abuse

Since evidence had been produced showing that there were huge numbers of websites infringing the trade marks of the current claimants, appropriate safeguards were required in order to ensure that ISPs were able to apply to court to vary or discharge the Orders if the costs of implementation became significant. It was adjudged that the Orders should identify the parties who obtained the Order, and state that they have the right to apply to Court to discharge the Order and also have a 'sunset clause,' under which the Order would cease to have effect after a defined period (Arnold J indicated an initial period of two years).

### Conclusion

This decision provides a welcome recognition of the problems brand owners face when dealing with the reality of online counterfeiting. Infringers are often based outside of the jurisdiction of the UK/EU Courts and are very difficult to identify. It gives trade mark owners, particularly those who deal with frequent infringements, another option to deal with counterfeit goods where other avenues such as de-indexing of websites and payment freezing are futile or have failed and in the case of premium brands such as Cartier, and will go some way to restoring the air of exclusivity and prestige surrounding them.

Given some of the principles applied in the judgment, it may also open the door to more Orders of this type which can only be good news for brand owners.

If you would like more advice please speak to your usual Boult Wade Tennant adviser.

**Author:** Suzanna Skier, Assistant



## > End in sight for Specsavers and Asda

Specsavers International Healthcare Ltd & others v. Asda Stores Ltd v. Registrar of Trade Marks [2014] EWCA Civ 1294 (CA)

The long running dispute between Specsavers and Asda concerning a 2009 marketing campaign launched by Asda to promote its competing optician services has finally drawn to a close with the handing down of this decision by the Court of Appeal (CA) in October 2014.

Specsavers and Asda had in fact settled their dispute out of court prior to this hearing. However, the terms of the settlement permitted Specsavers to pursue their appeal against the finding of the first instance court that their so called "wordless logo mark" was to be revoked for non-use. Thus this was the only remaining issue for the CA to decide upon.

Readers who have been monitoring this saga will recall that the Court of Appeal had previously found that Asda's use of a variety of advertising slogans, including "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, had infringed Specsavers'

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registered trade marks under section 5(3) of the Trade Marks Act 1994, by taking unfair advantage of the reputation built up by Specsavers in their trade marks.

There was also a question of whether the "wordless logo mark", a Community Trade Mark owned by Specsavers consisting of a logo of two opaque black overlapping ovals, was liable to be revoked for non-use, since this mark had never been used in the format as registered. In fact Specsavers had only ever made use of their mark in colour, with shading where the ovals overlapped, and together with the superimposed word "Specsavers". The CA referred some questions to the Court of Justice of the European Union (CJEU) to help it determine whether Specsavers' use could constitute genuine use of the wordless logo mark. The CJEU answered that use of a composite mark could indeed be genuine use of the underlying wordless logo, as long as the wordless logo was recognised by consumers as having an independent distinctive role in denoting the goods and services of Specsavers. Furthermore, the CJEU held that a trade mark which is registered in black and white but consistently used in a particular colour or combination of colours can have this use taken into account as a relevant factor in any assessment of whether infringement has occurred.

The CA, now with the benefit of the CJEU's guidance, found that the wordless logo mark was recognised by consumers as designating the goods and services of Specsavers independently of the other elements used with it, and accordingly overturned the order for revocation of Specsavers' registration issued by the first instance court.

In reaching its decision the CA was careful to point out that in general it is unlikely that the background of a composite mark will be perceived by a consumer as an indication of origin. In this particular case the court was persuaded that Specsavers had established that much of the use they made of the shaded logo mark

also constituted use of the wordless logo mark, due to the extensive and "powerful" evidence of use they put forward. Evidence that consumers recognise the shapes of the ovals from a distance on signage and on shops, before they see the words Specsavers, was cited as particularly convincing, as was evidence of Asda's logo development process, in which Asda's marketing team used Specsavers' wordless logo mark as the starting point for their own logo and moved what they considered to be a safe distance away, showing that Asda was well aware that overlapping ovals denoted Specsavers in that market.

Since the parties settled prior to the hearing, the CJEU's guidance on colour was no longer relevant to the appeal. Therefore, the CA did not need to make a decision as to whether Asda had infringed the wordless logo mark leaving the legal and business communities, in need of further guidance on questions of marks which are registered in black and white but used in colour, in the wake of the **Common Communication on the Common Practice of the Scope of Protection of Black and White Marks** issued recently by OHIM and the EU national IP offices. The Common Communication is not law, but simply a statement setting out the practice of the participating IP Offices. In Specsavers the CA stated, obiter, that as per the court's previous case law, a trade mark which is registered in black and white but without any colour limitation "is registered in respect of all colours", which is clearly inconsistent with the position taken in the Common Communication. It appears that we will need to wait a little longer for a case which will put Trade Mark Office practice under the Common Communication to the test.

If you would like more advice please speak to your usual Boult Wade Tennant adviser.

**Author:** Donna Trysbury, Assistant

## > Clash of the Colleges Cranford: Community College v Cranford College Limited 2014 EWHC2999

This decision from the Intellectual Property Enterprise Court reminds us that when trying to allege passing-off it really is all about the evidence.

The Claimant Cranford Community College (CCC) launched passing-off proceedings against Cranford College Limited (CCL) on the basis of the latter's use of CRANFORD COLLEGE in their name and on the basis of the logos used. CCL was also the owner of two UK trade mark registrations and CCC applied to invalidate those on the grounds of passing-off and bad faith.

CCC is state secondary school that has been in existence since 1975, initially under the name Cranford Community School and since 1997 under the name Cranford Community College. CCL is a privately owned educational establishment that was incorporated on 25 June 2010 and accepted its first enrolment in October 2011.

Cranford is a part of West London in which both parties are located. Due to this, there were descriptiveness issues that CCC needed to overcome.

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## **Passing off**

Uncontroversially, the classical trinity of goodwill, misrepresentation and damage were, as always, required.

### **Goodwill**

There was a side issue regarding the assignment of goodwill regarding CCC's status before and after incorporation. However, not much turned on this point.

It was confirmed that goodwill could extend to a school in the state sector. Private schools have previously been found to have goodwill and the Judge cited the case of Eton school more than once. Passing off had to be assessed as of the date that CCL's conduct was first complained of, which was February 2011 when CCL's website went live.

### **Descriptive names**

CCL relied on the descriptive nature of their name, stating that "*Cranford College describes literally what it is: a college in Cranford*". The Judge agreed, accepting that Cranford College is *prima facie* descriptive. A descriptive name can be protected under the law of passing-off if it has acquired a secondary meaning sufficient that the Claimant's goods or services are distinguished from those of others. However, where a name is descriptive, such as in the present case, a Defendant can avoid passing-off by changing minor details in the name as discussed in the Office Cleaning Services case.

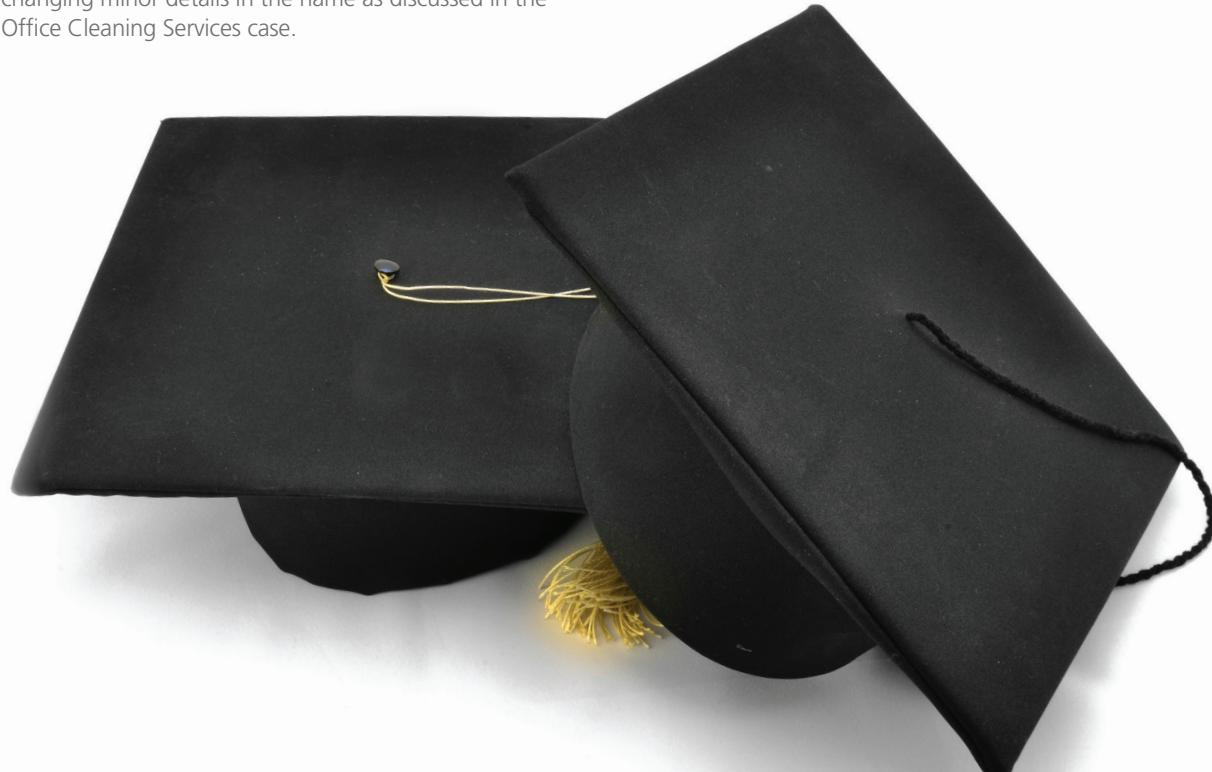
Furthermore, caution needs to be exercised to make sure that any confusion is the type of confusion which is actionable under passing-off. If there is confusion caused by the use of common descriptive words then that is not misrepresentation, it is just confusion due to the selection of descriptive terms. Even if that descriptive term does have a secondary meaning, the Judge stated that "*the scope of protection afforded in respect of a descriptive name with a secondary meaning is liable to be narrower*". The Judge also stated that what initially looks like relevant confusion may not be because if the name at issue has not acquired secondary meaning then this will not be evidence of a misrepresentation.

### **CCC's case**

CCC agreed that its best case was in the name Cranford College. CCL submitted that this was *prima facie* descriptive and the Judge accepted this, applying a literal meaning of a College located in Cranford. Therefore, CCC needed to show that by February 2011 they had acquired secondary meaning in Cranford College.

The relevant public was discussed and these were found to be a very narrow group of individuals and was likely to be narrower than the public living in Hounslow, Ealing and Hillingdon who were, in particular, parents, guardians and students and for whom Cranford College has brand recognition.

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CCC submitted evidence to show that Cranford College had acquired goodwill and a secondary meaning but this was largely found to be contradictory and most of the evidence was too late to prove goodwill at the relevant date. Whilst the Judge found that CCC had generated a reputation as "a particularly fine school" it had not shown that it had goodwill in the name Cranford College by February 2011. As such, the first element of passing-off could not be established.

In relation to the logos that CCC used, the secondary meaning was not a problem as they were inherently distinctive. However, CCC did not file any evidence to show that the relevant public identified its goods or services by reference to the logos such that any significant goodwill would be attached to these. As such, goodwill was not shown in these marks.

A common field of activity is not required for a passing-off claim to succeed but it can assist. In the present case, the Judge found that there was not a particular overlap between the parties' services; one is provided by the State to secondary school students and the other is provided on a private basis for those who have left school. However, the activities were close enough that a connection between the two institutions was not entirely improbable.

CCC filed evidence to show there was a misrepresentation which largely consisted of showing that CCL did not take sufficient steps to check for third party rights when setting up the company. The Judge did not find that there was any evidence of a deliberate intent by CCL to pass itself off as CCC.

CCC filed evidence of confusion and relied on the nine most promising examples. All of these were given fairly short shrift as none of the evidence came from individuals who formed the relevant public for the purpose of identifying misrepresentation. Instead, the type of

confusion which occurred was deemed by the Judge to be the sort that is expected when two organisations use the same descriptive name.

No evidence of misrepresentation was filed by CCC in relation to the logos.

In relation to damage, CCC argued that there was a risk of the school acquiring a bad reputation due to CCL's activities which could lead to fewer applications and lower funding for the school. However, there was no evidence of a misrepresentation so any arguments on damage were not relevant.

In relation to revocation of CCL's registrations, there was little argument about these issues during the trial as it was accepted that CCC's case would either succeed or fail on their argument of passing-off. As this failed, the invalidity actions also failed. Furthermore, there was no evidence to support the bad faith ground as it was determined that CCL had not intended to pass-off its services at those of CCC. Therefore, CCC's action was dismissed.

## Summary

This case reminds us that evidence is key and all three strands of a passing-off claim must be satisfied in order to be successful. However, this case is a useful reminder that the law of passing-off is not only concerned with the goodwill and business of a trader as it can also be relied on to protect non-traders such as state schools, churches and charities.

If you would like more advice please speak to your usual Boult Wade Tennant adviser.

**Author:** Charlotte Duly, Partner

## > AdWords: clarity out of confusion

The position on trademark infringement regarding Google AdWords and keyword bidding has been clarified in recent years with a number of rulings handed down by the CJEU.

As Europe's highest court, the Court of Justice of the EU's (CJEU) decisions are binding throughout the EU. Its rulings on AdWords have originated from national courts, which refer to it questions on points of European law, especially in relation to the Community Trademark (CTM) Regulation. The Regulation provides for CTM applications and the harmonisation of trademark law throughout the EU. This article examines the significance of these recent

rulings, and how they have been interpreted by national courts, particularly in the UK.

### Google France v Louis Vitton

The first important case was Google France v Louis Vuitton, in which Louis Vuitton Moët Hennessy (LVMH) had argued that Google was infringing its trademarks when it allowed anyone other than LVMH to bid on its registered marks using the AdWords system.

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The CJEU ruled that Google is an information service provider and so does not infringe any trademarks but only creates the environment in which trademark owners and advertisers do business. Put simply, a referencing service provider such as Google is not involved in the use of a trademark "in the course of trade", the court said.

However, the CJEU did go on to state that "in the case where a third party's ad suggests that there is an economic link between that third party and the proprietor of the trademark, the conclusion must be that there is an adverse effect on the function of indicating origin".

The CJEU also said that where an ad (while not suggesting the existence of an economic link) is so vague that "normally informed and reasonably attentive internet users are unable to determine whether the advertiser is a third party vis-à-vis the proprietor of the trademark or, on the contrary, economically linked to that proprietor", then the conclusion must be that this also provides an adverse effect on the function of the trademark. Whether or not this encompasses the concept of 'initial interest confusion' is now the subject of a well-publicised infringement case in the UK.

### Interflora v Marks & Spencer

Shortly after Google France v Louis Vuitton, the CJEU was asked to provide guidance on a further keyword bidding dispute, in Interflora v Marks & Spencer.

Interflora is the operator of a large and well-known flower delivery network, and Marks & Spencer (M&S) is one of the best-known retailers in the UK. M&S has sold flowers online since as early as 2000. In its adverts, M&S used Google AdWords so that when Google users entered 'Interflora' as a search term, an advertisement or sponsored link would appear for the competing M&S flower service with a link to its website. In spite of the trademark 'Interflora' never appearing in the M&S advertisement itself, Interflora sued M&S for infringement.

Initially it was thought that the CJEU ruling in Google France v Louis Vuitton could not help Interflora as M&S was not using the word Interflora in its sponsored link advertisement. However, Interflora was able to argue that M&S's use of the AdWord Interflora was damaging its reputation and distinctive character without due cause.

When the UK court referred several questions to the CJEU during the early proceedings, the court confirmed that a trademark owner is entitled to prevent a third-party competitor from using another mark covering goods or services identical to those protected by that mark, where that use is likely to either:

- Have an adverse effect on one of the functions of the proprietor's trademark (including, in summary:
  - (i) adversely affecting the earlier registered trademark's function of indicating origin; (ii) adversely affecting the earlier registered trademark's advertising function; or
  - (iii) adversely affecting the earlier registered trademark's investment function if it substantially interferes with the proprietor's ability to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty); or
- Prevent a company from using a trademark in keyword advertising where the competitor takes unfair advantage of its distinctive character or repute (free-riding), or where the advertising is detrimental to that distinctive character (dilution) or to that repute (tarnishment), where the registered mark has a reputation.

The English High Court found that M&S infringed Interflora's trademark, on the basis that the people who searched for Interflora and then clicked on the M&S advertisement were led to believe (incorrectly) that M&S's flower service was part of the Interflora network. The UK court's interpretation of the CJEU's Interflora ruling is subject to an appeal, based on the argument that the UK court misapplied the 'reasonable internet user' test laid down by the CJEU and that it incorrectly decided that initial interest confusion was sufficient to establish liability. It may be that further case law and clarity on the point of initial interest confusion may come out of this latest round of the litigation.

### Lush v Amazon

Regarding developments since these initial CJEU rulings, in February 2014 the English High Court handed down a judgment in the AdWords case of Lush v Amazon.

Here, Amazon was using Lush's trademark 'Lush', both in keyword advertising and also on its website search engine, to generate sponsored advertisements in Amazon's own internal search results - these ads led to products that were not Lush's.

In summary, there were deemed to be three 'classes' of use by Amazon of Lush's trademark: (i) the trademark appearing within the sponsored advertisement when consumers searched for Lush on Google; (ii) sponsored links that did not use/show the word Lush but did reference products similar to those sold by Lush; and (iii) results shown when a user typed the word Lush into the search facility on Amazon's website (eg, when typing the letters 'lu' the drop-down menu would appear with search options such as 'Lush bath bombs' or 'Lush cosmetics').

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Based on Google France and Interflora, the UK court decided very quickly on the question of infringement relating to the use of 'Lush' under classes (i) and (ii) mentioned. For the first class, this was an infringement, as the ads included the trademark and the average consumer would not expect Amazon to be advertising the 'Lush' mark if those goods were not available to buy. For the second class, there was no infringement, because consumers are familiar with sponsored adverts and accustomed to seeing a competitor's adverts when using a search engine, so if the sponsored link was for Lush products, the ad would have said so.

The third and most interesting class (ie, the use of 'Lush' on the dropdown search bar on Amazon's website) presented more of a problem. After much consideration, the High Court held that the average consumer would be unlikely to know how Amazon's dropdown menu worked, and so would expect to find Lush products when clicking on the 'Lush' results. This meant that Amazon was using the 'Lush' mark as a generic indicator of a class of goods, and this damaged the origin function of the trademark. The investment function was also damaged by Amazon's implication that it sold Lush goods, as Lush does not allow Amazon to sell its goods.

Here we see how flexible, and adaptable, the basic legal position and principles laid down by the CJEU in *Interflora v M&S* can be. This also shows an underlying public policy consideration behind Interflora that search results should be easy and clear for consumers in order to avoid the traditional confusion associated with trademark infringement.

The most important and far-reaching CJEU rulings (Google France v Louis Vuitton and *Interflora v M&S*) hold that Google's AdWords system does not violate the trademark rights of a brand owner when its marks are used by a third party to trigger adverts. However, third parties using a proprietor's trademark as an AdWord can be liable to infringement if an ad suggests there is an economic link between the parties and/or if the ad has an adverse effect on the essential function of the trademark - ie, its indication of origin or its reputation.

This article is also reported in *Trademarks & Brands Online*. Please click [here](#) for the article or alternatively contact your usual Boult Wade Tennant adviser for more information.

**Author:** Luke Portnow, Assistant



# > WIPO Update – European Union (CTM) Designations

From 1 October 2014, OHIM has been examining the list of goods and services covered by CTM designations for vague terms to bring its practice into line with the Common Communication on the implementation of the IP Translator decision ([see our previous update here](#)).

This change in practice affects all CTM designations notified by WIPO to OHIM on or after 1 October 2014. From that date, if a term used in a specification is considered to be too broad or too vague by OHIM, a Notice of Provisional Refusal will issue. Helpfully, OHIM has provided a list of 11 terms that they consider to be too broad, too vague, lacking in clarity or lacking in precision along with possible amendments as follows:

Term too broad or too vague, and lacking clarity and precision	Proposals / possible solutions: (examples from harmonized database)
Goods of common metal not included in other classes (class 6)	Construction elements of metal (class 6) Building materials of metal (class 6)
Machines (class 7)	Agriculture machines (class 7) Machines for processing plastics (class 7) Milking machines (class 7)
Goods in precious metals or coated therewith (class 14)	Works of art of precious metal (class 14)
Goods made from paper and cardboard (class 16)	Filtering materials of paper (class 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (class 17)	Rings of rubber (class 17)
Goods made of these materials [leather and imitations of leather] (class 18)	Briefcases [leather goods] (class 18)
Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (class 20)	Door fittings, made of plastics (class 20) Figurines of wood (class 20)
Repair (class 37)	Shoe repair (class 37) Repair of computer hardware (class 37)
Installation services (class 37)	Installation of doors and windows (class 37) Installation of burglar alarms (class 37)
Treatment of materials (class 40)	Treatment of toxic waste (class 40) Air purification (class 40)
Personal and social services rendered by others to meet the needs of individuals (class 45)	Personal background investigations (class 45) Personal shopping for others (class 45) Adoption agency services (class 45)

OHIM has stated that this list is not binding but it does provide some guidance as to the terms that OHIM are likely to object to.

If you would like more advice please speak to your usual Boult Wade Tennant adviser.