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1. What do recent cases reveal about "context" in trade mark disputes?
2. How are judges reacting ?
3. How do you use context to turn the scale in your client's favour?



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1. What do recent cases reveal about "context" in trade mark disputes?



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“In neurophysiology, a distinction is generally made between mechanical and chemical senses. The first group consists of touch, sight and hearing, which are all easily comprehensible because **they relate to the concept of shape and form (*gestalthaft*) and can be described relatively objectively...**”



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“However, care must be exercised when speaking of the subjectivity and objectivity of the senses. There are no objective or subjective sensory organs. In the work cited above, Goethe asserted that the sense of sight and the perception of colours were **clouded by relativism.**”



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“On the other hand, we know that the description of a work of music is not always the same, depending on the listener and his sensitivities. After all, the person receiving a message is an individual with his own experience and unique capacity for perception. **In other words, sensory perception can only be described as more or less perfect, and consequently the recipient's description of what he perceives will only be accurate to a greater or lesser degree.”**



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“It would be difficult at this level to attempt any general characterisation of the senses in order to confirm that sight is the most developed. The ability of the human eye to perceive colours is just as limited as the ability of the sense of smell to perceive odours. Moreover, a description of a colour can be just as inaccurate and difficult as that of an odour.”



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“Where does the difference lie, then? **Whereas the eye sees not just colours, but also shapes,** the sense of smell only permits perception of the colour of an odour and never its outline. The sense of sight operates over a wider range and therefore has a wider range of perception.”

OPINION OF ADVOCATE GENERAL RUIZ-JARABO COLOME, Case C-273/00, Ralf Sieckmann



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"In *Origins Natural Resources Inc v Origin Clothing Ltd* case ([1995] FSR 280 at page 284) (which was under section 10(2) because the marks were slightly different) I said that section 10:

"requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to goods for which it is registered and then to assess a likelihood of confusion in relation to the way the defendant uses its mark, **discounting added matter or circumstances.**"

British Sugar PLC v. James Robertson & Sons Ltd., 1996 R.P.C. 281 (Chancery Division) (U.K.) per Jacob J.



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This is essentially the same rule as under the old law. Thus Sir Wilfred Greene MR in *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth Ltd* ((1941) 58 RPC 147 at page 161. The House of Lords agreed with this:

"the statutory protection is absolute in the sense that once a mark is shown to offend, **the user of it cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor.**"

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“I think the rule is the same under the 1994 Act because it follows from the language of section 10 which merely requires the court to look to see what sign the defendant is using and says nothing about anything else. **Strictly in Origins I should have said under the 1994 Act that the comparison is "mark for sign" rather than "mark for mark" because section 10 uses sign for what the defendant is using.**”

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O2 carries on business as suppliers of mobile telephone services using bubble images in the context of mobile phones, so consumers associate images of bubbles in water (particularly against a graduated blue background) with O2 and O2 (UK).

During 2004, H3G launched an advertising campaign, a television advertisement in which it compared the price of its services with those of O2 using the name 'O2' and moving black-and-white bubble imagery, followed by 'Threepay' and '3' imagery, together with a message that H3G's services were cheaper in a specific way.

Reference Question No 2: "Whether consideration should be limited exclusively to a comparison between the trade mark and the disputed sign and between the goods or services for which the mark is registered and those for which the sign is used, **or whether, on the other hand, it is appropriate to take account of the factual context in which the sign is used.**"

Not answered. O2 v Hutchinson C-533/06



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Reference Question No:3: Where a CTM is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours so that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under those provisions.

Answer: Yes.

Case C-252/12 Specsavers International Healthcare Ltd v Asda Stores Ltd





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Reference Question No: 4: “The fact that **the third party making use of a sign** which allegedly infringes the registered trade mark **is itself associated**, in the mind of a significant portion of the public, **with the colour or particular combination of colours** which it uses for the representation of that sign **is relevant** to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.”

Answer: Yes.

Case C-252/12 Specsavers International Healthcare Ltd v
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Moreover, **it is apparent from the case-law** of the Court that those assessments **must take account of the precise context** in which the sign which is allegedly similar to the registered trade mark was used (see, to that effect, concerning Article 5(1) of Directive 89/104, Case C-533/06 O2 Holdings and O2 (UK) [2008] ECR I-4231, paragraph 64).



Case C-252/12 Specsavers International Healthcare
Ltd v Asda Stores Ltd



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However, there is another type of context, returning to Seickman:

In neurophysiology, a distinction is generally made between mechanical and chemical senses. The first group consists of touch, sight and hearing, which are all easily comprehensible because they relate to the concept of shape and form (*gestalthaft*) and can be described relatively objectively... **shapes can change according to perspective...**

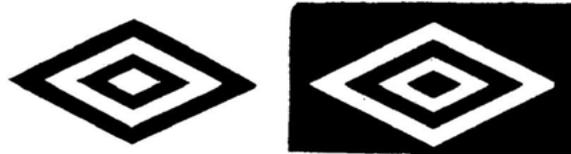
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Iconix Luxemboug Holdings SARL v Dream Paris Europe Inc (2) Top Glory
Trading Group Inc, [2023] EWHC 706 (Ch)





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DREAM PAIRS

“The claimant submitted that while many consumers will perceive the overall impression of the Marks as two concentric diamonds, wider than they are tall, a significant number of people with the characteristics of the average consumer will perceive the Marks as an isometric view of flat concentric squares. I do not agree. I consider that effectively all consumers would perceive the marks as flat, elongated, diamonds and not as tilted squares.

The Sign, considered as a two-dimensional graphic image, is a square shape with rounded corners, tilted through 45 degrees so that it sits on one of its corners. It has an outer element with a break in it. There is a line from the outer element to the inner, which has a closed loop. Together the line between the elements and the loop have the form of a “P”. I do not think that the average consumer would necessarily see a “D” in the outer shape; overall it is a broken square with a P-shape in the middle.

There is no aural or conceptual element to the Marks or the Sign. They are just shapes. While average consumers might think the P shape in the Sign had some point, I do not think that he or she would necessarily attribute a sound to it.”



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DREAM PAIRS

“In my judgment the judge did fall into error in these respects ... The average consumer encountering the Sign for the first time affixed to, say, a pair of football boots worn by someone else would not know what the Sign looked like when represented graphically. Nor would they even necessarily know, or find out, what the Sign looked like when viewed square-on. **They might well only see it looking down, and therefore at an angle. In those circumstances the appearance of the Sign would be foreshortened. Furthermore, the viewer might well not see the Sign side-on, but only from the front or rear. In all of these circumstances the Sign would appear more like a double diamond, and therefore more similar to 668, than in the graphic image. There is nothing artificial or unrealistic about this comparison. On the contrary, it is a realistic and representative scenario for assessing the post-sale impact of the use of the Sign upon the perception of the average consumer.**”

Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc (2) Top Glory Trading Group Inc [2024] EWCA Civ 29 per Arnold LJ



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The Ambassadors
by Holbein





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2. How are judges reacting?

Judges are willing to consider both: (i) added matter, (ii) circumstances and (iii) perspective.

Treat is no longer good law.



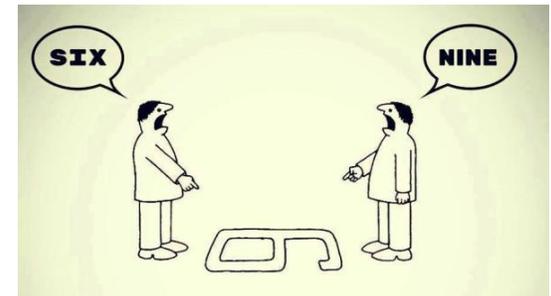
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1. If you are going to protect your mark use your house style and house colours.
2. If your client is going to use a 3rd-party mark use your house style and house colours.
3. As ever, consider the Holbein effect particularly in relation to clothing, the internet, apps.
4. Bear in mind the point-of-sale and post-sale context, the consumer, the friends of the consumer and even the friends of the friends of the consumer.





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‘Bare in mind’ is a misspelling of the phrasal verb **bear in mind**, which means ‘remember’ or ‘consider’. The verb ‘bear’ means ‘carry’; the idea is that you’re holding something in your mind. The verb ‘bare’ means ‘uncover’, which doesn’t make sense in this context.

People also confuse ‘bear’ and ‘bare’ in other contexts, such as in the phrase ‘bear with me’.