

Uk trademarks and intellectual property



**ASSIGN
BUSTER**

Part A

In the UK, trademarks are filed and protected on a first-come first-served basis. In this case, therefore, the Canadian All Reds have registered a trademark in the UK and this will take priority over the attempt by Preston Rugby Union Club (PRU). Therefore, when PRU go to register the name ' Lancashire All Reds', the Canadian All Reds could object to the registration. There are several grounds upon which they could object to the registration; these objections would have to be lodged at the Company Names Tribunal which is a department within the UK Intellectual Property Office. In order to make an objection, it will be necessary for the Canadian All Reds to show that the name is the same as their name and that they have built up a degree of goodwill or reputation with the name. The name does not have to be exactly the same; however, it does have to be so similar that it is likely to mislead individuals into believing that the two are linked.

One of the factors that have been established when objecting to a trademark registration is that ' a genuine, properly substantiated likelihood of confusion' exists. The case of Royal Berkshire Polo Club stated that, in order for an objection to be successful, it is absolutely essential that there is this element of confusion. In this case, the Royal Berkshire Polo Club attempted to register a trademark that was objected to by the Polo Ralph Lauren Company by virtue of section 5(2) of the Trade Marks Act 1994, stating that it believed the mark was similar to identical goods. This would be the same objection that the Canadian All Reds would bring, due to the fact that they are similar products and that confusion is likely . It was also argued by Ralph Lauren that they had built up a substantial amount of goodwill and as the

Canadian All Reds have been in operation for over a century and gained considerable success in this time, it is likely that this argument could also be used by the Canadian All Reds.

It was held, in this case, that it was necessary to consider what a reasonable consumer would think and whether confusion would be reasonably likely. Based on this, it will be necessary for the Canadian All Reds to argue that allowing the name ‘ Lancashire All Reds’ (particularly given their nickname ‘ All Reds’) would confuse consumers. As the Canadian All Reds’ trademark is registered in the UK and the Lancashire All Reds are also attempting to register in the UK, there is a definite overlap of jurisdiction. Moreover, it is also highly likely that there would be some confusion due to the fact that both organisations operate substantially in the same market place, i. e. in rugby. Based on this and combined with the fact substantial goodwill has been built up in the name ‘ Canadian All Reds’, it would seem likely that they would be able to object, successfully, to this trademark registration.

Part B

One of the first issues that the Canadian All Reds will have to consider is whether or not they actually own the intellectual property rights to the logo. The logo was designed by an independent designer employed by the Canadian All Reds. In these circumstances, it would be normal for the contract between the designer and the Canadian All Reds to ensure that any intellectual property rights stemming from the relationship are vested in the Canadian All Reds; this needs to be checked, before the Canadian All Reds could bring any action.

The logo is not registered and therefore the action open to the Canadian All Reds would be either passing off or design right infringement. Design rights protect the unique shape or design of a product and not the two dimensional shape. For example, in this case, the actual design of the scarves could be protected and the Canadian All Reds could bring an action against John in relation to the scarves, alongside any action being brought in relation to the logo itself. Design rights are not registered; they are automatically vested in a new design when it is recorded in material form. The Canadian All Reds, therefore, need to ensure that the design right in the merchandise is vested in them, before they become available to the public. This will be the evidence required in order to ensure that an action against John is possible. It should be noted that design rights only exist in the UK and although international recognition is possible, it is not offered as standard. Clothing is capable of gaining design right protection as held in the unreported case of *Jo-Y-Jo Ltd v Matalan*, in 1999, where knitted vests were held to have design right protection.

Alternatively, the Canadian All Reds could bring an action for passing off as defined in *Reckitt & Colman Ltd v Borden Inc*, which they would be able to bring if they could prove that they have built up goodwill in their logo and that the logo of PRU was established and could be a misrepresentation which would confuse consumers. Finally, the Canadian All Reds would have to prove that they had suffered loss as a result. In this case, it may be difficult to prove that the loss has actually occurred, unless the Canadian All Reds could show that individuals were purchasing items from PRU instead of

themselves, by accident, which is unlikely for rugby union fans who would understand the differences between the two teams.

Part C

In this case, the Canadian All Reds would have to rely on the law of passing off in order to prevent John from selling the scarves outside the grounds. It does not confer an exclusive right on the owner; it is a protection from misrepresentation. In order to prove the case for passing off, it would be necessary for the Canadian All Reds to show that they had goodwill in the mark, which they do have, and that there had been some form of misrepresentation and that this had damaged their goodwill. It would be up to the Canadian All Reds to show that they did have goodwill in the goods and the logo; they would also have to prove that there had been some form of false representation, whether it was intentional or not, to the public, by virtue of the goods being offered by John. For this to be the case, it will be necessary for them to show that there is a likelihood that the public would be deceived, but it has been established that the standard is not that of a 'moron in a hurry', but rather the public at large. The court will determine whether or not there is a similarity in terms of the goods. This may result in a difference of opinion in terms of whether or not the scarves without the words 'All Reds' on them would be deemed passing off, in comparison to the ones without the words on the scarves. When considering all factors including the look of the scarves, it is more likely that the court will deem the scarves with the words 'All Reds' written on them to be more deceptive than the plain scarves.

A similar case was seen in Arsenal Football Club v Matthew Reed . In this case, Mr Reed was selling unofficial merchandise such as scarves and hats that included marks similar to those of the Arsenal crest and logo. Arsenal brought an action for trademark infringement against Mr Reed, but Mr Reed argued that he was not using the mark as a trademark and was using it, rather, as merchandising, despite the fact that it was accepted that the customers did not necessarily think that the goods had come from the club, but rather that it was a ' badge of support, loyalty or affiliation'. It was held, in this case, that it could be a trademark infringement where the use of the mark undermined the essential function of a trademark and that by allowing the merchandise to be sold, it would mean that the function of a trademark was a way of identifying origin. The judge stated: ' As the ECJ pointed out, the actions of Mr Reed meant that goods not coming from Arsenal but bearing the trademarks, were in circulation. That affected the ability of the trademarks to guarantee the origin of the goods'.

Based on this, it is expected that the Canadian All Reds could rely on this case to prevent John from selling the merchandise.

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