CONTENTS

	Foreword by The Rt. Hon. Sir Robin Jacob	xvii
	Preface and Acknowledgements	xix
	Tables of Cases	XXV
	Table of Treaties and Legislation	lxxxi
	Abbreviations	lxxxvii
8.		
	A INTRODUCING TRADE MARK LAW	
1	Petty Matters: About this Book	
	A. Pedantry and conceptual preoccupation: the true signs of the	
	trade mark expert	1.01
	B. Conventions employed in writing this book	1.06
	C. Important definitions and distinctions	1.09
	D. A word about jurisdictions	1.25
	E. Case law	1.28
	F. Trade marks and history	1.38
2	Why Trade Marks?	
	A. Introduction	2.01
	B. The interested parties	2.05
	C. The function of the trade mark system	2.16
	D. Conclusion	2.59
3	Trade Mark Law and Trade Mark Registration Systems	,
	A. Introduction	3.01
	B. Sources of trade mark law	3.05
	C. Trade mark registration systems	3.19
	D. Community trade marks and the trade marks of EU Member	
	States	3.47
	E. Conclusion	3.52

B REGISTRABLE TRADE MARKS

í	Re	gistrability: The Basic Principles	
	A.	Introduction	4.01
	B.	Absolute bars to registration	4.16
	C.	Graphic representation and the function of the register	4.24
	D.	Signs may not be registrable if consumers do not regard them	
		as being trade marks	4.31
	E.	Signs which are not registrable on policy grounds	4.32
	F.	Signs which other traders may wish to use	4.50
	G.	Distinctiveness	4.88
	H.	Descriptive marks	4.128
	I.	Distinctiveness acquired through use	4.163
	J.	Relative grounds of unregistrability: a reminder	4.179
	K.	Conclusion	4.180
5	Re	gistrability of Specific Types of Trade Mark	
	A.	Introduction	5.01
	B.	Are there minimum and maximum criteria for registrability?	5.04
	C.	Identifiers which may not serve as trade marks	5.12
	D.	Cultural emblems	5.17
	E.	Locators	5.25
	F.	Issues relating to letters and numbers	5.30
	G.	Geographical marks	5.44
	H.	Trade dress and business formats	5.56
	I.	Names, titles and cultural icons	5.57
	J.	Slogans	5.73
	K.	Technology standards	5.78
	L.	Product surfaces and shapes	5.79
	M.	Non-traditional trade marks	5.117
	N.	Registration and the conduct of the applicant	5.145
	Ο.	Building up a portfolio of registrations in order to cover	
		unprotectable classes	5.146
	P.	Conclusion	5.151

6	Trade Marks and Generic Terms		
	A. Introduction	6.01	
	B. 'Fencing in the commons': competing public and private		
	claims upon words	6.07	
	C. Legal issues relating to generic terms	6.22	
	D. Conclusion	6.45	
	C LAWFUL AND UNLAWFUL USE OF TRADE MARKS		
7	Infringing Acts		
	A. Introduction	7.01	
	B. The scope of trade mark infringement	7.03	
	C. Specific instances of infringing use	7.16	
	D. Further observations concerning infringing use	7.26	
	E. The 'course of trade' requirement	7.38	
	F. Infringement by the trade mark owner	7.52	
	G. Secondary infringements and infringers	7.55	
	H. The United States perspective	7.63	
	I. Conclusion	7.65	
3	Non-infringing Acts		
	A. Introduction	8.01	
	B. Taxonomy of non-infringing acts	8.02	
	C. Acts for which specific defences are provided	8.13	
	D. Acts which are permitted in principle, even without a statutory		
	defence	8.52	
	E. Limitation of actions	8.90	
	F. Comparative advertising	8.93	
	G. The effect of consent	8.177	
	H. Conclusion	8.179	
9	Exhaustion of Trade Mark Rights		1
	A. Introduction	9.01	
	B. The legal basis of modern exhaustion law	9.22	
	C. The requirement of consent	9.36	
	D. Legitimate reasons for prohibiting further use of a trade mark	9.53	

	E. Exhaustion and its relationship with other legal rights	9.65
	F. Some interesting problems relating to exhaustion	9.75
	G. Conclusion	9.95
10	Identical and Similar Marks, Goods and Services	
	A. Introduction	10.01
	B. Identical and similar marks	10.10
	C. Identical and similar goods and services	10.76
	D. Likelihood of confusion	10.103
	E. Likelihood of association	10.143
	F. Conclusion	10.156
11	Reputation, Unfair Advantage and Detriment	
	A. Introduction	11.01
	B. Reputation	11.30
	C. Unfair advantage and detriment	11.52
	D. Conclusion	11.95
12	Well-known Marks, Famous Marks and Dilution	
	A. Introduction	12.01
	B. Europe	12.25
	C. Famous mark protection in the United States	12.49
	D. Conclusion	12.69
13	The Killing Fields: Opposition, Cancellation and Revocation	
	A. Introduction	13.01
	B. Opposition	13.16
	C. Cancellation	13.35
	D. Revocation	13.46
	E. Suspension of trade mark applications and of hostilities in	
	general	13.70
	F. Trade mark systems and 'bad faith'	13.72
	G. Conclusion	13.149

14	Trade Marks in Court		
	A. Introduction		14.01
	B. Preliminary issues in trade mark litigation		14.06
	C. Injunctive relief		14.29
	D. Pecuniary relief		14.76
	E. Dealing with infringing goods		14.95
	F. Liability for making groundless threats		14.101
	G. Declaration of non-infringement		14.116
	H. Competition law		14.118
	I. Conclusion		14.123
	D TRADE MARKS IN INDUSTRY	AND COMMER	CE
15	Transactions Involving Trade Marks		
	A. Introduction		15.01
	B. The nature of trade mark transactions		15.02
	C. Basic legal provisions governing transactio	ns	15.14
	D. Classification of trade mark licences		15.26
	E. The consequences of being a licensee		15.35
	F. Internal transactions and external transact	ions	15.42
	G. Some examples of trade mark transactions		15.47
	H. Important issues in trade mark licences		15.71
	I. Litigation of trade mark transactions		15.88
	J. The valuation of trade marks		15.93
	K. Conclusion		15.98
16	Trade Marks in Specific Sectors		
	A. Introduction		
	B. Pharmaceutical marks		16.01
	C. Retail sales service marks		16.37
	D. Celebrity trade marks		16.50
	E. Conclusion		16.73

17	Trade Marks on the Internet	
	A. Introduction	17.01
	B. Use of another's trade mark as a domain name	17.02
	C. Use of another's trade mark on a web page	17.51
	D. Use of another's trade mark as a metatag	17.64
	E. Use of another's trade mark as the name of an Internet service	
	provider	17.73
	F. Conclusion	17.74
18	Geographical Indications and other Forms of Protection	
	A. Introduction	18.01
	B. The protection of geographical indications	18.04
	C. GIs in the European Union	18.21
	D. GIs under national law in Europe	18.38
	E. The interface between GI protection and trade mark protection	18.41
	F. Case law of the European Court of Justice	18.47
	G. Future plans for GIs	18.52
	H. Company name registrations	18.54
	I. Protection of titles	18.55
	J. Certification marks, guarantee marks and collective marks	18.56
	K. Conclusion	18.60
	E ISSUES FOR TRADE MARK OWNERS	
19	Choosing a Trade Mark	
	A. Introduction	19.01
	B. Legal considerations	19.03
	C. Cultural considerations	19.10
	D. Business considerations	19.19
	E. Psychological considerations	19.24
	F. Conclusion	19.25
20	The Psychology of Trade Marks	
	A. Introduction	20.01
	B. The trade mark as an icon of brand loyalty	20.03

	C. Branding strategy in action	20.13
	D. Some aspects of brand psychology	20.26
	E. Conclusion	20.32
21	Trade Marks, Images, Icons and Social Responsibility	
	A. Introduction	21.01
	B. No Logo: the thesis	21.03
	C. No excuse: formulating a response	21.15
	D. No chance: brand power and goodwill	21.24
	E. No change: why the public's best weapons may never be adequately utilized	21.29
	F. No fear: why the consumer apocalypse may never happen	21.38
	G. No Armageddon: the threat of trade mark litigation	21.40
	H. Conclusion	21.44
Bib	liography	669
	essary	681
Ind	lex of Word Marks	689
Ind	lex	701