

D YOUNG & CO TRADE MARK NEWSLETTER *no.105*

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Glenfiddich on the rocks William Grant & Sons fail to stop Glenfield UK trade mark application



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We are delighted to share in the EUIPO's celebrations having received its two millionth EU trade mark application in June, 25 years after the office itself was established. Our partner Jana Bogatz is actively participating in the EUIPO's Stakeholder Quality Assurance Panels project (SQAP) and the Convergence Programme project CP 11 on new forms of trademarks – and was interviewed for the EUIPO's 2018 Annual Report: dycip.com/euipo-2018.

We are also pleased to report that partner Tamsin Holman, head of our dispute resolution & legal team, features as one of only 20 UK women on the MIP 2019 global "Top Women in IP" list. More on this at: dycip.com/mip-top-women.

D Young & Co trade mark team.

Events



17-20 September 2019
MARQUES, Dublin Ireland
 Matthew Dick, Anna Reid and Jana Bogatz will be attending the 33rd annual MARQUES conference in September.

www.dyoung.com/news-events

Brexit news



We welcome your Brexit questions (email our advisors at brexit@dyoung.com) and regularly publish news and advice regarding Brexit on our website: www.dyoung.com/knowledgebank/ip-brexit.

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Opposition grounds / Reputation

Glenfiddich on the rocks

William Grant & Sons fail to stop Glenfield UK trade mark application

In a recent trade mark opposition, William Grant & Sons Ltd, the biggest independent whisky company in Scotland and owner of the famous GLENFIDDICH brand of Scotch Whisky, has failed to stop an application for a green and gold label mark containing the word GLENFIELD in white lettering. This unexpected result shows the limits of a word mark and provides warning to owners of famous brands that name and reputation alone are not always enough to win an opposition.

Background

William Grant & Sons Ltd (William Grant) is the owner of the well-known earlier word mark GLENFIDDICH, registered in 1960 in respect of Scotch Whisky. William Grant also uses, and claims to have substantial goodwill in, its label (which was presented to the hearing officer in the poor quality black and white representation shown below).



In January 2018, Vivek Anasane, a Mumbai-based businessman, filed an application for a label mark in class 33 (Scotch Whisky) comprising the sign GLENFIELD together with stags aside a shield on a green and gold background (the application), shown below:



William Grant opposed the application on the grounds of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.

Opposition under 5(2)(b)

In comparison to William Grant's mark, which consists only of the word GLENFIDDICH, the hearing officer considered the application to be suitably more complex. The word GLENFIELD is emboldened in white letters against a dark green background, together with other less dominant words ("Blended Scotch Whisky" and "Product of Scotland") and stags rampant on either side of a shield, each element contributing to the distinctive character of the device overall.

William Grant argued that both marks shared visual similarity as FIELD and FIDDICH both contain the letters "F" and "D", but the hearing officer disagreed. He recognised that the letters appeared in both, but concluded that this had little impact on the assessment, in particular because the word GLENFIDDICH is noticeably longer than GLENFIELD. Taking into account all the additional elements of the application, the hearing officer concluded a very low level of visual similarity.

Aurally, GLENFIELD was held to be the only aspect of the application relevant to the pronunciation. Although both shared the first syllable GLEN together with the "F" sound at the start of the second syllable, the hearing officer concluded that they shared a low to medium level of aural similarity, as GLENFIDDICH had three syllables, with the last two being different to GLENFIELD.

The conceptual similarity of the marks was also considered to be a very low level. Other than the common occurrence of GLEN (meaning "a narrow valley, especially in Scotland or Ireland"), the multiple additional elements of the application (such as the stags) impacted on its overall "conceptual identity", none of which were found in the earlier mark.

In William Grant's favour, the hearing officer decided that GLENFIDDICH benefits from a high level of distinctive character as a result of long-standing and extensive use.

The hearing officer acknowledged that there were elements of this opposition that typically would point towards a finding of

➤ **Case details at a glance**
Jurisdiction: England & Wales
Decision level: UKIPO
Parties: Vivek Anasane (applicant) and William Grant & Sons Limited (opponent)
Date: 08 April 2019
BL Number: O/183/19
Full decision: <https://dycip.com/glenfield>

A stiff warning for brands that name and reputation may not guarantee an opposition win



misrepresentation as towards the word mark.

Upon conducting an assessment of the application as against the GLENFIDDICH label, the hearing officer concluded that there were some similarities, including the dominant elements of the marks (that is, GLEN, F, I and D) and colour combinations. This was not, however, enough to convince him to find misrepresentation. Overall the differences, such as the number of stags, and low degree of visual, aural and conceptual similarity, outweighed the similar elements.

Authors:

Samantha Drake & Jake Hayes



likelihood of confusion (that is, identical goods, high-level of distinctive character), but he was satisfied that there would be no confusion due to the multiple differences between the marks. GLEN, being the only common element, would be readily understood by the average consumer to be an allusion to Scotland. Furthermore, the second element of the earlier mark FIDDICH has no conceptual meaning whereas FIELD does, and would not be mistaken by the average consumer. In his assessment, “[the application] will not even bring [GLENFIDDICH] to mind let alone confuse the consumer into believing that the goods sold under the respective marks originate from the same or linked undertaking”.

Opposition under 5(3)

After a brief restatement of the law, the hearing officer came to the conclusion that there was no link between the undertakings or risk to the distinctive character or reputation of the opponent’s mark.

Referring to earlier parts of the decision, the hearing officer was satisfied that William Grant had provided sufficient evidence of use of its mark in the UK and enjoyed a significant amount of reputation in respect to whisky products. With only a low degree of similarity of the marks, he concluded it was unlikely that the average consumer would bring the GLENFIDDICH mark to mind. Therefore, the application was unlikely to cause confusion or make the average consumer believe that the goods would originate from the same or linked undertaking. It followed that GLENFIELD would not take unfair advantage

or cause detriment to the earlier mark.

Opposition under 5(4)(a)

Having decided earlier that GLENFIDDICH (word) enjoys a significant reputation in the UK, the hearing officer concluded that William Grant had considerable goodwill identified by the word mark.

Hedging their bets, however, William Grant also relied on its label to show goodwill, stating that it “uses the colour combination green and gold, [and] features an image of a stag device which has become highly recognisable to consumers”. Confusingly, William Grant put into evidence only black and white representations of the label, many of which were of poor quality. Further, the evidence showed that there was not just one label, but several: some with different words, some which were light-coloured or clear, and some that did not feature the word GLENFIDDICH prominently or at all. Despite this, the hearing officer accepted that the main label relied upon generally has the colour combination of GLENFIDDICH in white, other labelling in gold, and the background in dark green. He decided that the label had significant goodwill, although less than the word mark due to the other various labels in use.

Acknowledging that the test for misrepresentation is different than tests for confusion, similarity or causal link under 5(2)(b) and 5(3), the hearing officer was prepared to follow his reasoning under those grounds, and found there was no

In short

This decision is an example of the limits of a word mark in opposition proceedings against a label which may have its own distinctive elements. William Grant’s opposition failed on all grounds, despite the Hearing Officer finding that the GLENFIDDICH registered mark and unregistered label had a high degree of distinctive character, enjoyed significant reputation and shared some similarity with the GLENFIELD application.

It is difficult to say whether the result would have been different had William Grant asserted a registered, full-colour label mark, but the decision serves as a reminder that brand-owners should review their trade mark portfolio regularly and fill in any gaps in protection where they appear, in particular if reliant on a particular colour scheme or get-up.

Headstock in the clouds? Don't fret (just yet)

➤ **Case details at a glance**
Jurisdiction: European Union
Decision level: Board of Appeal
Parties: Paul Reed Smith Guitars Limited Partnership
Date: 01 April 2019
Citation: R 1656/2018-4
Full decision (link): dycip.com/prs-headstock

Paul Reed Smith Guitars' (PRS) trade mark for a guitar headstock was held to be non-distinctive by the Board of Appeal. Trade marks which consist of part of the goods themselves are notoriously difficult to register. A filing by PRS is off to a rocky start, but if acquired distinctiveness can be shown, registration may still be possible.



PRS filed a European Union trade mark (EUTM) application, covering "musical instruments; guitars" in class 15, for the figurative mark shown on the left.

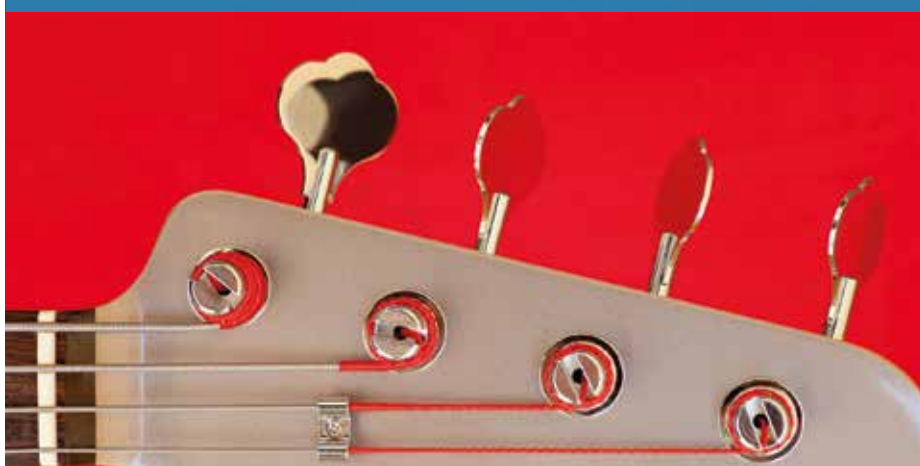
At first instance, the EUIPO refused the application as it was considered to be non-distinctive under Art 7(1)(b) EUTMR. The EUIPO considered the mark to be a representation of a guitar headstock which was not markedly different from those of other guitar manufacturers.

PRS appealed the decision to the Board of Appeal arguing that the relevant consumer should not be defined as the "general consumer". Guitars are not everyday items but rather specialised goods advertised at a specific and narrow consumer group. Further, the price would mean that the relevant consumer would pay a high degree of attention when purchasing the goods. (Take note, humble beginner!)

The Board of Appeal countered all of these points. Guitars range from very cheap to very expensive with the former costing as little as EUR50. Even if a guitar is not a product purchased on a daily basis, the attention of the public is not necessarily higher than average on that basis. In any event, the conclusion as to whether the mark was distinctive would not turn on whether the relevant consumer's attention was high. The Board of Appeal also noted that price and the concept of "luxury" depends on the marketing strategy of the proprietor, and could be subject to change. Hence, price could not be a determinative factor for the purposes of deciding the distinctiveness of the mark.

PRS argued that it is common for leading guitar manufacturers to use guitar headstocks as indicators of origin (the shape dictating the

This case concerned the headstock shapes of guitars



particular manufacturer). PRS claimed that consumers would recognise various guitar brands given their different headstocks, noting that each manufacturer would use a shape consistently across their different models (e.g. acoustic guitars and electric guitars). Whilst a manufacturer may use various logos on their headstocks, the shape would be consistent. This, according to PRS, was an important indicator as logos and other trade marks may not be visible from a distance (e.g. in shop windows or in a concert hall). PRS also submitted evidence showing examples of headstocks of other manufacturers, arguing that they differed significantly from the shape covered by the application. In other words, the mark applied for was a departure from the norms/customs of the trade.

The Board of Appeal dismissed PRS' arguments. Consumers do not tend to make assumptions about the origin of goods based on shape alone. In practice, this means that a consumer must be educated that a particular shape is associated with a specific company/manufacturer.

Whilst consumers may be able to distinguish different headstock designs, it did not necessarily mean that they would assume the guitars had different commercial origins. It was held to be irrelevant that high-end guitar manufacturers use the shape of headstocks as identifiers (intending them to be indicative of origin). The relevant consideration was

the perception of the general consumer. The Board of Appeal also noted that PRS had not provided any arguments as to why the general consumer would recognise the commercial origin of a guitar based on its headstock. The market for simple, lower price guitars in terms of guitars sold is much bigger than the market for higher-end versions (even though the turnover for the latter may be higher).

The appeal ultimately failed and the case has been sent back to the EUIPO examiner so that the subsidiary claim of acquired distinctiveness can be considered.

Author:
Flora Cook



In short

The headstock shape was not markedly different from basic headstock shapes commonly used in trade, but was simply a variation of them. Thus, if PRS wants to obtain a registration, it will need to provide evidence that the shape has acquired distinctiveness – i.e. that consumers recognise the headstock shape as indicating goods originating from PRS.

Victory song Success for THE X FACTOR against THE PETS FACTOR at the UKIPO

The UKIPO has recently rejected an application to register the trade mark THE PETS FACTOR for a variety of goods and services, such as DVDs and the production of TV shows and TV entertainment, following opposition by the owners of various earlier trade marks for THE X FACTOR.

Background

FremantleMedia Ltd and Simco Limited (the opponents) brought opposition against a trade mark application filed by Duf Ltd (the applicant) for THE PETS FACTOR in classes 9 and 41. The opponents relied on various earlier EU and UK trade mark registrations for the mark THE X FACTOR and the marks set out below:



All of the earlier trade marks related to the popular television show The X Factor which has aired in the UK since 2004. The opponents also relied on goodwill in the mark THE X FACTOR/X FACTOR in the UK

The opposition was based on sections 5(2)(b), 5(3) and 5(4) of the Trade Marks Act 1994 (TMA).

The UKIPO decision - preliminary points

The hearing officer considered it to be abundantly clear from the evidence presented that The X Factor is one of the most popular television entertainment shows ever aired on UK television. Over the years the show has spawned a number of well-known singers and bands including: One Direction, Little Mix and Olly Murs. In light of this, the hearing officer was satisfied that the opponent's earlier marks were very well-known to the UK general public within the television entertainment context and that the reputation of the earlier marks was extremely strong.

Opposition under section 5(4)(a): passing off

Interestingly the hearing officer chose to start his analysis here. While the hearing officer agreed that the opponents had protectable goodwill in the marks THE X FACTOR/X

The hearing officer considered passing off, likelihood of confusion and reputation



FACTOR in the UK, he dismissed this ground of opposition because he was not convinced that substantial numbers of consumers would assume that television programmes called THE PETS FACTOR were the responsibility of the opponents. As a result, while THE PETS FACTOR would be seen as a play on the name of THE X FACTOR, it did not pass the test for misrepresentation necessary for a finding of passing off.

Opposition under section 5(2): likelihood of confusion

The hearing officer also dismissed this ground of opposition as he did not consider there would be any likelihood of confusion on the part of consumers. This was again because he did not believe consumers would consider shows called THE PETS FACTOR to be the responsibility of those behind The X Factor.

Opposition under section 5(3): marks with a reputation

The opposition was successful for the vast majority of the goods in class 9 and all of the services in class 41 on the basis of section 5(3) TMA.

In light of the huge reputation of the earlier trade marks in the UK, the hearing officer was

satisfied that a large number of the relevant public would perceive a link between the earlier marks and the application for THE PETS FACTOR. He was also satisfied that THE PETS FACTOR application would take unfair advantage of the earlier marks for the services in class 41 and most of the goods in class 9 as THE PETS FACTOR mark was intended to, and would, create an attraction with the applicant's services which would not otherwise be there. This was all achieved without the applicant having to go through the marketing effort and expense of educating consumers in the same way as the opponents did. On this basis THE PETS FACTOR application was refused for the majority of goods in class 9 and all of the services in class 41.

Author:
Anna Reid



In short

This decision underlines the risks of seeking to adopt a trade mark which is a play on words of a trade mark with a strong reputation.

VIRGIN v VIRGINIC

High Court agrees adding adjectival suffix “IC” to well-known brand name causes likelihood of confusion

Virgin Enterprises Ltd (Virgin) has won an appeal against a UKIPO decision dismissing its opposition to the mark VIRGINIC in respect of class 3 goods. The appeal was heard before the High Court.

The opposition was based on Section 5(2)(b) of the Trade Marks Act 1994, alleging a likelihood of confusion with two earlier registrations (European Union trade mark and UK trade mark) for the mark VIRGIN in class 3.

The opposition had been a fast-track dispute decided on the papers alone. The court had the benefit on appeal of hearing oral submissions from the parties.

Both parties agreed that the marks were visually and aurally similar to a high degree; that the goods in question were identical; and that there was no direct likelihood of confusion between them overall.

However, Virgin contended that the marks were also conceptually similar to more than a medium degree; that the earlier marks had more than a normal degree of distinctive character; and that there was a likelihood of indirect confusion between the marks.

Virgin argued that because the mark VIRGIN was arbitrary in relation to class 3 goods, it should be considered to have a fairly high degree of distinctive character, arguing that it would be incorrect to hold that only invented words can enjoy an enhanced degree of inherent distinctive character.

The court agreed (though noted that the mark would not enjoy as high a degree of distinctive character as an invented word).

Could VIRGINIC be perceived to be a newly-minted adjective meaning “pertaining to VIRGIN”?



The court disagreed that because the hearing officer held the marks to be highly similar visually and aurally, he should also have found them to be highly similar conceptually, noting that it is possible for marks to be visually and aurally similar without being conceptually similar at all, “let alone so conceptually similar”. Interestingly, the court did not give any examples to support this view.

The court agreed that because the hearing officer had found that consumers would perceive the VIRGIN element in VIRGINIC, he should have found that they would have perceived VIRGINIC to be a “newly-minted” adjective, meaning “of or pertaining to VIRGIN”.

As such there was a fairly high degree of conceptual similarity between the trade marks.

As regards the likelihood of indirect confusion (where a consumer notes that a later mark is different to an earlier mark, but also has something in common with it and thereby

concludes that the later mark is another brand of the owner of the earlier mark), the court agreed that the hearing officer had fallen into error. Because the average consumer would perceive VIRGINIC as a newly-minted adjective meaning “of or pertaining to VIRGIN”, they would also likely think it was a brand extension of VIRGIN. As such indirect confusion was likely, and the appeal succeeded.

Author:
Matthew Dick



In short

This case will be welcomed by brand owners because it gives nuance to what are usually considered to be well-settled areas of trade mark law (at least as they tend to be routinely applied by hearing officers at the UKIPO in dispute matters).

The case also highlights the potential benefits of contesting certain oppositions at a hearing, rather than relying solely on written submissions.

Chocolate wars Another loss for Cadbury in purple trade mark battle

This is yet another episode in the Nestlé v Cadbury trade mark conflict series (see “related articles” below). In 2013, Cadbury UK Limited filed three new UK applications for the below colour mark with varying descriptions:



1. Application No 3019362: The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods.
2. Application No 3019361: The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of goods.
3. Application No 3025822: The colour purple (Pantone 2685C), shown on the form of application.

The applications were all accepted for “milk chocolate in bar and tablet form; milk chocolate for eating; drinking chocolate; preparations for making drinking chocolate” in class 30.

However, the marks were then opposed by Société des Produits Nestlé SA under section 3(1)(a) on the basis that reference to a Pantone number was insufficient and that the description in each case was not intelligible or was ambiguous.

Nestlé also opposed under section 3(1)(b) but this ground was suspended whilst

section 3(1)(a) was considered.

The first application was accepted; disagreeing with Nestlé, the hearing officer concluded that the screenshot of the Public Register, which a person can easily access online, does indeed show the mark applied for, together with a representation of the colour and the description, and that this information is accessible.

It was also confirmed that use of a Pantone number is sufficient to identify the colour.

It is particularly useful to refer to a recognised colour code as this will ensure that a specific colour is understood even though the media of display of the mark could affect the colour and appearance of it.

The whole visible surface

In the 2013 judgment, there had been an issue with the word “predominant” and it was suggested that the position could be clarified with reference to “the whole visible surface”.

The hearing officer understood from this decision that reference to the “whole visible surface of the packaging of the goods” is clear and precise. The mark is not ambiguous in that it could refer to a number of different signs; case law has already established that a colour may be registered in the abstract.

The oppositions were successful against the other two applications, both of which were considered imprecise and ambiguous.

Application no. 3019362 will now be considered in relation to the opposition filed under section 3(1)(b). Watch this space!

Author:
Jackie Johnson



Related articles

“Cadbury fails to safeguard UK purple TM registration” Jackie Johnson, 09 January 2019:

<https://dycip.com/cadbury-jan19>

Hague designs Nominal easing of rules for applications designating Japan

WIPO has confirmed that it is no longer a formal requirement for any Hague design application filed after 01 May 2019 which designates Japan, and which relates to a three dimensional product, to provide six orthogonal views of the product.

Under the Hague design registration system, it is possible to obtain registered design protection in a number of territories around the world (including the UK, Germany, EU and Japan) via the use of a single registered design application applied for centrally at WIPO. Historically, when designating Japan in a Hague design application, for any design relating to a three dimensional product, it has been necessary to provide an orthogonal top; bottom; left; right; front; and back view of the product. Failure to provide all of these orthogonal views would result in a formal objection from the Japanese design registry (the JPO), which may often be irreparable.

Following the change in rules, failure to submit all six of the above orthogonal views will no longer result in a formal objection from the JPO. Whilst in practice this rule change will be of benefit to those using a Hague design application to cover Japan, care must still be taken to ensure that any design therefrom which relates to a three dimensional product still provides appropriate disclosure of the product. In that regard, failure to provide such sufficient disclosure may still result in an objection from the JPO, not on the above formal ground, but on the ground that the design has not been sufficiently disclosed. In practice therefore, it may well still be advisable to provide six orthogonal views in any Hague design application designating Japan concerning a three dimensional product, or at least provide enough other views (e.g. perspective views) which show the product from all sides.

If you are interested in obtaining design right protection via the Hague system, or have any questions in respect of the above, please do not hesitate to contact us.

Author:
William Burrell



And finally...

CJEU practice update

CJEU appeals New rules for appeals already considered twice

View the full news release from the CJEU at dycip.com/cjeu-rules-twice



New rules came into force on 01 May 2019 which affect appeals to the Court of Justice of the European Union (CJEU) where cases have already been considered twice. Appeals that have already been considered twice, that is initially by an independent board of appeal (including the EUIPO Board of Appeal) and then by the General Court, may now only proceed at the CJEU, wholly or in part, where they raise an issue that is significant with respect to the unity, consistency or development of EU law.

In terms of formalities, appeals to the CJEU must now be accompanied by a request that sets out how an issue is significant with respect to the unity, consistency or development of EU law. This request must not exceed seven pages. If no request is filed,

the appeal will be deemed inadmissible. If the request complies with all formal requirements, the CJEU will rule on whether the appeal may proceed. The order that the appeal should be allowed to proceed will be served, together with the appeal, on the parties to the relevant case before the General Court along with the General Court itself.

These new rules are intended to reduce the number of cases that are dismissed by the CJEU on the grounds that they are manifestly unfounded or inadmissible. The CJEU has seen a large increase in the number of cases before it, and it is hoped that the procedural change will improve the functioning of the court.

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