

Bird & Bird & IP and IT Law Bytes

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Trade marks: genuine use, distinctive character and infringement

Summary

The High Court has held that use of the trade mark “PINK” on goods and as the name of stores infringed registered UK and Community trade marks (CTM) under sections 10(2) and (3) of the Trade Marks Act 1994 (TMA), and Articles 9(1)(b) and (c) of the CTM Regulation (207/2009/EC).

Background

A trade mark owner has the right to prevent unauthorised third parties from using, in the course of trade, any sign:

- Where, because of its similarity to the trade mark, and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion or association on the part of the public (*section 10(2)(b), TMA*).
- Which is identical with, or similar to, the trade mark, which has a reputation in the UK, and where the use of the sign is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark (*section 10(3), TMA*). Similar provisions are set out in Articles 9(1)(b) and (c) of the CTM Regulation.
- A CTM owner’s rights will be revoked 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 (*Article 51(1)(a), CTM Regulation*).

A trade mark must not be registered if it is devoid of distinctive character, or consists exclusively of signs or indications that designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of goods or services (*sections 3(1)(b) and (c), TMA*). However, it will not be refused registration if, before the date of application for registration, it has, in fact, acquired a distinctive character as a result of the use made of it.

Facts

T sold shirts and accessories under the names “Thomas Pink” and “PINK”. T filed a CTM in 2004 and a UK trade mark in 2010 for, among other things, “clothing, footwear, headgear” in class 25 and retail services in class 35.

V was famous in the USA and worldwide for selling lingerie under its “VICTORIA’S SECRET” brand. In 2004, V launched a sub-brand “PINK” in the USA for lingerie and other clothing.

In 2012, V opened “VICTORIA’S SECRET” and “PINK” stores in the EU, including the UK. In its “PINK” stores, V sold clothing that used the word “PINK” alone in a prominent way, although all V clothes carried the words “VICTORIA’S SECRET” on the label.

T brought proceedings against V for passing off, and infringement of its registered trade marks. V counterclaimed on the basis that T’s trade marks were invalid for lack of distinctiveness and applied for revocation of the CTM for non-use.

Decision

The court found in favour of T. It held that V's use in the EU of "PINK" on its goods and as the name of its stores was an infringement of T's registered trade mark rights.

V's counterclaim for revocation failed as there had been genuine use in relation to a wide variety of categories of clothing and the trade marks had acquired a distinctive character in relation to all the registered goods despite its use in a form that differed from its registration.

V's use of "PINK" on clothing gave rise to a likelihood of confusion with the CTM on the part of the average consumer. The goods were identical, the sign was very similar to the mark and nothing in the context would act to reduce a likelihood of confusion. V's other goods were similar and so, again, the use of the "PINK" sign gave rise to a likelihood of confusion.

The "PINK" store fronts also gave rise to a likelihood of confusion because the retail services were identical and the reference to "VICTORIA'S SECRET" in the window was too small to play a material role.

On the other hand, the use of the sign "PINK" inside retail stores on clothing labels that also had the name VICTORIA'S SECRET in small writing underneath would not, in that context, give rise to a likelihood of confusion.

The use of "VICTORIA'S SECRET PINK" on Facebook would also not give rise to a likelihood of confusion, even if it was targeted at the UK. The site was not selling goods to the public, but was general promotional activity by V, and would be seen as this by the average consumer.

V's substantial use in the USA, and the fact that its use in the UK was a natural extension of this, was not due cause to act in a manner that would infringe T's trade mark rights. The use relied on by V was in the USA, not the EU, and it did not predate the CTM.

Detriment would be caused to the repute of T's mark. T's trade mark would be associated with a mass market offering, reducing its luxurious reputation. There would be a change in the economic behaviour of T's customers. There was a risk consumers would not buy products from T when they otherwise would have done. The association of the marks would also inevitably cause a detriment to the distinctive character of T's mark.

Comment

The court found that the UK mark could acquire distinctiveness under section 3(1) of the TMA where it was used, in a form that differed from the mark as registered, in elements that did not alter the distinctive character of the registered mark. Applying the same principles, the court also found that an infringement claim under section 10(3) of the TMA could succeed even if an identical trade mark had not been used, on the basis that this would not prevent the mark from acquiring the relevant reputation.

It is interesting that evidence of confusion was adduced by T's employees who recounted incidents where members of the public appeared to be confused, although none of the consumers gave evidence. The court noted that the employees' evidence was not of sufficient weight to lend any significant positive support to T's case. However, it played an important negative role as it stopped V from credibly arguing that there was no evidence of actual confusion in the UK or the EU.

Case: Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch).