



THE FATE OF WEAK BRANDS

on the register, in court and on the market

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Registering weak brands

BioID AG v. OHIM (C-37/03 P)

BioID.[®]

computer software (Cl.9), telecommunications (Cl.38) and computer programming (Cl. 42) for computer-aided identification and/or verification of live organisms based on one or more specific biometric characteristics

Registering weak brands

Biold[®].

- the graphic elements (■) and (®) do nothing to enable the relevant public to distinguish the products or services (para. 72)
- overall impression: the abbreviation Biold is the dominant element (para. 73)
- the figurative and graphic elements are so minimal that they do not endow the trade mark with any distinctive character. They do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing the mark to fulfil its essential function (para. 74)

Guidance on registration of weak brands

CP3 – Common Communication on the Common Practice of Distinctiveness: Figurative Marks containing descriptive/ non-distinctive words

- Objective: to determine when a figurative mark containing purely descriptive/ non-distinctive words has sufficient distinctive character to be registered

CP3 – Figurative Marks / Descriptive Words

- Typeface and font

Flavour and aroma

FLAVOUR AND AROMA

- Combination with colour

Flavour and aroma

- Combination with punctuation marks and other symbols

“Flavour and aroma”

- Position of word elements

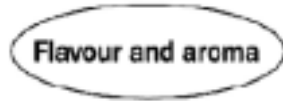
Flavour and Aroma

A n d
r
F l a v o u r
m
a

F l a v o u r
a n d
a r o m a

CP3 – Figurative Marks / Descriptive Words

- Use of simple geometric shapes



- Position and proportion of figurative element vs word element










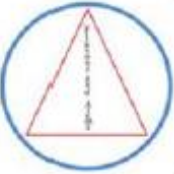







- Link between figurative element and goods/services



- Commonly used figurative element



CP3 – Figurative Marks / Descriptive Words

Non-distinctive	Distinctive
<p>1.</p> <p> <i>Flavour and aroma</i> <i>Flavour and Aroma</i> Flavour and aroma Flavour and Aroma </p>	<p> F A R A O A <i>Flavour and Aroma</i>  </p>
<p>2.</p> <p>     </p>	<p>    </p>
<p>3.</p> <p>  Fresh sardine    </p>	<p>  Fresh Sardine  Fresh sardine  </p>

Weak brands in court

Starbucks (HK) Ltd v BSkyB Group Plc [2012] EWHC 3074 (Ch)



CTM for “TV broadcasting services” etc.

v.

NOW TV

NOWTV.com



Defendant’s internet TV service

Weak brands in court: **now** v **NOW TV**

Factors taken into account:

- no claim to acquired distinctiveness
- average consumer = the general public
- “now” has everyday meanings as an adverb, conjunction, noun and adjective
- “now” is the 73rd most common word in the English language, frequently used in advertising
- lots of examples of ‘nominative use’: e.g. *Now Wireless, Now That’s What I Call Music, Now Movies, Live Music Now, The Now Show*

Weak brands in court: v NOW TV

Arnold J:

*Taking all of the evidence into account, I conclude that the CTM is precluded from registration by Article 7(1)(c) in relation to the services in issue because **NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service.***

*The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that **the CTM is devoid of distinctive character and thus unregistrable by virtue of Article 7(1)(b).***

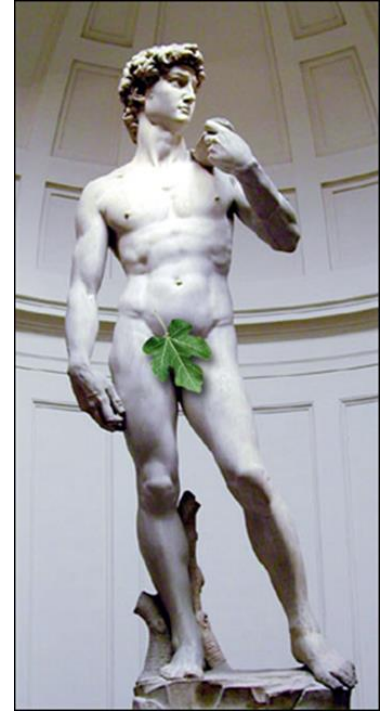
Weak brands in court: **now** v **NOW TV**

Arnold J:

... it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM.

Weak brands in court: **now** v **NOW TV**

*Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a **figurative figleaf of distinctiveness**, and refuse registration of such marks in the first place.*



Weak brands in court

Supreme Petfoods Ltd v Henry Bell & Co (Grantham) Ltd
[2015] EWHC 256 (Ch)



UK and CTMs for "animal foodstuffs" etc.

v.



Defendant's product

Weak brands in court: *Supreme Petfoods*


SUPREME

(word only)

- would be understood to mean “of the highest quality” when used in relation to animal food
- it is therefore descriptive
- if that is wrong, it is laudatory and therefore lacks distinctive character

Weak brands in court: *Supreme Petfoods*



- the specific font of “upreme” adds nothing
- although a “borderline case”, on balance the stylisation of the “S” does not help
- if that is wrong, any distinctiveness lies purely in the 

Weak brands in court: *Supreme Petfoods*



the Ribbon Marks do have some distinctive character as a result of the visual presentation of the mark

Weak brands in court: *Supreme Petfoods*

- “Henry Bell’s use of the sign SUPREME would be understood by the average consumer as being purely descriptive”
- the confusion evidence was very weak
- *“Given the coexistence of Mr Johnson’s SUPREME RABBIT MIX with Supreme Petfoods’ use of SUPREME for over 20 years and the absence of confusion, I conclude that Henry Bell has established that its use of the sign does not adversely affect the origin function of the UK Trade Mark (or any other function...)”*
- ergo failure under both art. 5(1)(a) and 5(1)(b); same for art. 5(2)



Conclusions

- Examination of trade marks must be “stringent and full”
- Convergence programme should increase consistency
- But one person’s non-distinctive is another person’s distinctive, even with identical guidance and examples

E.g. CP3 says distinctive for sardines:



UK IPO says non-distinctive for cafés:



The reality of weak(?) brands on the market

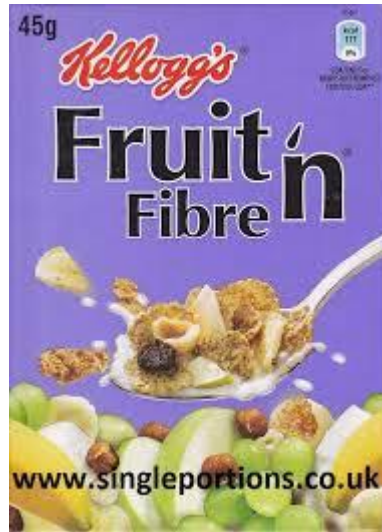
★ PRET A MANGER ★



EAT.



The reality of weak(?) brands on the market





Thank You

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