

## TRADE MARK NEWSLETTER

## CAMPAIGN FOR REAL BEAUTY?

Many readers may be familiar with Unilever's prominent advertising campaign, promoting their Dove range of products, to celebrate or recognise "real beauty". Dove advertisements have recently featured "real women" as part of this campaign, which is referred to by the slogan "CAMPAIGN FOR REAL BEAUTY".

Whilst in theory the acceptance of slogan marks for the UK and Community Trade Mark Office should be no more difficult than any other trade mark, in practice it has of late been difficult to secure the acceptance of slogan marks unless they are considered to be particularly fanciful or "impenetrable". Accordingly, when Unilever first applied to register "CAMPAIGN FOR REAL BEAUTY" at the Community Trade Mark Office, the Examiner found the mark to be non-distinctive and descriptive in relation to the goods and services claimed (the application listed a variety of Class 3 goods, Class 16 goods including printed publications, newsletters and magazines and Class 41 services relating to education and training in respect of beauty, healthcare etc).

Unilever appealed, and the OHIM Board of Appeal were more persuaded by the concept of Dove's "campaign for real beauty". Since the essence of the campaign, which the Board of Appeal appeared to accept whole-heartedly, was that concepts such as "beauty" are necessarily subjective and can (and should) not convey any concrete or definite ideas to the relevant purchasing public, the rejection of this slogan was reversed.

In the Board's view, the contested mark, "CAMPAIGN FOR REAL BEAUTY", was only suggestive of the applicant's goods and services. The Board took the view that the mark as a whole merely suggested the existence of an "aesthetically minded

movement engaged in harnessing resources to make people beautiful". This was necessarily a fanciful notion, since real beauty is something essentially inherent in a person.

One may wonder if the Board of Appeal's comments went rather too far when they indicated that a person's beauty could not be

materially altered through the use of the applicant's goods or services and therefore they found the mark to be ironical! The suggestion that one could obtain "real beauty" by use of cosmetic products was apparently humorous!

In a remarkably severe statement, the Board of Appeal held that "no amount of training or education or publicity in the field of skincare will bring any closer the average person's dream of becoming handsome or beautiful when those qualities are lacking or are only partly present before"!

Accordingly, the case is perhaps a pyrrhic victory for Unilever since they have obtained registration of the trade mark CAMPAIGN FOR REAL BEAUTY but the Board of Appeal has suggested that their products are unlikely to be of much use to the average person! Perhaps the Board didn't understand the real point of the Dove campaign at all.

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SUBSCRIPTIONS

# AUTUMN SHADES: THE COLOUR ORANGE ... OR IS IT YELLOW?

Psychology suggests that, in the West, the positive associations of the colour orange include energy, warmth, playfulness, fun, enthusiasm, vibrancy, sensuality and passion. It is not surprising, therefore, that so many businesses are keen to align their image with that of the colour orange.

Use of orange as their corporate colour is not all that Orange telecommunications, EasyGroup, Hermès luxury goods, B&Q do-it-yourself supplies and Veuve Clicquot champagne have in common. All have tried and, so far, with the notable exception of the champagne house, failed to secure registered trade mark protection for their house colour as a "stand-alone" mark in the UK or as a CTM.

So now, what lessons can be learnt from Veuve Clicquot?

- Persevere. The application was filed in February 1998 and the decision of the Board of Appeal that the mark was distinctive was issued in April 2006 following many rounds of evidence and written submissions. However, if proper consideration is given to the issues before the application is filed, there is no reason for the process to take any

longer than average, if the guidance given in this and a number of other decisions on "non-traditional" marks is followed.

- Make sure the description of the mark meets the requirements of "graphical representation". Veuve Clicquot stated that the application was for the colour orange. During prosecution it further identified this colour as closest to Pantone shade 137C.
- Consider the evidence to be submitted before filing the application. Multi-faceted evidence is likely to be necessary, including extent of sales, length of use and market share supported by more specific survey evidence relating to the relationship between the colour and the business in question as perceived by the average consumer.
- Consider conducting market research (to substantiate the claim that colour is perceived as an indication of origin by the relevant public) immediately prior to filing the application. Market research conducted years after the application is filed is unlikely to reflect the

position at the time of filing, which is the relevant date.

- If possible, obtain trade evidence (e.g. from a trade association or institute) at the time of filing, confirming that the applicant is the only trader in that market using the colour to identify their business – exclusivity helps.
- Educate the relevant public, through advertising, that the colour in question is an indication of origin. Veuve Clicquot referred to their colour in advertising campaigns throughout Europe: "Das berühmte gelbe Etikett", "all'inconfondibile colore arancione dell'etichetta dello champagne", "une étiquette orangée" etc.
- Be specific and focused about the goods or services included in the application. Veuve Clicquot's application was originally filed for a broad range of goods in classes 32 and 33 but was later restricted to "champagne" only.

Another application for a single colour mark (in this case, the colour yellow), filed in the UK by Calor Gas (Northern Ireland) Limited, did not meet such a happy end; the mark was recently rejected in May 2006.

The Calor Gas application was filed in 1997 and in the course of examination had a series of objections raised to the representation of the mark. The application form carried a representation of a gas cylinder together with the words "The Trade Mark consists of the colour yellow applied to the outer surface of the cylinder within which gas is contained".

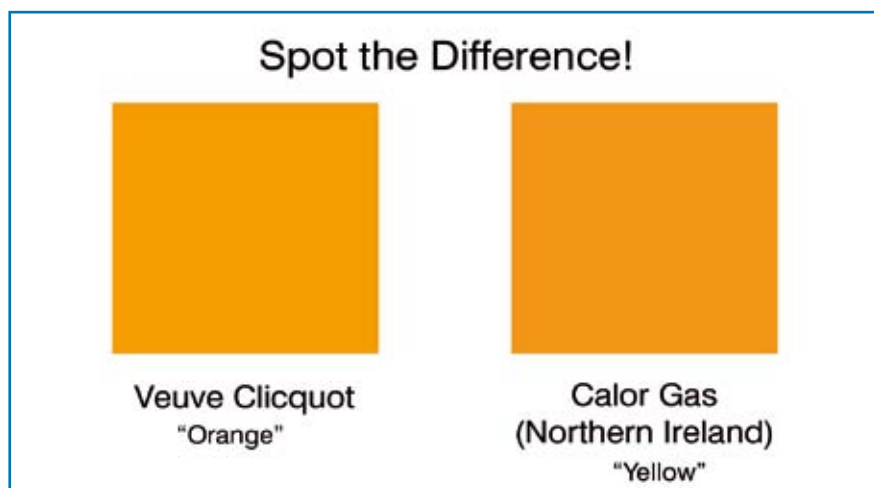
The first of these objections followed the *Ty Nant Spring Water* decision [2000] RPC 55, on

precise identification of the mark but was waived when the wording was amended to read "The Trade Mark consists of the colour yellow applied to the *whole visible surface* of the cylinder within which gas is contained". Then, following *Libertel*, a further objection was raised asking for a specific colour reference using an internationally recognisable identification code.

In response, a representation of the colour applied for was filed as a JPEG file which had been copied on to a floppy disc. This represented the colour "yellow" by identifying the reference values using the RGB coding

concluded that the colour in question was closest to "coated inks" Pantone 1375 C. To help our readers picture these colours, it is the case that Pantone 1375 C and 137 C (the Veuve Clicquot colour) are very similar.

The arguments and supporting evidence put forward by the applicant's representative to justify registration of the colour as yellow were impressive. They included the Oxford Concise Dictionary's definition of "yellow" (a colour between green and orange) and "orange" (a reddish yellow colour); the results of a survey conducted of retailers of the gas cylinders, where the colour



system. At the time, the Trade Mark Registry's guidance on filing documents electronically indicated that this was an acceptable means of identifying an electronically filed colour, because it would allow the Office to reproduce the colour accurately on the electronic register.

Lo and behold, the Registry wrote back to say that this was a clear representation of a specific colour but the colour in question was not yellow, it was...ORANGE! They asked the applicant to re-send the representation in the same format but for the colour originally applied for. The problem was that this was the correct colour.

Although the Calor Gas "yellow" is not a shade represented exactly in the Pantone colour system, the registrar had an examination of the colour conducted by an in house technical expert. This

was referred to as "yellow" throughout; and an OHIM Board of Appeal decision on an application to register an almost identical colour, which was referred to as "yellow" throughout.

All this was to no avail. To the UK Registrar, the colour was undoubtedly orange and the Examiner found that there was "ambiguity caused by the tension between the written description and the colour represented in the JPEG file". Eight years after filing, the application was deemed never to have been made because it did not contain a proper representation of the mark.

It is true that each person perceives colour in their own way. However, this case highlights the potential danger of this subjectivity.

## A DECISION WORTH MORE THAN A COUPLE OF NICKERS TO NIKE?

In February 2000, Fina Calzados filed an application to register "D'Nickers" with an accompanying logo as a Community Trade Mark claiming "footwear" and the related services of retailing, distribution and storage of footwear.

Following publication, the US corporation, Nike International, Inc., filed an opposition, basing it on a number of earlier Community and EU national rights, all of which included protection for shoes or footwear. These earlier rights consisted of either the trade mark NIKE (block letters), or the well-known "swoosh" mark, or the composite mark made up of the word NIKE with the "swoosh" appearing beneath the word. Nike claimed that the words NIKE and D'NICKERS were identical or confusingly similar and that the mark applied for was in respect of identical or similar goods to those protected by their earlier rights. The opposition was also based on Nike's reputation in the mark and the fact that they had earlier rights in the sign Nike International Limited. Nike filed extensive evidence in support of their claim to reputation.

Nevertheless, in their initial Decision, given on 21 January 2005, the Community Trade Mark Office rejected certain details of Nike's earlier national rights, which were in the name of an associate company of the opponents, as a correct basis for opposition. They concluded that



***Comment on a Decision of the Second Board of Appeal of 19 May 2006 in Case R 301/2005-2: Nike International, Inc v Fina Calzados, S.L***

the evidence filed in support of the claim to reputation Nike enjoys in its trade marks was not sufficient and that the case had not been properly argued to show the existence of detriment and unfair advantage. Therefore, the objection filed under Article 8(5) CTMR failed.

No evidence showing use of the sign Nike International Limited was submitted and therefore, the claim to user rights in this sign failed under Article 8(4). Not surprisingly, the Office decided that the earlier trade marks and the marks applied for were not identical and therefore the opposition failed under Article 8(1)(a).

Moreover, it was considered that although the NIKE and D’NICKERS trade marks had certain similarities, they were not sufficient to make the signs similar overall, especially in the light of other and far more dominant elements being present. Therefore, since the signs were dissimilar, there could be no likelihood of confusion and the opposition failed under Article 8(1)(b) also.

Nike appealed, but only in regard to the adverse decision relating to their objections on Article 8(1)(b) and 8(5) grounds. OHIM’s Second Board of Appeal found that in regard to reputation, the Office is restricted to considering the evidence submitted by the parties and that assessment of reputation is based on considerations of fact. However, the Board cannot make a decision that is contrary to reality and, therefore, they must take into account any information generally or publicly available. Such information in this case pointed to the fact that Nike’s reputation for their brand demonstrated that “it is, indeed, a very famous brand name”.

In considering whether the respective trade marks were identical or



similar, the Board of Appeal concluded that phonetically, particularly in non-English countries, the marks were similar. It also found that there was much greater evidence of visual similarity where similar overall impressions created by the common features existed; although those features were not so close so that the marks would be considered to be confusingly similar, as is required under Article 8(1)(b), nevertheless, the protection conferred by Article 8(5) is not conditional on a finding of confusingly similar signs. It is only necessary to show that the public will perceive a link. Therefore, a lower threshold of similarity between the marks is sufficient if the opponent can show that he enjoys renown and reputation in his trade mark.

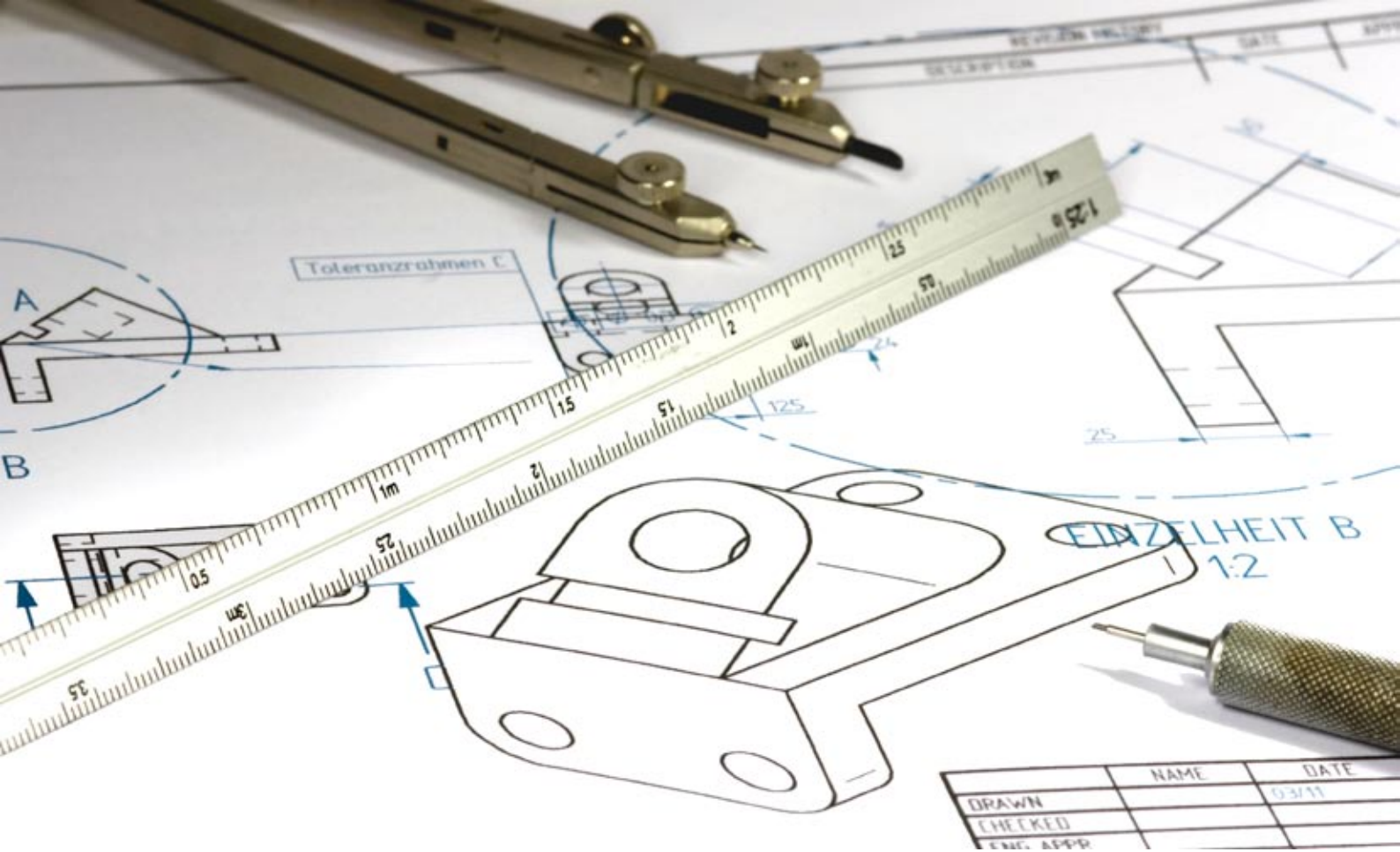
Conceptually, the Board considered that a significant part of the relevant public would not give either mark a conceptual meaning but nevertheless would associate the mark applied for with Nike’s earlier marks due to Nike’s reputation. They would not be confused because purchasers of Nike’s goods are brand conscious and attentive but nevertheless they would make such a link.

However, to succeed under Article 8(5) CTMR, the opponent must also show that there is prima facie evidence that the applicant would enjoy an unfair advantage by using the mark applied for. The stronger the earlier mark’s distinctive character and reputation, the easier it will be to accept that detriment will be caused. A strong distinctive character and reputation in the earlier NIKE trade marks had been shown and there was a clear connection between the goods and services for which protection had been sought in the application and the goods on which Nike use their trade marks.

Accordingly, the Second Board of Appeal found that the appeal under Article 8(5) was well-founded and rejected the application in its entirety.

There is a useful lesson to be learned here, insofar as your trade mark enjoys renown and reputation; it is important, firstly, to claim reputation as the basis for the opposition, and then substantiate it with strong evidence of the reputation enjoyed in the EU Member States. You should also file arguments as to why use of the mark applied for would be detrimental to the distinctive character of your earlier mark.

If the claim to reputation is successful, then it will not be necessary to show that the marks are identical or similar and used on identical or similar goods but simply, that through knowledge of your mark, the public will perceive a link.



## UK DESIGNS UPDATE

In a further bid to harmonise the laws of EU Member states together with an underlying interest to encourage British design innovation, additional reforms to the UK Registered Designs Act 1949 are due to come into force later this year.

The Regulatory Reform (Registered Designs) Order 2006, The Registered Designs Rules 2006 and The Registered Designs (Fees) Rules 2006 will all come into force on 1 October 2006.

The reforms are intended to curtail the bureaucracy and generally speed up the application process for registering designs in the UK. They will have the following effects on the Registered Designs Act 1949 and corresponding Registered Design Rules 1995:

- Novelty and individual character will no longer be examined in new applications. This will bring UK practice into line with the Community Registered Design system.
- Multiple designs will now be allowed in a single application and a reduction will be made to the fee for each additional design from the standard £60 to £40. This will ease the costs of filing, where several applications need to be made at the same time.
- Simplified application forms will be used.
- There will be an option to delay publication and registration of a new design for up to 12 months following acceptance. This allows the design to be put on the market at the same time it has become registered, which will reduce the likelihood of a design being copied.
- Restoration of lapsed design registrations will be made easier.
- Publication of new designs will be made mandatory.

If you require further information on any of these issues, please contact a member of our Trade Marks or Designs team who will be happy to answer any questions.

# TRADE MARK GROUP EVENTS AND VISITS

Our Trade Mark Group travels extensively, both in order to develop proactive relationships with clients and to build relationships with overseas attorneys.

In keeping with this, members of the Trade Mark Group are attending the following events:

## ITMA Autumn Conference: September 2006

Gillian Deas will be attending the Conference in Newcastle Upon Tyne, UK, in her role as Vice President of ITMA. Taking place over 2 days the conference will include keynote speeches from representatives of eBay and Nokia. For further details of this event visit: [www.itma.org.uk](http://www.itma.org.uk)

## PTMG Conference: October 2006

Penny Nicholls will be attending the 73rd Pharmaceutical Trade Marks Group Conference in Boston, USA. The theme of this conference will be current challenges to trade marks. For further details of this event visit: [www.ptmg.org](http://www.ptmg.org)

## ITMA Seminars - China & Japan: October 2006

In her role as Vice President of ITMA, Gillian Deas will be giving talks about European Case Law on Trade Mark Dilution in Beijing, China and Osaka and Tokyo, Japan.

## INTA Leadership Meeting: Phoenix, Arizona, USA

Jeremy Pennant will be attending the INTA Leadership Meeting which provides members the opportunity to exchange ideas, network with colleagues and plan the coming year's events and activities.



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