

# European Intellectual Property Review

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## Case Comment

### The protection of marks with a reputation: Intel v CPM

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#### **\*E.I.P.R. 326 Introduction**

On November 27, 2008, the European Court of Justice (ECJ) gave its judgment in *Intel Corporation Inc v CPM United Kingdom Ltd*,<sup>1</sup> a reference from the Court of Appeal<sup>2</sup> in a challenge brought by Intel Corporation Inc ("Intel") on the basis of its INTEL trade mark to the validity of a registration for INTELMARK owned by CPM United Kingdom Ltd ("CPM").<sup>3</sup>

The *Intel* case concerns the scope of protection available to well-known marks, those with a "reputation".<sup>4</sup> Such marks can have additional protection beyond that available to other marks (both in terms of the range of acts that can amount to infringement and in terms of the ability to object to the registration of other marks). The protection extends to use of an identical or similar mark not only in relation to identical or similar goods or services, but also to use in relation to dissimilar goods or services. That protection is available even in the absence of any likelihood of confusion. What matters is whether registration or use of a mark would take unfair advantage of or be detrimental to the distinctive character or repute of the well-known mark.

The true scope of these rights has never been definitively established in the relatively little case law on the subject. The *Intel* case required the ECJ to consider in some detail when this wider protection should be available. As a result of the ECJ's decision, it can now be said that:

- Establishing a "link" between a well-known mark and an allegedly infringing sign will typically be straightforward. A mere "calling to mind" is enough. Indeed, the notion of a "link" can now be seen as nothing more than a way of testing whether the well-known mark truly has a relevant "reputation".
- A prerequisite for establishing unfair advantage or detriment is demonstrating at least a serious risk of injury.
- Proof of detriment now requires a (serious risk of a) change in consumers' economic behaviour, presumably manifested in a reduced willingness to buy.

Cases will inevitably turn on their particular facts and, in particular, factors such as the fame and distinctiveness of the well-known mark and the extent to which that mark and the infringing sign, as well as the goods for which they are registered or used, are similar or dissimilar. The cause of action will require more substantial evidence than some had perhaps hoped. Nevertheless, in the right circumstances, marks with a reputation, and especially those that are particularly distinctive, will enjoy the wide protection promised by Directive 89/104 (Trade Marks Directive) [1989] OJ L40/1,<sup>5</sup> though there will be particular challenges in establishing the necessary evidence. This should come as a relief to trade mark owners since there was potential for the *Intel* case to narrow the cause of action far more than it has done. At first sight, the case introduces yet another gloss on the legislation, but on closer inspection, it may have the potential to work in practice. It also preserves a degree of flexibility for the national courts in relation to a species of infringement that is particularly dependent upon the individual facts such as the fame and distinctiveness of the mark.

#### **Reputation-based infringement and invalidity**

The owner of a well-known mark can object to a later mark being registered or used (whether in respect of similar or dissimilar goods<sup>6</sup>) if:

1. the earlier mark has the requisite reputation; and
2. use of the later mark would:

**\*E.I.P.R. 327** (a) take *unfair advantage* of the distinctive character or repute of the earlier mark (often referred to as “free riding”<sup>7</sup>); or

(b) be *detrimental* to:

(i) *the distinctive character of the earlier mark* (often referred to as diluting, whittling away or blurring, an effect that means the earlier mark is, in the ECJ's words, no longer capable of arousing an “immediate association with the goods and services for which it is registered”);<sup>8</sup> or

(ii) *the repute of the earlier mark* (often called degradation or tarnishment, an effect that means the later mark adversely affects the positive connotations and associations previously enjoyed by the earlier mark and diminishes the attractive power of that mark);<sup>9</sup> and

3. such use is without due cause.

A distinction is typically drawn between detriment to distinctive character (dilution) and detriment to repute (tarnishment). These forms of injury are, at least in principle, different and independent. No equivalent distinction is usually drawn between different “species” of free-riding because the injury is the same--namely, the unfair annexation by the infringer of some part of the mark's value.

The *Intel* case concerned a question of “*reputation-based invalidity*” under art.4(4)(a) of the Trade Marks Directive. However, the ECJ's decision also relates to the equivalent provision for “*reputation-based infringement*” under art.5(2) of the Trade Marks Directive. The ECJ expressly noted that the two provisions are essentially identical.<sup>10</sup>

### Summary of the ECJ's decision

The ECJ has previously determined that reputation-based invalidity or infringement require that use of the later mark cause the consumer to establish a “*link*” between the two marks<sup>11</sup> where that “*link*” is (or at least can be) something less than confusion. The nature of that link, and whether such a link is in itself sufficient to establish reputation-based invalidity, was at the heart of the dispute in *Intel*.

The questions referred to the ECJ by the Court of Appeal ultimately boil down to two key inquiries:

1. What is required to establish a “*link*” between an earlier mark and a later mark? In particular, if the earlier mark is merely called to mind by the later mark, is that in itself sufficient to establish the necessary link?
2. Can establishing a link (whatever that may require) ever suffice in itself to show the unfair advantage and/or detriment required to make out a case of reputation-based invalidity or infringement?

If the answer on both points were to be “yes”, the owners of well-known trade marks would be handed a powerful and far-reaching weapon with which to prevent the use of identical or similar marks by third parties, irrespective of the goods or services for which such marks might be used. The English courts have long been conscious of the potentially pervasive (even oppressive<sup>12</sup>) reach of the action for reputation-based invalidity or infringement.

In the event, the ECJ in *Intel* decided that (1) if the later mark calls the earlier mark to mind, that *is* in itself tantamount to establishing the necessary link, *but* (2) the existence of such a link is *not* enough to establish that any unfair advantage has been taken of, or detriment caused to, the earlier mark. The existence (or risk) of unfair advantage or detriment must be established over and above the link itself.

Further, it seems that proof of detriment (or a risk of it) is now subject to a new test. It requires evidence of a change in the economic behaviour of consumers resulting from the use of the later mark (or a serious likelihood of such change).

In deciding that establishing a link alone is not in itself sufficient, the ECJ's judgment is explicitly directed to all the forms of the cause of action. That principle applies whether it is alleged that unfair advantage is taken of the distinctive character or repute of the earlier mark, that the later mark is detrimental to the distinctive character of the earlier mark or that the later mark is detrimental to the

repute of the earlier mark. All require more than the link alone.

By contrast, the ECJ's decision that reputation-based invalidity or infringement requires some change in the economic behaviour of consumers is on its face confined to instances of dilution. By the time the dispute reached the Court of Appeal, Intel's case had become focussed on the allegation that CPM's use of INTELMARK would cause detriment to the distinctive character of the INTEL trade mark<sup>13</sup> and the Court of Appeal's questions to the ECJ reflected the case as so focussed. This has had the unfortunate consequence of leaving it undecided whether or not a change in economic behaviour is also required when the allegation is one of free-riding or tarnishment. It is submitted that this is the better view of the ECJ's judgment. The alternative view, in which it is only dilution--and not free-riding or tarnishment--that needs to be proved by evidence of a change in economic behaviour would be difficult to maintain on any logical basis.

**\*E.I.P.R. 328** The case is also significant for what it rejected. The Court held that proof of actual damage was not required. Pre-emptive action can be taken where there is a serious risk of injury being caused in the future. This is good news for the owners of well-known marks. Action can be taken before the mark is wounded, avoiding a "death by a thousand cuts".

### Where to next?

The case has of course raised new questions, in particular the issue of what is required to show an "effect on economic behaviour". Although the concepts of unfair advantage and detriment require some precision and clarity to define the scope of the cause of action, the ECJ has not specified what a relevant "effect on economic behaviour" actually is. Substituting one imprecise test for another does not in itself clarify anything. However, if this is taken to mean a reduced willingness to buy the trade mark owner's goods (or, for unfair advantage, an increased willingness to buy the infringer's goods), then it would seem to be a reasonable test that is likely to give the right result in at least the majority of cases.

### Background to the case

In 1997, CPM registered INTELMARK as a UK trade mark in respect of "marketing and telemarketing services" in Class 35. In 2003, Intel applied to the Intellectual Property Office (IPO) for CPM's registration to be cancelled. It was common ground between the parties that the "marketing and telemarketing services" covered by CPM's registration are not similar to any of the goods and services covered by Intel's own trade marks. That being so, Intel's only cause of action was for reputation-based invalidity. CPM's mark was initially also said to be invalid on the grounds that any use made by CPM of INTELMARK would amount to passing off, but Intel abandoned this aspect of its case in the course of the hearing before the IPO.<sup>14</sup> The abandonment of this case prompted Jacob L.J. to say<sup>15</sup> that "this case must be decided on the basis that use of Intelmark does not suggest a trade connection with [Intel]".

CPM conceded that INTELMARK is similar to INTEL<sup>16</sup> and admitted that Intel's marks had a reputation in relation to computers and related products.<sup>17</sup> The case proceeded on the basis that the INTEL mark had a strong reputation in respect of this limited range of goods.<sup>18</sup> The only issues between the parties were, therefore, whether CPM's use of INTELMARK took unfair advantage of, diluted or tarnished the INTEL trade mark and, if so, whether that use was made without due cause.<sup>19</sup> However, after failing to persuade the Hearing Officer that it could take the benefit of a "due cause" defence, CPM did not pursue the point any further.<sup>20</sup>

Intel's claim failed before the IPO and again on appeal to the High Court. The Hearing Officer was not persuaded that a link would be drawn between INTEL and INTELMARK.<sup>21</sup> Patten J. was more inclined to accept that INTELMARK would at least call INTEL to mind for the average consumer<sup>22</sup> and may therefore have been minded to conclude there was a link (provided a mere "calling to mind" is sufficient). However, neither the Hearing Officer nor Patten J. were persuaded that any detriment was caused to, or unfair advantage taken of, INTEL by the use of INTELMARK. Although both considered that Intel's strongest case was the dilution argument, neither thought the evidence supported a finding of invalidity.

### The Court of Appeal and the ECJ

Intel appealed again to the Court of Appeal, focussing its case on dilution. Before the Court of Appeal (and later before the ECJ), Intel argued that a link is established by any kind of mental association

between the later mark and the earlier mark. If exposure to INTEL MARK would bring INTEL to mind, as Patten J. accepted it would, that is sufficient to establish the necessary link.<sup>23</sup> Further, Intel argued that, at least if the earlier mark is both highly distinctive and unique (in the sense that no one else uses that mark for any goods or services whatsoever), then, once that link is made, essentially any use of the later mark must be taken to be detrimental to the distinctive character of the earlier mark. In such *\*E.I.P.R. 329* circumstances, there is no need to look any further for any mechanism by which dilution might occur. Marks in this privileged position will suffer “a death by a thousand cuts” if not permitted to prevent encroachment on their unique position from the outset and that is sufficient to establish detriment. Since the INTEL mark was, at the time INTEL MARK was filed,<sup>24</sup> both highly distinctive<sup>25</sup> and unique,<sup>26</sup> it followed that, if INTEL MARK would call INTEL to mind, any use by CPM of INTEL MARK must be detrimental to the distinctive character of INTEL.

Jacob L.J. (with whom Mummery and Keene L.J.J. agreed) was persuaded that the true scope of reputation-based invalidity and infringement was an open question and referred a series of questions to the ECJ. The questions were:

“1. For the purposes of Art. 4(4)(a) of the ... Directive ... , where:

- (a) the earlier mark has a huge reputation for certain specific types of goods or services,
- (b) those goods or services are dissimilar or dissimilar to a substantial degree to the goods or services of the later mark,
- (c) the earlier mark is unique in respect of any goods or services,
- (d) the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

2. If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a ‘link’, what significance is to be attached to the goods or services in the specification of the later mark?

3. In the context of Art. 4(4)(a), what is required in order to satisfy the condition of detriment to distinctive character? Specifically, does (i) the earlier mark have to be unique, (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?”

The ECJ tackled these questions in two stages, taking 1(i) and 2 (the link) together and 1(ii) and 3 (unfair advantage and detriment) together. A number of concepts and issues emerge as central to the question of reputation-based infringement or invalidity which merit further analysis, starting with that of a “link”.

### The link

The ECJ has confirmed that the requirements for a “link” are not onerous. A “link” can be established in circumstances that fall far short of anything approaching confusion. According to the ECJ,<sup>27</sup> “the fact that the later mark calls the earlier mark with a reputation to mind is tantamount to the evidence of such a link”.

The possibility that a link might be so readily established was of considerable concern to the Court of Appeal, which felt the link must be more than such a “tenuous association”.<sup>28</sup> However, the Court of Appeal had gone significantly in the other direction, recommending that the ECJ impose a high hurdle so that a link was made only if a consumer was caused “to think there is a trade connection” between owners of the earlier and later marks or “at least wonder whether there is such a connection”.<sup>29</sup> This formulation seemed dangerously close to importing into reputation-based infringement a requirement for confusion (which the ECJ has consistently confirmed is not required).<sup>30</sup> It would have risked making reputation-based invalidity and infringement almost redundant and would have effectively negated the impact of the ECJ’s decision in *Davidoff & Cie SA v Gofkid Ltd.*<sup>31</sup>

It is suggested that the ECJ’s clarification of how weak the “link” requirement is need not result in the “oppressive” trade mark law that the Court of Appeal feared.<sup>32</sup> What it does mean is that the most effective limitations on the scope of that law are to be found elsewhere. Nevertheless, this is not to say that the link does not do some work in restricting the scope of the cause of action.

Sharpston A.G. suggested in her Opinion in *Intel* that the link is “bound up with the question of similarity or identity” between the marks in issue.<sup>33</sup> With respect, this does not adequately explain why it should be necessary to think in terms of a link for the purposes of infringement under art.5(2) but not under art.5(1) of the Trade \*E.I.P.R. 330 Marks Directive. It is suggested that the best explanation of the role of the link is that it is in fact tied up with the question of *reputation*. After all, it may be said that it is difficult to see how a trade mark can have a reputation --or at least, a relevant reputation--if it is not at least called to mind when an identical or similar mark is encountered. In that sense, the link places a limit (albeit not necessarily a very restrictive one) on the circumstances under which a mark with a reputation can qualify for reputation-based protection. It is not enough for the mark to have “a reputation” per se. Its reputation must be one that is (for want of a better word) “engaged” by the use of the later mark. As the ECJ says<sup>34</sup> :

“It is ... conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, *although it has a reputation*, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it *will not establish any link* between those marks.” (*Emphasis added.* )

In other words, the requirement of a link means that the qualifying prerequisite that a mark must satisfy to take the benefit of arts 4(4)(a) and 5(2) of the Trade Marks Directive is not “a reputation” as such, but “a reputation among the relevant section(s) of the public”.

The Trade Marks Directive makes no mention of a link and it might be said that the concept has been given an independent status of which it is not worthy. The Directive simply requires that the use of the later mark (which is identical or similar to the earlier mark) has a particular effect on the earlier mark, either taking unfair advantage of, or being detrimental to, that mark (or more precisely its distinctive character or repute). In other words, the use and the similarity must be shown to have *caused* the detriment or unfair advantage. What need is there for extra-statutory concepts to be erected as additional hurdles to be overcome (or as filters to exclude certain claims)? Ultimately, if the claim is ill-founded, there will be no causal link between use of the later mark and any injury said to have been suffered (or likely to be suffered) by the earlier mark with a reputation.

In *L'Oréal v Bellure*, the Court of Appeal suggested that a link is established:

“... only if consumers, or are likely to be, moved in any depth to buy *by reason* of the use of the defendants' signs”.<sup>35</sup>

Following *Intel*, this is clearly not required to show a link, but the principle has considerable force in relation to the question of whether any detriment has been caused or unfair advantage taken. (That said, it may be that the requirement of being “moved to buy” is too high. Even if not, this formulation is arguably appropriate only for unfair advantage and should at least extend to being moved *not* to buy in order to capture detriment.) This analysis is consistent with the ECJ's repeated formulation of trade mark infringement as confined to circumstances:

“... in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of goods”.<sup>36</sup>

(We will come back to look at the question of “effect on essential function” in the light of the *Intel* decision.)

It is submitted that the ECJ could have reached the same result in *Intel* by focussing on the central role of causation in the analysis of reputation-based infringement and invalidity.<sup>37</sup> The ECJ could have seized the opportunity to dispense with the notion of a “link” as a separate requirement. This would have simplified matters. Indeed, the ECJ implied at one point that a link might not in fact be a true prerequisite for reputation-based infringement or invalidity. It said that, in the absence of a link, “use of the later mark is *not likely* to take unfair advantage of, or be detrimental to ... the earlier mark”.<sup>38</sup> This suggests there may be circumstances in which the unlikely happens and detriment is caused (or unfair advantage taken) *without* there being any link. The possibility was not developed further in the judgment.

### The global assessment test

The ECJ confirmed that the existence of a link, as with other elements of the cause of action, must be

assessed globally, taking into account all relevant factors.<sup>39</sup> Happily, the Court resisted the call to identify an exhaustive list of factors. No one factor can be singled out as definitive. Nonetheless, it is clear that in many cases a short list of important factors is likely to recur. As identified by the ECJ, these are most likely to include:

- *The degree of similarity between the marks.* It is noteworthy that even where two marks are identical, use of one may not call the other to mind--take for example the case of POLO mints and POLO cars.
- *The nature and (dis)similarity of the respective goods and services.* There must be some degree of overlap between the consumers of goods sold under the two marks<sup>40</sup> but that overlap is of itself not sufficient to establish a link.
- *The strength of the earlier mark's reputation.* In the absence of an overlap of consumers, the strength of the earlier mark's reputation and its ability to reach beyond consumers of goods sold under that mark may determine whether there is any prospect of a link being made at all.<sup>41</sup> The reputation of the earlier mark is assessed with reference to the average *\*E.I.P.R. 331* consumer of the goods or services for which that mark is registered.<sup>42</sup> It seems that any reputation the earlier mark might have among other groups of people will be regarded as an extension of this "core" reputation.<sup>43</sup>
- *The degree of the well-known mark's distinctiveness.* The distinctiveness of the earlier mark must be assessed primarily with reference to the perception of consumers of the goods sold under that mark.<sup>44</sup> According to the ECJ, a mark that is unique (as INTEL is said to be unique) will have a strong, distinctive character,<sup>45</sup> although this will not in itself guarantee that a link will be made.
- *A likelihood of confusion.* Unsurprisingly, if use of the later mark creates a likelihood of confusion with the earlier mark, then the necessary link has been established.<sup>46</sup> Alternatively (or additionally), it might be said that confusion demonstrates a likelihood that some form of detriment has been caused or unfair advantage taken.

Not only must the existence of a link be determined on a global appreciation of all the circumstances, so too must the question of detriment (or unfair advantage). The ECJ expressly noted that the same factors are likely to be relevant at both stages of the analysis.<sup>47</sup> This raises the question: why bother with the first stage at all? If a global appreciation indicates that there is a link, it does not answer the question whether there is any detriment or unfair advantage. Conversely, if a global appreciation indicates that there is no link, it can still only be said that it is "not likely" that detriment has been caused (or unfair advantage taken). A second global appreciation should always be necessary, whether or not there is a link.

### **Change in economic behaviour: a reduced willingness to buy?**

The ECJ is clear that detriment or unfair advantage must be proved over and above the existence of a link. A link alone is never sufficient to prove reputation-based infringement or invalidity. As noted, whether or not there is detriment or unfair advantage is also to be determined on the basis of a global appreciation of all the relevant circumstances (including those factors already discussed). That is not surprising. What is perhaps more surprising is that the ECJ concluded<sup>48</sup> that detriment to the distinctive character of a trade mark (i.e. dilution):

"... requires evidence of a *change in the economic behaviour* of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in future." (Emphasis added.)

In referring its questions to the ECJ, the Court of Appeal nominated seven factors as being particularly pertinent to the analysis on a global appreciation, of which one was:

"... whether the economic behaviour of the average consumer in relation to the earlier mark when used for its goods or services is likely to be affected".<sup>49</sup>

Sharpston A.G.'s view was that "detriment to distinctiveness need not *necessarily* involve economic detriment, so that a change in economic behaviour is not essential", but she did not dispute that such a change would be one relevant factor to take into account and would "buttress the claimant's case". (See [74] of her Opinion.)

The ECJ has significantly promoted this concept. Rather than being one factor to be taken into

account among others on a global appreciation of the circumstances to determine whether any detriment has been caused, a change in economic behaviour is now what needs to be proved (on a global appreciation). It is not evidence of detriment, but the manifestation of detriment.

As Patten J. noted in *Intel/HC*, this test appears to have been derived<sup>50</sup> from Directive 84/450 (the Comparative Advertising Directive).<sup>51</sup> In a series of English cases, however, it has been applied to the issue of whether there is a link. In *Electrocoin Automatics Ltd v Coinworld Ltd*,<sup>52</sup> Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) said at [102]:

“I think it is clear that in order to be productive of advantage or detriment of the kind proscribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

**\*E.I.P.R. 332** In the context of the Comparative Advertising Directive, the requirement of a change in the economic behaviour of consumers is part of the test as to whether an advertisement is misleading.<sup>53</sup> Given the ECJ's conclusion that a “link” requires nothing more than a “calling to mind”, there can be no role for this concept as part of the test for whether there is such a link. Nevertheless, the ECJ has now adopted the term in relation to whether or not there is detriment as a result of the use of the later mark rather than in relation to the establishment of a link. At first glance, the introduction of another term which is new to the analysis of infringement has the capacity to cause further uncertainty and debate. It is, however, helpful to have some guidance as to what in practice will amount to detriment or unfair advantage, provided that the concept of “economic advantage” is given a consistent interpretation and the application of this new test strikes the right balance between certainty and flexibility in the face of the different circumstances of each case.

The crux of the issue now becomes what does it mean to say there must be an “effect on economic behaviour”. The few English cases that have considered the concept shed little light on the issue, although the comments of the Hearing Officer in *Chartered Financial Analyst/CFA* are apposite:

“If this is understood as meaning that the claim represented by the mark is likely to be a factor (but not necessarily a decisive factor) in consumers' choice of goods then I accept it.”<sup>54</sup>

The ECJ does not suggest what sort of economic behavioural change would be required to manifest dilution, but it has stated that economic benefit to the user of the later mark is irrelevant for these purposes.<sup>55</sup> On the one hand, this means the owner of an earlier mark can prove reputation-based invalidity or infringement based on detriment without having to show that some advantage is conferred on the user of the later mark. On the other, it means that evidence of an advantage being conferred on the user of the later mark cannot be used as a proxy for proof that use of the mark is detrimental to the earlier mark. Trade is not necessarily a zero-sum game; and this is especially true where two traders are engaged in the sale of dissimilar goods and are not in competition. If the true complaint is that the user of the later mark has obtained an illegitimate commercial benefit, the action should be brought on the basis of unfair advantage and not detriment (of either kind).

As such, it would seem that for dilution to occur, there must be an economic behavioural change that adversely affects the earlier mark. Presumably, this must ultimately involve a reduced willingness on the part of consumers to purchase goods or services sold under the earlier mark. Without some such impact, the distinctive character of the mark cannot be said to be under threat. A “reduced willingness to buy” might encompass greater price sensitivity on the part of consumers of goods sold under the well-known mark, i.e. the damage done to the repute or distinctive character of the mark means that consumers are less willing to remain loyal to the relevant brand in the event of any given increase in price. If so, the change in economic behaviour might not immediately be manifested in a reduction in the quantity of goods sold under that mark.

Although it is difficult to predict how the test will be applied in particular cases, it is suggested that the ECJ was right to leave it to the national courts to decide how to assess whether an appropriate behavioural change has been caused. This issue must be decided on the facts of each case, i.e. assessed on the basis of a global appreciation. The result of that balancing of various factors is likely to be highly dependent on such matters as the distinctiveness of the earlier mark and the degree of similarity between it and the later mark.

### **Evidence of detriment--a “serious risk” of damage**

The ECJ has confirmed that “the proprietor of the earlier mark cannot be required to wait for [injury]

actually to occur". However, the proprietor must in any event "prove that there is a *serious risk* that such an injury will occur in future".<sup>56</sup> (Emphasis added.)

The *Intel* case concerned dilution and in this context also, helpfully, establishes that a "first use" of a later mark can be sufficient to give rise to detriment or a serious risk of detriment. In appropriate cases it is submitted that one of the benefits of the protection available to well-known marks is that it can stop a slow but steady erosion of distinctiveness, which might be seen as classic dilution. This is restrained from becoming an "oppressive" protection by the requirement for evidence of damage or a serious risk of damage (which, at least in respect of dilution, is manifested by a change in the economic behaviour of consumers). As a result, the cause of action rightly falls well short of the sort of "automatic" protection against use of a similar mark wherever a sufficient reputation and link is established that so concerned the Court of Appeal.

Reputation-based invalidity, with which the ECJ was concerned in *Intel*, arises where use of that mark "would" take unfair advantage or cause detriment. By contrast, reputation-based infringement arises when use of a similar mark "takes" unfair advantage or "is" detrimental. Nevertheless, despite this difference in wording, there does not seem to be any reason in principle why a proprietor should be compelled to wait until an injury is suffered before taking action against an infringement when they would not have to wait in order to prevent a later mark from being registered. It is submitted that the "serious risk" test should be applied to reputation-based infringement as much as to reputation-based invalidity.

**\*E.I.P.R. 333** The ECJ did not attempt to quantify what constitutes a "serious" risk or likelihood. It seems the ECJ agrees with Jacob L.J. that "the harm or prospect of harm must be real and tangible"<sup>57</sup> before relief for reputation-based invalidity or infringement can be obtained. Nevertheless, the line between a "risk" and a "serious risk" remains fuzzy. It cannot, for example, be said that a risk of injury is "serious" only if it is more likely than not that the injury will be caused. It might, however, be enough to establish that the risk of damage is a "real" rather than hypothetical one. No doubt much will depend on the circumstances of each case.

It is clear that the ECJ intends that the owner of the earlier mark should be required to provide a convincing explanation of how and why use of the later mark can be expected to cause a relevant injury. By declining to quantify what makes a risk "serious" enough, the ECJ has left national courts with significant flexibility in the application of the test it has laid down. Trade mark owners and their advisors will need to consider carefully what sort of evidence will best demonstrate that risk in the circumstances of each case and how that evidence might be obtained. This will often not be a straightforward matter.

### Tarnishment

The ECJ's judgment on the "economic behaviour" point is confined to dilution. It is certain that tarnishment cannot be presumed to follow from a link being established any more than can dilution. Something more is always required. It is conceivable that in cases of tarnishment, that "something more" does not need to be a change in the economic behaviour of consumers. Nevertheless, it is unlikely that a trade mark owner who brings a claim on the basis of tarnishment would be held to a fundamentally different standard.

There is no obvious rationale for adopting a different approach in cases of tarnishment. Where the earlier mark is diluted, the consumer may be less likely to purchase goods sold under that mark because it ceases to exert such a hold over the consumer's mind. Where the earlier mark is tarnished, the consumer may be less likely to purchase goods sold under that mark because it has become unshackled from the desirable connotations it previously held for them. Both cases are examples of detriment being caused to the earlier mark by a later mark (without any confusion). It is submitted that the better view of the ECJ's judgment is that both dilution and tarnishment require that use of the later mark causes a change in the economic behaviour of consumers of goods sold under the earlier mark.

### Unfair advantage

Does the "economic behavioural change" analysis also hold for unfair advantage cases? Again, there is no clear reason to take a fundamentally different approach from that set out by the ECJ for dilution cases. That said, there would be one key difference in unfair advantage cases. Having established a link, the second question here (to be answered taking all relevant factors into account) would be *will*

*the consumer of goods sold under the later mark change their economic behaviour?*

In such cases, it would also follow that it is irrelevant whether or not the earlier mark is diluted or tarnished in the process. If commercial benefit to the user of the later mark is immaterial in cases of detriment, commercial harm suffered by the owner of the earlier mark must be equally immaterial in cases of unfair advantage. As the ECJ pointed out in *Intel*, the “drawing of benefit from that [earlier] mark by the proprietor of the later mark” is central to the concept of unfair advantage.<sup>58</sup> In this case it would seem that any effect on economic behaviour that manifests unfair advantage must be an “increased willingness to buy” among consumers of goods sold under the later mark as a result of its similarity to the earlier mark. This increased willingness to buy might, in principle, take the form of a decrease in price sensitivity on the part of consumers of the goods sold under the infringing mark. That is, by taking advantage of the reputation of the well-known mark, the infringer is able to attract and retain custom at higher prices than would otherwise have been possible.

Of course, not every such change in economic behaviour would necessarily demonstrate an infringement. Advantages accruing to the user of the later mark are prohibited only to the extent they are unfair. The Court of Appeal in *L'Oréal v Bellure* emphasised that “unfair” is not a meaningless or redundant qualification and has referred a further question to the ECJ in an attempt to elicit a “fairly bright-line rule” to distinguish fair from unfair advantage.<sup>59</sup>

Interestingly, Jacob L.J. speculated that examples of unfair advantage might include the following:

“Consider a very distinctive mark famous for a particular kind of product, perfumes say. The trade mark owner may reasonably one day contemplate a line extension--perhaps into jewellery or wines. If another used that self-same mark, or a confusingly similar one, for these different goods, then, even if no one is confused, he would foreclose the trade mark owner's future options. I do not see why that should not be regarded as “unfair”. Similarly, if the mark is used for wholly different goods, axle grease say, in a context intended to parody, then the use may be unfair.”

The “parody” example might well be regarded as an instance of tarnishment rather than (or as well as) unfair advantage. If use of the mark for axle grease causes consumers of perfume to change their economic behaviour (i.e. to be less willing to buy the branded perfume), it would seem the famous mark will have been tarnished. If use of that mark for axle grease causes consumers of axle grease to change their economic behaviour (i.e. to be more willing to buy the branded grease), it would seem that unfair advantage might have been taken of the famous mark. But *Intel* strongly suggests that the fact that famous mark may have been tarnished is entirely irrelevant to the question of whether unfair advantage has been taken of it. It cannot be the risk of tarnishment (or dilution) that marks the “bright line” between fair and unfair advantage.

**\*E.I.P.R. 334** Similarly, the “line extension” example might be regarded as a case of dilution as much as unfair advantage. For this to be unfair advantage, there must (it seems) be an effect on the economic behaviour of wine consumers to the benefit of the third party user. The fact that the trade mark owner may also be foreclosed from entering that market in future under its mark is irrelevant for these purposes. However, in the process of foreclosing the market, the wine merchant might have been more successful because people recognised the mark as a result of its original use.

It remains to be seen whether the ECJ will be able to deliver the clear distinction between fair and unfair advantage that the Court of Appeal has sought. However, unless the ECJ departs substantially from the principles so recently established in *Intel*, any such distinction will not turn on the presence or absence of any detriment to the trade mark owner.

In his Opinion of February 10, 2009 in *L'Oréal, Mengozzi A.G.* suggested (i) that “advantage” is taken of a mark when its use induces consumers to buy the allegedly infringing products (thereby following the *Intel* line that what matters is a serious risk of a change in economic behaviour and applying this expressly to unfair advantage) and (ii) any such advantage is tantamount to an infringement unless the alleged infringer can show due cause for using the mark. According to Mengozzi A.G., only if there is due cause for using the mark is it necessary to consider whether the advantage derived by the alleged infringer is “unfair”. Absent due cause, any advantage must be deemed to be unfair. He also appears to conclude that “unfairness” will defeat any “due cause” that might otherwise be shown.<sup>60</sup> Whether this somewhat surprising approach is followed by the ECJ remains to be seen. If it is, it would call into question whether the courts have to date set the bar too high for showing due cause. It has previously been understood that due cause will excuse even the taking of an unfair advantage. It must also be remembered that it is for the alleged infringer to demonstrate due cause.

## The nature of the “injury” to marks with reputation

The ECJ has indicated that the well-known mark's reputation and distinctiveness is to be assessed with reference to the perception of consumers of the goods for which the mark is registered. The existence of any detriment to that distinctive character or repute must also be assessed with reference to the same consumers. (By contrast, any unfair advantage is to be assessed by reference to consumers of the goods for which the allegedly infringing mark is used.<sup>61</sup>) It is clear that the injury to the well-known mark must in some sense be tied to the specification of that mark as registered. This should not be surprising. Were the injury not so tied, the cause of action would be protecting not the registered trade mark as such, but some unregistered reputation or goodwill.

However, the Court of Appeal went further than this. Jacob L.J. suggested that detriment would be relevant only to the extent it affected “the distinctive character or repute of the earlier mark *for the goods or services for which it is registered*”.<sup>62</sup> On this formulation, a mark registered for perfumes could not be injured by use of the same mark on wines unless that use was detrimental to its reputation “for” perfumes. There is a tension between the restrictive approach recommended by the Court of Appeal in *Intel* and the “line extension” example from *L'Oréal*. However, it seems perfectly possible in principle that third party use of a mark in relation to goods not covered by a registration might have an impact on the reputation or distinctiveness of that mark as it relates to those goods that are covered by the registration. The detriment might be analysed on the basis that because there are now two “sources” for the same mark, the mark is less distinctive to its original customers (who must presumably overlap with the consumers for the new line extension). Alternatively, it may be sufficient to cause the consumer to wonder whether there may be a trade connection between the owner of the well-known mark and the infringer, which may be enough to produce a change in economic behaviour and thereby a form of detriment or unfair advantage.

The ECJ's approach allows for the reputation of a mark to be appropriately tied to the goods for which that mark is registered, without unduly restricting the circumstances in which there may be detriment or unfair advantage. However, even on this approach, it may be difficult to accommodate at least some “line extension” scenarios.

## An effect on the functions of the trade mark

It is interesting that the ECJ did not analyse reputation-based invalidity and infringement by reference to the *Arsenal Football Club Plc v Reed*<sup>63</sup> formulation--namely, that third party use infringes a trade mark only if it “affects or is liable to affect the functions of the trade mark”, particularly its essential function. It may be felt that this test is not relevant in any case other than “double identity” infringement.<sup>64</sup> The conclusions in *Intel* are in any event consistent with this approach, provided it is recognised that trade marks have functions other than the essential function and that infringement can in some circumstances arise when these other functions are impaired, even if the essential function is not.

Sharpston A.G. said at [13] of her *Intel* Opinion<sup>65</sup> that reputation-based invalidity and infringement:

“... concerns less the link between a product and its source than the use of the trade mark as a communication tool, carrying a broader marketing message”.

Trade marks have an “advertising” or “marketing” function as well as operating as a guarantee as to the origin of the products bearing the mark. As Colomer *\*E.I.P.R. 335* A.G. noted in his Opinion in the *Arsenal* case, “trade marks may also be used for advertising purposes in order to inform and persuade the consumer”.<sup>66</sup>

As noted earlier, the ECJ describes dilution of a trade mark as a “dispersion of its identity and hold upon the public mind”. This could readily be characterised as impairing the ability of the mark to perform its advertising function, to inform and persuade the consumer. The question is, of course, how to distinguish between cases in which such impairment is a real danger and those in which it is merely a speculative outcome of the alleged infringer's use. The answer will depend on the circumstances (and such factors as the nature of the relevant market, the distinctiveness of the mark and its reputation and the similarity between the marks in issue and the respective goods for which they are used). But ultimately, where the advertising function of a mark is impaired, it may be expected that some adverse change in the economic behaviour of consumers will be evident.

*Intel* is therefore consistent with the ECJ's earlier position that infringement demands that the

functions of a trade mark (but not necessarily the essential function) be put at risk or impaired by use of the infringing sign. However, in considering whether there is sufficient evidence of an adverse change in economic behaviour in any given case, it will be important to have in mind that it is not only the essential function that matters.<sup>67</sup>

### Without due cause

It should not be forgotten that it must also be established that the use of the later mark is “without due cause”. This was initially in issue between Intel and CPM, since CPM argued before the IPO that it had due cause to use INTEL MARK. As noted by the Court of Appeal in *L'Oréal*, the onus of establishing “due cause” lies with the alleged infringer.<sup>68</sup> The Hearing Officer in *Intel* quoted the views of the Benelux Court, as approved by Neuberger J. in *Premier Brands UK Ltd v Typhoon Europe Ltd*,<sup>69</sup> that a third party has “due cause” to use a mark only if:

“... the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark.”

The Hearing Officer was not persuaded that CPM had due cause to use INTEL MARK. CPM did not pursue the point on appeal. The ECJ in *Intel* did not touch on this issue although, as noted above, further guidance may shortly be forthcoming in *L'Oréal*.

### Conclusion

Reputation-based invalidity and infringement define the very outer limits of the protection that can be conferred by a trade mark. In appropriate circumstances, the owner of a trade mark with a reputation can prevent the use of a similar mark in relation to any goods or services, irrespective of how dissimilar they may be from those sold under the owner's mark and notwithstanding the absence of any confusion. That remains the case. Indeed, the ECJ has confirmed that it is relatively easy to qualify for this sort of protection. All that is required is a sufficient reputation to cause the earlier mark to be called to mind when exposed to the later mark. However, the ECJ has also made it clear that reputation and a link are not enough. No remedy is available unless there is at least a serious risk of genuine injury.

So the INTEL mark qualifies for reputation-based invalidity and infringement protection:

“[The] reputation enjoyed by the INTEL mark would be sufficient for the average consumer to focus on INTEL in INTEL MARK at least so as to bring to mind the INTEL mark”.<sup>70</sup>

But a court is not compelled to accept that it will be diluted or otherwise injured by use of an identical or similar mark in any particular case. Indeed, a court should not accept any such assertion without proof that there is at least a serious risk that use of a later mark in connection with the specific goods or services in issue will result in an adverse change in the economic behaviour of relevant consumers. Only if there is a serious risk that use of INTEL MARK for marketing services will have an adverse impact on the economic behaviour of consumers of microprocessors and other computer-related products will Intel be entitled to prevent CPM's use of its mark. Nevertheless, the ECJ has left sufficient flexibility as to what makes a risk “serious” to ensure that a court can provide the necessary relief in an appropriate case.

The ECJ shed no light on the new requirement for “effect on economic behaviour” though this seems likely to equate to a reduced willingness on the part of consumers to purchase goods and services sold under the well-known mark (or, in the case of unfair advantage, an increased willingness to buy the goods sold under the later mark).

Although the ECJ expressly insisted on proof of a change in economic behaviour only in relation to **\*E.I.P.R. 336** dilution, there is no obvious reason to treat tarnishment (or, with appropriate revisions to the analysis, unfair advantage) any differently. It is necessary, as the Office of Harmonization for the Internal Market (OHIM) has previously said, to adduce evidence that will “demonstrate why and how damage could be caused”.<sup>71</sup> If there can be shown to be a serious risk of confusion, it is likely to be sufficient to demonstrate at least one relevant form of injury, most readily unfair advantage. Confusion will typically cause some change in economic behaviour, whether to the benefit of the infringer or to the detriment of the trade mark owner (or both).

The case underlines the fact that the outcome of such cases will be heavily dependent on the particular facts, in particular the degree of similarity between the relevant marks and goods and the degree of distinctiveness and reputation enjoyed by the well-known mark. While that can make it difficult to predict the outcome in individual cases, it seems logically right that the degree of reputation based protection available will depend upon the “strength” of the mark--its reputation, distinctiveness and the circumstances in which a similar mark is used. For very strong marks--KODAK, perhaps--it may be effectively impossible for a third party to use the same mark on any goods without creating not only a link, but a risk of confusion. If so, such use would almost certainly result in some form of detriment or unfair advantage and could be restrained. Whether the same would be true of a merely similar mark would depend on the facts, even for a mark with “huge reputation” for a broad range of goods.

The addition of further tests for a link and an effect on economic behaviour may be unattractive on its face, appearing further to complicate an already complex cause of action. However, the *Intel* approach has the virtue of being at least potentially easier to apply in practice than the somewhat nebulous and previously undefined concepts of detriment and unfair advantage. If this potential is realised, the *Intel* judgment may prove valuable to all trade mark owners and users.

### *Slaughter and May*

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1. *Intel Corporation Inc v CPM United Kingdom Ltd* (C-252/07) [2009] E.T.M.R. 13 (hereafter referred to as *Intel/ECJ*).
  2. *Intel Corporation Inc v CPM United Kingdom Ltd* [2007] EWCA Civ 431 (hereafter referred to as *Intel/CA*).
  3. Intel in fact relied on a number of registrations for the INTEL word, as well as registrations for a stylised representation of INTEL and a number of word and device registrations for INTEL INSIDE. (See the Annex to the Decision of the Hearing Officer at O/037/06, hereafter *Intel/IPO*.) However, the case proceeded primarily with reference to the INTEL mark alone and the other marks can, for present purposes, be ignored.
  4. In this article the term “well-known mark” will be used as a synonym for a “mark with a reputation”. It is not intended to refer to marks that qualify for protection under s.56 of the Trade Marks Act 1994.
  5. Directive 89/104 to approximate the laws of the Member States relating to trade marks (Trade Marks Directive) [1989] OJ L40/1; particularly art.4(4)(a) and art.5(2).
  6. The express wording of arts 4(4)(a) and 5(2) of the Trade Marks Directive cover only circumstances in which the later mark is registered or used for goods or services that are *dissimilar* to those for which the earlier mark is registered. However, in *Davidoff & Cie SA v Gofkid Ltd* (C-292/00) [2003] F.S.R. 28, the ECJ decided that these provisions also extend to cases in which the later mark is registered or used for similar goods and services.
  7. See Jacobs A.G.’s Opinion in *Adidas-Salomon AG v Fitnessworld Trading Ltd* (C-408/01) [2004] F.S.R. 21 at [37].
  8. See *Intel/ECJ* [2009] E.T.M.R. 13 at [29] where the European Court of Justice (ECJ) also refers to use of the later mark which “leads to dispersion of the identity and hold upon the public mind of the earlier mark”.
  9. *Adidas-Salomon* [2004] F.S.R. 21 per Jacobs A.G at [38], “the goods for which the infringing sign is used appeal to the public’s senses in such a way that the trade mark’s power of attraction is affected”.
  10. *Intel/ECJ* [2009] E.T.M.R. 13 at [24].
  11. *General Motors Corp v Yplon SA* (C-375/97) [2000] R.P.C. 572 and *Adidas-Salomon* [2004] F.S.R. 21.
  12. In *Intel/CA* [2007] EWCA Civ 431, Jacob L.J. at [25] described a trade mark law that would allow reputation-based invalidity or infringement to be established on the basis of a “calling to mind” alone as “oppressive and all powerful”.
  13. Before the Intellectual Property Office (IPO) and then on appeal to Patten J., Intel had alleged reputation-based invalidity on the grounds of unfair advantage, detriment to distinctive character and detriment to repute. See *Intel/IPO* and *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWHC 1878 (Ch) (hereafter, *Intel/HC*).
  14. See *Intel/IPO* at [43] and *Intel/HC* [2006] EWHC 1878 (ch) at [3].
  15. *Intel/CA* [2007] EWCA Civ 431 at [9].
  16. A concession that the Hearing Officer described (*Intel/IPO* at [89]) as “sensible” and (at [120]) as both “sensible and necessary”.
  17. The Hearing Officer considered this to be an “inevitable” concession in light of *Intel Corp Inc v Sihra* [2003] R.P.C. 44, in which Patten J. found (at [19]) that “by July 1995 the INTEL mark was widely known and recognised as a mark distinctive in its own right, with an established reputation in the eyes of the consumer in relation to computers and computer-linked products”. See *Intel/IPO* at [120].
  18. Intel initially contended that its marks were also used on a range of other branded products, including clothing, clocks, jewellery, dolls and novelty items and that these “non-computer” uses both generated significant income and extended the reach of the reputation attaching to the INTEL trade mark. See *Intel/IPO* at [3]. However, this argument was not pursued, a decision the Hearing Officer considered wise on the basis that the supporting evidence was “nowhere near strong enough”. See *Intel/IPO* at [71].
  19. Before the IPO, CPM also argued a defence of statutory acquiescence (see art.9 of the Trade Marks Directive). CPM claimed that Intel had known of its use of INTEL MARK for at least five years and, as such, was no longer entitled to invoke its own INTEL trade marks against CPM. The Hearing Officer considered that art.9 acquiescence requires only an assent to the relevant conduct without complaint. This acquiescence can arise in circumstances that would not satisfy the requirements of a common law estoppel (e.g. that some detrimental reliance must have been placed on the alleged acquiescence). See *Intel/IPO* at [49]. However, the Hearing Officer concluded

- on the evidence that CPM could not make out a case of acquiescence. See *Intel/IPO* at [66]. CPM did not appeal this decision (see *Intel/HC* [2006] EWHC 1878 (Ch) at [8]).
20. *Intel/IPO* at [115] and *Intel/HC* [2006] EWHC 1878 (Ch) at [8].
  21. *Intel/IPO* at [94].
  22. See *Intel/HC* [2006] EWHC 1878 (Ch) at [42].
  23. *Intel/CA* [2007] EWCA Civ 431 at [21] and *Intel/ECJ* [2009] E.T.M.R. 13 at [17].
  24. Since the case concerned an application to invalidate CPM's mark, it was the position as at the filing date of that mark that was in issue. Had Intel brought an infringement claim against CPM, the status of the INTEL mark as at the date of the claim would have been what mattered.
  25. Before the Hearing Officer, it was said that INTEL had been coined as an abbreviation of the phrase "INTEgrated ELEctronics" and INTELMARK as an abbreviation of "INTEgrated TELEphone MARKeting" (*Intel/IPO* at [85]). The Hearing Officer commented, however, that he did not consider that the derivation of INTEL and INTELMARK would be "particularly obvious to the public at large. More likely they would be seen as invented words." On appeal, Patten J. in fact said (*Intel/HC* [2006] EWHC 1878 (Ch) at [39]) that "INTEL is, of course, an invented word with no meaning or significance beyond the products which it identifies", a description accepted by the Court of Appeal (*Intel/CA* [2007] EWCA Civ 431 at [11]). Throughout, the case has proceeded on the basis that INTEL is an inherently distinctive mark.
  26. CPM did not accept that INTEL was unique and suggested it was for Intel to prove this was the case. However, Jacob L.J. noted (at *Intel/CA* [2007] EWCA Civ 431 at [10]) that CPM had tried and failed to identify any third party who also used the INTEL mark and concluded that it was "unrealistic to suppose that there is out there some other enterprise using Intel for some sort of goods or services". The INTEL mark could therefore be taken to be unique to Intel's business.
  27. *Intel/ECJ* [2009] E.T.M.R. 13 at [63].
  28. *Intel/CA* [2007] EWCA Civ 431 at [51].
  29. *Intel/CA* [2007] EWCA Civ 431 at [30].
  30. See for example *Adidas-Salomon* [2004] F.S.R. 21.
  31. *Davidoff* [2003] F.S.R. 28. If it were necessary to prove confusion, reputation-based infringement would be entirely redundant where the infringer's mark is used on similar goods or services. In such cases, there would be an infringement under art.5(1)(b) and it would be unnecessary to consider whether there was also some unfair advantage taken of, or detriment caused to, the earlier mark. Reputation-based invalidity would therefore be relevant only where dissimilar goods or services were in issue, negating the effect of *Davidoff*.
  32. See *Intel/CA* [2007] EWCA Civ 431 at [29].
  33. Sharpston A.G.'s Opinion in *Intel/ECJ* [2009] E.T.M.R. 13 at AG42.
  34. *Intel/ECJ* [2009] E.T.M.R. 13 at [48].
  35. *L'Oréal SA v Bellure NV* [2007] EWCA Civ 968 at [81] (emphasis added).
  36. *Arsenal Football Club Plc v Reed (C-206/01)* [2003] 1 C.M.L.R. 12 at [51].
  37. This is not to suggest that the ECJ ignores the need for causation. Ultimately, detriment must be "consequent on the use of the later mark" (*Intel/ECJ* [2009] E.T.M.R. 13 at [77]).
  38. *Intel/ECJ* [2009] E.T.M.R. 13 at [31] (emphasis added).
  39. *Intel/ECJ* [2009] E.T.M.R. 13 at [41].
  40. *Intel/ECJ* [2009] E.T.M.R. 13 at [46]-[48].
  41. *Intel/ECJ* [2009] E.T.M.R. 13 at [53].
  42. *Intel/ECJ* [2009] E.T.M.R. 13 at [34].
  43. *Intel/ECJ* [2009] E.T.M.R. 13 at [51]. This approach does seem to ignore the possibility that a trade mark might have one reputation among consumers of the goods sold under it (e.g. for high quality, technically advanced products) and a different reputation among other members of the public (e.g. for being a luxurious or exclusive brand). No doubt the "outsider" reputation in such cases will still be parasitic to some extent on the "insider" reputation (although it may also depend on the identity of the "insider" group and how they are perceived by "outsiders"), but it is not necessarily simply the same reputation writ large. In such a case, it will be important properly to identify the reputation that is said to be tarnished (or of which unfair advantage is said to be taken).
  44. *Intel/ECJ* [2009] E.T.M.R. 13 at [34].
  45. *Intel/ECJ* [2009] E.T.M.R. 13 at [56]. In fact, it is not certain that a unique mark will necessarily have a strong distinctive character. Suppose that instead of INTEL, the mark chosen by Intel for its microprocessors was COMPUTCHIP. This would, at best, be of limited inherent distinctiveness. Its distinctive strength would need to be acquired over time. Nevertheless, it may be that, despite the borderline descriptive nature of the mark, no one else has used the same mark for any goods or services. Such a mark might be unique while having significantly less distinctiveness than other marks that are not unique in the same way.
  46. *Intel/ECJ* [2009] E.T.M.R. 13 at [57].
  47. *Intel/ECJ* [2009] E.T.M.R. 13 at [68].
  48. *Intel/ECJ* [2009] E.T.M.R. 13 at [77].
  49. *Intel/CA* [2007] EWCA Civ 431 at [36].
  50. By Geoffrey Hobbs Q.C. sitting as the Authorised Person in *CA Sheimer Sdn Bhd's Trade Mark Applications* [2003] R.P.C. 484.
  51. Directive 84/450 [1984] OJ L250/17 as amended by Directive 97/55 [1997] OJ L290/18 (the Comparative Advertising Directive).
  52. *Electrocoin Automatics Ltd v Coinworld Ltd* [2004] EWHC 1498.
  53. Misleading advertising is defined in art.2(2) of the Comparative Advertising Directive as "any advertising which in any way, including its presentation, deceives or is likely to deceive the persons to whom it is addressed or whom it reaches and which, by reason of its deceptive nature, is likely to affect their economic behaviour or which, for those reasons, injures or is likely to injure a competitor".

- [54.](#) *Chartered Financial Analyst/CFA O/315/06*. In this case, the Hearing Officer was in fact considering the meaning of art.3(1)(g), which provides that a trade mark shall not be registered if it is "of such a nature as to deceive the public".
- [55.](#) *Intel/ECJ* [2009] E.T.M.R. 13 at [78].
- [56.](#) *Intel/ECJ* [2009] E.T.M.R. 13 at [38].
- [57.](#) *Intel/CA* [2007] EWCA Civ 431 at [37].
- [58.](#) *Intel/ECJ* [2009] E.T.M.R. 13 at [36] and [78].
- [59.](#) *L'Oréal* [2007] EWCA Civ 968 at [87] to [95].
- [60.](#) *L'Oréal* [2007] EWCA Civ 968 at [103] to [108].
- [61.](#) *Intel/ECJ* [2009] E.T.M.R. 13 at [34] to [36].
- [62.](#) *Intel/CA* [2007] EWCA Civ 431 at [34], emphasis in original.
- [63.](#) *Arsenal Football Club* [2003] 1 C.M.L.R. 12.
- [64.](#) That is, infringement under art.5(1)(a) of the Trade Marks Directive, which requires that the infringer be using a sign identical to the registered mark in relation to goods or services that are identical to those for which the mark is registered.
- [65.](#) Sharpston A.G.'s Opinion in *Intel/ECJ* [2009] E.T.M.R. 12 at AG13.
- [66.](#) *Arsenal Football Club* [2003] 1 C.M.L.R. 12 at [43].
- [67.](#) In his *L'Oréal* [2007] EWCA Civ 968 Opinion, Mengozzi A.G. reaffirms the principle that a trade mark has a variety of functions and concludes that the trade mark owner is entitled to protect more than just the essential function. He considers it to be settled by case law that art.5(1)(b) infringement arises only where the essential function is liable to be affected. But this is not the case with art.5(2) infringement and may not be the case with art.5(1)(a) infringement. Mengozzi A.G. concludes it is unclear whether it is possible to protect "non-origin" functions under art.5(1)(a) or whether the protection of such functions is confined to instances of reputation-based infringement under art.5(2). Unfortunately, he also concludes that is unnecessary to resolve this question for the purposes of answering the questions referred in *L'Oréal*. Nevertheless, the Opinion does appear to confirm that functions other than the essential function are engaged by art.5(2) at least, although according to Mengozzi A.G., this may be true only in cases of detriment. He doubts that cases of unfair advantage can, absent any tarnishment or dilution, be said to undermine or endanger any of the functions of a trade mark. This would suggest that the basis for legislating against "unfair advantage" infringement is fundamentally different from all other forms of infringement. See [31] to [60] of Mengozzi's A.G. Opinion.
- [68.](#) *L'Oréal* [2007] EWCA Civ 968 at [83].
- [69.](#) *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] EWHC 1557 (Ch).
- [70.](#) *Intel/HC* [2006] EWHC 1878 (Ch) at [42].
- [71.](#) *Elleni Holding BV v Sigla SA* [2005] E.T.M.R. 7 at [45].