Trademark Laws and Regulations

Answer 3

a) Issue

The issue that has been taken into consideration in this case is related to Ariel who is a chocolate manufacturer and is looking to trade mark the shape of its chocolate bars in the UK. The analysis therefore needs to be directed towards whether Ariel can achieve success through the application of this particular design. Trademarks can be considered as the badges related to origin of a product as they provide them unique identity from the goods and the services that are offered by other traders. There are different examples of trademarks that can be used by the manufacturers such as those that are related to words, slogans, logos along with shapes, colour and sounds[1]

b) Rule

The analysis that has been provided related to trademark in the issue can be linked with the trade mark act 1994 which is applicable in the UK as well as within the countries that exist in the EU region. There are different provision that have been provided within the trade mark 1994 which provides a substantial groud for the acceptance and rejection of a particular trade mark. The provisions regarding the acceptance of a trade mark include differentiaing the good or service belonging to one undertakig from those that are provided through some other undertakings. In addition to that, the rule say that the trademarks are acceptable in situations where they are being represenetd in a way which would provide opportunity to the relevent authorities as well as the public to take decisions about the clear and precise protection that is being provided to the proprietor . Further analysis regarding the things that can be considered as part of a trademark include designs, letters, numbers, colours, sounds as well as packaging of a particular good [2]

[1] Stobbs, J., Zhou, Y. and Weaver, J. (2020). Overview of United Kingdom Trade Mark and Designs Cases 2019. *IIC-International Review of Intellectual Property and Competition Law*, 1-12.

[2] Johnson, P. (2018). "So Precisely What Will You Use Your Trade Mark for?" Bad Faith and Clarity in Trade Mark Specifications. *IIC-International Review of Intellectual Property and Competition Law*, *49*(8), 940-970.

c) Application

Considering the provisions that have been demonstrated through trade mark act 1994 and by applying them on the case of Ariel, it can be safely stated that the organization would be successful in terms of registering its trademark as it fits in the definition and the specifications that are needed for the owners of a trademark. This is because of the fact that Ariel through its advertisement has provided information about the shapes and sizes of its chocolate bar which is not in any way contrary to the legal provisions that are needed to be taken into consideration by the owner of a particular trademark.

The findings and the overall process of application that has been undertaken can be further discussed in the light of the case of Gap (ITM) v Gap 360 Limited. The case depicts that Gap 360 had applied for registration regarding its trademark of “Gap 360”. The process of registration was undertaken in a formal manner through making application to the registrar. The application regarding the opposition of this registration was filed on the grounds of confusion. The court of law gave the verdict against GAP 360 in this case on the grounds of lack of the involvement of distinct and unique features resultin in not being able to provide clear understanding to the consumers regarding the use and the application of the term Gap. Although there may be some of the avergae customers that may be able to recognize Gap 360 because of their prior engagement; yet, the court believed that majority of the average customers would not be in a position to make a significant degree of differentiaton and uniqueness in this regard[3].

d) Conclusion

The conclusion that can be provided regarding this case of Ariel is that it is expected to successfully apply for the registration of its newly introduced trademark under the trademark act of 1994.

Part B

Issue

[3] Ibid 1

The issue illustrated within this case is concerned with Caliban manufactures that is involved in the sale of clothes along with alcohol under the brand name of “Wellness”. Further analysis of the case demonstrates that Calliban employs its mark to offer alcohol free drinks that are handed out as a gift in the bottles that are marked as wellness drink. Caliban has not been able to use its brand appropriately in the name of Wellness result in an outsider by the name of Prospero filing a suit against Caliban to drop or cancel the mark Wellness because of lack of proper utilization.

Rule

The rule that can be considered as applicable in the case of Caliban is related to trade mark act 1994 regarding the issues of infringements and highlighting the extent to which Prospero has the right to make request regarding the cancellation of the mark by the name of wellness which has not been used for drinks that are sold separately. Further analysis in this respect illustrated that a third party has the right to call for revocation of a mark in different situations such as the situation where the mark has not been used for five years or the use of a registered on a certain degree of products and services. In addition to that, the use of a trademark in a misleading manner along with its registration is also some of the factors that can lead towards cancellation of a trade mark.[4]

Application

The application of the provisions illustrated through trademark act 1994 suggests that Prospero is well within its right to ask for cancellation of the wellness mark of Caliban on the grounds of non-use for the drinks that are sold separately and not for any other product that is being offered by the organization. Therefore, Caliban should be asked of withdrawal of its right of trademark by the name of Wellness as far as the sale of this drink is concerned that are sold separately. The case of *Altecnic Limited Trade Mark Application (2001)*, can be provided in relation to this issue where the court of appeal gave the decision that the trademarks is considered revoked in the case of not being used for a period of five years. The analysis in the case therefore highlights the need for the organizations to use their trademarks as lack of utilization can lead towards their cancellation.

[4] Mondaq (2013) The basics of Trade mark law [Online] Available at https://www.mondaq.com/uk/trademark/648042/the-basics-of-trade-mark-law [Assessed on 6th May, 2020]

Similar findings can also be extracted from the case of L'Oréal SA v. Bellure NV (the L'Oréal case), where revocation was offered as a result of lack of use of the trademark of a specific nature resulting in the organization being forced to give up the right of trademark in favour of the appealing party [5]

Conclusion

To conclude, it can be stated that Caliban can use its trademark by the name of Wellness for its products such as clothing and the alcohol-free drink that is being provided as a gift but not for the drinks that are sold separately. Therefore, in this case it would be important for Caliban to apply once again for the trademark for Wellness to be used for its drinks that are sold separately and therefore should ensure that it used this trademark on consistent basis in the future. In addition to that, the analysis of the case has also highlighted the need for the organizations to have the required degree of awareness in terms of the ways through which they are needed to utilize their trademarks for the purpose of marketing their products and services.

[5] Pak, I. (2012). The expansion of trademark rights in europe. *IP Theory*, *3*, xiii.

Answer 4

Issue

The two parties that are involved in this particular case are Softel Limited and Softbit. The overview of the case demonstrates that Softel limited owns four registered EU trademarks and one registered trademark for the UK either for exact word of Softel or for its figurative depictions. The trademarks in this respect are obtained for a variety of goods and services particularly for the purpose of television broadcasting along with providing broadcasting and software services. On the other hand, Softbit is a start-up and while purchasing trademarks they were of the opinion that they could not any marks by the name of Softel. However, Softel filed a case against Softbit for the infringement of property of trademarks and in counterclaim, Softbit adopted the opinion that the declarations of trademarks that are registered are not clearly defined and therefore they lack clarity and precision.

Rule

Considering the specifications of the case that have been provided, the rule that is applicable is related to the recognition of trademarks and the things that come under this domain. The rule in relation to this issue illustrate that trademarks can be recognized if they can be visibly and precisely represented within the register of trademarks so as to determine the things that are protected along with substantially differentiating the products and the services of one person from those that are on offer by the other individual. The other aspect that is required to be taken into consideration in relation to this issue is concerned with the need for the business that are involved in registering their trademark that they should have some kind of separate identity. The benefit of having this identity is that it will prohibit other businesses from using that particular trademark for similar products. However, this does not stop other businesses from selling the same or similar products provided the fact that different trademarks are being used or using similar trademarks for the sale of entirely different products and services[6]

[6] Mercer, J. (2010). A mark of distinction: Branding and trade mark law in the UK from the 1860s. *Business History*, *52*(1), 17-42.

Application

The case between Sky and Skykick can be used as a reference to provide further analysis regarding the issue of recognition of trademarks. The details of the case reveal that Sky sued Skykick for being allegedly involved in conducting infringement of EU trademarks which consists of the work Sky with the help of the sign Skykick and its different variants. Skykick defended its position by denying these claims of infringement that were made by Sky and instead made a counterclaim that the trademarks of Sky are registered in an invalid manner because of the fact that specifications of goods and services lack of clarity and precision along with the fact that the applications related to trademarks were as a result made in bad faith. After analyzing the position of both parties in the case and the claims that were made by them, the court of law gave its decision in the favour of Skykick mainly because there was lack of clarity regarding the trademark of Sky which provided the opportunity to Skykick to adopt the trademark of Sky. Therefore, Sky in this case has no right to sue Skykick for the infringement of property rights and therefore the case has no legal ground to succeed. The court further ordered that Sky should in the future obtain clarity and precision regarding its trademarks to avoid the occurrence of any such confusion in the future. [7]

The situation regarding clarity can also explained through the case of C-577/14 related to brand concern of Lambretta in a slightly different way. The decision that was given in this case demonstrated that an element of the ruling in the case of IP Translator was not applicable to the issues of trademarks that were already registered. Rather than that, there were primarily applicable to the pending trademark applications. In the other case of C-501/15 Cactus, the decision was given that the rules in Prakktiker Bau and IP Translator can only be associated with applications and not registered with trademarks. These are the two sides through which the case regarding lack of clarity needs to be observed for the purpose of making applications in the future. Nevertheless, it is important to note that the requirements of trademark clarity can only apply to applications and the other major factor in this issue is to consider that rules also apply in the case of applications that

---

[7] Lexology (2020) Details of Cases [Online] Available at https://www.lexology.com/library/detail.aspx?g=fb64116f-6414-46d2-9a39-affd316c82d0 [Assessed on 6th May 2020]

are pending or are filed after the date of judgments. Therefore, it is important to expedite the speed at which decisions are being made.[8]

Conclusion

On the basis of the analysis that has been conducted in the light of the relevant legislations as well as in accordance with the specifications that were made in the case of Skykick and Sky, it can be concluded that Softel Limited also has no right to register a proper legal case against Softbit because of the fact that Softel does not possess a clear and precise trademark which can be recognized from the registrar of trademark. This situation therefore resulted in Softbit using the trademark of Softel because upon searching for trademark it did not find anything related to the trademarks of Softel. Therefore, it would be fair to say that Softel does not stand any chance of achieving success in this case of infringement and therefore should withdraw its case along with obtaining clarity regarding its trademark issues. On the other hand, the major defence that was available with Softbit was related to the fact that Softel does not have a clarified trademark presence due to which it does not sue Softel regarding any kind of infringement.

The major issues that can be learned through the analysis of this case is that organizations while obtaining trademark should have a policy of obtaining clarity and preciseness in order to avoid any confusion in the future. The clarity would therefore be helpful for them in terms of eradicating the possibilities of any infringements in the future along with getting indulged into the issues of copyrights. Nevertheless, it is important that organizations should have detailed knowledge and understanding regarding these issues as well so that they will be able to make the required arrangements with respect to obtaining trademarks in the manner that can be considered as desired.

[8] Johnson, P. (2018). "So Precisely What Will You Use Your Trade Mark for?" Bad Faith and Clarity in Trade Mark Specifications. *IIC-International Review of Intellectual Property and Competition Law, 49*(8), 940-970.

Answer 5

Issue

The case begins with the scenario where Trilo which is a pharmaceutical company purchases the rights within the branded products from different pharmaceutical companies and promote the generic products under its own brand name Trilo. Therefore, Trilo was the proprietor of the UK and EU trade marks for the word Trilo. On the other hand, there was another entity by the name of Zeus who was making ingredient phenytoin sodium and was selling it under the name of Donbain. In the year 2016, both parties reached an agreement where Zeus was to obtain market authorization for phenytoin sodium capsules with the objective of manufacturing a generic drug in the UK under the brand name of Trilo. However, in other parts of the UK; Zeus would continue to sell this drug under its brand name of Donbain. The situation went on like that until Lennox Limited who was involved in trading in parallel pharmaceutical products found out that Donalbain was being offered in the market by Zeus within the territory of Ireland at a very low rate as compared to the price at which it is being sold in the UK. Consequently, Lennox began to import and sell the drug within different parts of the UK be rebranding the product Phenytoin Sodium Donbain. Consequently, Trilo intends to initiate trade mark infringement proceedings against Lennox; whereas, Lennox responded by making a claim that the actions of Trilo trade mark rights are in contrast to trade mark and competition law. Therefore, it would be fair to say that the issue that has been highlighted has three main parties that are involved in its namely Trilo, Donbain and Lennox.

Rules

The trade mark law in the UK provides protection in terms of the utilization of trade marks in the UK. A trade mark refers to way for one entity to differentiate them from the other. In the field of business, a trade mark offers a product or organization with the kind of identity that is not possible for the competitors to imitate. Further analysis of the rule that has been developed in this regard suggest that registration of a trade mark provides owner exclusive rights for preventing other owners from using that particular mark or a similar mark without obtaining any prior consent. Consequently in this situation, owner of the trademark has the right to initiate legal proceedings against the traders or the organizations that are involved in infringement of the copyrights. The purpose of application of this type of rules and regulations is to ensure that the organizations can compete effectively and freely in the market.[9] Taking into consideration these rules and regulations, it would be fair to say that the issue of infringement is a complex one for the regulators to deal with as in some cases it becomes extremely difficult to judge and analyze the kind and the areas of infringements that have been made.

Application

There are different cases that can be applied in the situation that has been discussed in this particular question regarding infringement of trademarks by the companies. One of the cases that took place was between Bentley Limited v Bentley Motors in 1962. The judgments in the case were related to issuing warning to the owners of a brand that are looking to expand the scope of their branding activities into a new marketplace in relation to avoiding the issue of infringement in the case of promotion of a brand under a new name or under a relatively similar name. The other case which can be discussed with regards to the issue of infringement claims took place between Beauty Bay limited and Benefit Cosmetics Limited. The findings of the case demonstrated that the significance of context in conducting assessments of confusions within the claims that are made related to infringements of trade mark issues. Furthermore, the case also highlights a situation where marks can be considered as similar but the possibility of confusion related to infringement is still something that needs to be looked at[10]. The importance of this judgment can be attributed to the fact that it has the potential to provide legal protection to the owners of the trademarks who can be exploited in the field of competition and in the name of competition law.

Conclusion

The analysis of the rules and the case study demonstrated that Trilo cannot commence trademark infringement proceedings against Lennox because the brand name of Donbain is the trademark of Lennox which has been exploited by Trilo within the UK and in the Ireland by means of

---

[9] Bently, L. A., Davis, J. and Ginsburg, J. C. (2008). *Trade Marks and Brands: an interdisciplinary critique.* Cambridge University Press.

[10] Ibid 1

undertaking secret arrangement with Zeus. Therefore, Lennox is well within its right to claim that Trilo has indeed taken steps that can be considered as in contradiction with the competition and trade mark laws. The decision in this regard has also been given because of the fact that Trilo through the arrangements that it made tried to modified and change the name of the brand and started to sell the product under its own name by the name of Trilo trademark. However, as the case suggests that prior arrangements were made between Trilo and Zeus which could have been one of the factors that can reduce the liability of Trilo of making unauthorized use of the trademark in accordance with copyright laws. The other interesting aspect that needs to be looked at is related to the confusions and the ambiguities that can arise in the case of trademark infringements. The purpose of these ambiguities can be mainly linked with the fact that the organizations can get involved in performing secret dealing and making secret agreements and arrangements that can cause significant degree of confusion within the legal status and position of their activities. Therefore, it is important to consider all the legal provisions in order to avoid the issue of copyrights in the future. Since there were multiple entities that were involved in this particular case; therefore, it was important to give the kind of judgment that would satisfy the rights and interests of all the relevant and concerned parties.

Answer 6

Issue

The issue that has been discussed in this particular question is related to difficulty of attempting to register a three-dimensional shape mark as a trade mark in particular providing acquired distinctiveness of the type of shape mark when it has been utilized with another trademark that has been registered. The analysis therefore will be made in the light of the EU and the UK laws for the purpose of highlighting different issues and challenges that can arise in this regard along with the measures that are needed to be taken into consideration by the stakeholders in terms of reducing the intensity of these issues.

Rule

One of the rules related to distinctiveness of trademarks are concerned with the features of a registered design which provides identification with the products and services that are related to specific organizations [11]The findings with regards to the trademark laws that are applicable in the UK depicts that the trademark issues within the UK are generally governed through Trade Marks Act 1994 and they are linked with the trade mark laws that are applicable within the EU. The rule of law that is applicable in this particular case depicts that the presence of any sign that is capable of being represented in graphical terms of which can be considered as capable of differentiating goods or services of one undertaking to those of other undertakings. Further analysis in this regard illustrate that the trademark is expected to be deprived of registration in case it does not have any unique character and the fact that the mark has not been able to acquire the distinctiveness through utilization in the marketplace. [12]On the basis of this analysis, it would be fair to say the involvement of unique and distinctive characteristics is an important requirement for the registration of a three dimensional shape mark as a trademark in the UK and in other European countries as well.

[11] Helmers, C. and Rogers, M. (2010). Trademarks and performance in UK firms. In *Trademarks, brands, and competitiveness* (pp. 73-94). Routledge.

[12] Annand, R. E. (1996). Lookalikes under the New United Kingdom Trade Marks Act 1994. *Trademark Rep.*, *86*, 142.

The rule with specific reference to three dimensional shape mark that is applicable within the EU and the UK has been presented within the article 3 (1)/7 (1) has highlighted different elements which will not be considered for registration and even if considered will be liable to be declared invalid. The provisions that have been made in this respect include signs which cannot be considered as a trade mark, trademarks that do not have any unique character, signs which exclusively includes the shape which is based on the results obtained from the nature of the goods along with the shape of goods that are necessary for the purpose of obtaining technical result. In addition to that, the provisions made in this particular article include shape which provides substantial value to the goods[13]

The legislations about trademarks that are highlighted within the article of 3(1) (b)/ 7(1) (b) applicable within the UK and the EU depict that providing substantial evidence regarding the distinctiveness of three dimensional trademark can be a major challenge. Although the tests that are conducted for the purpose of identifying the validity of the traditional three dimensional are more or less; yet, there is a general acceptance that the perception of the public regarding trademarks that consistent of the appearance of a product is not similar for trademarks that are not related to the shape of that particular product. Further analysis in regarding three dimensional trademark and the issues related to its registration illustrate that in order to consider three dimensional trademark capable of being registered, it should be distinctive from the shapes that are generally been viewed by the consumers or it will not be considered as a trademark which will make it extremely difficult for the relevant concerns to prove it as a trademark unless there are some distinctive elements that are applied to it. Article 3(1)(e) (iii)/7(1) (e) (iii), provides significance of the signs that exclusively consist the shapes which provides substantial value to the goods. This particular legislation is primarily directed towards the aesthetic characteristics of a product and not something which can add value to a particular good or a product.

Application

[13] Legislations UK (2020) 1994 Trade mark laws [Online] Available at http://www.legislation.gov.uk/ukpga/1994/26/section/10 [Assessed on 6th May 2020]

The application of the legislations that have been presented above can be further provided through the application of the relevant case laws in order to develop substantial understanding. The case of Dyson Limited v Registrar of Trade Marks can be presented in relation to this issue. The analysis of the case demonstrates that Dyson applied for the registration of two trademarks. The trademark consisted of a transparent bin which was part of an external surface of certain a vacuum cleaner. The petition for obtaining trademark was filed by providing explanation regarding these specifications along with providing picture of a vacuum cleaner that is manufactured by Dyson. The court of law decided that the description provides cannot be considered as a sign and therefore it does not constitute as a trademark[14]

The case of Chocoladefabrilen Lindt & Sprungli AG v OHIM (2012), can be provided as an example in this case where the judgment that was given illustrated that the three dimensional trademark must be for a shape that is viewed as significantly different from those that can be considered part of the customs of the industry. The other factor which was highlighted in this decision was the fact that the uniqueness of the trademarks should be visible to the customers in order for them to be considered as capable of being registered. The judgment provided in this case further shed light on the challenges that can be faced within the UK and other EU countries regarding gaining acceptance and approval about three dimensional trademarks.

The other case that can be applied regarding the issue of trademark is concerned with the decision of the court that was given in the case of Bang & Olufsen v OHIM (2011). The court found that the aesthetic features of the shape were given emphasis during the time the product was being put up for sale resulting in making the shop a key aspect of selling. It was also admitted during the case that the shape was a key aspect of branding and results in increasing the appeal of the product under question. Considering these circumstances, the application of the owners of the trademark was refused[15]

Conclusion

[14] Dyson Ltd v. Registrar of Trade Marks, 2007 E.C.R. I. 687 (2007).

[15] Bang & Olufsen v. OHIM, 2011 E.C.R. I.I. 6975 (2011).

The analysis that has been performed in relation to the issue of three dimensional trademarks illustrates that there are significant issues that are faced by the manufacturers and organizations while obtaining registration in relation to this issue within the EU. While some of these issues can be dealt with through making sure that description of trademark is visibly appearing within the application; yet, if the trademark covers the shape of the products in relation to which registration is being claimed; then the possibility of reduction and eradication of the obstacles are on the lower side. The other factor that needs to be taken into consideration in this regard is the tendency of the owners of the trademarks and the ways in which they are able to develop understanding about various issues and circumstances that can influence the process of registration of their trademark. The fact that these laws are applicable throughout the EU and not only just in the UK further creates the need to develop substantial understanding regarding them in order to avoid the occurrence of issues related to registration of trademarks.

References

Annand, R. E. (1996). Lookalikes under the New United Kingdom Trade Marks Act 1994. *Trademark Rep.*, *86*, 142.

Bang & Olufsen v. OHIM, 2011 E.C.R. I.I. 6975 (2011).

Bently, L. A., Davis, J. and Ginsburg, J. C. (2008). *Trade Marks and Brands: an interdisciplinary critique*. Cambridge University Press.

Dyson Ltd v. Registrar of Trade Marks, 2007 E.C.R. I. 687 (2007).

Helmers, C. and Rogers, M. (2010). Trademarks and performance in UK firms. In *Trademarks, brands, and competitiveness* (pp. 73-94). Routledge.

Johnson, P. (2018). "So Precisely What Will You Use Your Trade Mark for?" Bad Faith and Clarity in Trade Mark Specifications. *IIC-International Review of Intellectual Property and Competition Law*, *49*(8), 940-970.

Johnson, P. (2018). "So Precisely What Will You Use Your Trade Mark for?" Bad Faith and Clarity in Trade Mark Specifications. *IIC-International Review of Intellectual Property and Competition Law*, *49*(8), 940-970.

Legislations UK (2020) 1994 Trade mark laws [Online] Available at http://www.legislation.gov.uk/ukpga/1994/26/section/10 [Assessed on 6th May 2020].

Lexology (2020) Details of Cases [Online] Available at https://www.lexology.com/library/detail.aspx?g=fb64116f-6414-46d2-9a39-affd316c82d0 [Assessed on 6th May 2020].

Mercer, J. (2010). A mark of distinction: Branding and trade mark law in the UK from the 1860s. *Business History*, *52*(1), 17-42.

Mondaq (2013) The basics of Trade mark law [Online] Available at https://www.mondaq.com/uk/trademark/648042/the-basics-of-trade-mark-law [Assessed on 6th May, 2020].

Pak, I. (2012). The expansion of trademark rights in europe. *IP Theory, 3*, xiii.

Stobbs, J., Zhou, Y. and Weaver, J. (2020). Overview of United Kingdom Trade Mark and Designs Cases 2019. *IIC-International Review of Intellectual Property and Competition Law*, 1-12.