

EIP

Colour and Composition: Just how relevant are they?

The issues of colour and composition form the basis of the questions referred to the CJEU by the Court of Appeal in this case of Specsavers International Healthcare & ors v Asda Stores Ltd.

The appeal relates to allegations of infringement and validity of a number of community trademarks owned by the claimants (“Specsavers”). The marks in issue can be viewed by clicking [here](#).

None of the registered trademarks comprise any colour element. However, Specsavers consistently make use of a sign in which the overlapping ovals are a specific shade of green, with a darker shade of green in the region of the overlap, ([see Fig 1](#)).

It is the difference between the marks as registered and the sign as used which has caused the Court of Appeal to refer the first of two sets of questions to the CJEU.

Asda alleged that the Wordless Logo Mark should be revoked on the ground of non-use. Specsavers contended that they had used The Wordless Logo Mark as part of the use of the Shaded Logo Mark. At first instance, Mann J. agreed with Asda, on the basis that, to the average consumer, the addition of the word “Specsavers” altered the distinctive character of the mark, and so the use of the shaded sign could not be relied upon as use of the Wordless Logo Mark. As there was no other relevant use, Mann J. held that the Wordless Logo Mark should be revoked.

On appeal, Kitchen LJ, giving the lead judgment, felt this raised questions both of fact and law: did the average consumer, as a matter of fact, recognise the Wordless Logo Mark when seeing the shaded sign; and did this legally constitute use of the Wordless Logo

Mark?

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On the first point, there was extensive evidence of the use the shaded sign, and importantly, the Defendant's ("Asda's") own internal material acknowledged that a device of overlapping ovals would be recognised as referring to Specsavers. The second point, however, was less clear.

Non-use is governed by Art. 15 of the Trade Mark Regulation (Council Regulation (EC) No 207/2009), which states that a trade mark can be revoked if not put to genuine use within five years of registration, and (as per Art. 15.1(a)) that use of the mark in a form differing in elements which do not alter the distinctive character of the mark can be taken into account. Hence the court needed to assess what the differences were between the mark as registered and as used, and assess whether they altered the distinctive character of the mark (BUD [2003] RPC 25).

The Court of Appeal referred to the "Have a Break" case, by which Nestle sought to register the mark "Have a break" on the basis of an acquired distinctiveness obtained through using the phrase "Have a break...have a kit kat" (C-353/03 Société des Produits Nestlé v Mars UK Ltd [2005] ECR I-6135). In that case, the ECJ ruled that distinctiveness could be acquired in a mark when the mark is used as a component of another mark; hence there was an implication that the same should apply to the consideration of non-use, an implication seemingly confirmed in the Advocate General's opinion in that case, as well as in the General Court's judgment in Castellblanch (T-29/04 Castellblanch SA v OHIM [2005] ECR II-5309).

However, reference was also made to *Il Ponte Finanziaria v OHIM* (T-149/03 [2006] ECR II-445), in which the Court of Justice stated that use of a mark cannot be proved by relying on use of a different mark which is a slight variant of the former.

Given this inconsistency in the case law of the CJEU, the Court of Appeal decided that guidance must be sought, and referred the following questions to the CJEU for a ruling:

- 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 Article 15 of Regulation 40/94? 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?

Because at first instance the Wordless Logo Mark was revoked, there was no consideration given in Mann J's judgment to infringement of the mark. However, if the Court of Appeal go on to find that the mark is valid, they will be required to assess whether it has also been infringed. This would necessitate an assessment as to whether Asda's use of their signs gave rise to a likelihood of confusion with Specsavers' mark.

Asda had used the colour green in their signs, (see Fig 2 and Fig 3).

The shade of green used by Asda was that generally used by Asda across its business.

Specsavers argued that there was a greater likelihood of confusion because of Asda's use of the colour green, due to the enhanced reputation Specsavers claimed to have in relation to the colour green as used for their overlapping ovals. Kitchin LJ was inclined to agree, noting that a mark registered in black and white is treated as being registered for all colours. When assessing a likelihood of confusion, the reputation of the earlier mark had to be taken into account, and so if a logo registered in black and white has acquired, through use, a particular and distinctive character, in, for example, the colour green, that would seem to be a matter which ought to be considered.

Despite this, Kitchin LJ felt that the law was again not clear, in light of L'Oreal (L'Oréal SA v Bellure NV [2007] EWCA Civ 968; [2008] RPC 9), in which it was held that likelihood of confusion must be assessed based on the mark as registered and not how it is marketed, and cases such as Canon (C-39/97 Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc [1998] ECR I-5507) by which it has been consistently held that the reputation of an earlier mark should be taken into account. Consequently, the following questions were also referred to the CJEU:

- 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?

So, we now await the decision of the CJEU and the answers given to these questions will be of great importance to the owners both of composite marks and colour marks. If a trademark consists of both a word and a device, the strongest infringement rights are achieved by registering the two elements both separately and together. The CJEU's answers to the above questions should tell us whether it is necessary to (a) make some (genuine) use of the individual elements on their own and/or (b) re-register them every few years to protect them from a non-use attack. On the colour point, we should learn whether it is essential to register marks in the colour in which they are actually used, rather than in black and white. Since most brands feature some sort of colour in use, multiple registrations may be needed to achieve full protection, especially if there are colour variants or if the colour is adapted or changed over time.

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