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Trademark Law and Consumer Perception Are We Protecting Consumers or Traders?



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Contents

- Dutch Case: Babyclub
- Legal framework
- Guidelines of the CJEU
- Analysis
- Conclusion

Identical signs



Identical signs



Utrecht District Court, July 8, 2004, (Babyclub)

- C&A:
 - C&A store has registered BABY CLUB as a Benelux trademark for baby clothes
 - Besides the word mark BABY CLUB, several figurative marks with the words BABY CLUB have been registered
- Kruidvat:
 - Kruidvat chain uses the sign KRUIDVAT BABY CLUB for baby clothes.

Utrecht District Court, July 8, 2004, (Babyclub)

- Wordmark BABYCLUB is not descriptive
 - The Dutch word ‘club’ refers to a golf club or a closed company.
 - ‘Babyclub’ refers to a group of parents doing activities with baby’s.
 - ‘Babyclub’ does not refer to baby clothes
- Wordmark BABYCLUB has acquired distinctiveness through use in trade

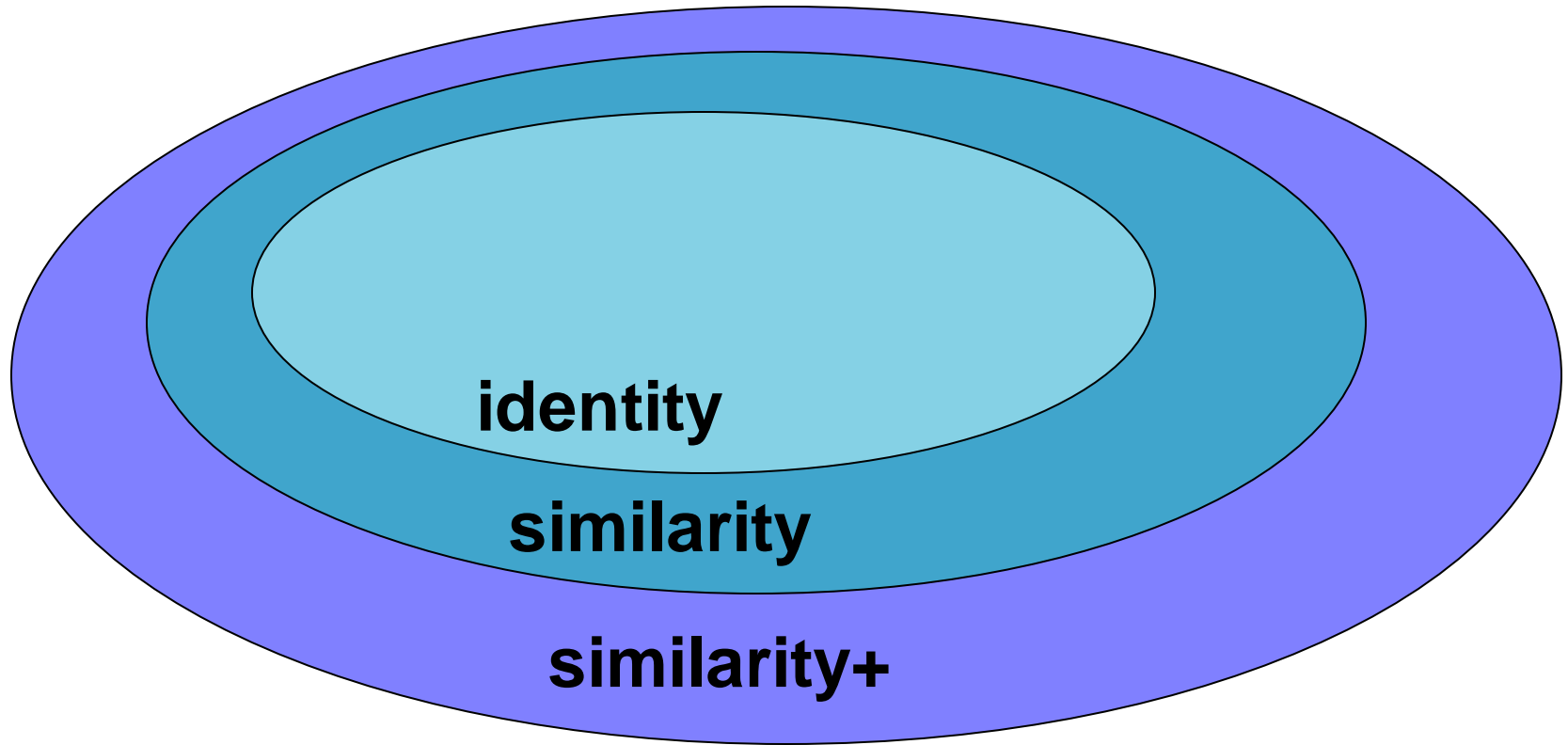
Utrecht District Court, July 8, 2004, (Babyclub)

- Infringement
 - Identical signs for identical goods
 - No clues in trademark law for assuming that the addition of another sign or mark cancels the infringing character of the use of a trademark
 - Public will interpret the sign KRUIDVAT BABYCLUB as a trademark combined with the tradename of a company where the trademark is offered
 - No different trademark is created

Rights of the trademark owner



Areas of protection



...of conflicting signs?

...of goods or services involved?

Art. 16(1) TRIPS Agreement

‘...the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.’

Art. 5(1) Trademark Directive

- ‘...shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where: (a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered.’

Identity

identical signs

identical goods
or services

likelihood of confusion as to the
origin of the goods or services can
be presumed (art. 16(1) TRIPS)

“Lacoste” for shirts
“Swatch” for watches
“Toyota” for cars

CJEU's guidelines



CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- LTJ Diffusion
 - 's business is the design, manufacture, marketing and distribution of clothing and footwear, in particular adults' and children's nightwear, underwear, shoes and slippers.
 - has registered ARTHUR as a trademark for textile articles

A handwritten signature in black ink that reads "Arthur". The signature is written in a cursive style with a prominent dot above the letter 'A'.

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- Sadas
 - is a company operating a mail-order business, which distributes a catalogue entitled 'Vertbaudet'. It markets inter alia children's clothing and accessories.
 - has registered the trademark
ARTHUR ET FELICIE for textile articles



CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- ‘On the substance of the case, it is settled case-law that the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.’ (para. 44)
- Essential function of a trademark is protecting consumers against confusion

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- ‘The Community legislature confirmed that essential function of trade marks by providing, in Article 2 of the Directive, that signs which are capable of being represented graphically may constitute a trade mark only if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’ (para. 45)
- Distinctiveness requirement

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- ‘On the other hand, Article 5(1)(a) of the directive does not require evidence of such a likelihood in order to afford absolute protection in the case of identity of the sign and the trade mark and of the goods or services.’ (para. 49)
- Absolute protection
- Likelihood of confusion is presumed

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- ‘The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects.’ (para. 50)
- ‘There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.’ (para. 51)
- Identity is strictly interpreted
- The same in *all* respects

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- ‘However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind.
- Global assessment
- Average consumer as leading yardstick
- Imperfect picture kept in mind

CJEU, judgment of March 20, 2003, Case C-291/00, Arthur/Arthur et felicie

- Moreover, his level of attention is likely to vary according to the category of goods or services in question.’ (para. 52)
- ‘Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.’ (para. 53)
- Insignificant differences may go unnoticed

**Is trademark law
more normatively or
empirically
grounded?**



Analysis

- ‘The perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect.’
- The decision whether a sign is identical is in fact normative

Average consumer



Identical signs



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- ‘On the substance of the case, it is settled case-law that the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.’ (para. 44)
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Baby clothes of C&A



Conclusion



Conclusion

- Concept of identity is more normatively based
- How normative or empirical should EU trademark law be?
- Non-existing average consumer is schizophrenic
- Consumer perception depends on which interests should and do come first: consumer protection or a well-functioning market?
- Consumer is a mix of empirical and normative elements

Keyword advertising

The image shows a screenshot of a Google search results page in a Windows Internet Explorer browser. The search query is 'tempur', and the results are displayed in Dutch. The top navigation bar includes links for 'Internet', 'Afbeeldingen', 'Maps', 'Nieuws', 'Boeken', 'Vertaling', 'Gmail', and 'meer'. The search bar contains the text 'tempur' and a 'Zoeken' button. Below the search bar, it indicates 'Ongeveer 7.130.000 resultaten (0.06 seconden)'. The first result is an advertisement for 'MedicomfortMatras.nl' with the headline 'Toe aan een Nieuw Matras?' and the sub-headline 'Bestel Medicomfort Matras. Tot 40% Goedkoper dan de andere Topmerken!'. Other search results include 'Drukverlagend matras', 'Limpa meubelen in Lummen', and 'TEMPUR® Hoofdkussens, Bedden, Matrassen & Comfortproducten ...'. On the right side, there are additional advertisements for 'Topkwaliteit matras', 'Het ultieme slaapcomfort', and 'Sleepwise'.

Google zoeken - Windows Internet Explorer
http://www.google.be/#hl=nl&source=hp&biw=1114&bih=732&q=tempur&aqf&aqi=g10&aqi=&oeq=&gs_rfai=&fp=2407364c4bfefde9

Medicomfort, het bedrijf a... tempur - Google zoeken

Internet Afbeeldingen Maps Nieuws Boeken Vertaling Gmail meer

Webgeschiedenis | Zoekinstellingen | Aanmelden

google tempur Zoeken

Ongeveer 7.130.000 resultaten (0.06 seconden) Geavanceerd zoeken

Toe aan een Nieuw Matras?
MedicomfortMatras.nl Bestel Medicomfort Matras. Tot 40% Goedkoper dan de andere Topmerken!

Drukverlagend matras
www.Medi-Active.nl/Matrassen Wakker worden zonder rugpijn? Gratis 14 dagen Thuis Proefslapen

Limpa meubelen in Lummen
www.limpa.be Meubelen op jouw maat en budget waar de klant centraal staat!

TEMPUR® Hoofdkussens, Bedden, Matrassen & Comfortproducten ...
Op de TEMPUR Website vindt u o.a. meer informatie over onze producten, het unieke materiaal, onze winkels/dealers en natuurlijk over slapen!
www.tempur.be/ - In cache - Vergelijkbaar

Advertenties

Topkwaliteit matras
Drukverlagend dus ultieme nachtrust
Gratis 14 dagen Thuis Proefslapen
www.Energy-Plus.info/Matras

Het ultieme slaapcomfort
Ontdek nu ons gamma matrassen, hoofdkussens en boxsprings!
www.fitnife.eu

Sleepwise
Maak kennis met goed slapen.
Geen nek- en ruggelachten meer

Interflora Inc & Anor v Marks and Spencer Plc & Anor [2013] EWHC 1291 (Ch) (21 May 2013)

- ‘...I must be careful not to consider the issues in this case from my own perspective, namely that of an experienced and technically literate internet user who knows precisely how Google Adwords operates and is aware of the issues. The average reasonably well-informed and reasonably observant internet user is not particularly technically literate, does not know precisely how AdWords operates and is not aware of the issues.’ (para. 289)
- average internet user is not as intelligent as Justice Arnold

Interflora Inc & Anor v Marks and Spencer Plc & Anor [2013] EWHC 1291 (Ch) (21 May 2013

- ‘As stated above, I am not satisfied that this was generally known in May 2008. Nor am I satisfied that it is generally known now.’ (para. 295)
- Average internet user is not aware, on the basis of his or her general knowledge of the market, that M&S’s flower delivery service is not part of the Interflora network

The End.



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