



HOLY COW

ARE **YOU** SELLING MOO JUICE?

The UK case of Almighty Marketing Ltd and Milk Link Ltd, one of the first to be heard by the new IP Judge, the Honourable Mr Justice Kitchin, concerned an action for revocation on the grounds of non-use against the mark MOO JUICE. The case turned on the question of what evidence the registered proprietor was required to file at the initial stages.

Milk Link had applied to revoke the registration for MOO JUICE in the name of Almighty Marketing on the grounds that it had not been used in respect of milk and milk beverages between 1999 and 2004. Almighty Marketing responded by filing evidence in the form of a Witness Statement from a director of Almighty Marketing who confirmed that MOO JUICE had been in use in relation to milk until at least March 2001. Exhibited were sample labels used on milk cartons and a letter from the registered proprietor's accountants attesting to the daily use of the mark.

The Registrar of Trade Marks had then to decide whether the initial evidence filed by Almighty Marketing satisfied the first stage requirements of the Rules, namely to show that the proprietor has an arguable defence to the application for revocation. The initial decision from the Trade Mark Registry was that Almighty Marketing's evidence met this requirement (as set

out in Rule 31(3) of the Trade Mark Rules 2000). However, Milk Link were not satisfied with this and asked for a hearing where, surprisingly, the Hearing Officer decided to reverse the preliminary view. Almighty Marketing appealed this decision to the High Court where the matter was heard before Mr Justice Kitchin.

In a well reasoned and clear decision, the Judge outlined the history of revocation on the grounds of non use under the Trade Marks Act 1994 and confirms that the onus lies with the registered proprietor to show genuine use. He stated, however, that the proprietor's initial evidence merely needs to show a viable defence to the pleaded allegation of non-use. He indicated that the evidence does not have to be so persuasive that, if unanswered, it would necessarily discharge the burden of proof lying with the proprietor.

Mr Justice Kitchin confirmed that whilst it might be desirable for the proprietor to provide use information such as brochures, catalogues, pamphlets, advertisements and the like together with an indication of the sales of goods immediately, there is no requirement for him to do so at this stage of the proceedings. Accordingly, the Judge held that Almighty Marketing had done enough to show that they had an arguable or viable defence to the allegation of non-use and overturned The Hearing Officer's

decision. The appeal was therefore allowed and the case remitted back to the Trade Mark Registry for the revocation proceedings to continue.

Trade mark owners should remember that a bare assertion of use in their defence counter-statement or initial evidence is still unlikely to be regarded as sufficient to support an arguable case. However, the initial evidence is not determinative, and this case confirms that the registered proprietor has the further opportunity to supplement their evidence of use prior to the Registrar's final decision.

CONTENTS

Cover Page
HOLY COW - ARE YOU
SELLING MOO JUICE?

Page 2
WHEN DID YOU LAST VISIT
CLOPPENBURG?

Page 3
CASE 0/312/05 - NEW
COVENT GARDEN SOUP
COMPANY
TRADE MARK MIS-USE ON
THE INTERNET - SPONSORED
LINKS

Page 4
CONTACT THE D YOUNG &
CO TRADE MARK GROUP
SUBSCRIPTIONS



WHEN DID YOU LAST VISIT CLOPPENBURG?

Words which have geographical significance are potentially unregistrable as trade marks where they are likely to be perceived by consumers as an indication of geographical origin. This principle was established by the ECJ in the decision involving the trade mark *WINDSURFING CHIEMSEE* (joined cases C-108/97 and C-109/97 reported in [1999] ECR I-2779).

However, not all geographical names are unregistrable, particularly those where there is no obvious link between the name and the goods or services claimed. This topic was recently revisited by the European Court of First Instance in a case involving the name "CLOPPENBURG". The applicant had filed for "retail services" in class 35 and

OHIM rejected the mark initially, on the basis that "CLOPPENBURG" was the name of a town and a district in Lower Saxony in Germany. On appeal to OHIM's Fourth Board of Appeal, this decision was upheld. In their reasoning, the Board of Appeal went further, claiming that the name would certainly be seen as indicating geographical origin, because it would be referred to (*inter alia*) in weather reports and forecasts or, alternatively, in traffic information bulletins and thereby become known for having geographical significance to the relevant public who were, in this case, the average German consumer.

The applicant appealed further to the European Court of First Instance (CFI) arguing that CLOPPENBURG was also a common surname, with over 16,000 subscribers listed under that name in German telephone directories.

This raised an interesting conflict, since regular readers will be aware that the ECJ decided in the *NICHOLLS* case that common surnames could be registrable, unless it was shown that they could not function as an indication of origin.

In the CLOPPENBURG appeal, the applicants claimed that the surname significance served to diminish the potential impact of the word "CLOPPENBURG" as a geographical term. They also claimed that it would be more usual for the word to be used in an adjectival form, e.g. "Cloppenburger" (meaning "from Cloppenburg") before geographical meaning would be ascribed to it by the consumer. The appellant also pointed out that there had been no evidence to show that the general public would associate the geographical location of Cloppenburg with retail trade services, or that such a connection would be likely in the foreseeable future.

The CFI accepted these arguments, pointing out that "CLOPPENBURG" as the name of a town referred to a location with only 30,000 inhabitants; as a consequence, it seemed unlikely that most German consumers would be aware of the town name. The suggestion that it could become known to all consumers in Germany through usage in weather reports and forecasts was rejected; the CFI commented that such reports and forecasts usually referred to larger towns or areas, e.g. Hamburg or Hanover, rather than being so location specific.

The argument that the town name would feature on maps and road signs, thus reinforcing the geographical meaning was also rejected, again on the basis that this would only be apparent to members of the public in that particular area. It appeared that the town did not have any particular attractions or industrial specialisation and, therefore, the Court deduced that the awareness of "CLOPPENBURG" as a geographical location name amongst most German consumers would be low. No link between "CLOPPENBURG" and retail services

had been shown.

Interestingly, by the time the CFI heard the case, OHIM had changed its mind about the mark and decided that the original objection under Article 7(1)(c) on grounds of geographical significance was incorrect. However, OHIM itself had no power to annul the subsequent decision of the Board of Appeal upholding the original rejection and therefore had to allow the case to go forward for formal decision before the CFI. During the argument before the Court, OHIM filed submissions which supported the applicant's appeal, somewhat absurdly.

In their decision, the CFI acknowledged that OHIM, in its own right, had no power to bring any action to annul a decision of its Boards of Appeal. At the same time, they awarded costs against OHIM at the conclusion of the proceedings, which hopefully will incentivise them to examine such borderline cases more carefully in future.

NEW COVENT GARDEN SOUP COMPANY

CASE O/312/05

This case involved a revocation action in the UK Registry on the basis of non-use of the registered trade mark. The registered trade mark in this case was NEW COVENT GARDEN SOUP CO., written in block type face. The mark was registered for "soups and soup preparations".

The UK Act provides that to maintain a registration in revocation cases, any use relied on must be of the mark as registered or in a form differing in elements which do not alter the distinctive character of the mark.

There was no real dispute that the words NEW COVENT GARDEN SOUP had been used by the trade mark owner on the registered goods within the relevant period, and indeed on a substantial scale. However, the applicant for revocation argued that there was no use of NEW COVENT GARDEN SOUP CO., as an independent trade mark, but only as a composite part of other marks, or as the full company name. This "alternative" use was, in their submission, not sufficient to save the registered mark.

The Registry Hearing Officer, Alan James made two rather unusual findings in dismissing the action for revocation: Firstly, he accepted the applicant for

revocation's submission that use of the words NEW COVENT GARDEN SOUP (omitting the element CO) amounted to use of the mark which did differ in the elements affecting the distinctive character of the registered word mark. This was because the registered mark brought to mind a particular soup company, whereas the variant mark did not. This is surprising, since it would generally be considered that the element Co. (as an abbreviation for the word "company") would not add to the overall distinctive character of the trade mark, hence its absence or addition would not normally be regarded as a material element, which altered the distinctive character of the mark overall.

Equally surprising was the Hearing Officer's second finding that use of the device mark (depicted above), was use of the registered trade mark in a form differing in elements which did not alter the distinctive character of the registered mark. This use was held sufficient to maintain the registration of the registered block type word mark.

The Hearing Officer commented (in relation to this device) that he did not think it could be seriously argued that arranging the words into a roundel could affect the mark's overall distinctive character; this finding is

probably sustainable. His view that the added device does not affect the registered mark's distinctive character is less easy to understand.

Clearly, it is arguable that a depiction of a bowl of soup and a spoon is not particularly distinctive in connection with soup products, but overall the device relied on appears significantly different to the word mark NEW COVENT GARDEN SOUP CO.

If the proprietor had wished to obtain a monopoly in this particular representation, standard advice would have been that a separate trade mark application would be required, i.e., in addition to the simple word mark NEW COVENT GARDEN SOUP CO.

Indeed, it is established Registry practice that such device elements, which are non-distinctive when viewed on their own, can add little to the overall distinctive character when they are a part of a mark. The Hearing Officer's reasoning is also a little difficult to reconcile with the first finding above. The use or absence of Co. does have a material impact on the distinctive character of the mark but an added depiction of a bowl of soup does not?

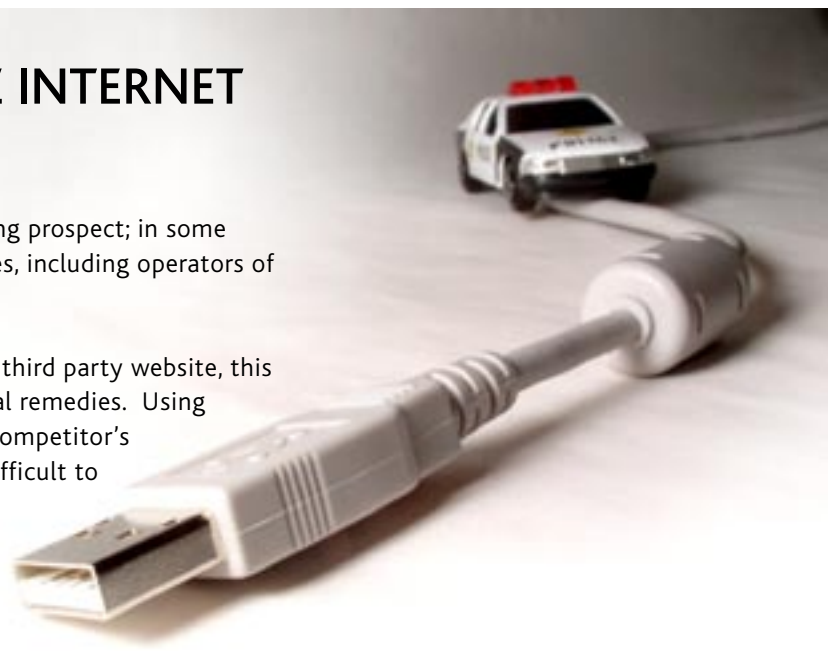


TRADE MARK MIS-USE ON THE INTERNET – SPONSORED LINKS

Policing the Internet for trade mark mis-use can be a daunting prospect; in some cases however, help can be available from unexpected sources, including operators of Internet search engines themselves.

Where there is clear mis-use of a registered trade mark on a third party website, this can be enjoined by the trade mark owner using standard legal remedies. Using a registered trade mark in a metatag to link the public to a competitor's website may also be actionable, although somewhat more difficult to establish.

A third type of abuse can occur when the registered trade mark appears in the heading or content of a sponsored link on Internet search engines. The operators of "Google" will now co-operate with the trade mark owner to prevent this type of mis-use, via their standard trade mark complaint procedure. This can be far more efficient and cost-effective than legal proceedings to prevent trade mark mis-use. The procedure can be invoked either by the trade mark owner itself or their representative, such as their trade mark attorney. [\[CONTINUED OVERLEAF\]](#)





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Details of the registered mark must be provided to Google.

If their enquiries using the mark as the key word indicate that it is being used as a heading or title on the sponsored link (which normally appears on the right-hand side of the Google pages), they will act to remove that link until the reference to the trade mark is deleted. It should be noted that this procedure will only apply to a sponsored link, since Google obtains a revenue from such arrangements and correspondingly feels responsible for ensuring that they are above board.

The position is less clear where the trade mark is being used as a metatag to make the connection with the sponsored link, but does not appear on the web page. It has been argued, in recent US Court proceedings, that Google is still responsible for policing this type of trade mark mis-use (again, the justification is that since it derives sales or advertising revenue from such sponsorship payments, it needs to police the operations of the businesses creating these links). The US Court which considered this argument (in the Geico v. Google case) concluded finally that no relevant likelihood of confusion had been shown where the trade mark itself was not referenced in the

headings to the sponsored links or in the text which they contained and this "hidden" use in metatags was therefore not Google's responsibility.

Whether the law of unfair competition (largely embodied in common-law "passing-off" rights, but now supplemented by Section 10(3) of the UK Trade Marks Act protecting marks with a reputation) could be invoked to prevent such "covert" trade mark use in sponsored links in the UK is still an open question.

It could be argued that using a well known trade mark as a search link is taking unfair advantage of that mark's distinctive character or repute for the purposes of Section 10(3) of the UK Trade Marks Act. The search engine provider is making an income out of an unauthorised use of the mark, even if its business operations are not in direct conflict with those of the trade mark owner.

Whether this argument will find favour with the UK Court or even the ECJ remains to be seen. As aspects of the Internet become subject to ever closer Government regulation however, it is not impossible that such a claim could go in the trade mark owner's favour in the near future.

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