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Slogans

While the European Court of Justice has clarified what can, and can't, be taken into consideration when deciding whether a slogan is registrable, protecting slogans as trade marks will continue to be difficult.

In its decision concerning the trade mark DAS PRINZIP DER BEQUEMLICHKEIT, which may be translated as THE PRINCIPLE OF COMFORT, the European Court of Justice (ECJ) stated:

- It is not necessary that, in order to serve as trade marks, slogans must possess an additional element of imagination. In principle, slogans do not have to be fanciful to be acceptable for registration;
- It is not a requirement for refusal of registration that the slogan in question is shown to be commonly used in business communications and, in particular, advertising;
- Slogans should not be assessed according to different (or stricter) criteria than other trade marks;
- However, *difficulties in establishing distinctiveness...may be associated with certain categories of trade marks because of their very nature, such as those consisting of advertising slogans...average consumers are not in the habit of making assumptions about the origins of products* on the basis of slogans.

The ECJ decided that neither the tests used by OHIM's Appeal Board, nor those applied by the Court of First Instance, in assessing registrability of DAS PRINZIP DER BEQUEMLICHKEIT, had been correct. In consequence, the refusal to register the trade mark was lifted. However, this decision should not be seen as a green light for the registration of slogan marks. Even if a slogan does not describe the qualities or characteristics of the goods or services applied for, many slogans will continue to be devoid of distinctive character, and so unregistrable, on the grounds they are not likely to be perceived by consumers as identifying the producer of goods or services. The question to be answered will always be whether the mark is capable of distinguishing, to the relevant public, the goods and services claimed.

Trade Marks With Reputation

A recent decision of the Court of First Instance confirms the onus on an opponent to substantiate its case with good evidence, when seeking to rely upon its reputation in a trade mark to prevent registration of a similar trade mark for non-similar goods.

An application for SPA-FINDERS in respect of printed publications and travel agency services, was opposed on the basis of rights and reputation of the earlier trade mark SPA for mineral waters.

The similarity of the trade marks was acknowledged, and that this might cause the public to establish a link between the marks. However, the existence of such a link did not of itself establish detriment to the repute or the distinctive character of the earlier mark, or that unfair advantage might be taken of it. The court said *it should be made clear that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment.* The stronger the earlier mark's distinctive character and reputation, the easier it would be to accept that detriment had been caused to it. Here, the opposition failed, not only because the term "SPA" was used in other contexts, but because of the lack of evidence supporting the opponent's contentions.

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Same Meaning, Different Words

This is the first ECJ (Court of First Instance) decision dealing with conceptual similarity arising out of translation.

The court held, on 9 March 2005, that there was no conflict between HAI (meaning “shark” in German) and SHARK, despite partially identical goods. The visual and phonetic differences were more important than the conceptual overlap.

Italian Names

SISSI ROSSI/MISS ROSSI; ENZO FUSCO/ANTONIO FUSCO: are the trade marks in these two pairings likely to be confused?

The ECJ's Court of First Instance held, on 1 March 2005, that an application for SISSI ROSSI for *leather goods, including bags*, would not be confused with the earlier trade mark MISS ROSSI, registered for *footwear*. The Court considered the degree of similarity between the trade marks to be “average, if not slight”. It rejected the opponent's argument that the goods were “complementary”, pointing out that complementary goods must be sufficiently closely connected that one is indispensable or important for the use of the other. The Court did accept that the goods had some points in common, in particular that they were sometimes sold in the same sales outlets. However, the surname ROSSI was common in Italy, and in the field of clothing and fashion it was common to use marks consisting of patronymics. Consumers would not believe there was an economic link between the respective enterprises selling goods under these trade marks, and there was not a likelihood of confusion. This decision has been further appealed to the full ECJ.

On 1 March 2005 the same chamber of the Court of First Instance issued another decision in a case concerning conflicting Italian names. Here, the application was for ENZO FUSCO, and the opponent's earlier mark was ANTONIO FUSCO. There were some identical goods at issue, for example *perfumery, leather bags, clothing*. The Court noted that the perception of signs made up of personal names may vary from country to country within the European Community. The Court had already held that this case must be determined according to the perception of the typical Italian consumer for the goods. That person would generally attribute greater distinctiveness to the surname rather than to the forename. Here, FUSCO was not a particularly common surname, and the goods were identical. There was held to be a likelihood of confusion.

These cases are not truly at odds with each other as initial impressions might suggest. They do illustrate the way in which the Court will always attempt to consider the likelihood of confusion from the point of view of the average consumer for the goods. It is interesting that, in the FUSCO case, the earlier trade mark on which the opposition was based was not an Italian national registration, but a Community registration: the reason the Italian consumer was taken to be the relevant consumer for the goods was that all of the arguments put forward by the parties related to Italy alone.

Names in the United Kingdom

The UK Office, following the ECJ judgement in the NICHOLS case, C-404/02, has revised its practice on registrability of both surnames, and forenames. From now on, trade marks consisting of these should normally be registrable in the UK.

OHIM Fees

Proposals are being discussed for a reduction in the filing and renewal fees for Community Trade Marks, and an increase in the opposition fee. These changes may become effective in November 2005.

.eu Domain Name

It should be possible to register .eu domain names before the end of 2005. Only organisations with a registered office, central administration, or principal place of business within the EU (or natural persons resident in the EU) will be able to hold such rights. There will be a two-month stage 1 “sunrise” period during which owners (or licensees) of registered Community and national trade marks may apply. This will be followed by a stage 2 “sunrise” period allowing owners of all other prior rights, such as company names and unregistered trade marks, two months in which to apply, before applications by all parties are permitted on a first come first served basis.

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