

# D YOUNG & CO TRADE MARK NEWSLETTER<sup>no.52</sup>

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4-5 October 2010

### Life Sciences Patent Seminar

Book now to guarantee your place at this two day seminar, to be held at the Radisson Blu (SAS) Royal Hotel, Copenhagen, Denmark. Speakers will include D Young & Co Biotechnology, Chemistry and Pharmaceuticals Group patent partners. The seminar will provide an interactive workshop addressing patent drafting strategies and in depth presentations covering a range of patent related topics.

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2 November 2010

### Collaborate2Innovate

Jeremy Pennant will be speaking at this free event, which aims to build connectivity across sectors and provides businesses in the Solent region with the opportunity to listen to and learn from specialists with a knowledge of collaboration and technology transfer.

9-13 November 2010

### INTA Leadership Meeting

Jeremy Pennant will be attending the INTA Leadership Meeting, which provides INTA leaders with the latest information on the hottest topics in the trade mark field.

## Editorial



**With a change of government in the UK in May, the UK Intellectual Property Office has just unveiled a research programme into intellectual property and its value to the British economy. The minister in charge has said that, 'Britain must have an intellectual property system that encourages innovation and is internationally competitive...The important research the IPO will carry out over the coming year will help ensure Britain has an intellectual property system that helps businesses grow and prosper.'**

**Anything the government can do to further streamline and ease the process of securing and enforcing IP rights will be of benefit to our clients. We will report further in due course.**

### Editor:

**Angela Thornton-Jackson**



## Article 01

# General Court Socks It to Clothing Manufacturer in Rejection of CTM for Orange Toe Colour X-Technology Swiss v OHIM (Case T-547/08)



In this decision from the General Court dated 15 June 2010, the refusal was upheld in relation to a Community trade mark application seeking to protect the colour orange as applied to the toe area of a sports sock.

The applicant, X-Technology Swiss, failed to substantiate their claim that the level of attention when purchasing such goods would be high. Nor did they adduce any evidence to support the assertion that consumers perceive the colour of the toe of a sport sock as an indication of commercial origin. The applicant referred to a competitor's sock having a gold-coloured toe but did not lodge any evidence that the colouring was inherently suited to indicate commercial origin.

The Court also confirmed that the distinctive character of a mark must be assessed:

1. By reference to the goods or services in respect of which registration is being sought and,
2. By reference to the perception which the public has of those goods or services.

The General Court confirmed that it is necessary to determine whether the mark applied for is indistinguishable

from the appearance of the product designated or whether, on the contrary, it is independent thereof.

The Court concluded (wrongly in our view) that the mark applied for is to protect a specific sign placed on a specific part of the designated product, namely socks, and thus the mark applied for is indistinguishable from the form of a part of that product, namely the shape of the toe for an article of hosiery.

The General Court appears to have been overly harsh in relation to the applicant. Logically the mark applied for, namely the coloured toe area of a sock, should be viewed as distinguishable from the form of the product which should be considered as the sock in its entirety rather than just the shape of the toe.

Moreover, whilst the General Court reiterates previous statements made by OHIM and the Board of Appeal relating to the multitude of socks being offered for sale with various coloured elements, the case in relation to sports or technical socks is somewhat different. The fact that the applicant failed to adduce relevant evidence appears to have led to their failure (so far) to secure protection for this mark.

### Author:

**Jeremy Pennant**



# Coca-Cola Fails in Bid for FIVE ALIVE Domain Name UK Registration Deemed Not “Abusive”

In a recent domain name dispute, The Coca-Cola Company (Coca-Cola) brought an action against a UK individual who had registered the domain name [www.fivealive.co.uk](http://www.fivealive.co.uk).

Coca-Cola have an extensive reputation and goodwill in the various UK “FIVE ALIVE” trade mark registrations and “Five Alive” drinks have been available since the 1980s. The complaint was not resolved at the mediation stages and Coca-Cola requested that an independent expert decide the case under Nominet’s Dispute Resolution Service (DRS) Policy. The respondent in this case was an individual named Paolo Ciuffa and the domain name was registered in his company’s name, Bo Cat, in 2004.

Coca-Cola argued that Mr Ciuffa had no legitimate interest in the domain name, particularly given the well known FIVE ALIVE brand. They argued that the only reasonable conclusion to reach regarding the registration of the domain name was that Mr Ciuffa intended to capitalise on their goodwill and divert customers away from

them. They said the domain name was disrupting their legitimate business interests and amounted to an “abusive registration”.

*According to the Nominet DRS Policy, an abusive registration is one that takes unfair advantage of, or is unfairly detrimental to the complainant’s rights.*

In his response, Mr Ciuffa claimed that he had registered the domain name with the sole intention of representing and promoting the music artist MC Five Alive. He provided evidence in the form of a MySpace link and recent flyers from events which MC Five Alive had performed at. He denied that it was an “abusive registration”.

The expert said that there was little doubt that Coca-Cola had rights in the FIVE ALIVE mark. The expert commented, however, that a registration can only be considered “abusive” if there is something ‘morally reprehensible’ in the respondent’s behaviour. Instead, it

was held that there was a perfectly plausible and legitimate explanation for the registration, supported with evidence, and the expert was given no reason to disbelieve Mr Ciuffa.

This case emphasises that two elements must be proven in order to succeed in a domain name complaint:

1. The complainant has rights in respect of a name or mark which is similar or identical to the domain name at issue.
2. The domain name constitutes an “abusive registration”.

The fact that the domain name incorporated Coca-Cola’s famous mark did not automatically mean that the registration of the domain name was an “abusive registration”. They could prove one but not the other requirement and so the case failed.

Author:  
Richard Burton







# Lost in Translation? Referral to ECJ for Clarification of Class Headings for Goods and Services



**A**t present, OHIM (and other member states of the EU) consider that Nice class headings include all goods and services in that class. However, the UK Intellectual Property Office (UKIPO) believes that the interpretation of the goods and services claimed may only be made by reference to those goods and services actually covered by the statement. For example,

*at OHIM an application for the class 41 heading: “Education; providing of training; entertainment; sporting and cultural activities” would be deemed to cover all services falling within class 41, even if not expressly stated – such as “translation services” – which do fall within class 41. Traditionally, at the UKIPO, a claim for the class 41 heading would not include translation services.*

Following an application by CIPA (Chartered Institute of Patent Attorneys) for IP TRANSLATOR for “Education; providing of training; entertainment; sporting and cultural activities” in class 41, the following

three questions have been referred to the ECJ for clarification of the correct approach:

1. Is it necessary for the various goods or services covered by a trade mark application to be identified with any and, if so, what particular degree of clarity and precision?
2. Is it permissible to use the general words of the class headings of the International Classification of Goods and Services established under the Nice Agreement...for the purposes of identifying the various goods or services covered by a trade mark application?
3. Is it necessary or permissible for such use of the general words of the class headings of the said International Classification of Goods and Services to be interpreted in accordance with Communication No. 4103 of the President of the Office for Harmonisation in the Internal Market (OHIM) of 16 June 2003?

[The latter communication set down OHIM’s policy, above, that claims Nice class headings do include all goods and services in that class.]

The clarification is clearly desirable since, at present, the scope of protection afforded under the same wording at the UKIPO and at OHIM can be markedly different. However, a finding by the ECJ that a claim to the class heading includes all goods in that class would potentially significantly increase both the number of opposition proceedings and non-use revocation actions across Europe, with proprietors seeking to enforce and defend very wide specifications.

At the UKIPO, an applicant still requires a *bona fide* intention to use the mark applied for in relation to the goods/services claimed, which in theory should avoid overuse of the class headings in UK filings. No such intention is required at OHIM. Nevertheless, applicants should be wary of using the class headings if they seek protection for specific goods or services in order to avoid unwanted oppositions. For example, if the ECJ confirms OHIM’s position, an applicant claiming “Education; providing of training; entertainment; sporting and cultural activities”, with an intention to use the mark only in respect of sporting activities may well receive an objection from an earlier proprietor with interests only in respect of translation services.

A decision is awaited with interest.

**Author:**  
**Angela Thornton-Jackson**



# Is the PORTAKABIN Trade Mark Infringed by Use of the Word as an Adword? ECJ Provides Further Ruling on Use of Trade Marks as Adwords

**T**he European Court of Justice has recently provided another ruling in yet another case concerning the use of trade marks as adwords.

In Portakabin Limited and Portakabin BV (PORTAKABIN) v Primakabin BV (PRIMAKABIN), Primakabin sold various mobile building structures, including those made by Portakabin. Portakabin sued Primakabin on the basis that Primakabin's use of the PORTAKABIN trade mark in an internet advertisement for 'used portakabins' infringed its registered trade mark for PORTAKABIN.

At first instance, Portakabin were unsuccessful because the court held that the PORTAKABIN trade mark was not being used to distinguish goods, but was merely directing consumers to Primakabin's website. On appeal, Portakabin were partially successful and Primakabin were ordered to refrain from using the word PORTAKABIN in adverts for the mobile buildings. However, Portakabin appealed to the Hoge Raad Court in the Netherlands for a ruling on whether Primakabin's use of the PORTAKABIN trade mark in adverts amounted to use of the mark in relation to goods or services.

The European Court of Justice held that:

- A trade mark owner can prohibit an advert using a keyword identical or similar to a registered trade mark for identical goods or services without the consent of the proprietor where the advert does not enable consumers to confirm whether the goods or services referred to in the advert originate from the trade mark owner or from an economically linked undertaking.
- Use by advertisers of identical or similar signs to the registered trade mark as keywords is liable to be prohibited, but it will be for the national court to determine whether the use is in accordance with honest industrial or commercial practices.
- A trade mark owner cannot prohibit

New adwords ruling by ECJ - welcome news for trade mark owners?



advertisers from advertising the resale of goods where those goods have already been put on the market in the European Economic Area (EEA) by the proprietor or with his consent unless there is a legitimate reason to do so, such as, for example, there being a serious risk of detriment to the reputation of the trade mark.

- The national court cannot find that the advert gives the impression that the reseller and the trade mark owner are linked, or that the advert is seriously detrimental to the reputation of the trade mark merely on the basis that the advert uses the trade mark to indicate that goods are being resold, eg, by using words such as "used" or "second hand".
- The national court is obliged to find a legitimate reason for prohibiting the advert where the reseller, without the consent of the trade mark owner, removes all references to the trade mark from goods

already placed on the market and replaces it with a label bearing the reseller's name.

- The national court is obliged to find that specialist retailers of second hand goods that bear another person's trade mark cannot be prohibited from using the trade mark to advertise their goods to the public unless there is a serious risk of damage to the image of the trade mark.

The decision is likely to be met with mixed reviews. On the one hand, it provides some level of comfort to trade mark owners whose trade marks are being used in adverts by third parties. On the other, unless there is a "legitimate" reason which leads to detriment to the reputation of the trade mark, trade mark owners may find it difficult to enforce their rights in the trade mark where the trade mark is being used in an advert but where the goods have already been put on the market in the EEA by the proprietor or with his consent.

**Author:**  
Gemma Williams





# Partial Revocation and Subcategories of Goods/Services Clarification Awaited from ECJ

Extreme (appeal to the Appointed Person in the case O-217-10) and Kureha Corp v OHIM (case T-487/08)

**O**n page 4 of this newsletter (article 03) we report that reference is made to the ECJ to determine whether applicants claiming the Nice classifications

headings are entitled to protection for all goods/services falling within that class.

However, as yet we have no guidance from the ECJ as to the extent to which a specification will be cut down (either for the purposes of proof of use in opposition proceedings or in a revocation challenge) when a proprietor can only show use of the trade mark in relation to certain goods or services covered by the specification.

Whilst we await a suitable case to make the appropriate reference to the ECJ on this point, further guidance has recently been provided both by the UKIPO and the CFI (General Court) in the cases of *Extreme* (appeal to the Appointed Person in the UK case O-217-10) and *Kureha Corp v OHIM* (case T-487/08).

In the UK, the current law on partial revocation for non-use was most recently summarised by Mr Geoffrey Hobbs QC, sitting as deputy judge in the High Court in *Damla AG v Sani Group Limited*. This highlights a difference of approach which has, to date, been shown between the UK courts' position and that of the General Court. In the UK, the essence of the approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, the General Court indicates that the matter is to be approached from the consumer's perspective, but focuses on the purpose and intended use of the goods to find a specification which covers no independent

subcategory of goods other than ones within which the trade mark has been used.

*A danger of the subcategory approach is that it invites subdivision according to the products concerned and a tribunal may be led into equating a fair description with the actual use shown.*

This appeared to be the case in the *EXTREME* decision where on first hearing of the case, the hearing officer had reduced the original specification for "fishing rods" to "rods for use with sea fishing and saltwater fishing". On appeal, the appointed person found that the specification should be reinstated to "fishing rods". Genuine use of the *EXTREME* trade mark had been shown for various types of fishing rods. The specification reformulated by the hearing officer to "fishing rods for use in sea fishing and saltwater fishing" failed to achieve a just balance. Applying the average consumer test, the average consumer would not have chosen that description for trade mark purposes. Instead, they would have just said fishing rods.

Similarly, in the case of *Kureha v OHIM* the General Court found that the subcategory of goods suggested by the applicant in this case, namely "a sterile solution of a demonzine for use in the treatment of specific heart condition, being for intravenous administration in hospitals" could not be accepted. The definition was not compatible with the established case law on the topic since in giving not only the therapeutic indication but also the pharmaceutical form (liquid) the active substance (adenazine) was

too restrictive, and the method and place of administration (intravenous in a hospital) definition did not correspond to the category or subcategory of goods.

By contrast, the General Court found that the subcategory of goods identified by the Opposition Division and confirmed by the Board of Appeal was appropriate, in this case "pharmaceutical preparations for the treatment of the heart". That subcategory was based on the therapeutic indication of the goods at issue but was sufficiently broad not to undermine the legitimate interest in being able in future to extend the range of goods or services, whilst enjoying the protection which registration of that trade mark confers on it.

In reality, there is perhaps not too much difference between the respective approaches. One should firstly look at both the intended use of the goods to find a specification which covers no independent subcategory; and secondly devise a specification which seems to be a fair description based on the way in which the average consumer might have described the relevant goods or services.

The purpose of the non-use provisions are to reduce the number of conflicts between trade marks. The relevant tribunal will be influenced by any evidence showing how the relevant goods or services are marketed so as to determine the appropriate subcategories. Pending a definitive statement from the ECJ on the topic, it is helpful to have these two working examples from the appeal tribunals in Europe and the UK as to the degree of restriction which is appropriate.

**Author:**  
**Angela Thornton-Jackson**



## Online Update The Latest Keyword and Domain Name News

### Google Keyword & Adtext Policies

Search engine Google has announced a change to its keyword policy in Europe meaning that as of 14 September 2010 it will introduce a notice and take down procedure. This means that complaints can then be made directly to Google and if it agrees that they are valid, it will remove the offending ads.

This follows the recent ruling of the Court of Justice in the recent Google France joined Cases C-236/08 and C-238/08

In a post on its blog Google also confirmed that Adtext complaints will continue to be considered, and its Adtext policy will change for the UK (also Ireland and Canada), following last year's change in the United States, which Google claims has 'helped both our users and advertisers by improving the usefulness of text ads'. This will allow some advertisers to use third party trade marks in their Adtext even if they do not actually own them or have explicit approval from the trade mark owners to use them. In other words, use must be legitimate but can effectively be without consent.

### Nominet

Following Nominet's consultation on the release of two letter, one character and other reserved .uk domain names, a summary and analysis of the responses has been published. These responses are to be used to draft a release plan on Nominet's website before the application process for short domains is formally opened.

Nominet's Policy Advisory Body has advised Nominet to release the domain names, but indicates that adequate protection must be put in place first to protect those parties with legitimate prior rights. During the "sunrise" period, the proposal is to accept applications from those who can show bona fide use of a trade mark at a date prior to the 2008 recommendations to change the policy.

Author:  
Richard Burton



Hot topics: keywords and domain names



### .cn Domain Name Owners Please Check Your Inbox!

The CNNIC, which is the Chinese Registry, has begun sending out emails to holders of existing .cn domain names, seeking confirmation that the holders' registration details are accurate and complete.

The CNNIC allows a deadline of 15 days from the receipt of the email for the information to be confirmed.

Accordingly, if you are the holder of a .cn domain, you should ensure that you respond to any emails received from "@cnnic.cn" as swiftly as possible in order to maintain the domain.

Author:  
Gillian Deas



## Stop Press! Evidence of Use At OHIM

Two recent cases from the General Court and OHIM's first Board of Appeal provide helpful guidance on the extent and nature of evidence of use required to satisfy the test of genuine use of a trade mark.

The General Court (in *Atlas Transport GmbH v OHIM*) overturned the decision of the fourth Board of Appeal in a revocation action based on non-use. The Court found that just 19 invoices showing use within the relevant period was sufficient to validate the CTM registration.

Moreover, in a decision which will surely be welcomed by all users of the CTM system, the Board of Appeal in *Lycra/Rowe Legra* accepted that a detailed affidavit by an employee of the relevant party may be sufficient to prove genuine use, without any supporting documentary evidence.

In the past, OHIM has always been suspicious of such evidence. The Board of Appeal sensibly held that any doubts concerning the trustworthiness of the declaration must be based on objective elements rather than from a starting point of mistrust. Indeed, such statements do contain a declaration of truth and there is no reason to doubt the veracity of statements often made by the people best placed to comment on the use of the trade mark in preceding years.

Author:  
Angela Thornton-Jackson



### UKIPO To Drop Opt-In System?

Since the UK Intellectual Property Office (UKIPO) abolished examination on relative grounds in October 2007, there has been an option for owners of Community trade marks to "opt-in" to a notification system whereby they receive notifications of later potentially conflicting UK trade mark applications. Each "opt-in" was for an initial three year period, and it was expected that these three year periods would be renewable. However, in the opinion of the UKIPO, there has been insufficient take up of this service and, accordingly, the Office is considering abolishing the system. Anyone deciding to renew their "opt-in" subscription should be aware that this service is currently under review and could be stopped at any time.

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Gillian Deas

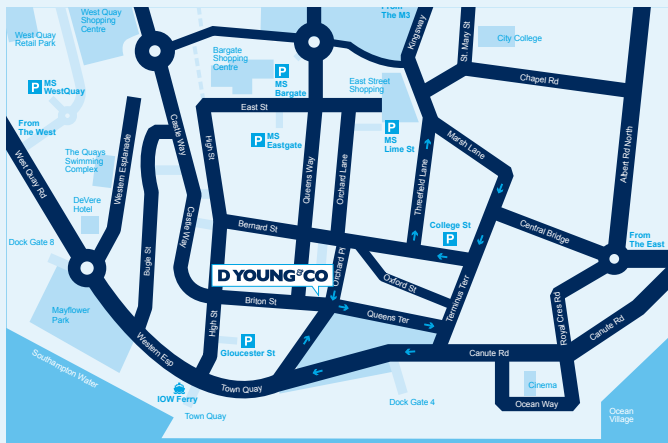


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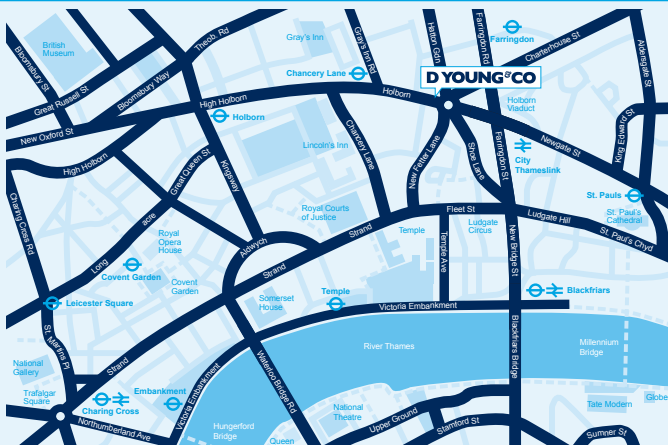
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