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The commercial functions of a trade mark, unconventional trade marks and modern technology

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Abstract

The paper analyses the current legislation within the UK and Europe with respect to trade mark law. A number of legal journals and case reports provide the bulk of research material, with use of direct judicial quotes and key opinions of journal authors providing the framework for research into the state of current trade mark law. The historical functions of trade marks dating back nearly a century are still relevant today, with concepts recognised and enshrined by both domestic UK and European Union courts. Trade marks work as a badge of origin and, by extension, allow similar products to be differentiated. They act as a guarantee of quality and an ambassador for the generation and preservation of goodwill that has been generated within a given trade mark. Gaining a trade mark confers a near monopoly on its use and the legislation provides mechanisms to protect and recognise this. A trade mark allows businesses to build identity, quality and reputation into the core essence and branding of their products. A diverse quantity of ideas and concepts are capable of representation graphically, in both conventional and abstract forms, allowing them to be trade marked. The resulting monopoly granted by the trade mark is of exceptional importance to businesses of all sizes, allowing them to benefit from the breadth of commercial functions that a trade mark can fulfil. Despite the law regularly playing catch-up to new technological advances, the courts are applying flexible and practical solutions to accommodate the developing needs of modern informational technology.

Keywords: Intellectual property; trade marks; unconventional trade marks; Trade Marks Act 1994; Directive 2008/95/EC.

Introduction

This paper will consider the commercial functions of a trade mark and look at how effective the current law is at allowing trade marks to be registered, with a focus on unconventional marks. It will analyse and discuss how capable the current law is of protecting and upholding the commercial functions of a trade mark in the face of modern consumer habits and technology.

Functions of a trade mark

The basic function of a trade mark

According to Bainbridge, in order to find an early definition of a trade mark you should look towards s 3 Trade Mark Act 1905. It defined a trade mark as a mark used with goods 'for the purpose of indicating that they are the goods of the proprietor of such mark by virtue of manufacture, selection, certification, dealing with or offering for sale'.¹

This was followed by s 68(1) Trade Marks Act 1938, giving a broader definition of 'a mark used ... in relation to goods for the purpose of indicating ... a connection in the course of trade between the goods and some person having the right ... to use the mark'.²

At the present time, art 2 of Directive 2008/95/EC³ (the Directive) as implemented in s 1(1) Trade Marks Act 1994 (TMA 1994) defines a trade mark as 'any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another'.⁴

It is clear that over time the legislative definition of trade marks has changed with each revision of the relevant statutes. Despite this, subsequent iterations contain the same common concept: a trade mark helps to identify the origin of goods.

The essential function of a trade mark

As early as 1927, Schechter identified the various functions of a trade mark. A contrast can be made between Schechter's analysis and more recent case law, settling the question of how modern trademarks differ from those of nearly a century ago.

Schechter argued that the orthodox purpose of a trade mark is 'to identify the origin or ownership of the goods to which it is affixed'.⁵ This is the badge of origin concept that is enshrined in over a century of legislation from the 1905 Trade Marks Act to the Directive, which itself states 'the function of [a registered trade mark] is in particular to guarantee the trade mark as an indication of origin'.⁶

UK courts have referred to the 'essential function' of trade marks as in the recent case of *IPC Media Ltd v Media 10 Ltd*.⁷ Kitchen LJ put forward a trade mark's 'essential function of guaranteeing the identity of the origin of the goods and services to which it was applied'.⁸

In *Total Ltd v YouView TV Ltd*,⁹ Sales J noted a trade mark's 'indication-of-origin-function', citing jurisprudence from the Court of Justice of the European Union (CJEU).

The CJEU has ruled on numerous occasions that a trade mark serves as a 'guarantee of origin'. In the recent case of *Leidseplein Beheer BV v Red Bull GmbH*,¹⁰ the CJEU noted that it was settled case law that the 'essential function of the trade mark ... is to guarantee to consumers the origin of the goods or services in question'.¹¹

Schechter notes both a unifying and differentiating function, stating that trade marks show a consumer that 'two articles, bearing the same mark, emanate from a single source' and, in contrast, a differentiating function, using the case *McDowell v Standard Oil Company (New Jersey)*.¹² This case went to the House of Lords, where the issue of contention was whether the trade mark would, as per Viscount Cave LC, 'deceive or mislead the trade or the public and ... produce confusion between the goods [of the] two traders'.¹³

A differentiating function naturally implies a unifying function. Any function designed to differentiate between similar goods of different origins would also act as a unifying agent to identify different goods from the same origin. As a logical conclusion, a differentiation function must also be part of the 'essential function' of a trade mark.

Legislation pays significant attention to the concept of differentiation and prevention of confusion of the origin of goods.

Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), to which the UK is a party, confers:

the exclusive right to prevent all third parties not having the owner's consent from using ... identical or similar signs ... which are identical or similar to [the registered trade mark] where such use would result in a likelihood of confusion.¹⁴

Recital 11 to the Directive offers identical protection.¹⁵ Likewise, s 5(2) TMA 1994 refuses registration of a trade mark where 'there exists a likelihood of confusion on the part of the public'. The same concept also provides protection against infringement in s 10 TMA 1994.

The CJEU held in the joined cases of *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber*¹⁶ that the function of a trade mark is 'to identify an undertaking's goods and to distinguish them from other similar products'.¹⁷

The phrase 'essential function' implies a base requirement, the idea that a trade mark would fail if it were not capable of performing such a function. A trade mark acting as a guarantee of origin has been present in over a century of legislation, which present-day case law recognises as an essential function. It is clear that unless a trade mark is capable, at a minimum, of distinguishing the origin of one set of seemingly identical goods from another, it loses a significant amount of purpose.

Further still, this minimum requires recognition from the law in order to fulfil the essential function. Without such recognition from the courts, trade mark owners would have no redress against fraudsters attempting to create confusion and trick consumers by misusing trade marks.

The true functions of a trade mark

From the 'essential function', other functions can take root and grow. Schechter discussed what he believes to be the 'true functions' of a trade mark. The first is 'to identify a product as satisfactory'.¹⁸ This function serves to guarantee quality. The second is to 'stimulate further purchases by the public',¹⁹ effectively acting with an advertising function, an agent for 'the actual creation and perpetuation of good will'.

The CJEU recognises both of these concepts. *Leidseplein* shows a recent example, with the CJEU stating that the functions of a trade mark include 'guaranteeing the quality of ... goods or services or [guaranteeing the quality] of communication, investment or advertising'.²⁰ Recognising these functions was a result of continued case law, as in *Martin Y Paz Diffusion SA v Depuydt*²¹ and many other cases.²²

These 'true functions' are a logical extension of the 'essential function' of a trade mark. When each set of goods are marked based on their origin, with no two different origins capable of using the same mark, a trade mark becomes an ambassador for any given product in the eyes of the public.

Using a trade mark, a company can build up a positive reputation for the quality of goods based on their trade mark. Communication of this reputation is a natural consequence, and this acts as an agent for the creation of goodwill and, as a result, can promote advertising between consumers.

If the 'essential function' operates as the roots and branches of the trade mark tree, the 'true functions' are branches. The branches provide a platform for the leaves of goodwill to sprout and provide nourishment to the 'essential function', which allows the fruits of advertising to flourish. In picking these fruits and sharing their positive experience with others, the trade mark tree draws more people to the owner's orchard.

Davis submits an argument on Community trade mark registration, stating that '[it] was designed to support a system of genuine competition within the EC'.²³

It is submitted that this is a combination of all the discussed functions of trade marks. It guarantees that marked goods come from a specific origin, often with a known quality. Trade marks also differentiate identical products from different origins, generating 'goodwill' within a given mark and acting as a conduit to advertise where a product has sufficient quality attributable to the mark.

Likewise, Schechter's analysis of trade mark protection in 1927 is still relevant even today, citing all the major functions that a modern trade mark possesses.

The limitations of a trade mark

The introduction of the Trade Marks Act 1994 brought with it excitement and curiosity as to how the new definition of a trade mark would allow the registration of previous registrable trade marks. Lewin comments that there was potential for registering product shapes, smells and even musical jingles.²⁴ Elmslie, stating the general view at the time, proposes a counter point that it was '... unlikely that a smell could be represented graphically so as to distinguish a product ...'²⁵

An analysis will be conducted below on the limitations of registering trade marks and how these limitations hamper the essential and true functions of a trade mark.

How easy it is to register a trade mark is an important concern. S 31 TMA 1994 covers trade mark registration, requiring basic paperwork to be completed and an application fee to be paid. It is clear that the barrier for entry on the administrative side of registering a trade mark is very low, making registered trade marks relatively easy to apply for compared to the protections conferred by successful registration.

There is an argument in support of a strong protection being afforded by successfully registering trade marks. In *Société des Produits Nestlé SA v Cadbury UK Ltd*,²⁶ as per Sir John Mummery, ‘... the registration of a trade mark creates a form of intellectual property conferring a potentially perpetual monopoly in the mark and excluding everybody else from use in various ways’.²⁷

Such protection is necessary. If a trade mark acts as the ambassador for any given product in the eyes of the purchasing public, to have a situation where someone is capable of using that given trade mark without permission of the trade mark owner has potential to open the floodgates to foul play, defeating the badge of origin function in the process. Were such a monopoly not provided, a trade mark would lose a significant amount of worth and thus would be likely to find its purpose defeated.

A representation of the trade mark is also required under s 31 TMA 1994, which will be discussed below with regard to various unconventional types of trade marks.

Under art 2 of the Directive, as implemented in s 1(1) TMA 1994, a trade mark is ... any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may ... consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

Anything falling within this description is *prima facie* capable of registration. Additional guidance was provided by the CJEU in *Sieckmann v Deutsches Patent und Markenamt*,²⁸ stating ‘[t]he purpose of graphic representation is to give a clear, precise and objective image of the mark’. The *Sieckmann* definition remains good law and will be referred to later.

This is with respect to the absolute and relative grounds as per UK legislation, or the grounds and further grounds as per the Directive, for refusal. For example, one of the absolute grounds under art 3 of the Directive as implemented in s 3(1)(b) TMA 1994 is that a trade mark must not be devoid of ‘distinctive character’. Distinctive character was discussed in *British Sugar Plc v James Robertson & Sons Ltd*,²⁹ in which it was asked whether the mark is ‘the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?’³⁰

The approach taken by the CJEU can be seen in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*.³¹ It was held that:

‘[i]n determining the distinctive character of a mark and ... assessing whether it is highly distinctive, the national court must make an overall assessment [on

the] capacity of the mark to identify the goods or services ... as coming from a particular undertaking, and ... to distinguish ... goods or services from those of other undertakings.³²

Thus, it becomes clear that beyond the limitations within s 1(1) TMA 1994, a wide variety of marks are capable of registration, with the remaining grounds for refusal existing as practical and procedural requirements, as well as safeguards and protections against immoral, illegal or obviously infringing marks being registered.

The main limiting factor is simply the interpretation of the courts, both domestic and European, of the relevant legislation.

Unconventional trade marks

A question could be asked regarding the scope of trade marks that are capable of registration. An analysis of existing trade marks and case law can provide insight into the interpretation of the Trade Marks Act 1994 and the Directive it implements.

Colours can be registered as trade marks. Colour trade marks were the issue in contention when a reference was made to the CJEU in *Heidelberger Bauchemie GmbH*.³³ It was held that, following *Libertel Groep BV v Benelux-Merkenbureau*,³⁴ colours 'may constitute a trade mark'.

However, the recent case of *Nestlé v Cadbury*³⁵ may change how easy it is to register a colour trade mark within the UK, as well as limit the protections afforded to existing colour trade marks. In this case, the court held that the colour purple with the description provided did not satisfy the s 3(1)(a) TMA 1994 requirement.

Stobbs comments on this technical case, explaining that the term 'predominant' with regard to the colour being applied to the whole visible surface was not specific enough. This effectively failed under the *Sieckmann* criteria. Stobbs further comments that this decision puts existing colour trade marks in contention because the '... vast majority of the existing protected colour marks are described in the form analysed in this case'.³⁶

Despite this, Stobbs argues, '... the judgement confirmed that "applied to the whole visible surface" would satisfy the requirements ...³⁷ under s 3(1)(a) TMA 1994. Stretch also argues that '... Cadbury fell short ... by using subjective language but had they used a more precise description it is likely that the application would have succeeded ...'³⁸

Other types of trade marks include smells. In *Sieckmann* an application for a 'smell mark' was made. This was ultimately rejected by the CJEU, laying down their criteria for graphic representation discussed above. The court held that a '... chemical formula did not represent the odour of a substance ...' and that '... a description of the odour was not sufficiently clear, precise and objective'. Depositing a sample of the odour did not '... constitute a graphic representation ... [m]oreover, an odour sample is not sufficiently stable or durable'.³⁹

A smell would satisfy the requirement of graphic representation if the graphic, in the condition it was defined, 'was and was likely to remain generally accessible for use as a benchmark of the specified smell', as per *John Lewis of Hungerford Ltd's Trade Mark Application*.⁴⁰

Wong suggests that it is 'difficult for olfactory marks to be protected'.⁴¹ There exist only two registered olfactory marks in the UK, as a testament to this difficulty.⁴² These marks are registered simply by text descriptions of their smell and elaboration on their basic use.

Sound marks are another potential type of trade mark. The CJEU has recognised that sound marks can be protected, giving specific requirements in *Shield Mark BV v Joost Kist h.o.d.n. Memex*.⁴³ A sound is capable of graphic representation where 'the sign is represented by a stave divided into measures and showing ... a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals'.

Likewise, slogans were shown as capable of being registered as trade marks, as shown in *Société des Produits Nestlé SA v Mars UK Ltd*⁴⁴ and *Tesco Stores Ltd's Trade Mark Applications*.⁴⁵ Slogans are arguably the most conventional of the unconventional trade marks, comprising simply a string of words as opposed to a string of letters. It seems a logical conclusion that if one can trade mark a word, one can trade mark a phrase or a slogan that is made of multiple words.

Shapes can be registered as trade marks subject to restrictions under art 3(1)(e) of the Directive as implemented in s 3(1)(2) TMA 1994. These restrictions serve the public interest, as noted in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*,⁴⁶ 'that a shape whose essential characteristics perform a technical function and were chosen to fulfil that function may be freely used by all'.⁴⁷

These restrictions are vital. For example, if a company was successful in trade marking the standard cylindrical shape of a deodorant canister, it could potentially force all other deodorant manufacturers to bottle their products in more expensive or less structurally sound containers, conferring a practical advantage to the trade mark holder over their competitors.

Bergquist and Curley, analysing the trade marking of shapes in fast-moving consumer goods, concluded that 'only a trace of distinctive character is prima facie required for registration of shapes ... as trade marks ...', but that '[e]ven those that are granted may not withstand a validity attack, if challenged'.⁴⁸

Coca-Cola provides an example of this concept applied in practice. They have successfully registered a trade mark for the Coca-Cola bottle's three-dimensional shape.⁴⁹ This shape serves no practical purpose, nor does it perform any technical function. The bottle serves as a unique shape, acting as an ambassador for the Coca-Cola brand, even if only in a subtle manner.

Another example of an unconventional trade mark was registered by Asda Stores Limited. They successfully trade marked the so-called 'pocket pat' gesture in 1995.⁵⁰

This remains registered to this day, showing that even a gesture is capable of trade mark registration, providing it can be represented graphically.

Significantly more unconventional trade marks are capable of registration. In *Apple v Deutsches Patent- und Markenamt*⁵¹ the CJEU held that 'the representation ... of the layout of a retail store, may be registered as a trade mark'.⁵²

Blum and Cullen provide commentary on this case. They note the benefits of being able to register a store layout as a trade mark, namely that 'it can make an action for trade mark infringement available where otherwise it might be necessary to rely on passing off'. This is based on the particular difficulty of establishing the misrepresentation required under passing off, mainly owing to potential for a defendant's well-known brand to be on the outside of their store.⁵³

It is submitted that a large number of concepts, both tangible, such as shape or colour, and abstract, such as smell or sound, are capable of registration as trade marks. As a result, the commercial functions of a trade mark are largely upheld, especially in the area of the origin function. This, in turn, enables advertising functions, allowing products and brands to be associated with specific sounds, songs, colours, shapes, smells, gestures, slogans and even store layouts.

Trade marks and the internet

On a technological level, internet domain names can also technically be trade marked, albeit it in an indirect manner. With regard to Community trade marks, it was held in *Getty Images v OHIM*⁵⁴ that '... the distinctiveness of trade marks composed of words and a typographical sign', such as a domain name, 'may ... be assessed by examining each of its terms or elements ... but must in any event depend on an appraisal of the composite whole'.⁵⁵ Manning comments that that '... it is insufficient that internet users use the mark to visit the site on which goods or services are offered ...'.⁵⁶

Manning concludes that '... when it comes to domain names it is not their general use but their use as a trade mark that warrants the protection of trade mark law'.

As such, just because a domain name is used in general for any given purpose does not necessarily make it capable of being trade marked. The domain name would have to be capable of being trade marked in its own right, with no respect paid to its use as a domain name.

Within the UK, domain names are not directly capable of registration as trade marks. This argument is based on guidance from the Intellectual Property Office, which states that '[b]eing the owner of a registered trade mark, does not automatically entitle you to use that mark as a domain name'.⁵⁷

The justification for this lies in the fact that '... the same trade mark can be registered for different goods or services and by different proprietors'.⁵⁸ This is more of a practical problem, as different people may have identical valid trade marks in entirely different categories, and deciding who has rights over any given domain name would be impractical.

The case of *British Telecommunications v One in a Million*⁵⁹ showcases the protection afforded to registered trade mark owners with regard to domain names. Barker briefly comments on this case, noting that the registration of the domain names offered for resale by the defendant ‘... constituted threatened use for the purposes of s 10 of the Trade Marks Act 1994 ...’⁶⁰

As submitted by Hart commenting on *Tesco Stores Ltd v Elogicom*,⁶¹ registration and use of Tesco-related domain names to reap commission from Tesco as an affiliate ‘... would also be regarded as detrimental to the distinctive character or the repute of Tesco’s trade marks within the meaning of TMA 1994, s 10(3) ...’⁶²

As such, it is submitted that, while domain names are not registered as trade marks, an established registered trade mark can successfully be used as a basis to prevent others taking advantage of the distinctive character or reputation of that trade mark when registering a domain name. While this is primarily to protect the owners of the trade mark, it is submitted that this also protects consumers by ensuring that, within reason, websites they visit with domain names incorporating elements of existing registered trade marks originate from that trade mark holder.

The vessel to reach these potentially infringing sites is more often than not a search engine. Search engines are a service that can be used to attempt to locate a website without knowing its domain name. In such a scenario, having a domain name incorporating another’s trade mark or a website utilising another’s trade marks could lead to a web surfer unknowingly visiting a fraudulent website.

There are a series of cases relating to the use of trade marks as adwords in internet search engines, starting with *Google France v Louis Vuitton*,⁶³ where the CJEU ruled that search engines themselves are not liable for the use of trade marks as adwords. Blythe comments that ‘the advertiser who selected and purchased as an adword the keyword corresponding to a registered trade mark’ was the party using the sign in the course of trade,⁶⁴ not the search engine itself.

This was followed by *Interflora v Marks & Spencer*,⁶⁵ applying the decision of the CJEU in *Google France* of a new test for whether adword advertising using keywords had affected the ability of the trade mark to signal origin, the essential function of the trade mark as discussed above.

An implication of consumer protection is present in these decisions. In her analysis of the case law surrounding this, Blythe notes that the courts use a hypothetical construct of ‘the average consumer, who is reasonably observant and circumspect’.⁶⁶ It is submitted that this construct contains implications that not only should the trade mark holder have their rights protected, but the average consumer being misled is the trigger mechanism for the trade mark holder’s rights being breached.

In *Cosmetic Warriors v Amazon*⁶⁷ there were multiple potential grounds for infringement similar to *Interflora* and *Google France* above. There was also a new ground, where searches for ‘Lush’ on the Amazon website, despite Amazon not selling any Lush products, did not display a ‘no results found’ message and instead automatically directed consumers to alternative products. It was held that the

argument that the public has a right to access technological developments with regard to Amazon's internal search engine '... does not go so far as to allow a trader such as Amazon to ride roughshod over intellectual property rights ...'⁶⁸

Still, Blythe concludes that '... internet advertising using keywords which are identical to trade marks is not an inherently objectionable practice'. A legitimate reason for it could be offering users alternatives to goods and services of trade mark proprietors, as 'it is not the purpose of trade marks to protect their proprietors from fair competition'.⁶⁹

In *L'Oréal v eBay International*,⁷⁰ a Grand Chamber of the CJEU was called upon to answer questions regarding the sale of goods bearing trade marks or Community trade marks within the EEA or EU that had not been put on market in the EU. They held that '[i]t is the task of the national courts to assess ... whether relevant factors exist ... that an offer for sale or an advertisement displayed on an online marketplace accessible from the territory covered by the trade mark is targeted at consumers in that territory'. When this is true, the trade mark proprietor may prevent the sale or offering for sale or advertising of the relevant goods.

They also had to answer a question on the use of keywords that are identical to trademarks and have been included in an internet search by an online market place operator, holding that the trade mark proprietor can prevent the inclusion of goods from appearing in these services. This can occur 'where the advertising does not enable reasonably well informed and observant internet users ... to ascertain whether the goods ... originate from the proprietor of the trade mark', which is a concept also discussed in *Cosmetic Warriors*.

It is submitted that the existing law takes into account many factors when it comes to modern consumer habits such as online shopping, trying to strike a delicate balance between competition, the rights of consumers and the rights of trade mark holders. Ultimately, the law will always play catch-up as new technological advancements progress. The law is in many ways reactive to the developing needs of society, as shown in *Google France* with adwords, *L'Oréal* with international auctions and *Cosmetic Warriors* with Amazon's advanced search functionality.

Following the concepts laid out in *Cosmetic Warriors*, it is clear that the courts are trying to strike a balance between the rights of intellectual property holders such as those with trade marks and the rights of competitors to offer fair competition online, despite interfering with the essential functions of trade marks.

Conclusion

While certain limitations persist, the broad range of unconventional trade marks capable of registration provides ample opportunities to exploit the wide functions that trade marks fulfil. The general body of case law suggests that the courts are willing to allow a wide variety of marks to be registered that would not otherwise be considered conventional.

An idea of where this will lead to in the future can be seen in the suggestion that a store layout may be capable of trade mark registration, as per the CJEU in the above discussed case of *Apple v Deutsches Patent- und Markenamt*. Perhaps such

concepts could lay the foundation for moving or animated trade marks, or trade marks for the texture of a material. These concepts are arguably capable of being represented graphically without subjective elements.

It is unlikely that any concept as subjective as tastes or scents would be capable of registration in the future after *Sieckmann* ruled out the possibility of using a chemical formula. Even a perfectly accurate chemical formula would not adequately describe the scent or taste of the mark in question.

While the scope of what is or is not capable of being registered as a trade mark may change, the fundamental functions that underpin the entire purpose of such trade marks have remained steadfast for a century and look set to continue into the future under the vigilant eyes of the courts. This is in contrast to the internet, where the courts are constantly playing catch-up. They are called upon to consider the interests of trade mark holders and to weigh them against the rapid evolution of mainstream technology that is providing new opportunities to businesses and consumers.

As per EU aims, trade mark registration is designed to support a system of genuine competition within the EC. As a result, the CJEU has a delicate balancing act between preserving the rights of trade mark holders, not stifling competition between trade mark holders and protecting the interests of consumers. It is clear that there is no easy solution to this problem, as evidenced by the courts applying flexible and practical solutions even where they erode the functions of trade marks.

The courts will no doubt remain reactive in the field of technology, as novel ways to subvert the functions of a trade mark are developed and then challenged. They will continue to be called upon to weigh protecting the functions of trade marks against promoting genuine competition while safeguarding the interests of consumers.

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3. *Cosmetic Warriors Ltd v Amazon.co.uk Ltd* [2014] EWHC 181 (Ch)
4. *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1439
5. *John Lewis of Hungerford Ltd's Trade Mark Application* [2001] RPC 28
6. *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159
7. *McDowell v Standard Oil Company (New Jersey)* [1927] AC 632
8. *Société des Produits Nestlé SA v Cadbury UK Ltd* [2013] EWCA Civ 1174
9. *Tesco Stores Ltd's Trade Mark Applications* [2005] RPC 17
10. *Tesco Stores Ltd v Elogicom* [2006] EWHC 403 (Ch)
11. *Total Ltd v YouView TV Ltd* [2014] EWHC 1963 (Ch)

UK Legislation

1. Trade Marks Act 1905 as enacted
2. Trade Marks Act 1938 as enacted
3. Trade Marks Act 1994

UK Trade Marks

1. UK trade mark registration no.2000234
2. UK trade mark registration no.2000548
3. UK trade mark registration no.2001416
4. UK trade mark registration no.2048660

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- ¹ David Bainbridge, *Intellectual Property* (9th edn, Pearson 2012) 689.
- ² Trade Marks Act 1938, s 68(1) as enacted.
- ³ Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25, art 2.
- ⁴ Trade Marks Act 1994, s 1(1).
- ⁵ Frank Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harv L Rev 813, 813–814.
- ⁶ Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25, recital 11.
- ⁷ *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1439.
- ⁸ *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1439, para 29.
- ⁹ *Total Ltd v YouView TV Ltd* [2014] EWHC 1963 (Ch).
- ¹⁰ Case C-65/12 *Leidseplein Beheer BV v Red Bull GmbH* [2014] Bus LR 280.
- ¹¹ Case C-65/12 *Leidseplein Beheer BV v Red Bull GmbH* [2014] Bus LR 280, para 30.
- ¹² *McDowell v Standard Oil Company (New Jersey)* [1927] AC 632.
- ¹³ *McDowell v Standard Oil Company (New Jersey)* [1927] AC 632, 637.
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- ¹⁵ Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25, recital 11.
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- ¹⁹ Frank Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harv L Rev 813, 818.
- ²⁰ Case C-65/12 *Leidseplein Beheer BV v Red Bull GmbH* [2014] Bus LR 280, para 30.
- ²¹ Case C-661/11 *Martin Y Paz Diffusion SA v Depuydt* [2014] Bus LR 329, para 58.
- ²² See also C-487/07 *L'Oréal SA v Bellure NV* [2010] Bus LR 303, para 51; Case C-232/09 *Interflora Inc v Marks & Spencer plc* [2012] Bus LR 1440, para 38.
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- ²⁴ Russell Lewin, 'The new UK trade marks law – a godsend for trade mark owners or a goldmine for their lawyers?' [1994] 16(3) EIPR 91.
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- ²⁶ *Société des Produits Nestlé SA v Cadbury UK Ltd* [2013] EWCA Civ 1174.
- ²⁷ *Société des Produits Nestlé SA v Cadbury UK Ltd* [2013] EWCA Civ 1174, para 13.
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