

WHAT SPECSAVERS TAUGHT BRAND OWNERS AND THE UKIPO

Specsavers is the largest chain of retail opticians in the UK. In its shops and promotional materials it makes much use of this trade mark:



("the Logo in Green")

So when Asda set about re-launching its own existing optician's business in October 2009 under this mark:

The Asda Logo



Specsavers predictably was not best pleased. Specsavers was equally unamused by two straplines which Asda used to promote its own in-store optician's business:

"Be a real spec saver at Asda" (the First Strap Line)

"Spec savings at Asda" (the Second Strap Line)

Specsavers, perhaps not unsurprisingly, sued Asda for trade mark infringement and passing off.

The passing off claims failed because the trial judge at first instance held that none of the marks used by Asda either alone or cumulatively effected the required misrepresentation – the use of the Asda mark was too prominent in the logos and in the strap lines to allow for any confusion.

The real interest was in the trade mark infringement case.

Specsavers had a number of community trade marks (a) in respect of the word mark SPECSAVERS and also (b) in respect of three device marks:

Shaded Logo



Unshaded Logo



Wordless Logo



It will be noted that Specsavers did not have a registration for the Logo in Green – their device in the colour green, which they actually use.

Three Ways in Which a Trade Mark Can Be Infringed

The table below illustrates the three main ways in which a trade mark, UK or Community, can be infringed:

Type of infringement	Sign used by defendant	Used by defendant in respect of	Comment
Article 9.1(a)/ section 10(1) Trade Marks Act 1994 (TMA 1994)	Identical to registered trade mark	Identical goods or services to those covered by the registration	No need for TM owner to show a likelihood of confusion.
Article 9.1(b)/ section 10(2) TMA 1994	Identical to registered trade mark	Goods or services similar to those covered by the registration	TM owner needs to show a likelihood of confusion, which is assessed globally taking numerous factors into consideration.
Article 9.1(b)/ section 10(2) TMA 1994	Similar to registered trade mark	Goods or services identical or similar to those covered by the registration	TM owner needs to show a likelihood of confusion, which is assessed globally taking numerous factors into consideration.
Article 9.1(c)/section 10(3) TMA 1994	Identical or similar to registered trade mark	Any goods or services: they do not need to be similar	TM owner needs to show that his mark has a reputation and that the use complained of, being without due cause, either takes unfair advantage of or is detrimental to the distinctive character or repute of the trade mark.

In this case the High Court found that the First Strap Line “Be a real spec saver at Asda” infringed Specsavers’s SPECSAVER word marks under Article 9.1(c). The Court of Appeal additionally found that Asda’s Second Strap Line “Spec savings at Asda” also infringed those word marks and the Shaded Logo and the Unshaded Logo, again under Article 9.1(c). Asda’s use of “Spec savings” was sufficiently close, visually, aurally and conceptually, to all those marks (each of which comprised or included the word SPECSAVERS) such that the average consumer would make the necessary link with Specsavers – as indeed the evidence established was Asda’s intention. Such use also took unfair advantage of those marks.

Logo Infringement

The more difficult issue for Specsavers concerned their device trade marks. Specsavers used the Logo in Green and not the Shaded Logo nor the Unshaded Logo as registered. The Asda Logo was also green. The question arose then as to whether or not the similarity of colours as between the Logo in Green and the Asda Logo mattered for the purposes of determining the question of infringement under Articles 9.1(b) & (c), given that Specsavers’ registrations for its logos were not in green but only in grey/black or unshaded.

The Court of Appeal referred that question to the Court of Justice of the European Union (CJEU), which sensibly determined that, notwithstanding that a trade mark is not registered in colour, if the proprietor of it has used it in a particular colour or combination of colours such that that colour or combination has become associated in the mind of a significant proportion of the public with that mark then the colour in which a third party uses his mark is relevant when determining the likelihood of confusion under Article 9.1(b) or the unfair advantage under 9.1(c).

The Non-Use Point

Asda also challenged the validity of Specsavers’s Wordless Logo on the basis that Specsavers had made no genuine use of it in the EU for a continuous period of five years, which is a ground for invalidating a registered community trade mark.

Specsavers’s answer to that point was to say that use of the shaded logo constituted use of the Wordless Logo. In other words, use of this logo:



amounted to use of this logo:-



Again the Court of Appeal referred this question to CJEU.

The CJEU ruled that use of the Shaded Logo, even with the word Specsavers (for which Specsavers had another trade mark registration) superimposed upon it could be considered to be a genuine use of the Wordless Logo to the extent that the differences between the mark (a) as registered (the Wordless Logo) and (b) as used did not change the distinctive character of the mark as registered. In other words for the use of the mark as used to count as use of the mark as registered, some significant elements of the mark as registered need to be present in the mark as used, which elements are capable, in all the circumstances, of denoting trade source or origin to the relevant class of consumers.

Impact on Oppositions: A Sword But Not a Shield

As the colour in which a mark, not registered in colour, is used is relevant to the question of infringement, it follows that it should also be relevant to opposition and cancellation proceedings based on so-called relative grounds – i.e. based on conflicts with earlier registered trade marks.

Following the Specsavers decision, the UK Intellectual Property Office (IPO) has recently issued a Tribunal Practice Notice (1/2014) dealing with this issue. The key points of that practice note are the following:

1. When considering an opposition or cancellation attack based on the ground specified in section 5(2) of the TMA 1994 (which is equivalent to Article 9.1(b) of the CTM Regulation set out above), the Registrar is required to consider the likelihood of confusion in all the circumstances in which the mark applied for might be used if it were registered. Thus, where the earlier mark is either registered in colour or evidence establishes that colour forms a part of the distinctive character of the earlier mark, then the potential or actual use of the later mark in colour will be considered to be a relevant factor, when assessing the likelihood of confusion¹.
2. Because the enquiry which the Registrar undertakes, when dealing with opposition or cancellation proceedings, based on the grounds specified in sections 5(2) of the TMA 1994, covers all normal and fair future potential uses of the attacked mark, evidence that the later mark has actually been used in colours different to those in which the earlier mark is registered or used is not a relevant factor when assessing the likelihood of confusion².
3. Similarly where the earlier mark has a reputation for the purposes of section 5(3) TMA 1994, (equivalent to Article 9.1(c) of the CTM Regulation set out above), the potential or actual use of the later (attacked) mark in colour will also be considered to be a relevant factor, when assessing whether the use of the later mark takes unfair advantage of the earlier mark³.

Thus the IPO's position appears to be that where the attacker's earlier rights (registered or as used) are in colour then the colours actually or potentially used by the owner of the later mark will be a relevant factor, when assessing the likelihood of confusion, save that if the actual colours used by the owner of the later mark are different to those in which the earlier mark is registered or used then that fact will be ignored.

In short, the IPO interprets the CJEU's decision as providing owners of existing marks with a sword but not owners of later marks with a shield. This probably goes too far and appears to be inconsistent with the CJEU's decision in Specsavers. The proper approach would surely have been to say that the actual use of the later mark in a different colour is a relevant factor when assessing the likelihood of confusion but that the IPO is also likely to be mindful, when considering the weight to be given to such evidence of use in a different colour, of the relative ease with which the owner of the later mark could change the colours in which it is used at some point in the future. Such an approach would allow the IPO to distinguish between cases where changing the colour in which the later mark is used would be relatively straight forward from those cases where changing the colour in which the trade mark is used would be altogether very much more difficult, expensive and impractical.

The IPO tribunal practice note does not explain what the IPO's position will be as to whether or not the potential or actual use of the later mark in colour will also be considered to be a relevant factor when assessing a claim that the use of a later mark is detrimental to the distinctive character or repute of the earlier mark under section 5(3) TMA. However that is not surprising as the CJEU did not deal with that issue in its judgement in Specsavers.

OHIM (the Community Trade Mark Office) has not yet published any guidance on this important issue.

¹ Tribunal Notice, paragraph 6,

² Tribunal Notice, paragraph 8,

³ Tribunal Notice, paragraph 7,

Implications for Brand Owners

Where a trade mark is commercially significant and comprises both a logo/device element and a word element then best practice has long been to register (a) the word element alone as a word trade mark, (b) the logo/device element alone without the word and (c) the composite logo/device + word mark.

The thinking behind this strategy is this:

1. The composite logo/device + word mark, as the mark which is actually used in practice, should be immune to any successful challenge to validity based on non-use. Such a composite mark also gives the owner plenty of options in an infringement action to argue about which elements are distinctive and have been used by an infringer.
2. Registration of the standalone word mark is advisable where, for example, it is or is likely to become the de facto name for the product (such as Marmite, Domestos and Bovril) or the well-known name of the trade source/supplier of a product or service (Dyson, Hoover, Mercedes). Registrations for word marks alone will often provide the most effective first line of attack when all that has been used by an infringer is the word mark alone or something clearly suggestive of it such as "Be a real spec saver at Asda". Pure word marks can also be particularly helpful in relation to the various forms of infringement that can occur on the Internet, such as in relation to domain names and Google adwords.
3. The registration of the logo/device element alone is intended to protect the owner of the composite mark from third parties, who only use his logo/the get up bit of the composite mark (or elements of it) but don't also use the word mark element. Such marks come into their own, for example, in relation to supermarket own branded me-too products, whose get up is often devised so as to be suggestive of that of the market leading product.

The concern with such logo/device element alone marks has always been that they are likely to be subjected to just the kind of revocation for non-use challenge that faced the Wordless Logo, as such marks are never used by themselves. *Specsavers v Asda* is thus an important decision for brand owners as it makes it clear that registrations of such logo/device only marks can be defended by the use of composite marks which include the distinctive elements of such logo/device only marks.

The decision also makes it clear that if a mark is registered in black and white but actually used by the trade mark owner in various colours such that those colours have become associated with the mark in the minds of the relevant public that the colour(s) in which a suspected infringer uses his sign will also be relevant in determining infringement under Articles 9.1(b) & (c) or sections 10(2) and 10(3) of the TMA 1994.

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