



Welcome

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E is for.... vehicle hire?

In a trade mark battle in the High Court between two major players in the European car rental market, Enterprise has succeeded over rival Europcar, preventing Europcar from trading under a logo comprising the stylised letter "e".

Enterprise has used a stylised "e" logo in green as part of its branding since 1967, and its current logo (*shown below left*) since 2006. The current logo is registered as a trade mark for "vehicles" and "vehicle rental services."

The dispute with Europcar arose in 2012 when Europcar adopted new branding, also using a form of stylised "e" in green, as shown (*below right*).

Europcar's case was that the "e" was always used in conjunction with the word EUROPCAR (sometimes also with the addition of a strapline), or in combination with descriptive words (e.g. "Prestige", "Chauffeur"). However, Enterprise found evidence that Europcar was also using the "e" by itself, as an icon on mobile phone apps. Enterprise commenced

High Court proceedings against Europcar for trade mark infringement and passing off.

Arnold J found that all three types of use of the "e" by Europcar infringed. The context of use was important – Enterprise had made extensive use of green in its branding. Arnold J also noted that there had been a large amount of actual confusion (e.g. people mistakenly boarding the wrong buses at the airport). He said that had it not been for the instances of actual confusion, he would have hesitated to find against Europcar in relation to the uses of the "e" in conjunction with additional elements.

If he had not found a likelihood of confusion, Arnold J concluded in relation to the reputation-based claims that (a) the unfair advantage claim would have failed if there was no likelihood of confusion; and (b) there was no detriment to the distinctive character of Enterprise's marks because there was no evidence of any change in the economic behaviour of the average consumer.



Company name selection made easier?

From 31 January there's now only two rather than five Statutory Instruments to refer to when choosing a name for a company or LLP, a result in the Government's Red Tape Challenge. The SIs apply on first registration or when considering a change of name. The SIs are The Company, Limited Liability Partnership and Business Names (Sensitive Words and Expressions) Regulations 2014 (SI 2014/3140); and The Company, Limited Liability Partnership and Business Names (Names and Trading Disclosures) Regulations (SI 2015/17).

The 2014 Regulations reduce the list of sensitive words and expressions for which prior approval is needed from the Secretary of State. The 2015 Regulations reduce the list of words or symbols that will be considered the same in determining if a name is the "same as" a name registered at Companies House. The 2015 Regulations also extend the list of characters that can be used, including accents, diacritical marks, ligatures, signs and signals, so there may be more scope for aligning trademarks and business names. Objections can be made at Companies House to a registered name that is the same as or too like another registered company name.



However, it is also worth remembering the Company Names Tribunal which deals with complaints about opportunistic registrations; where a company name is registered for the primary purpose of preventing someone else with a legitimate interest from registering it or demanding payment from them for its release. Anyone who has a trade mark or simply goodwill in a name can challenge an opportunistic registration of a company name which is the same as or similar to their brand or name and ask the Tribunal to order a change of name.

Refusal to register *Pianissimo* and *GentleCare* as trade marks upheld

The General Court has dismissed two separate appeals by Grundig Multimedia, following refusal of the company's applications to register *Pianissimo* and *GentleCare* as Community trade marks.

Both CTMs were filed in respect of a variety of goods, including kitchen apparatus, washing machines and vacuum cleaners.

In the case of *GentleCare*, the mark was rejected on the basis that it was descriptive of the fact that the primary function of the product was carried out in a gentle manner and that that fact would have significance for the consumer as a desirable selling point. *GentleCare* would be first and foremost perceived as describing that characteristic, and not denoting the origin of the product with a particular manufacturer.

The General Court agreed. Grundig's argument that *GentleCare* was fanciful, does not appear in the dictionary and that any characteristics it describes were not commercially essential were all rejected.

In the case of *Pianissimo*, the mark was rejected because the Italian consumer (Italy being one of the 28 EU member states covered by a CTM) would understand the expression as meaning "extremely silent". This would be perceived as a desirable characteristic of the goods for which protection was sought.

Again the General Court agreed and rejected Grundig's appeal. The fact that *Pianissimo* may have a different meaning ("very slow") is irrelevant if just one of its meanings describes a characteristic. It also rejected Grundig's assertion that the vast majority of the European public would only understand *pianissimo* in the context of classical music. A CTM is unitary in nature and a mark must be distinctive throughout the Union for it to be registrable as a CTM.

These cases provide a useful restatement of the limits of trade mark protection and the potential for applicants to be unable to obtain protection if they choose signs that have an immediate and obvious meaning to the consumer.



The sale by Topshop of Rihanna t-shirt amounts to passing off

The Court of Appeal has unanimously upheld the High Court decision that the sale by Topshop of a t-shirt displaying an image of Rihanna amounted to passing off ([2015] EWCA Civ 3).

The image used was a photograph taken during an official video shoot. Topshop obtained a licence from the photographer, but had not asked Rihanna's permission.

The case was an action for passing off. The High Court was keen to impress that there is "no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image". In finding for Rihanna, Birss J concluded that the mere sale by a trader of a t-shirt bearing an image of a famous person would not, without more, be an act of passing off. However "the sale of this image of this person on this garment by this shop in these circumstances" was a different matter. Birss J found that Topshop's prior public associations with Rihanna would enhance the likelihood in the purchaser's mind that the t-shirt was authorised. Further, the image looked like a publicity shoot and, to Rihanna fans, may look like part of a wider marketing campaign.

Topshop appealed the decision on four grounds, all of which were rejected. Underhill LJ noted that the case was "close to the borderline" and essentially turned on two things which, taken together, were key: Rihanna's prior association with Topshop; and the nature of the image itself.

In the absence of a codified law to protect image rights, whether an action like this can succeed comes down to whether there has been a misrepresentation as to trade origin. Each case will turn on its facts. The parties, their prior dealings and the nature of the image are all crucial factors.



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Board of Appeal rules on registrability of character marks

OHIM recently allowed an appeal in respect of a Community trade mark application to register a depiction of a cartoon postman (R/1801/2014-4).

The examiner rejected the application in respect of virtually all goods for which protection was sought, reasoning that the mark was not distinctive because consumers would perceive it as nothing more than decoration and not as an indication of commercial origin.

For a trade mark to possess distinctive character, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking. That distinctive character must be assessed by reference to the goods or services in respect of which registration has been applied for, and by reference to their public perception.

The applicant appealed.

It was held that the figurative mark did not lack distinctiveness, and there were no indications that the public would not perceive the

mark applied for as a commercial indication of origin. In particular, it was considered that (i) the mark was the type of character that one would expect to have a specific name (in contrast to a standardised simplistic and faceless figurine used for board games and construction toys); and (ii) the fact that the sign may fulfil a decorative function in respect of the goods in certain classes, in itself is not sufficient to deny distinctive character. Typical decorative elements are those which consumers fail to distinguish due to their common use (e.g. stripes, dots or other patterns).



The appeal succeeded and the mark was allowed to proceed, along with other character marks subject of concurrent appeals by the same applicant.

Patent assignment validity considered

In the recent case of *Future New Developments Limited v B&S Patente und Marken GmbH*, Hacon J of the Intellectual Property Enterprise Court (IPEC) considered an application for summary judgment which was brought by FND.

The application related to a European patent for energy-saving technology for use with fluorescent lighting, which FND claimed had not been validly assigned pursuant to a declaration of assignment signed in March 2009. FND argued that as the assignment had not been valid, the patent still belonged to FND, despite the registered proprietor being B&S. The arguments presented by the parties included points of Cayman and German law.

FND put its case for summary judgment on the grounds that (a) the declaration of assignment had been signed by a director who had in fact been lawfully

removed as a director in February 2009 (a month before signing), and (b) even if that person had been a valid director at the time of the assignment, he did not have authority to assign the patent.

B&S did not appear at the summary judgment hearing. Having considered B&S's expert evidence and all the arguments potentially available to B&S in regard to the application, Hacon J ultimately found that none raised any real prospect of B&S succeeding at trial. This was supported in particular by the fact that FND has continued to pay renewal fees for the patent since 2009.



SIMPLY too simple

A recent opposition decision by the UK Intellectual Property Office considered the level of distinctiveness of the word SIMPLY.

Tesco applied to register SIMPLY for alcoholic and non-alcoholic beverages. The application was opposed by International Supermarket Stores, owner of an earlier Community Trade Mark Registration for SIMPLY. The opposition was based on "retail services in relation to food products, household or kitchen goods", as covered by the earlier right.

Tesco put ISS to proof of use of its earlier right. The majority of the evidence which ISS filed in response was use in the stylised form shown. The hearing officer agreed with Tesco's argument that use in this format is "a clear alteration of distinctive character" of the mark as registered. *"The mark as registered is a plain word which has a low level of distinctive character... The mark SIMPLY is made much more distinctive on account of its form of use"*. As a result there had been no genuine use of the mark as registered and the opposition must fail.



The hearing officer went on to say that, even if he was wrong and the evidence presented did constitute use of the mark as registered, then the opposition would still fail:

"Retail services in relation to food" would not, on a normal construction, also encompass drink, so the respective goods and services are only similar to a low degree. While the signs at issue are identical, SIMPLY is of a very low-level of distinctiveness being *"strongly suggestive of a service that is simple to use, or provides the basic and simple products that one needs"*. *"The average consumer would not be surprised to find two different undertakings using such a mark to send the suggestive message described"* and as such there is no likelihood of consumer confusion. Tesco's application was allowed to proceed.

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