



TOPIC 16
ENFORCEMENT OF
TRADEMARKS

TOKYO 2017
Louis Harms

BADGE OF ORIGIN



GUARANTEE OF ORIGIN

- Trade-marks are an important tool to assist consumers and businesses. In the marketplace, a business marks its wares or services as an indication of provenance or origin.
- This allows consumers to know who stands behind those goods or services.
- Trade-marks provide a shortcut to get consumers to where they want to go.
- Where the trade-marks of different businesses are similar, a consumer may be unable to discern which company stands behind the wares or services.
- Confusion between trade-marks impairs the objective of providing consumers with a reliable indication of the expected source of wares or services.

THE ESSENCE OF INFRINGEMENT: TO CAUSE CONFUSION

- Object of trade mark law is to prevent misleading commercial ‘speech’.
- Trademark infringement consists essentially in causing confusion in relation to origin.
- It destroys or dilutes the badge of origin.
- It confuses and misleads the public.
- Through “trademark use” by the defendant.

Infringement: trademark use

- Trademarks do not give copyright protection.
- There can only be trade mark infringement if consumers are likely to interpret the mark, *as it is used by the ‘infringer’*, as designating the undertaking from which the ‘infringer’s’ goods or services originate.

Descriptive use

- Descriptive use is not use as a trade mark.
- The test is how the ordinary, reasonable member of the purchasing public would regard and interpret defendant's use of the name as advertisement or not:
- Where the relevant section of the public views the sign purely as an embellishment, it is not tm use:
- Intention of the defendant is irrelevant.
- The public's perception is relevant.



COMPLEX TRADEMARKS ADDED MATTER

Identify the defendant's indication of origin:



POLO



Royal County of Berkshire
POLO CLUB



Infringement through confusingly similar marks on similar goods







AIR ZIDANE



BEAN GONE



9 RADA

Likelihood of confusion: no rules

FUTURE ENTERPRISES vs. MCDONALD'S

- "The smorgasbord of trademark cases demonstrates the innumerable (and subjectively perceived) similarities and differences that can be conjured up and persuasively articulated by an imaginative and inventive legal mind.
- Trademark infringement is 'more a matter of feel than science'.

Likelihood of confusion

MCDONALD'S



- MacTea, MacChocolate and MacNoodles – Singapore. No confusion.
- McCurry – Malaysia. No
- McBagel, McPretzel and McSalad – USA. Yes
- ‘McMint, McVeg – Australia. No confusion.
- McSALAD and McFRESH - Australia. Yes.

Global assessment

Global appreciation of

- the visual, aural or conceptual similarity
- based on the overall impression,
- of the marks as a whole
- comparing the overall impressions created by each of them
- bearing in mind, in particular, their
 - distinctive and
 - dominant components.

Detailed analysis not permitted

- Move from the courtroom to the market place.
- Look at the marks as they will be seen, in fair and normal commercial use.
- By the hypothetical consumers.
- Do not postulate a consumer of 'phenomenal ignorance or extraordinary intelligence'.
- Consider a person of average intelligence and proper eyesight, buying with ordinary caution.

List of factors

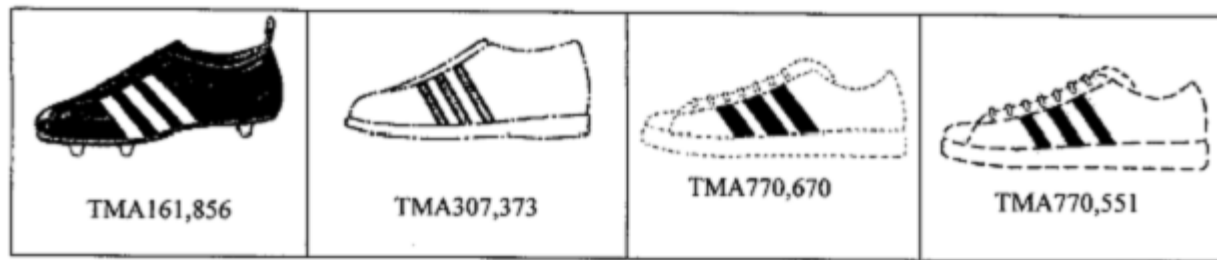
- Factors are not a mechanical checklist, and the proper weight given to each will vary from case to case.
- For a recent list: Specsavers International Healthcare Ltd v Asda Stores Ltd [2012] EWCA Civ 24 par 51-52



“Be a real spec saver at Asda”

ADIDAS CASES

Typical Adidas trademarks

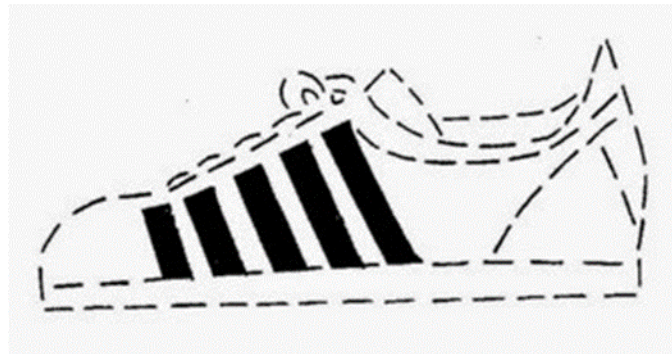


Not a trademark!

K-Swiss Inc v OHIM and Künzli

Trade mark protection requires passing two different tests:

- They have to “depart significantly from the norm or customs” of the field.
- The sign must not play a merely decorative role



Adidas-Salomon AG

- If the defendant uses similar stripes (eg 2 or 4) the question is whether they are used as decoration or as a badge of origin
- This depends on the public perception.
- But a decoration may at the same time be perceived to be a badge of origin.
- Unless the public views the sign *purely* as an embellishment.

Adidas AG v OHIM, Case T-145/14

Registration refused

- The public's perception that a sign is a decoration cannot constitute a restriction of the protection when, despite its decorative nature, that sign is so similar to the registered trade mark that the relevant public is likely to believe that the goods come from the same undertaking.
- The difference between two or three stripes cannot be regarded as important for the average consumer with an average level of attention.



Adidas v Pacbrands (Australia) 2013



Decorative or tm use?

The court held as follows:

- Common practice to place identifiers on the side of sports footwear.
- Signs decorative and/ or functional
- But can also serve a trade mark function.
- Defendant's uses were trade mark uses.

Infringement!



- The adidas 3-stripe mark is famous.
- This does not mean that the consumer may have an imperfect recollection
- There was no reason to assume that the average consumer would perfectly recollect the number of stripes.

No infringement



- Wider gap between the two central stripes
- Impression of two groups of two parallel stripes.
- No likelihood of confusion.

Adidas v Pepkor (SA) 2013

- Where the registered mark consists of three stripes it is a question of fact whether the use of two or four stripes is
 - decorative or
 - trademark use.
- One cannot use a trademark and then argue that it was used as ornamentation.

Infringing



Fame and notoriety (South Africa)

- The more distinctive the trademark is, or the greater its reputation, the greater the likelihood of confusion where a similar mark is used on competing products.
- The fact that trademarks are famous, does not mean that there is no likelihood of deception or confusion because purchasers will see immediately that the respondent's marks are not Adidas's trademarks.
- Purchasers still experience imperfect recollection.

Adidas AG v. Globe International Nominees Pty Ltd, 2015 FC 443

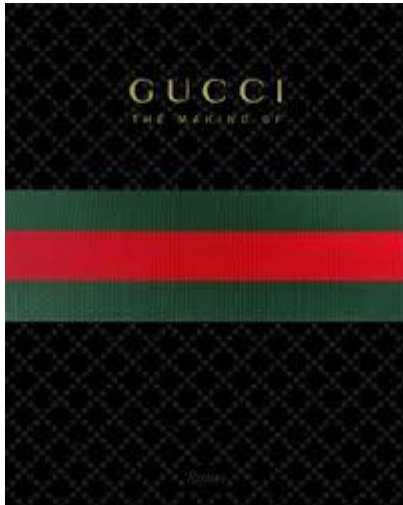
“When a trademark becomes so well known or famous, it may be that even as a matter of first impression, any differences may more easily distinguish and reduce any likelihood of confusion.”



GUCCI vs GUESS



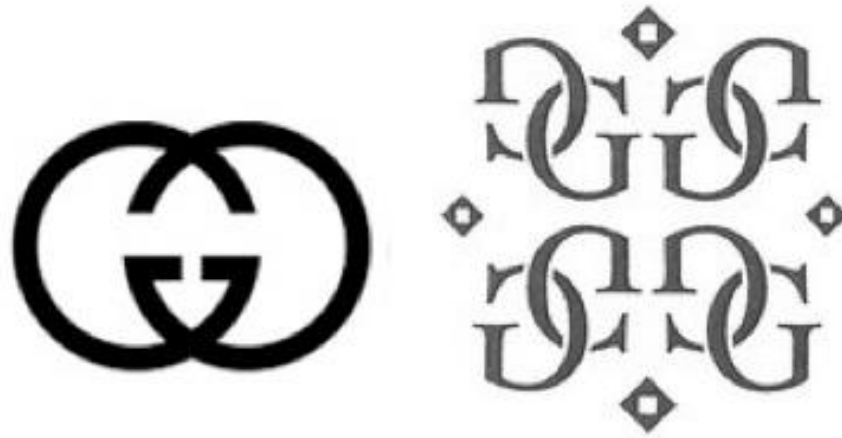
The Green-Red-Green Stripe mark



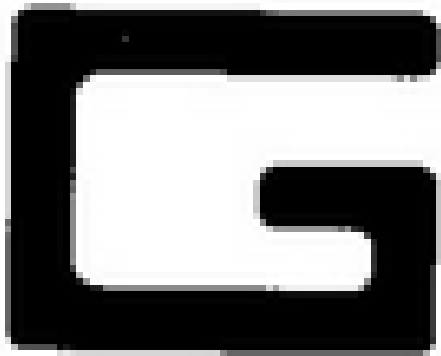
The Diamond Motif Trade Dress



The Repeating Interlocking GG Pattern



The Stylized G Design mark



The Script Gucci Design mark

Gucci



JUDGMENTS

TM	USA	ITALY	FRANCE	CHINA	EUROPE	AUSTRALIA
STRIPES	INFR	UNFAIR C	NO	INFR		
DIAMOND	INFR	UNFAIR C	NO	INFR		
INTERLOCK	INFR	UNFAIR C	NO	INFR	NO	GUESS REG REFUSED
STYLISED G	INFR		VOID		NO	
SCRIPT	NO		VOID			

