

# MACFARLANES

## LOGOS AND NO-GOS



### ARE DEVICE MARKS MERE DEVICES?

#### If your word mark is not distinctive, don't dress it up.

Companies should not try to obtain un-registrable trade marks by hiding behind fig leaves of embellishment to the mark, and trade mark registries should be "astute to the consequences of" this practice. This is the recent guidance handed down by the High Court following proceedings brought by Starbucks (unconnected to the coffee company), PCCW Media and UK Broadband Limited (which together are part of a broadcasting, media and telecommunications group, PCCW) against companies within the Sky Broadcasting Group (together, Sky).

PCCW (which provides internet television and mobile services both outside and within the UK) applied to the English Courts for an injunction and a speedy trial to decide whether Sky's use of "NOW" in relation to the provision of television services (NOW TV) infringed PCCW's earlier figurative Community Trade Mark comprising the word "now" in lower-case letters with six fine lines arranged in a star or sun shape emanating from the central "o" (CTM). Sky had both already applied to OHIM to invalidate the CTM and had sought a stay of the UK proceedings, which had been rejected.

PCCW was unsuccessful on both counts of infringement and its claim for passing off failed. Arnold J held that PCCW's CTM was invalid because it consisted exclusively of signs or indications which may serve to designate characteristics of the goods or services, and the average consumer would understand "NOW" as a description of the characteristic of PCCW's television service. If the figurative elements of the registration mean that the mark did not consist exclusively of the unregistrable word NOW, the figurative elements did not add anything, and the CTM would be devoid of distinctive character.

Even if the CTM were valid, which Arnold J held it was not, Sky had not infringed it as it had not made use of the figurative elements of the CTM which would have contributed to the distinctive character of the mark. If the CTM did, however, have inherent distinctiveness, Sky's use would have been infringing for likelihood of confusion and it follows that any defence by Sky of use of indications concerning the characteristics of the goods or services would fail as its behaviour amounted to unfair competition.

Trade mark applicants may see an increased clamping down by registries on applications that dress-up word marks lacking distinctive character and/or only serving to describe the goods and/or services in question, by adding unnecessary embellishments and trying to register them as a device. Courts will also take a dim view of proprietors shouting "infringement" where they have no entitlement. NOW is therefore the time to review your trade mark portfolios to weed out unenforceable device marks, before jumping on the bandwagon of infringement proceedings against a third party's use of a sign, incurring wasted costs and time, where the trade mark should not have been registered in the first place.

For a copy of the judgment, see [Starbucks \(UK\) Ltd v British Sky Broadcasting Group Plc & Others \[2012\] EWHC 1842 \(Ch\)](#).

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This note is intended to provide general information about some recent and anticipated developments which may be of interest.

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