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A PRACTICAL GUIDE TO TRADE MARK LAW

FIFTH EDITION

Amanda Michaels
& Andrew Norris

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AMANDA MICHAELS
BA (Dunelm), MA (Bruges)

*Barrister
Appointed Person*

ANDREW NORRIS
BSc (St Andrews)

Barrister

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A PRACTICAL GUIDE TO
TRADE MARK LAW

FOREWORD

The Rt Hon Professor Sir Robin Jacob¹

Is it really less than 20 years since the new European trade mark law and system started? Are the various national trade mark laws (such as our Trade Marks Act 1994) implementing the 1989 Directive really less than 20 years old? The maths says 'yes' but it does not feel so—the European law feels as though it has always been with us. Even the early ECJ cases such as *Canon v MGM* and *Sabel v Puma* now feel like ancient history. The certainties of the old system now seem to belong to a far distant (and some might say golden) age. The House of Lords heard (I think) 17 appeals in trade marks in the period 1900 to 1994. Since then the ECJ (now the CJEU) has heard well over 100 references from national courts and almost as many appeals ultimately stemming from the Office for the Harmonisation of the Internal Market (as what is really the European Trade Marks and Designs Office is pompously called). As I write, the UKIPO (as the Patent Office was pointlessly renamed) shows 24 pending trade mark appeals/references for 2013 alone.

So there is now a morass of case-law. It has been and is being created by judges of no or but limited prior experience of trade marks, from a variety of different legal and commercially cultural perspectives. And they all work on the uncertain foundation of a not very precise Directive and Regulation.

The result has been that trade mark law is to a large extent at its edges uncertain. The core is all right—but those uncertain edges are wider than they should be. Trade mark law is like a clear but smallish picture in a frame with very thick sides representing uncertainty. It has all become too, too complicated. For instance, the Court of Justice has offered protection to a whole host of trade mark functions of uncertain meaning or import. Clearly the Court has become protectionist—though some might query the social value of protecting the illusion which famous marks engender at the expense of honest competition.

Amanda Michaels and Andrew Norris have done wonders in writing about all this. They (unlike the court) do not speak in riddles and ambiguities—indeed they write so clearly that they make you want to turn the page. Of course they cannot resolve the problems of trade mark law. But they can and do explain the law as best

¹ Hugh Laddie Professor of Intellectual Property Law, University College, London and a former member of the Court of Appeal of England and Wales.

it can be done. The reader will understand the problems and where the many Pooh traps lie.

I said of an earlier edition that I kept it by me. I will do the same with this. Sensible trade mark lawyers will do likewise. So also will law students—at least mine will!

Robin Jacob
Bentham House, UCL
November 2013

PREFACE

This book deals with the law of trade marks and passing off from a UK perspective.

That perspective has for many years been dominated by the broader EU position as a result of the harmonisation of trade mark law throughout the EU for the last 20 years. The UK regime for the registration of trade marks is derived from an EC Directive, currently Directive 2008/95, and coexists with and complements the regime permitting the registration of Community trade marks, pursuant to the Community Trade Mark Regulation, currently Council Regulation (EC) 207/2009. Both regimes are subject to the guidance of the Court of Justice of the European Union, which has produced very many trade mark decisions and is responsible for significant (and continuous) developments in the law.

At the time of writing, there are proposals to replace the current Directive and Regulation. The changes proposed in many respects reflect the case-law of the CJEU, but are also designed to try to modernise the system. The timing of the entry into force of those proposed amended texts is currently uncertain and, in the circumstances, we have stated the law as it is at present but have made some references to potential changes in this edition of our book.

As in earlier editions, we have endeavoured to provide a comprehensive but practical explanation of the law on the acquisition, registration, and protection of trade mark rights. Our aim throughout has been to provide a guide suitable for use by trade mark proprietors or in-house lawyers, and by non-specialist lawyers, but also a useful 'first point of call' for the more specialist reader.

The scheme of the book is to discuss the functions of trade marks and related rights and protections in the context of the harmonised EU system, before considering in some detail in Chapters 2 and 3 the requirements for the registration of trade marks.

Chapters 4 and 5 deal respectively with the registration process and with the important topics of revocation and invalidity. Chapter 6 deals with assignment and licensing.

Each of those chapters draws distinctions where necessary between the UK and Community trade mark systems.

Chapter 7 deals with the important topic of infringement. Chapter 8 discusses the law of passing off. Chapter 9 discusses the procedure of enforcement and

remedies available in the UK for both trade mark infringement and passing off. We have addressed the differences between the High Court and County Court, now known as the Intellectual Property Enterprise Court. This reflects the success of the streamlined County Court procedure.

Although the major legislation in the area is now almost 20 years old, trade mark law is constantly evolving. The 1994 Act and the main EU legislation have been amended and consolidated, important additional legislation such as that relating to comparative advertising has been brought into effect, and further amendments in the form of a new Directive and Regulation are on the way. In the meantime, there is a never-ending stream of case-law emanating from the European Court of Justice and national courts. Keeping up to date is a challenge for every practitioner.

We should be delighted to have feedback on any aspect of the book from our readers, at barristers@hogarthchambers.com.

Most of this text was written by mid-November 2013, but we are grateful to the editorial team at OUP for enabling us to incorporate into the text or footnotes references to significant developments up to 17 January 2014. Important pending cases have been identified wherever possible.

Both of us are also enormously grateful for the help and support of our colleagues at Hogarth Chambers. Special thanks go to Julia Clark, Gwilym Harbottle, Charlotte Scott, Jamie Muir Wood, Clive Nicholls and Briget Harrison. We are also indebted to Sir Robin Jacob for his kind support.

Amanda Michaels
Andrew Norris
Hogarth Chambers
London

LIST OF ABBREVIATIONS

1994 Act	Trade Marks Act 1994
AP	Appointed Person
Bd App	Board of Appeal
Block Exemption	Block Exemption Regulation (EC) 330/2010
CAD	Comparative Advertising Directive, Directive (EC) 2006/114
CEMA	Customs and Excise Management Act 1979
CFI	Court of First Instance of the European Court of Justice (now called the 'General Court')
CJEU	Court of Justice of the European Union
CTM	Community Trade Mark
CTMR	Regulation (EC) 207/2009
The Directive	Directive (EC) 2008/95
ECJ	European Court of Justice
EEA	European Economic Area
GC	General Court
IPEC	Intellectual Property and Enterprise Court
IPO	Intellectual Property Office <i>see also</i> UKIPO
The Manual	UKIPO's Manual of Trade Mark Practice
Modernisation Regulation	Regulation (EC) 1/2003
OHIM	Office for Harmonisation in the Internal Market (Trade Marks and Designs)
PAN	Practice Amendment Notice (UKIPO)
PDOs	Protected Designations of Origin
PGIs	Protected Geographical Indications
The Rules	The Trade Mark Rules 2008
TFEU	Treaty on the Functioning of the European Union
TPN	Tribunal Practice Notice (UKIPO)
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UKIPO	United Kingdom Intellectual Property Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

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Claudia Oberhauser v OHIM, Case T-104/01, [2002] ECR II-4359; [2003] ETMR 58	3.41
Club Sail Trade Mark Application [2010] RPC 32, AP	3.79
COFFEEMIX Trade Mark Application [1998] RPC 717	4.45
Coflexip SA v Stolt Comex Seaways MS Ltd [2001] RPC 9	9.50, 9.77
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Colbeam Palmer Ltd v Stock Affiliates Pty Ltd [1972] RPC 303	9.99
Colgate-Palmolive Ltd v Markwell Finance Ltd [1989] RPC 497	7.101
Colloseum Holding AG v Levi Strauss & Co, Case C-12/12, [2013] ETMR 34, 18 April 2013	2.57, 2.101, 5.19, 7.47
Commission of the European Communities v Germany, Case C-132/05, [2008] ECR I-957; [2008] ETMR 32	7.130
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Consorzio del Prosciutto di Parma v Asda Stores Limited, Case C-108/01, [2003] ECR I-5121; [2003] 2 CMLR 21; [2004] ETMR 23	2.124, 7.130
Consorzio del Prosciutto di Parma v Marks & Spencer plc [1991] RPC 351	8.07, 8.12
Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co KG, Case C-87/97, [1999] ECR I-1301; [1999] 1 CMLR 1203; [1999] ETMR 454	2.124
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Continental Shelf 128 Ltd v Hebrew University of Jerusalem [2007] RPC 23	5.11
Cooper Chasney Ltd v Commissioners of Customs and Excise [1992] FSR 298	9.93
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Copydex Ltd v Noso Products Ltd (1952) 69 RPC 38	8.50
Coty Prestige Lancaster Group GmbH v Simex Trading AG, Case C-127/09, [2010] ECR I-04965; [2010] ETMR 41; [2010] FSR 38	7.112
County Sound plc v Ocean Sound Ltd [1991] FSR 367	8.16, 8.84, 9.61

Courage Ltd v Crehan, Case C-453/99, [2001] ECR I-6297; [2001] 5 CMLR 28; [2002] QB 507; [2001] 3 WLR 1646	6.62
Couture Tech Ltd v OHIM, Case T-232/10, [2011] ECR II-06469; [2012] ETMR 5	2.119
CPC (United Kingdom) Ltd v Keenan [1986] FSR 527	9.72
Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd [2005] EWHC 1303, 22 June 2005	3.40
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Danjaq LLC v OHIM, Case T-435/05, [2009] ECR II-2097	2.67
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Davidoff & Cie SA v Gofkid Limited, Case C-292/00, [2003] ECR I-389; [2003] 1 CMLR 35; [2003] FSR 28; [2003] 1 WLR 1714	3.50
Dawney, Day & Co Ltd v Cantor Fitzgerald International [2000] RPC 669	6.10
Decon Laboratories Ltd v Fred Baker Scientific Ltd [2001] RPC 17; [2000] ETMR 46	3.20, 5.27
DEF-TEC Defense Technology GmbH v OHIM, Case T-6/05, [2006] ECR II-2671	2.129
De Landsheer Emmanuel SA v Comité Interprofessionnel du Vin de Champagne, Case C-381/05, [2007] ECR I-3115; [2007] 2 CMLR 43; [2007] ETMR 69 ...	7.67, 8.79
Demon Ale Trade Mark Application [2000] RPC 345.	2.136, 4.09, 4.45
Dent v Turpin (1861) 2 J&H 139.	8.29, 8.88
Desquenette et Giral UK Ltd v Richardson [2001] FSR 1.	9.58
Deutsche Renault AG v Audi AG, Case C-317/91, [1993] ECR I-6227; [1995] FSR 738 ...	9.41
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DHL Express France SAS v Chronopost SA, Case C-235/09, [2011] ECR I-02801; [2011] FSR 38; [2011] ETMR 33	9.37, 9.40
Diageo North America and anor v Intercontinental Brands (ICB) and Others ('Vodkat'), [2010] EWHC 173; [2010] ETMR 17, affirmed by [2010] EWCA Civ 920, [2011] RPC 2	8.08, 8.29, 8.31, 8.32
Die BergSpechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v Guni, Trade Mark Application, Case C-278/08, [2010] ECR I-2517; [2010] ETMR 33	7.24, 7.43, 7.50
Digipos Store Solutions Group Ltd v Digi International Inc [2008] RPC 24	2.26, 3.31
Doncaster Pharmaceuticals Group Ltd v Bolton Pharmaceutical Co 100 Limited [2007] FSR 3; [2006] ETMR 65	6.59, 7.102
Doosan Power Systems Ltd v Babcock International Group [2013] EWHC 1364, [2013] ETMR 40	8.65
Dormeuil Freres SA v Feraglow Ltd [1990] RPC 449	9.89, 9.91

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DU PONT Trade Mark Application [2004] FSR 15; [2006] 1 WLR 2793	4.70
Duro Sweden AB v OHIM, Case T-346/07, [2008] ECR II-00263; [2009] ETMR 22 ...	2.46
Dyson Limited v Registrar of Trade Marks, C-321/03, [2007] ECR I-687; [2007] 2	
CMLR 14; [2007] RPC 27; [2007] ETMR 34; a reference from Patten J	
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Ecoblock Trade Mark Application, BL O/178/06, 7 June 2006, AP	3.79
Eden v OHIM, Case T-304/04, [2005] ECR II-4705; [2006] ETMR 14	2.115
Edge & Sons Limited v William Niccolis & Sons Limited [1911] AC 693;	
(1911) 28 RPC 582.	8.40
Edwin Co v OHIM ('Fiorucci'), Case C-263/09, [2011] ECR I-05853; [2011] ETMR 45,	
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Einstein <i>see</i> Continental Shelf	
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EKORNES ASA's Application, BL O/017/06, 16 January 2006, AP	2.94
Elan Digital Systems Ltd v Elan Computers Ltd [1984] FSR 373	9.64
El Corte Inglés SA v OHIM, Case T-39/10, [2013] ETMR 3, 27 September 2012	3.47
Electrocoin Automatics Ltd v Coinworld Limited [2005] FSR 7; [2005] ETMR 31 ...	3.18, 3.61
Electrolux Ltd v Electrix Ltd (1953) 70 RPC 158	9.97
Eli Lilly and Co v 8PM Chemists Ltd [2008] EWCA Civ 24; [2008] FSR 11	7.18
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5 July 2011	5.39
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Environmental Manufacturing LLP v OHIM, Case C-383/12, 14 November 2013	
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Eric Burden's Trade Mark Application, BL O/369/13, 12 Sept 2013, AP	8.27
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Eurocermex SA v OHIM, Case C-286/04, [2005] ECR I-5797; [2005] ETMR 95 ...	2.24, 2.81

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Evans T/A Firecraft v Focal Point Fires plc [2009] EWHC 2784 (Ch); [2010] RPC 15; [2010] ETMR 29	3.78, 5.50, 5.51
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Executrices of the Estate of Diana, Princess of Wales' Application [2001] ETMR 25	2.64
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Federation Cynologique Internationale v Federacion Canina Internacional de Perros de Pura Raza, Case C-561/11, [2013] ETMR 23, 21 February 2013	7.78
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Ferrero SpA v OHIM, Case C-552/09, [2011] ECR I-02063; [2011] ETMR 30, 24 March 2011	3.29, 3.30, 3.57
Fine & Country Limited v Okotoks Limited [2013] EWCA Civ 672, 14 June 2013,	2.34, 2.38, 2.51, 2.73, 7.48, 8.36, 8.59, 8.61, 9.25
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Ford Motor Co v OHIM, Case T-67/07, [2008] ECR II-3411	2.23, 2.42
Formula One Licensing BV v OHIM, Case C-196/11, 24 May 2012	2.21, 2.31, 3.02
Fox International Group Ltd v Folly [2011] EWPC 30; [2012] ECC 3	7.47
Freixenet SA v OHIM, Joined Cases C-344/10 and C-345/10, 20 October 2011 ...	2.83, 2.84
Frisdranken Industrie Winters BV v Red Bull GmbH, Case C-119/10, [2012] ETMR 16, 15 December 2011	3.74, 7.15
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Fruit of the Loom Inc v OHIM, Case T-514/10, [2012] ETMR 44, 21 June 2012	5.18
FSTC Ltd Foundation for Science Technology and Civilisation's Application, BL O/008/07, 8 January 2007	2.60
Gala of London v Chandler [1991] FSR 294	9.73
Galatopoly Trade Mark Application, BL O/382/13, 13 September 2013, AP	3.31
Galileo International Technology, LLC v European Union [2011] EWHC 35 (Ch); [2011] ETMR 22	5.29
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Garden Cottage Foods v Milk Marketing Board [1984] AC 130	9.74
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General Cigar v Partagas y Cia [2005] EWHC 1729; [2005] FSR 45	4.31
General Electric Trade Mark Application [1972] 1 WLR 729	8.88
General Motors Corp v Yplon SA ('Chevy'), Case C-375/97, [1999] ECR I-5421; [1999] ETMR 950	3.52, 3.54–3.56, 3.61, 7.125
General Tire v Firestone [1976] RPC 197	9.85
George Ballantine & Sons v Ballantyne Stewart & Co [1959] RPC 273	9.28
Gerber Garment Technology Inc v Lectra Systems Ltd [1995] RPC 383, Ch D; [1997] RPC 443, CA	9.86
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Getty Images (US) Inc v OHIM, Case T-338/11, 21 November 2012	2.40
Ghazillian's Trade Mark Application [2002] RPC 33	2.119
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