

Trade mark law developments

New multinational trade mark search system

A test version of OHIM's new multinational search system, *TMview*, went live in November 2009.

This online search tool will provide free access to over five million trade marks. It allows a single search of all trade mark applications and registrations at OHIM, WIPO and the UK, Czech, Italian, Benelux, Portuguese and Danish IP offices. This will be useful for checking the availability of a potential trade mark and discovering which trade marks competitors are protecting.

The full version should be released this year, and it is hoped that more European IP offices will sign up early in the year. OHIM is currently receiving feedback on the test version in preparation for the full launch. To try it out *TMview* go to www.tmview.europa.eu.

BOOHOO gets the last laugh

The High Court has recently held that internet search traffic constituted evidence of confusion in an application for an interim injunction in a passing off matter (case: *Wasabi Frog Ltd v Miss Boo Ltd* (2009)).

Wasabi Frog was an online retailer of fashionable women's clothing, shoes and accessories, and trading from the website www.boohoo.com under the names BOOHOO and BOOHOO.COM. It was the registered proprietor of Community trade marks "BOO", "BOOHOO" and "BOOHOO.COM".

Miss Boo Ltd launched an online retail business selling women's clothing, shoes and accessories, in direct competition with Wasabi Frog, using the names MISS BOO and MISSBOO.CO.UK.

Once Wasabi Frog learnt of Miss Boo Ltd's activities, it purchased the words "MISS BOO" as Google Ad Words, with the result that when an Internet user entered the words "MISS BOO" into a search engine, its website appeared in the sponsored search results.

Google Analytics reports confirmed that the "click through" rate of visitors to the its website, via the

link which appears in the sponsored search results after they have searched against these words was the fourth largest source of traffic to the website.

Wasabi Frog argued that the Google Analytics reports showed that customers were searching for its website by searching against the term "MISS BOO", and a significant number of customers searching for its website had entered this term believing that this will take them there. These customers were likely to be confused if confronted with an alternative "MISS BOO.CO.UK" website or would believe the websites were connected or otherwise associated. The court held that Wasabi Frog had a well arguable case that this demonstrated a likelihood of confusion, establishing passing off.

The court also noted that the names "BOOHOO", "BOOHOO.COM" and "BOO" were distinctive and striking, unusual and quite different in the online retail and high street retail market for clothing, footwear and accessories, thereby giving rise to a higher distinctiveness and a higher likelihood of confusion and/or association in the minds of the relevant trade and/or public. The consumer was likely to associate the term "MISS BOO" with whatever it is that "BOO" (a registered trade mark) relates to, giving rise to a likelihood of confusion for the purposes of trade mark infringement.

This case is an interesting example of how evidence of confusion can be obtained, and emphasises the importance of the distinctiveness of a trade mark in establishing confusion.

Descriptive trade marks rejected

Towards the end of 2009, the European Court of First Instance (CFI) upheld three Board of Appeal decisions where trade marks were rejected or found to be invalid for being too descriptive or lacking distinctiveness.

These cases serve as an important reminder of the difficulties in attempting to register a trade mark that, on any construction of the words in question, describes the goods or services for which that mark is to be used or are devoid of distinctive character.

In the first case, a company attempted to register the trade mark “CLEARWIFI” for telecommunications services, which included the provision of wireless network connections. It was held that the word “clear” was descriptive of the quality of the services being provided as the public would perceive it to mean uninterrupted internet access. “Wifi” was also found to be a term in common usage to describe wireless internet provision.

The application for the trade mark “*THINKING AHEAD*” for services including education and training was also rejected as it was found to be lacking in distinctive character – it used simple words and would not provoke any element of surprise in the public. The CFI held that “*THINKING AHEAD*” was more akin to an advertising slogan than a brand name.

The third case involved a declaration of invalidity for the trade mark “*CANNABIS*”, registered for alcoholic beverages including beer. The CFI considered the meaning behind this word and found it was equated with the word ‘hemp’ – the legal foodstuff that can be used in alcoholic beverages. The CFI took the view that when a consumer saw this trade mark they might perceive it to be descriptive of the contents and characteristics of the beverages. The CFI did not examine in detail other implications of the use of “*CANNABIS*”.

This again emphasises the importance of ensuring that any trade marks that you wish to protect are as distinctive as possible.

The decisions referred to are: *Clearwire Corporation v OHIM (Case T-399/08)*; *ApolloGroup Inc. v OHIM (Case T-473/08)*; *Torresan v OHIM (Case T-234/06)*.

Green and yellow colour combination makes...a valid trade mark

Attempts to register specific colours as a trade mark are rarely successful. However, the European Court of First Instance (CFI) has in *BCS SpA v OHIM (Case T-137/08)* confirmed the validity of a colour trade mark registered for farm tractors and agricultural machinery.

The makers of John Deere tractors had registered the following trade mark for tractors.



The registration described the arrangement of the colours as being “green for the vehicle body and yellow for the wheels”, as shown below:



BCS SpA filed an application for a declaration that this trade mark was invalid, on the basis that it was devoid of any distinctive character when the application for registration was filed and that there had been insufficient proof of distinctive character acquired through use.

The CFI held that John Deere had consistently used the same combination of colours on all its agricultural machines in the European Union for a considerable period prior to the filing date. It therefore had been proven to the required legal standard that John Deere had used the combination of the colours green and yellow on its goods as a trade mark and that the market penetration of its goods had been deep and long-lasting in the European Union as at the filing date.

This decision demonstrates that a colour can validly be registered as a trade mark so long as the trade mark owner can show it has become distinctive through use and has a strong and lasting presence in the relevant market such that members of public will associate the colours with the relevant products.

Lack of distinctiveness is not a basis to oppose a Community trade mark application

The Community trade mark office (“OHIM”) has recently pointed out that arguments relating to absolute registrability of trade marks (eg that they are devoid of distinctive character or descriptive) made in Community trade mark opposition proceedings are not admitted.

Where the opponent wishes to raise grounds relating to the registrability of Community trade mark applications, it must do so in a separate submission, after the application has been published, pursuant to Article 40 of the CTM Regulation (Council Regulation (EC) No 207/2009).

For further information, visit:

<http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/decisionPresident/co2-09en.pdf>

Passing off proceedings

Successfully opposing a trade mark application on the basis of passing off could, if a recent High Court judgment is followed, enable summary judgment to be obtained in a subsequent passing off claim if that trade mark is later used.

The validity of UK trade marks can be challenged on the grounds that use of the trade mark would amount to passing off, because its use is likely to confuse the public as to the relationship between the trade mark applicant's goods or services and those of another business which has already established goodwill in the relevant mark.

In the case of *Evans and another v Focal Point Fires plc (2009)*, the defendant's trade mark registration had, on the application of the claimant, been declared invalid by the trade marks registry on the above basis. The defendant continued to use the trade mark, and the claimant instituted passing off proceedings.

The Court held that the decision of the trade mark registry in the earlier invalidity proceedings was a finding that as at the relevant date there was already an existing misrepresentation (a necessary element of passing off), and therefore determined that the claimant had a valid cause of action in passing off. Consequently, the Court held that the defendant was prevented from arguing that it was not passing off and therefore had no prospect of success in defending the passing off case.

However, this judgment is open to criticism on the basis that the issue before the trade marks registry was whether or not the trade mark was valid, not whether passing off had occurred. If appealed, this judgment could well be overturned.

This decision might in certain cases help expedite and reduce the cost of passing off claims...but don't bank on it!

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