

Court of Justice of the European Union
Cour de Justice des Communautés Européennes
L- 2925 Luxembourg

re: Specsavers International Healthcare Limited & others vs Asda Stores Limited, Court of Appeal of England and Wales

Amicus Brief – International Trademark Association

1. INTRODUCTION

The International Trademark Association (“INTA”), through its Europe Amicus Subcommittee, is pleased to submit this Amicus Brief in relation to the case *Specsavers International Healthcare Limited & others vs Asda Stores Limited*.

2. BASIS OF INTERVENTION

What is INTA?

- 2.1 INTA is a 134 year old not-for-profit organisation of trade mark owners and practitioners from more than 190 countries throughout the world with its headquarters in New York and offices in Brussels, Shanghai and Washington, D.C. INTA is dedicated to the support and advancement of trade marks and related intellectual property concepts as essential elements of commerce.
- 2.2 INTA’s worldwide membership includes nearly 6,000 companies, across all industry lines, including manufacturers and retailers ranging from aerospace to consumer goods and to service providers in the field of trade mark law in the broadest sense such as law firms, trade mark attorneys and business sector associations. There are some 1,000 INTA member companies and firms in the 27 member states of the European Union.
- 2.3 An important objective of INTA is to protect the interest of the public by the proper use of trade marks. In this regards, INTA strives to advance the development of trade mark and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organisation (WIPO) since 1979 and has contributed to various WIPO trade mark initiatives such as the Trademark Law Treaty and the 1999 WIPO Joint Recommendation on Provisions Concerning the Protection of Well-known Marks. INTA is also active in other international areas, including the Asia-Pacific Economic Cooperation Forum (APEC), the Association of Southeast Asia Nations (ASEAN), the European Union (EU) and the World Trade Organization (WTO).

Reasons why INTA is submitting this Brief

- 2.4 Since 1916, INTA has acted in the capacity of advisor and has appeared as amicus curiae (“friend of the court”) in various jurisdictions including the United States, Indonesia, China and the United Kingdom. (More information on the amicus curiae briefs and similar interventions or comments the association has filed in cases around the world is given in Annex A to this Amicus Brief). In Europe the most recent intervention by INTA was its joinder as a party before the Court of Justice of the European Union (“CJEU”) in *Nokia*

Corporation v. Her Majesty's Commissioners of Revenue and Customs (HMRC) (Joined Cases C 446/09) concerned the trans-shipment of counterfeit goods.

- 2.5 The circumstances in which INTA will file an Amicus Brief are set out in the Policy Statement attached as Annex B to this Amicus Brief. A key factor is whether the case in question involves a general principle of the law of trade marks, trade names, or trade dress, or the law of unfair competition, that is sufficiently significant to warrant a filing. In the present case *Specsavers International Healthcare Limited* and affiliated parties in the proceedings at stake through its lawyers has also requested that INTA file a brief.
- 2.6 Although INTA is not a party to this case, INTA (which represents a wide range of users of trade mark systems) believes that this case is significant to the development of European trade mark law. The present case raises important issues of principle; namely to what extent European law grants protection to trade marks that have been used in a form that differs slightly from the form in which they are registered within the meaning of Art. 15 (1)(a) of Council Regulation 207/2009/EC of 26 February 2009 on the Community trade mark ("the CTMR"), and the extent to which the colour in which a mark or sign is used can be taken into account in the global assessment of infringement when the mark alleged to be infringed is registered in monochrome.
- 2.7 It is against that background that INTA wishes to put forward submissions in this case on behalf of its members and therefore has prepared this Amicus Brief, in the hope that INTA's view, prepared through its Europe Amicus Subcommittee, may be of some assistance to the Court.

3. Questions Referred

- 3.1 The Court of Appeal of England and Wales has referred the following questions to the CJEU:

A. Where a trader has separate registrations of Community trade marks for

(i) a graphic device mark;

(ii) a word mark;

and uses the two together, is such use capable of amounting to use of the graphic device mark for the purposes of Articles 15 and 51 of Regulation 207/2009? If yes, how is the question of use of the graphic mark to be assessed?

B. Does it make a difference if:

(i) the word mark is superimposed over the graphic device?

(ii) the trader also has the combined mark comprising graphic device and word mark registered as a Community trade mark?

C. Does the answer to A or B depend upon whether the graphic device and the words are perceived by the average consumer as:

(i) being separate signs; or

(ii) each having an independent distinctive role? If so, how?

D. Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours such that it has become associated in the mind of a significant portion of the public (in a part but not the whole of the Community) with that colour or combination of colours, is the colour or colours in which the defendant uses the sign complained of relevant in the global assessment of (i) likelihood of confusion under Article 9(1)(b) or (ii) unfair advantage under Article 9(1)(c) of Regulation 40/94? If so, how?

E. If so, is it relevant as part of the global assessment that the defendant itself is associated in the mind of a significant portion of the public with the colour or particular combination of colours which it is using for the sign complained of?

4. Question A: Non-use/Revocation of Wordless Logo Mark

4.1 Article 15 of the CTMR provides that:

“If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non use”.

4.2 Article 15(1)(a) of the CTMR provides that:

“The following shall also constitute use within the meaning of the first sub paragraph: (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered...”.

4.3 Article 51(1)(a) of the CTMR provides that:

“The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: (a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use...”

Reasons for INTA Intervention

4.4 In INTA’s experience, it is common practice for brand owners to register a diverse portfolio of trade marks, comprised not only of individual marks, but also combined forms thereof. Often, those marks are only used in their combined form (indeed, as is the case in this matter, since it is common ground that “The Wordless Logo Mark” of Specsavers is not used alone, but as part of the “Shaded Logo Mark”).

4.5 Brand owners adopt this approach, among others, for the following reasons:

4.5.1 The extant practice note of the Examination Division at OHIM¹ itself acknowledges this issue “...There is no legal precept in the Community trade mark system which obliges the proprietor to provide evidence of the earlier mark alone when genuine use is required. Two or more trade marks may be used together in an

¹http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/partc_proof_of_use.pdf

autonomous way, with or without the company name, without altering the distinctive character of the earlier registered trade mark”;

- 4.5.2 Brand owners view, and they say their consumers view, both the collective whole of their combined mark as a mark in its own right and the individual marks that together comprise the combined mark as marks in their own right;
- 4.5.3 Taken together and individually, the combined mark and individual marks therein – when registered – provide the broadest form of protection against those that seek unlawfully to benefit from the reputation or distinctive character of the brand.
- 4.6 Were it to be held, in the abstract, that use of one mark within, upon or beside another could not constitute use of those component marks, then a substantial number of instantly recognisable marks would become vulnerable to revocation for non-use overnight. In and of itself, that would be a licence to third parties to exploit or register those marks, and would undermine the scope of protection for many marks. One simple example would be the Coca-Cola bottle shape mark. It has never been used *solus*, yet it is registered *solus*.
- 4.7 For the reasons that follow, INTA respectfully submits that use of one mark within, besides or upon another mark can constitute use of that one mark and indeed all of those marks. The decisions of the CJEU in *Societe des Produits Nestle v Mars UK Ltd* [2005] ECR I6135² (“*Have a Break*”), the view of Advocate General Kokott in *Have a Break*, the decision of the General Court in *Castellblanch SA v OHIM* [2005] ECR II-5309³ (“*Cristal*”) and of the CJEU in *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333⁴ (“*Il Ponte*”) can be reconciled to each position, and each decision is correct within its own particular context.

Interaction Between Article 15 and 51 of the CTMR

- 4.8 Unlike the decisions in *Cristal* and *Il Ponte*, which related to non-use in the context of opposition proceedings, in these proceedings the issue of non-use arose in the context of a counterclaim in infringement proceedings. Thus Article 51 should be considered alongside Article 15 of the CTMR in answering the questions put by the Court of Appeal.
- 4.9 INTA submits nothing turns upon this consequential point. It would be illogical were it to be otherwise, as a distinct test would arise for what constitutes use for the purpose of a counterclaim in infringement or invalidity as contrasted with use for the purpose of opposition. Article 15(1)(a) contains a species of genuine use and as such constitutes a species of genuine use for Article 51(1)(a) of the CTMR.

HAVE A BREAK, CRISTAL and IL PONTE

- 4.10 *Cristal* considered Article 15 of the CTMR in the context of genuine use of a mark relied upon in opposition proceedings, in circumstances where the mark relied upon in the opposition (CRISTAL) was not used *solus* on the relevant goods (champagne). Instead, CRISTAL was used with LOUIS ROEDERER, LR, CHAMPAGNE and all within stylised labels upon the champagne bottle marketed by the opponent – Champagne Louis Roederer SA.
- 4.11 The Court of First Instance followed the reasoning of the Board of Appeal, finding that:

“there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the

² Case C-353/03

³ Case T-29/04

⁴ Case C-234/06P

*Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously... That approach must be followed. The situation is not that the intervener's mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign*⁵ (our emphasis).

- 4.12 Independent marks were therefore not considered to have their distinctive character altered by use beside and upon other marks. They were each considered to be used independently, some in a trade mark sense and some not (the geographical indication champagne).
- 4.13 Significantly, the Court of First Instance made no distinction between use of a graphic mark and use of a word mark. The principles set out in *Cristal* are not limited by the nature of the marks alleged to be in use and nor should they be.
- 4.14 *Il Ponte* appears to contradict *Cristal* on first reading, which may be why the Court of Appeal has referred the questions it has in this dispute. But on a careful analysis, INTA maintains that it does not.
- 4.15 In *Il Ponte*, the CJEU was considering Article 15 of the CTMR in the context of use of an earlier mark in opposition proceedings. *Il Ponte Finanziaria SpA* opposed FMG Textiles Srl's application to register BAINBRIDGE on the basis of its earlier registered marks (for the purpose of the CJEU's judgment in the context of this reference by the Court of Appeal) THE BRIDGE and BRIDGE.
- 4.16 *Il Ponte Finanziaria SpA* sought to rely upon evidence of use of THE BRIDGE in and of itself, contending that such use also constituted use of BRIDGE. It failed to establish use of THE BRIDGE on its own evidence and thus could not show evidence of use of BRIDGE⁶. The opposition failed on that simple basis.
- 4.17 However, the CJEU went on to determine that:
- "...while it is possible [under Article 15 of the CTMR] to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation of the former"*⁷ (our emphasis).
- 4.18 On first reading, this appears to suggest that when one trade mark is used (a combined mark) then that use cannot be relied upon to establish use of another trade mark (one of the registered component marks comprising in part the combined mark). However, on closer scrutiny that is not what the CJEU had in mind. Instead, the CJEU was simply – and correctly – stating that the mere use of one mark could not in and of itself extend to constitute use of another mark, if that latter mark had not in and of itself been used in a trade mark sense.
- 4.19 This analysis is entirely consistent with the judgment of the CJEU in *Have a Break*.
- 4.20 In *Have a Break*, the CJEU was called upon to consider whether use of the registered mark "Have a break, have a Kit Kat" could result in the acquisition of distinctiveness of "Have a break" for the purpose of registration under Article 7(3) of the CTMR. It is to be noted that

⁵ see paragraph 33

⁶ see paragraphs 72-77 and 84-85

⁷ see paragraph 86

the two marks in issue (HAVE A BREAK, HAVE A KIT KAT and HAVE A BREAK) could on any sensible view be considered to have distinct meanings and thus use of the former combined mark be thought to have altered the distinctive character of the latter component mark were the dispute to have arisen under Article 15 of the CTMR.

4.21 The CJEU made the following key findings:

“In regard to the acquisition of distinctive character through use, the identification, by the relevant class of person, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark... In order for the latter condition...to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently”⁸ (our emphasis);

4.22 *“...such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component part thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking” (our emphasis)⁹; and*

4.23 *“In the final analysis... the distinctive character of a mark...may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark”¹⁰ (our emphasis).*

4.24 So use of a component mark within or beside another combined registered mark can serve to acquire distinctiveness in the component mark, even though on its face the component mark and registered combined mark have distinctive character. Clearly, HAVE A BREAK, HAVE A KIT KAT has a character distinct from HAVE A BREAK. But use of HAVE A BREAK, HAVE A KIT KAT constituted use of HAVE A BREAK sufficient to give distinctive character to the latter component.

4.25 Were it to be held in this dispute that use of a registered component mark cannot constitute use of one of its component registered marks, then the natural consequence is that – having acquired distinctiveness – HAVE A BREAK would be liable to now be revoked even though it was held to have acquired distinctiveness by its use within HAVE A BREAK, HAVE A KIT KAT. On any view, that cannot be right.

4.26 Question A further asks how the question of use of the graphic mark is to be assessed. INTA submits that this is a factual question which is dependent upon the circumstances of the case and, therefore, such an issue falls to the national court to decide. The only constraint is that this assessment must ensure that the sign is being used in a trade mark sense (i.e. in a manner such that it is capable of distinguishing the goods and services of one undertaking from those of another as required by Article 4 CTMR).

5. Questions B and C: Context of Assessment

5.1 For ease of reference, questions B and C are as follows:

B. Does it make a difference if:

⁸ Paragraphs 26 and 27

⁹ Paragraph 30

¹⁰ Paragraph 32

(i) *the word mark is superimposed over the graphic device?*

(ii) *the trader also has the combined mark comprising graphic device and word mark registered as a Community trade mark?*

C. *Does the answer to A or B depend upon whether the graphic device and the words are perceived by the average consumer as:*

(i) *being separate signs; or*

(ii) *each having an independent distinctive role? If so, how?*

- 5.2 It follows from the analysis at paragraph 4 above that, in INTA's submission, it does not make any difference if the word mark is superimposed over the graphic device. As highlighted in paragraph 4.6 above, if this positioning were of relevance then this would undermine the scope of protection for many marks, including, by way of example, the Coca-Cola bottle shape marks.
- 5.3 Similarly, INTA submits that it does not make any difference whether the trader also has the combined mark comprising graphic device and word mark registered as a Community trade mark. The analysis at paragraph 4 discusses the HAVE A BREAK and HAVE A BREAK, HAVE A KIT KAT mark. Ultimately, the fact that HAVE A BREAK, HAVE A KIT KAT was a registered mark did not have a bearing on whether HAVE A BREAK could have acquired distinctiveness as an independent mark. Likewise, this should not have any bearing on whether or not use is being made of the standalone graphic device.
- 5.4 INTA submits that to find otherwise would have negative practical consequences for brand owners and only serve to increase the costs and administrative burden of maintaining a portfolio. For example, if the CJEU was to find that registration of the combined mark could affect a brand owner's ability to claim genuine use of the standalone graphic mark, then this could reduce the scope of protection available to complex marks and force a decision whether to register only one or the other. In the converse, if the CJEU were to find that registration of the combined mark could have a positive effect on a brand owner's ability to claim genuine use of the standalone graphic mark, then any such brand owner would, in essence, be encouraged, if not forced, to make a further registration of a combined mark to support the validity of the standalone graphic device mark. Both consequences would be an unattractive outcome from a practical perspective.
- 5.5 For these reason, INTA submits that Questions B(i) and B(ii) must be answered in the negative.
- 5.6 Given that view, the questions put by the Court of Appeal in INTA's respectful view artificially reference different species of marks (word and device) used within, beside or upon each other and in conjunction with a combined mark. The species of mark does not matter. Nor does the question of whether the average consumer perceives the graphic device and the words as being separate signs or each having an independent distinctive role. What matters is whether the average consumer perceives each and all of the marks as functioning themselves as trademarks. Indeed, as stated by the CJEU in *Have a Break*:
- 5.7 *"The expression "use of the mark as a trade mark" must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking"*¹¹; and

¹¹ Paragraph 29

- 5.8 “...it is sufficient that...the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.”¹²
- 5.9 It is therefore not necessary for the court to consider any additional issues of consumer perception in determining if use has been made of the wordless mark. For this reason Question C should be answered in the negative.

6. Questions D and E – Global Assessment of Infringement

- 6.1 As to the second set of questions put to the CJEU, INTA is equally concerned to ensure that the views of its memberships are properly advanced.
- 6.2 For ease of reference, Questions D and E are as follows:

D. Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours such that it has become associated in the mind of a significant portion of the public (in a part but not the whole of the Community) with that colour or combination of colours, is the colour or colours in which the defendant uses the sign complained of relevant in the global assessment of (i) likelihood of confusion under Article 9(1)(b) or (ii) unfair advantage under Article 9(1)(c) of Regulation 40/94? If so, how?

E. If so, is it relevant as part of the global assessment that the defendant itself is associated in the mind of a significant portion of the public with the colour or particular combination of colours which it is using for the sign complained of?

- 6.3 INTA’s position is that, absent CJEU guidance on the relevance of colour as to the repute of a mark for the purpose of Article 9(1)(b) and Article 9(1)(c) of the CTMR, a monochrome mark should not secure lesser protection than that afforded to a trade mark registered in the very colour in which a reputation is claimed. By its very nature, a monochrome mark is afforded protection in any colour in which it is used, so its protection should extend to include a reputation in relation to a particular colour.
- 6.4 It is well established that the global assessment of the marks concerned will include the comparison between the trade mark as registered and the potentially infringing sign as used. Furthermore, it will include the usual factors including distinctiveness, similarity of the goods/services and extent of reputation of the earlier trademark as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*¹³. All relevant factors should be taken into account and the significance of any particular factor will depend on the facts of the case.
- 6.5 INTA submits that that there is no reason why the fact that the defendant is associated in the mind of a significant portion of the public with the colour which it is using for the sign complained of should not be a potentially relevant factor in assessing the likelihood of confusion. Indeed, in light of INTA’s proposed response to Question D, it would appear to be logically inevitable that Question E should also be answered in the affirmative.
- 6.6 Accordingly, INTA respectfully believes that the Court of Appeal’s second set of questions in D and E should take into account use in colour for the purpose of a reputation and for the purpose of any infringement assessment.

¹² Paragraph 30

¹³ Case C-39/97

- 6.7 Set out below is an analysis of the views identified in the above paragraphs, which INTA suggests are relevant to establish infringement under Article 9(1)(b) and 9(1)(c), 15 and 51 of the CTMR.

Infringement under Article 9(1)(b) - Likelihood of Confusion

- 6.8 [...] Recital 10 to Directive 89/104/EEC states that:

“Whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods and services identified, constitutes the specific condition for such protection.”..

- 6.9 This Recital, which has been included as the 8th recital of the CTMR as well, is often quoted in case law, providing the basis for the “global appreciation” test used to assess the likelihood of confusion under Article 9(1)(b) of the CTMR. This test has been built upon subsequently by case law of the CJEU. In particular, *SABEL v Puma*¹⁴ considers the global appreciation test in the context of registration concluding that:

“The likelihood of confusion must...be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.” (SABEL v Puma, paragraphs 22 and 23).

- 6.10 In fact this assessment was already commonly in use in some Member States, for example, under Benelux trade mark law through the infringement assessment given by the Benelux Court of Justice in its re. *Union* decision¹⁵ stating that the courts are invited to take into account all particular circumstances of the case. The BenCJ referred to the distinctiveness of the earlier mark in particular, as one of these circumstances.

- 6.11 The *SABEL v Puma* decision, furthermore, establishes that the greater the distinctiveness and/or reputation of the earlier mark, the greater the likelihood of confusion.

- 6.12 Such principles were applied in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*¹⁶ concluding that:

“...the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.” (C-39/97, paragraph 24).

- 6.13 This point is further emphasised in *Marca Mode v Adidas*¹⁷ which states that:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.”

¹⁴ Case C-251/95

¹⁵ BenCJ 20 May 1983, Case A82/5

¹⁶ Case C-39/97

¹⁷ Case C-425/98

- 6.14 INTA submits that such case law makes it clear that the reputation of the earlier mark is a factor to be taken into account when assessing the likelihood of confusion. The list of factors to be considered, as referred to in Recital 10 to Directive 89/104/EEC, is not intended to be exhaustive. It is generally accepted the relevant factors to be assessed include those circumstances that do not appear in the registration for which protection is sought, itself. This is evidenced by the fact that reputation is not mentioned in the list in Recital 10 and yet, as shown above, case law of the CJEU has clearly demonstrated that it is a relevant factor. Furthermore, the CJEU in *SABEL v Puma* refer to “taking into account all factors relevant to the circumstances of the case”. There is no attempt to suggest that there may be a definitive list of factors. The relevant factors and the weight to be attached to them is an issue for the national court in each individual case. A national court is therefore given substantial discretion as to the assessment of the concrete facts and circumstances of a case, taking into account the perception of the relevant public.
- 6.15 It has, for example, been accepted by the Benelux Court of Justice (*Michelin v Michels, BenCJ 16 December 1994*¹⁸) (dealing with the situation where the registered word mark was being used in a very specific and distinctive font) that under certain circumstances a court may take into account additional elements (i.e. font, colour) which are not part of the registered mark, unless such additional (device) element plays a dominant role in such manner that the trade mark will be perceived by public as to exist mainly in this additional expression and no longer in the form in which it has been registered.

Use of Colour

- 6.16 There is, therefore, no indication that the colour with which the defendant uses the sign complained of should not be considered as part of a global appreciation test on likelihood of confusion. This should include circumstances such as the present case, where the earlier mark is not registered in colour but the proprietor of the earlier mark has used that mark extensively in a particular colour (or combination of colours) such that it has become associated in the mind of the public with that colour or combination of colours.
- 6.17 Similar considerations on the global assessment of the likelihood of confusion (*Zeichenvergleich*) and enhanced reputation are provided by German case law arguing that a trade mark can only obtain an enhanced reputation for the form in which it has actually been used (for example, in a particular colour shade) and that the scope of protection resulting therefrom will overcome the registered form in as far as the distinctive character of the trade mark will not be altered due to the differing from the registration of the mark.¹⁹
- 6.18 INTA further submits that to find otherwise gives rise to practical difficulties. If the fact that a mark has acquired an enhanced character in a particular colour through use is not to be taken into account in conducting a global assessment of likelihood of confusion, then a registration which is limited by colour will potentially afford the proprietor greater protection than one that is not limited in this way (i.e. registered in black and white). It is readily accepted by brand owners and supported by case law in Member States, for example, the UK (*Phones 4u Ltd v Phone4u.co.uk Internet Ltd*²⁰); and in the Benelux (*Dunhill/Gallaher*²¹) that a mark registered in black and white covers all possible colour combinations. In order to obtain such a registration, the applicant must demonstrate distinctiveness regardless of colour. This provides a useful administrative shortcut for brand

¹⁸ Case A 93/7/11

¹⁹ Bekanntheit kann die Marke zwar nur in ihrer tatsächlich benutzten Form (zB in einer bestimmten Farbgestaltung) erlangt haben. Der daraus resultierende Schutzzumfang wächst aber immer der registrierten Marke zu, sofern sich durch die von der Eintragung abweichende Form der Benutzung die Charakteristik der Marke nicht ändert. Es ist die registrierte Marke, der wenn auch möglicherweise nur aufgrund einer Benutzung in bestimmter Formerhöhe Kennzeichnungskraft oder Bekanntheit im Rechtsinne zukommt. (Heyemanns Kommentare Markengesetz, Ströbele-Hacker, 10th edition, par.14 II, page 875; BGH GRUR 2006, 859,863, *MaltezerKreuz*.)

²⁰ [2006] EWCA Civ 244

²¹ District Court The Hague, June 26, 1991, BIE 194, 26

owners, obviating the need to file a registration in every possible colour combination. This minimises cost for brand owners, while also streamlining the register by avoiding superfluous registrations.

6.19 INTA submits that to reach a finding that would provide greater protection to marks limited by colour would serve to negate these benefits. Risk-averse brand owners would potentially register their mark in all colours which they use. For some brands, where the device mark is used in multiple colours, this could be a significant administrative and cost burden.

6.20 The High Court judge, Mann J, in the present case held at paragraph 120 that:

“What one does not do is to take the registered mark in a given colour because that is the colour used by the proprietor. To do so would contravene the principles expounded by Jacob LJ in L’Oreal SA v Bellure NV [2008] RPC 9.”

6.21 Quoting from paragraph 110 of *L’Oreal SA v Bellure NV* he states:

6.22 *“The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too – as though it formed part of the registered mark.”*

6.23 Mann J was impressed by the practical consequence of this, namely that “if someone wishes to know whether a proposed sign infringes, he ought to be entitled to answer that question by looking at the register and working from that.”

6.24 However, in respect of this argument, INTA makes two submissions. The first is that INTA agrees with the reasoning put forward by Kitchin LJ in the Court of Appeal decision in the present case at paragraph 96 where he states:

“The position is...markedly different from the cloud images in L’Oréal which did not form any part of the mark as registered.”

6.25 Secondly, the practical merit propounded by Mann J, is of little consequence, particularly when weighed up against the negative practical consequences described above. In assessing whether a proposed sign infringes a registered mark, the starting point will always be the register but in any event, and notwithstanding the decision reached by the CJEU in the present case, it has always been necessary, in certain contexts, to look beyond the register, in particular when considering acquired distinctiveness, reputation and non-use.

6.26 In light of the above analysis, INTA submits that the CJEU should answer Question D(i) in the affirmative.

Infringement under Article 9(1)(c) - Unfair advantage or detriment

6.27 Similarly, INTA submits that whether unfair advantage or detriment is likely is a question to be determined through the application of the global appreciation test. Question D(ii) should also be answered in the affirmative. The global appreciation test should be the same in both contexts. This is supported by the CJEU decision in *Adidas-Salomon AG, Adidas Benelux BV v Fitnessworld Trading Ltd*²², where it was held at paragraph 30 that:

“The existence of such a link [for the purposes of Article 5(2) of Directive 89/104/EEC] must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be

²² Case C-408/01

appreciated globally, taking into account all factors relevant to the circumstances of the case.”

- 6.28 The wording used is identical to that of the CJEU in *SABEL v Puma*.
- 6.29 Furthermore, reputation is an expressly relevant element of infringement under Article 9(1)(c) of the CTMR.
- 6.30 Question D further asks how the use in a particular colour is relevant in the global assessment test under Articles 9(1)(b) and 9(1)(c). INTA submits that it is simply a factor to be borne in mind much like any other factor to be assessed by the court in the global appreciation test. As highlighted earlier, the relevance of and weight to be attached to such a factor is entirely fact dependent and will be a matter for the national court to determine on the basis of the circumstances of the case.

Question E – colour used by potentially infringing sign

- 6.31 As held in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*²³, in assessing the likelihood of confusion, it is appropriate to take account of the factual context in which the sign is used.
- 6.32 This is supported by the judgment of Mann J in the present case at paragraph 136 and 137 where, in considering the use of the logo and straplines alongside Asda branding, it is stated that:

“Asda is itself a well-known name, and I do not readily understand how its name expressly spelled out, in prominent letters, could leave a reasonably circumspect consumer thinking that the mark is, or even might be, Specsavers’.

This conclusion is reinforced, not lessened, by the context of most of the actual use of the sign. It is primarily used in the optical section Asda stores, and online. If the circumspect consumer is in an Asda store already, he will hardly make an association with Specsavers by virtue of two ovals with Asda written in one of them. In that context I think there is hardly an argument in favour of confusion. The same applies to the online use. By the time that a consumer encounters the logo online he or she will have entered an Asda site already. As I have observed, Asda has its own strong reputation associated with its name, and the non-overlapping logos, with Asda’s name in one of them, will not cause any form of confusion with Specsavers.”

- 6.33 While INTA makes no comment on the application of the principles to the facts in the present case, it is submitted that the principle being applied is the correct one, namely that the sign complained of is not to be stripped of the context in which it is used. In INTA’s submission this should extend to the colour of the sign and the defendant’s reputation in that colour, if any.
- 6.34 Furthermore, as stated above in the context of Question D, the list of factors to be taken into account as part of the global appreciation test is not limited to those detailed in Recital 10 of Directive 89/104/EEC. INTA submits that there is no reason why the fact that the defendant is associated in the mind of a significant portion of the public with the colour which it is using for the sign complained of should not be a potentially relevant factor in assessing the likelihood of confusion.
- 6.35 Indeed, in light of INTA’s proposed response to Question D, it would appear to be logically inevitable the Question E should also be answered in the affirmative.

²³ Case C-533/06

7. Conclusion

7.1 In light of the above commentary and analysis, INTA respectfully submits that the CJEU should answer the questions referred by the Court of Appeal as follows:

A. Where a trader has separate registrations of Community trade marks for

(i) a graphic device mark;

(ii) a word mark;

and uses the two together, such use is capable of amounting to use of the graphic device mark for the purposes of Articles 15 and 51 of the CTMR. The use is to be assessed by the national court based on the facts and circumstances of the case.

B. It does not make a difference if:

(i) the word mark is superimposed over the graphic device; or

(ii) the trader also has the combined mark comprising graphic device and word mark registered as a Community trade mark.

C. The answer to A or B does not depend upon whether the graphic device and the words are perceived by the average consumer as:

(i) being separate signs; or

(ii) each having an independent distinctive role.

D. Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours such that it has become associated in the mind of a significant portion of the public (in a part but not the whole of the Community) with that colour or combination of colours, the colour or colours in which the defendant uses the sign complained of are relevant in the global assessment of (i) likelihood of confusion under Article 9(1)(b) and (ii) unfair advantage under Article 9(1)(c) of Regulation 40/94. This is relevant in the sense that it is another factor to be considered in the global assessment test. The weight of such a factor is to be assessed by the national court.

E. It is also relevant that as part of the global assessment that the defendant itself is associated in the mind of a significant portion of the public with the colour or particular combination of colours which it is using for the sign complained of. The weight of such a factor is to be assessed by the national court.



Gregg Marrazzo
President

August 23, 2012