

## REGISTERED TRADE MARKS AND DILUTION

### A British perspective

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### The Tempest

- Any registered mark with a reputation
- Unfair advantage to later mark owner
- Detriment to distinctive character of earlier mark owner
- Detriment to repute of earlier mark owner
  - Article 5(2) Trade Mark Approximation Directive



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### Or perhaps: A Comedy of Errors

- The U.S. experience
- Schechter: invented marks only



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## Measure for Measure

- A Tale of Two Mixers



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## As You Like It



Kenwood kMix

KitchenAid  
Artisan

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### All's Well that Ends Well

- “I think it would be excessive, in the realm of product shapes, to apply the concepts of ‘free riding’, ‘blurring’, ‘tarnishment’ or ‘dilution’ more generally so as to hold that the bodywork of the kMix was too close to the bodywork of the Artisan for the purposes of art. 9(1)(c) [CTMR]. I am not persuaded otherwise by the evidence indicating that consumers may or will be drawn into choosing the kMix by reason of its resemblance to the Artisan”, per Geoffrey Hobbs QC in *Whirlpool*



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### Much Ado about Nothing

- Intel
- Intelmark



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### What You Will

- For detriment to be found:
  - “Proprietor of earlier mark must ... prove that there is a serious risk that .. injury [to its mark] will occur in the future”
- Factors include ‘likelihood of confusion’. (Paras 37 & 38)



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### Love's Labour's Lost

- Where 'likelihood of confusion', a link between mark and sign 'is necessarily established' (para 57)
- Not so where mark is unique and has huge reputation (para 64)



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### Midsummer Night's Dream

- But: existence of link is not enough
- Proprietor must prove actual or present injury (or a serious likelihood of it in future)
- That means: "evidence of a change in the economic behaviour of the average consumer" of goods/services for which earlier mark registered (paras 71 and 77)



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### Back to the Future

- Back to pre Directive?
- Likelihood of confusion for Article 5(1)(a) identical/identical *and* Article 5(2)?



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### Merry Wives of Windsor

- Enough to drive the Dutch to drink?
  - But remember only gin not detergent.



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