

Battle of the Bubbles in Europe – Legitimate fair use or not

British mobile phone network Hutchison 3G was cleared of trademark infringement and unfair comparative advertisement claims by rival operator 'O2' in the UK High Court on March 23, 2006. The case was one of the first to consider how trade mark laws should interact with a more recent European directive on comparative advertising. The Hutchinson advertising campaign explicitly compared the price of the parties' mobile phone services, making use of the bubble imagery which O2 trademarked and had used in high profile marketing campaigns over the previous five years. Hutchinson's use of the bubbles "to identify O2 and compare the parties prices" was held to be "legitimate, fair and not misleading to consumers". The Hutchinson 3G advertisement therefore did not infringe O2's rights under the Trade Marks Directive 97/55/EC or the British Trade Marks Act of 1994. "Taking the advertisements as a whole", the court found no confusion was created between the parties' trademark and service. Though the O2 bubbles were held to have obtained inherent and acquired distinctiveness as trademarks, O2 failed to persuade the court this gave them a monopoly over the use of bubbles as a source identifier. Allegations that 3G misused the bubbles to attract consumers and thereby damaging O2 were dismissed.

Seeing Red... US PTO Refuse to Register Scandalous Matter as Trademark

In re Red Bull GmbH (Serial Number 75788830), the United States Trademark Trial and Appeal Board ruled that in holding matter to be immoral or scandalous within the meaning of Section 2(a), the burden is on the examiner to demonstrate that the applicant's mark is "shocking to the sense of truth, decency or propriety" of contemporary attitudes in "the context of the marketplace as applied to the identified goods..". It is sufficient if a substantial composite of the general public consider the mark to comprise scandalous matter, although a majority is not required. In this instance, applicant sought to register BULLS__T for a variety of alcoholic and non-alcoholic beverages and hospitality services. The examining attorney refused the application relying on the prior 1981 decision *In re Tinseltown, Inc 212 USPQ 863*, wherein the identical mark was refused for handbags and on six definitions taken from on-line dictionaries, of which the Board took judicial notice because the sources were clearly identified and were readily verifiable and reliable. Applicant's rebuttal evidence illustrating contemporary use of the term in popular culture was insufficient to overcome examining attorney's prima facie showing that the mark was immoral or scandalous.

Why the UK believes slogans may not function as trademarks

A recent Practice Amendment issued by the United Kingdom Trade Marks Office (*PAN 1/06 – Issued January 2006*) attempts to un-muddy the water concerning the registration of slogans as marks in the UK. Basically, the Notice maintains that while no stricter standard is to be applied to slogans than to other marks, slogans "are by their nature, adapted for use in advertising and examination should take full account of notional and fair use in that context." The underlying principle is to question whether slogans truly have the capacity to individualize the goods or services of an undertaking or whether their primary function is to serve as a promotional statement. Accordingly, examination of slogans should fall alongside other non-conventional marks that the public is slow to recognize as source identifiers. Thus, unless the slogan mark is obviously fanciful, impenetrable or unusual, resistance to registration should be anticipated.

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