



### Specsavers v Asda: use of Shaded logo is genuine use of Wordless logo

In the final instalment of the long standing litigation between Specsavers and Asda, the Court of Appeal has overturned the revocation of Specsavers' Wordless logo mark and ruled that the use of its Shaded logo mark amounted to genuine use of its Wordless logo mark (both marks depicted below).



The original appeal hearing against the order of Mr Justice Mann was stayed pending a reference to the Court of the Justice of the European Union ("CJEU"). The parties have since settled the dispute on confidential terms but agreed that Specsavers could pursue the appeal against the order to revoke the Wordless logo mark. Asda did not act as respondent to the appeal, but the Registrar of Trade Marks intervened to protect the public interest.

The claim for revocation of the Wordless logo mark had relied upon the ground of non-use under Articles 15 and 51 of Council Regulation (EC) No 207/2009/EC. However, Specsavers argued that use of the Shaded logo mark constituted use of the Wordless logo mark. The reference to the CJEU concerned whether "genuine use", within the meaning of Articles 15 and 51, could be satisfied where a

Community figurative mark is used only with a word mark imposed over it.

In its judgment the CJEU held:

- under Article 15, using a mark that differs from the registered mark is nevertheless considered use of the registered mark, as long as the distinctive character of the registered mark is not altered;
- to assess the distinctive character of a mark, the mark must identify the product or services of a particular undertaking, in this case, the Wordless logo mark needed to identify Specsavers; and
- if the Wordless logo mark was held to identify Specsavers then it did not matter that the word Specsavers and the combination of the Wordless logo mark and the word Specsavers (the Shaded logo mark) were themselves registered.

Therefore the issue before the Court of Appeal was to consider whether use of the Shaded logo mark changed the distinctive character of the registered mark i.e. the Wordless logo mark. In carrying out this exercise the court considered whether the Wordless logo marked served to identify the Specsavers group. Whilst Kitchin LJ noted that the use of the Shaded logo mark by Specsavers did not seem "a very promising basis for an argument that they have also used the Wordless logo mark", when he reviewed the evidence put forward by Specsavers he found it to be "unusually, powerful evidence" that the considerations concerning use and perception of the average consumer had been met. He took the following evidence into account:

- Specsavers had made substantial use of the Shaded logo mark over many years;
- none of Specsavers' major competitors used a logo which was similar to the Shaded logo mark or the Wordless logo mark;
- when developing its own competing logo, Asda had intentionally tried to keep a safe distance away from the design of the Wordless logo mark; and

- there was evidence that the average consumer recognised the overlapping green ellipses as denoting Specsavers.

The Court also took into account the guidance provided by the CJEU on the significance of colour in assessing the likelihood of confusion i.e. the green colour used by Specsavers could be taken into account in the global assessment. In this case the Wordless logo mark was registered without any colour limitation and was therefore registered in respect of all colours.

In concluding that use of the Shaded logo mark amounted to genuine use of the Wordless logo mark, the Court of Appeal held that the Wordless logo mark identified Specsavers and that the differences between the Wordless logo mark and the Shaded logo mark did not change the distinctive character of the Wordless logo mark.

However, this judgment may have limited application in future cases. Kitchin LJ was careful to point out that the circumstances of this case were unusual. The Registrar invited the court to make it clear that each case would be determined on its own facts, but Kitchin LJ went further stating that *“it is unlikely that the background of the mark will be perceived by the average consumer as an indication of origin. This is, however, an unusual case and Specsavers supported in their appeal by what I consider to be the convincing evidence that I have described”*. It is therefore likely that this decision will be confined to its own very specific facts. It does though provide

helpful guidance on the type of evidence that can be used to demonstrate genuine use in appropriate circumstances.

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