

DOMAIN NAME DISPUTES

NOMINET DECISION UPDATE

During 2004 Nominet received on average approximately 50 new complaints per month. Since the re-launch of the UK-based dispute resolution service, a staggering 26% of the complaints have been held inadmissible though failure to satisfy the requirements for filing a complaint and therefore deemed withdrawn. D Young & Co, have considerable experience in lodging such complaints and, to date have had a 100% success rate in obtaining the transfer of unauthorised domain names to our clients. This included the largest block transfer of domain names decided by Nominet to date in the United Kingdom for Geoffrey, Inc, owners of the Toys "R" Us trade mark. We have also been involved in several successful domain name disputes before WIPO.

Of the more recent disputes handled by Nominet, those involving what might be regarded as well known brands have generally resulted in transfers to the trade mark owner. In the last five months these have included *calvinklein.org.uk*, *starbuckscoffee.co.uk*, *carphonewarehouse.co.uk*, *dulux.org.uk*, *happysshopper.co.uk* and *allianceandleicester.co.uk*. In these cases it was relatively straight forward for the complainant to show that the unauthorised domain name would be regarded as an "abusive registration". To satisfy this requirement the complaint needs to show that the domain name was either registered or had been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

There is more to learn, however, from the recent decisions where the transfer request was refused and the domain name left with the original registrant.

In the case of *brabus.co.uk*, Brabus GmbH lodged a complaint based upon their Community Trade Mark Registration asserting that their previous UK distributor was no longer entitled to own the domain name *brabus.co.uk*. The complainant had originally consented to the registration of a domain name by Brabus UK Limited in February 2000; however, in lodging their complaint they failed to file any evidence showing why the domain name would be regarded as an abusive registration in the hands of the respondent. They even failed to evidence the existence of their registered trade mark rights. Consequently, the independent expert was unable to find any relevant abuse on the part of the respondent - who had since gone in to liquidation. Consequently, within the confines of the dispute resolution service policy, the expert held that the request for transfer should be refused.

In the case of *goldfinancialgroup.co.uk*, once again, the registrant failed to file any kind of response. This resulted in the independent expert having to assess whether or not the domain name constituted an abusive registration on the basis of the very brief complaint lodged by Gold Financial Group Limited. The complainant alleged that the registrant, Mr Steven Yates, had been asked to register the domain name (and several others) on behalf of the complainant company but had decided to register them in his own name;

however, no substantive evidence on this point was provided. The expert confirmed that the mere fact that a company is registered with a particular

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corporate name does not necessarily give that company any intellectual property rights in the name. Such rights would come from trade mark registration and/or use of the corporate name in trade or commerce in such a way to establish a protectable goodwill.

In conclusion, the expert decided that the complainant failed to establish the domain name registrations were abusive registrations and accordingly the request to transfer was refused.

Interestingly, the expert went on to add that given the nature of the allegations, the complainant should be entitled to re-file their complaint and that, in such circumstances,

the expert recommended that the matter should not be considered as "res judicata" even if the subsequent proceedings were based on the same facts. Given that Nominet's dispute resolution service is not part of the Court system in the United Kingdom, nor considered equivalent to a tribunal, it is likely that the expert's comments would be given favourable consideration should any further complaints be lodged with Nominet.

Finally, in *orbaoriginals.co.uk*, the case concerned a complaint by Orba Originals Limited, the owners of the domain name, *orbaoriginals.com*. In their evidence, Orba Originals Limited failed to establish any IP rights in the name Orba Originals or anything similar. No evidence of use was provided and, as the complainant company was shown to be a non-trading, dormant company, the independent expert was unable to address the other half of the test, namely, whether the domain name in the hands of the respondent could be regarded as an abusive registration.

The independent expert concluded that this was a case where the wrong complainant had been chosen, that is to say they could not establish that they were the owners of a valid earlier right. There was some evidence to show that another company, possibly associated with Orba Originals Limited, might have established common law rights in Orba Originals through past use of the brand. Rather surprisingly, the independent expert decided to suspend the domain name complaint procedure for a period of 28 days to preserve the status quo and thereby enable a complaint in the name of the correct complainant to be filed.

Conclusion

These cases all show that it is essential to file proper evidence designed to meet the clear rules set out in the Nominet dispute resolution service policy. Failure to do so will severely hinder the complainant's chances of obtaining a successful transfer of the domain name in question.

DOMAIN NAMES - FURTHER INFORMATION

Further information regarding D Young & Co domain name services can be found at:
www.dyoung.com/expertise/domain_names.htm.

An introduction to domain names is also available from our website in the form of our IP Primer (pdf):
www.dyoung.com/resourcesip_primers.htm or by contacting us at either our London or Southampton offices (see back page of this newsletter for contact details).





BAND NAMES GET BUSTED!

In a recent decision by the Appointed Person on appeal from the UK Trade Mark Office, it is made clear that pop groups and musical performers in general are unlikely to secure trade mark protection for many of the branded merchandise items which may be of interest to them. The applicants, the “nu metal” rock band, Linkin Park, failed to secure trade mark protection for printed matter and posters on the basis that the trade mark LINKIN PARK consisted exclusively of a sign which designates certain characteristics of the goods, i.e. describes the subject matter.

The decision confirmed that what matters most is the meaning of the mark at the date of application. Therefore, despite the fact that the word LINKIN and the phrase LINKIN PARK were invented by the group, it was held that by the time the trade mark application was filed, the mark was no longer meaningless but, on the contrary, had acquired a well established meaning denoting the group itself.

The applicant attempted to argue that a well known group should be able to stop use of their name without their consent through the grant of registrations in relation to any goods or services, without exception. A similar argument was pursued and rejected in the ELVIS PRESLEY case decided under the old trade mark law in the UK. The applicant contended that the new law introduced by the European Directive and CTM Regulation should result in a more liberal approach to registration of their marks, but was unable to cite any authority to demonstrate this.

The Appointed Person speculated that UK Government or the European Union might legislate in future to confer a right of personality upon performers (in the same way as many states in the USA have done), and there may even be some “personality” rights under Art.8 of the European Convention on Human Rights; however, to date, no developments had occurred which would support registration of the mark in question. Nor, following the case of *Irvine v Talksport*, did the law of “passing-off” assist the applicant. The Appointed Person also went on to review the ECJ decision in *Arsenal v Reed* where the defendant’s use of Arsenal was “such as to create the impression that there was a material link in the course of trade between the goods concerned and the trade mark proprietor”. The Appointed Person commented that different considerations may arise with regard to monopoly rights in trade marks for sports teams as opposed to performers and other celebrities, distinguishing that case from the issues in LINKIN PARK.

The Appointed Person also considered the case of *R v Johnstone*, where the defendant was a market trader in counterfeit compact discs. In that case, the House of Lords, confirmed that trade mark law is concerned essentially with the trade origin of goods. Protection for the rights of performers in their songs or sound recordings is properly found elsewhere, such as the Copyright, Designs and Patents Act, 1998.

The applicant asserted that it was wrong for the mark to be acceptable for calendars, decals and stickers but not for posters and printed matter, a point which was left unanswered. Furthermore, the applicant pointed out that OHIM had previously accepted an application for LINKIN PARK without any objections. Apparently, this latter point was not persuasive...

The decision affirms the reluctance of UK Trade Mark Authorities to grant protection for band names and musical groups in relation to items such as posters which third parties might legitimately wish to sell using the names. Bizarrely, other band names (including U2) are registered in the UK in respect of posters on the basis of acquired distinctiveness through use!

So what are the practical steps that can be taken to best protect the name of a band or musical group?

Firstly, an application filed at the time of the band’s creation and before they become well known, especially if the name is invented, such as LINKIN PARK, will result in an application almost certainly being accepted. It is however debatable whether the resulting registration would be regarded as valid.

There are two further options for the client to consider, which, in combination, might provide the best protection available.

The first is to seek Community trade mark protection since it is clear OHIM have less objection to accepting band names.

Secondly, and as is becoming increasingly important, if the band name is

represented in a stylised manner or as part of a composite logo, a Registered Community Design (“RCD”) will provide broad rights in relation to any goods. As RCD registrations are not limited by specification in the same way as a trade mark, and there is no substantive examination to speak of, the acquisition of design rights is both quick and cost-effective and potentially a strong deterrent to would-be infringers.

D Young & Co, has represented many bands and provided strategic trade mark advice to them. In addition, we have a thriving Design practice and have made considerable use of the protection afforded by the Registered Community Design since its introduction. For more advice, please do not hesitate to contact any of our trade mark attorneys or your usual advisor.



THE QUORN HUNT IS HALTED

In a recent opposition decision at the UK Trade Mark Registry, The Quorn Hunt's applications to register QUORN HUNT and THE QUORN HUNT as trade marks were rejected. The principal ground of rejection related to possible detriment to the opponent's mark under Section 5(3) of the Trade Marks Act 1994. This is one of the few successful cases alleging detriment as a ground of opposition.

The Quorn Hunt had filed their marks for a wide variety of goods and services ranging from protective headgear, through firearms, stationery, leather goods, kitchenware and clothing, as well as sporting services (not restricted to the sport of hunting however). The hunt is based in Leicestershire and has been meeting in that county for more than 300 years; it was fair to say that the Quorn Hunt is famous in hunting circles. Fame does not equate with popularity however (see below).

The opponent, Marlow Foods Limited, had several registrations of their trade mark QUORN, which had been used in the UK for more than 20 years in relation to a meat substitute product made from mycoprotein fungus. Sales of goods using the Quorn ingredient were substantial (most of the major supermarkets had a range of own brand vegetarian dishes using Quorn) and the consumer survey which was lodged as part of the opponent's evidence demonstrated that 70% of the respondents recognised the name QUORN in relation to foodstuffs, unprompted.

Opponents who may be deterred from compiling the type of evidence necessary to demonstrate reputation as a pre-requisite to arguing detriment, will be interested to note that the

Hearing Officer was prepared to award costs against the unsuccessful applicant towards the top end of the standard scale, to take account of the costs involved in commissioning the survey.

As well as pleading detriment, the opponents had argued that the applicant's claim included goods in class 16 which were similar to their prior rights in that class (this argument was partially successful in relation to "printed matter, cards, calendars and diaries") and also alleged a reputation in QUORN, such that use of THE QUORN HUNT marks would cause a misrepresentation to consumers, similar to that which would found a "passing-off" action. The Hearing Officer found that the opponent enjoyed a goodwill in their QUORN mark for their trade in meat-free food products, but concluded that use of THE QUORN HUNT marks would not amount to a misrepresentation leading or likely to lead the public to believe that the applicant's goods were those of the opponent, notwithstanding this goodwill.

The Hearing Officer also made a preliminary finding that QUORN and QUORN HUNT / THE QUORN HUNT were capable of confusion, given that QUORN was the distinctive component in both applicant's and opponent's marks. He relied on the survey evidence which demonstrated that a significant number of people would make an association between the words QUORN HUNT and the opponent's marks used on goods (although they would not actually be confused as to origin).

Most of the Hearing Officer's decision focuses on the "detriment" challenge. He considered what the Act meant when it required an opponent under Section 5(3) to demonstrate detriment and concluded that there must be real possibilities of harm as opposed to theoretical possibilities, although it was not necessary to demonstrate actual evidence of damage having occurred.

The Hearing Officer took judicial notice of the fact that the topic of hunting aroused strong feelings amongst the public at large, with the strength of views held by those on opposing sides of the argument for abolition of hunting being well known. He also took notice of the fact that the responses to the opponent's survey questions showed that the topic was apt to arouse strong emotions, concluding that a significant proportion of the general population would find such activities repugnant.

In the instant case, the Hearing Officer concluded that detriment in the shape of damage to the attractive and distinctive character of the opponent's mark would occur (essentially that it would be tarnished) because hunting and its associated activities arouse such strong feelings and many people found these activities abhorrent. Moreover, as the prime purchasers of the Marlow Foods QUORN products were vegetarians, any association with hunting would damage their business reputation in their trade mark to a material extent, i.e. could cause economic harm in the form of lost sales.

Interestingly, the Hearing Officer concluded that the potential harm to the Opponent's marks would extend to prevent registration of the applicant's marks in relation to any goods or services which are likely to give rise to an association with the hunt and the activities it undertook, since sale of such goods could be taken as activities indicating support of a hunt or hunting, with the consequent erosion of the goodwill which the opponents had built up in their mark.

Finally, the Hearing Officer considered whether use of the applicant's marks could be said to be with due cause in any way; although the applicant had pleaded this in their counter-statement, it had not been explained in the evidence, so this point was easily dismissed.

BAD FAITH CHALLENGES - HOW BAD IS "BAD"?

The applicant's intentions when making a UK trade mark filing have recently been examined in an interesting case involving Robert McBride's application for a 2D representation of the shape of an air freshener product. The mark applied for was opposed by Reckitt-Benckiser, who alleged that the applicant did not have a proper intent to use their mark at the time of filing. To support this claim, they filed evidence that the proprietor was selling goods in a three-dimensional format corresponding to the 2D representation. They claimed that the applicant had never intended to use the 2D mark in any way and that they had filed in bad faith.

Regular readers of this Newsletter will be aware of the difficulties inherent in securing trade mark registration for 3D shapes and the clear implication behind the opposition in this case was that the applicant was unfairly seeking to monopolise a 3D shape mark, by making a 2D filing, while knowing that they would never use the mark in the form as filed themselves.

At First Instance, the Registry Hearing Officer upheld the bad faith challenge. The applicant's failure to explain their intentions at the time of application, and to rebut the suggestion from the opponent that they had only intended to use the mark in 3D format, appears to have been highly influential. The argument by their Counsel that there was no great difference between applying for the trade mark as a 2D mark rather than a 3D mark for this type of product, was given short shrift.

The Hearing Officer felt that the claims in the Grounds of Opposition demanded an evidential response which the applicant had failed to satisfy, concluding that, at the date of application, Robert McBride had no intention to use the mark for the goods claimed. This was a materially false statement in his view and thus rendered the application one made in bad faith.

Not surprisingly, the applicant appealed and the Appointed Person, Richard Arnold QC, conducted a thorough analysis of the case law on bad faith to date, drawing support from decisions of the UK High Court, Court of Appeal and

Community Trade Mark Office, as well as other case law in related areas such as abusive company name and domain name registrations.

The Appointed Person noted that while neither the Harmonisation Directive nor the Community Trade Mark Regulation contained provisions corresponding to Section 32(3) of the 1994 Act, which requires the applicant for registration of a UK trade mark to claim that the mark is in use or intended so to be used, this did not render that provision incompatible with Community law (this point was not in issue in the current proceedings).

On appeal, the applicant's Counsel accepted that a materially false statement of intention to use, made at the time of filing, was capable of amounting to bad faith in an appropriate case.

When assessing whether the applicant's conduct had been dishonest, the Appointed Person rejected a truly subjective test (colloquially known as "The Robin Hood Test"), by which a dishonest person with low standards would be permitted to obtain trade mark registration in circumstances where a person abiding by a reasonable standard would not. However, it was inescapable in his view that the applicant's knowledge and conduct should be in issue and that these would be judged by an objective standard, based on acceptable commercial behaviour. Even if the applicant was not dishonest, bad faith could be found where the applicant's decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.

The Appointed Person noted that the cases he relied on suggested a consensus that seeking to monopolise another's trade mark would render an application invalid for bad faith; however, he also noted the Hearing Officer's finding that the applicant in this case had not deliberately and consciously decided to designate the mark in issue as a 2D mark in order to avoid distinctiveness objections.

He then accepted the applicant's

contention (introduced on appeal) that although the applicant probably only intended to use the mark in a 3D format at the time when he filed the TM3, this could in some circumstances be seen as use of the 2D trade mark applied for, since the particular presentation and packaging of the goods allowed the consumer to perceive the product in a form which was substantially a 2D image, which still corresponded quite closely to the mark applied for. These conclusions appear highly artificial, but the Appointed Person found that they were highly relevant to the issue of bad faith in the case.

He also accepted the applicant's argument that, at worst, they had made an error of judgement and that it was not enough to satisfy the "bad faith" test for the applicant to have made a statement of intention to use the mark applied for that turned out to have been incorrect. An honest, but mistaken, statement that the applicant intends to use the mark was not bad faith in the Appointed Person's view.

He commented that there was no evidence from which it could properly be inferred that the applicant knew that the sale of the 3D product would not constitute use of the mark applied for and that it was making a false statement on the application form. He rejected the argument (accepted initially by the Hearing Officer) that such an inference could be drawn from the applicant's failure to file any evidence in response to the opponent's criticisms of their conduct, or to explain what their intention was at the time of filing.

Readers of the report may consider that the applicant was lucky to survive this challenge, and that it was the skilled presentation of the argument on appeal which allowed the Appointed Person to reach this conclusion.

Overall, the case should ring warning bells when the applicant's intentions at the time of filing are unclear. Applicants should not be encouraged to file marks simply for their deterrent value or in an endeavour to gain what could be an unfair commercial or tactical advantage relative to their competitors.

PROTECTING SHAPES AS TRADE MARKS – UK v. CTM Approach

In previous issues of this Newsletter, we have commented on the intrinsic difficulty attaching to protection of 3D shapes as trade marks, both at the UK Trade Mark Office and OHIM.

Generally speaking, with the option of Registered Community Design/national registered design protection now available as an alternative for protecting product shapes, there is a strong message coming from the UK and European tribunals that seeking registration of trade marks is not the most appropriate means of securing monopoly rights in this area.

Most of the decisions for shape marks filed at OHIM have involved rejections of shapes where the owners have not filed evidence of use to support a claim to distinctiveness and secondary meaning.

The latest decision involving a Community Trade Mark is the ECJ decision in *MAGLITE*, upholding previous refusals by OHIM and the Court of First Instance to accept the applicant's 3D torch shape. The ECJ was reluctant to accept that 3D product marks had a capacity to distinguish the proprietor's goods, unless they were substantially different from the normal representations used in the relevant business sector. They rejected the applicant's claim that the 3D *MAGLITE* torch marks were actually distinctive, despite evidence of international recognition and expert opinion evidence, because they failed to argue that the marks had acquired distinctiveness (under Article 7(3) of the Regulation) at the outset.

The English Courts have, however, given two recent judgments where the applicants had filed this type of evidence. The first was the second set of proceedings in the ongoing dispute between Philips and Remington concerning the shape of electric shaver heads. In that case, evidence filed by Philips failed to establish that the alleged distinctive clover-leaf shape superimposed on their shaver head was recognised as a trade mark by the relevant public, separately and apart

from the familiar three-headed triangular shape of their product.

This point was not central to the decision in *Philips v. Remington*, but it was the key issue in an important decision of the English Court of Appeal involving an application by Bongrain S.A., to register the shape of their cheese product as a UK trade mark. The goods were presented in a floret-shaped format



(see left) which the applicant argued was strikingly unusual and would be recognised as a trade mark as a consequence.

This argument for inherent distinctive character had been rejected by the Registry and the English High Court on appeal, both of whom had reiterated that to be registrable, the shape should convey trade mark significance to the relevant public. The mere fact that the shape was unusual would not automatically mean that it functioned as an indication of origin.

The applicants had supported their trade mark application with evidence of past use of the shape mark; this was heavily criticised by the Court, since it did not demonstrate use of the mark actually applied for, but instead, use of a similar shape with an additional label. The extent of the use was also not seen as significant considering the size of the UK cheese market as a whole.

Independent evidence was also rejected on the basis that it simply contained assertions/guesses by the respondents as to what they thought when they saw a picture of the applicant's mark. Overall, this evidence was treated as valueless and falling far short of the necessary standards required to prove acquired distinctiveness through use.

In this respect, the Court of Appeal judgment has reaffirmed a well established trend in UK law, wherein applicants for UK trade mark registration relying on evidence of acquired distinctiveness are required to show not only that relevant use has occurred,

but that the average consumer would perceive the sign as having a trade mark significance. The lead judgment, by Jacob LJ, was particularly trenchant on this point.

In practical terms, this latter requirement is very difficult to satisfy; most consumers do not, unprompted, attribute trade mark significance to particular product features, although they may recognise them. The conceptual leap necessary to associate such features with a single trade source, however, is virtually impossible to demonstrate in survey evidence, absent a targeted marketing campaign which is designed to educate the consumer to make this connection.

Where the sign in issue has been used in conjunction with other, more obvious trade mark matter, such as a word mark or a fancy label, this will almost certainly mean that the consumer does not focus on the 3D shape as having a trade mark significance, since it is not usually viewed in isolation.

To date, there have been no clear decisions from the ECJ which state that evidence of secondary meaning must establish trade mark recognition on the part of a purchaser where a product configuration is the subject of monopoly claims. It may still be possible to ask OHIM to infer that such a connection is made when the evidence of use is sufficiently persuasive in terms of nature, extent and market share. In the *MAGLITE* case, the ECJ suggested that shape marks are *prima facie* acceptable if they depart significantly from the normal customs of the sector, thereby fulfilling the essential function of indicating origin. They did not go on to state that positive recognition of such a trade connection by consumers was necessary before such a conclusion could be reached (which would, in any case, have the effect of depriving applicants for most shape marks unsupported by evidence of any prospect of securing registration).

Accordingly, it may still be preferable for UK trade mark owners to seek protection for shape marks at Community level, rather than via national filings, where it is clear that additional proof of trade mark recognition by consumers is required.

Slogans

REGISTERABLE OR NOT?

Two recent decisions on slogans, one from the UK Trade

Marks Office and the other relating from OHIM to a European CTM have helped clarify trade mark law relating to the protection of slogans. Both cases have provided much needed guidance on slogans and phrases and whether they function only as a promotional tool or can also be viewed as trade marks.

The United Kingdom case concerned an opposition by ASDA Stores Limited (owned by Wal-Mart) against applications filed by Tesco Stores Limited, the largest supermarket chain in the UK to register the trade mark TESCO WE SELL FOR LESS both as a word and a composite device mark.

At the time of filing the applications, Tesco had issued a press release complaining that Wal-Mart and ASDA were attempting to "buy up the English language" by registering various everyday phrases. Tesco were well aware of Wal-Mart's use of the phrase, WE SELL FOR LESS. Not surprisingly, in their opposition, ASDA claimed bad faith under Section 3(6) of the UK Act.

Whilst the original Hearing Officer held that the applications filed by Tesco could not be viewed as spoiling mechanisms, he concluded that they had no bona fide intention of using the marks as trade marks and therefore had acted in bad faith. The applications were thus rejected. Tesco then appealed.

In their appeal to the Appointed Person Tesco argued that they intended to use TESCO WE SELL FOR LESS (logo) as a trade mark and the fact that it had a promotional element was irrelevant. They also filed evidence showing the contested slogans in use. They further asserted that whilst the UK requires a trade mark to be used, or for there to be an intention to use at filing, failure to comply (which requirement they argued was of questionable legal validity) does not necessarily mean that the application was made in bad faith.

The Appointed Person held (following the ECJ jurisprudence) that a Trade Mark cannot be refused simply because it contains promotional or other descriptive material. Since the appellant's marks both contained the word TESCO, they were inherently distinctive (this was not challenged by ASDA).

The Appointed Person then concluded that the Hearing Officer had erred in finding the applications to have been made in bad faith. Whilst the time at which the applications were filed would be the point for determining whether or not bad faith existed, subsequent events can be considered if they assist in clarifying the applicant's state of mind at the date of application. In this particular instance the evidence supported the applicant's contention that it did have an intention to use the marks applied for.

Whilst much of the case related to the question of bad faith, or lack thereof on the part of the applicant, the Appointed Person's comments relating to the fact that a slogan can be a promotional or advertising tool in addition to being a trade mark are noteworthy.

This latter point was confirmed by the earlier decision of the European Court of Justice in the case of the German slogan mark translated as "The principle of comfort". In a judgment issued in October 2004, the ECJ emphasised that the criteria for establishing distinctiveness for slogans should not be any more strict than for other types of trade marks.

UK – NEW REGISTRY PRACTICE ON SURNAMES

Following the decision of the European Court of Justice in the *Nichols* case (reported in our November 2004 Newsletter) the UK Trade Marks Registry has issued a Practice Amendment Notice (PAN 1/05) which amends its practice so far as marks consisting of surnames, forenames and full names are concerned.

In the *Nichols* case the ECJ held that in assessing the distinctiveness of a trade mark consisting of a surname it is wrong for registration authorities to use stricter criteria than that used for other types of mark. In particular an examination policy for such marks raising objections based on the number of surname entries in telephone directories should not be used.

As a result the UK Trade Marks Registry will no longer object to trade marks consisting of common surnames simply on the basis of the number of entries appearing in telephone directories.

In exceptional cases (e.g. of a common surname in a field where a large number of traders use that name) the Registry may conclude that customers would not see the name as having distinctive character and still raise objections – but generally such objections will now be rare at the examination stage and rather will be left to third party challenge at the opposition stage.

The same considerations will apply to trade marks consisting of surnames combined with initials or full names (indeed, objections to these at the examination stage are even less likely).

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If a common surname has another meaning which is itself objectionable in relation to the goods/services concerned (e.g. BROWN for paint which could be brown in colour) then an objection based on the "descriptive" meaning will still be raised.

Applications for trade marks consisting simply of forenames will normally be acceptable (except in relation to the kind of goods which are traditionally decorated with common forenames e.g. mugs/bracelets).

The UK Registry's previous practice of objecting to male/female forenames for restaurant services/hairdressing services etc. is to be relaxed; again such objections are unlikely to arise at the examination stage in future.

Following the *Nichols* decision a number of UK trade mark applications for marks consisting of/containing common surnames which had been suspended by the UK Trade Marks Office pending the ECJ decision are now going forward to publication/registration. In future, examination practice at the UK Office on surname marks is likely to be more in line with that operated by OHIM. Thus it will be easier to register a mark consisting of or containing a surname, even where this is not uncommon.

STOP PRESS! REDUCTIONS IN OHIM FEES

The European Commission is proposing reductions in OHIM's filing and registration fees for trade marks. This reduction will take account of the proposal to abolish the official search as part of the OHIM examination procedure for trade mark applications.

The basic application fee will go down from €975 to €600. There will be a further discount of €100 for electronic applications. The basic registration fee will reduce from €1,100 to €950. Renewal fees will also be reduced from €2,500 to €1,750.

In addition, the fee for a Madrid Protocol claim, designating the CTM will reduce from €1,875 to €1,300

(this covers both application and registration fees in a single upfront charge).

Not all of the proposals for amendment by the European Commission involve reducing OHIM's fees; both the opposition and appeal fees are likely to increase, as well as the fee for filing a Declaration of Invalidity or Revocation request.

Nevertheless, trade mark proprietors should welcome the proposed reductions in filing fees, which will make a CTM filing even better value, by comparison with the cost of individual national filings in the 25 countries covered by a Community Trade Mark.

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