Rights beyond the registration: from black and white to grey

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The boundaries that frame intangible subject matter are blurred. A tangible asset has physically delimited edges, making it clear where that object starts and ends. Intellectual property can be embodied in a tangible asset. However, there are no bright lines to determine what subject matter is captured by the intellectual property right in question. This issue is inherent and unavoidable when granting rights over a non-rivalrous and non-excludable resource.[1]

Some intellectual property rights have more precise boundaries than others. Specifically, the subject matter of registered intellectual property rights ('RIPRs') needs to meet the procedural requirements prescribed by legislation and the internal rules of the relevant examining body in order to be added to the register. The rules often require a combination of visual depictions and objective specifications that clarify what is being claimed and what is not.[2] Imprecision is usually penalized, whether through rejection of the application or the risk of invalidation proceedings post-grant. In the circumstances, it is tempting to think of RIPRs as having clear boundaries: the subject matter is precisely delineated, in black and white.

RIPRs are often described as true monopoly rights in the sense that infringement does not require copying.[3] Whether the defendant has, as a matter of fact, copied the claimant's RIPR is irrelevant for the purposes of determining infringement. If the defendant's creation is wholly independent, that is usually something taken

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This article

- This article considers how the scope of registered intellectual property rights extends beyond what is visible in black and white on the relevant register.
- In relation to patents, registered designs and trade marks, the register does not give the complete picture. Rather, the rights of the proprietor extend into a grey area, beyond the registration. The effect of this is amplified search costs when conducting freedom to operate analysis.

into account when addressing quantum.[4] One of the justifications for this approach is that it is perfectly feasible, although at times difficult, to search for and identify RIPRs, thereby presenting a defendant with the opportunity to avoid infringing.[5] The register serves as a notice to the world. Where a party fails to properly consult the relevant register or, having done so, elects to sail close to the wind, they do so at their own risk.

By contrast, unregistered intellectual property rights ('UIPRs') are not available on a public database for inspection. One of the fundamental reasons for not requiring UIPRs to be registered is practicality. For example, it would be impossible to search the entire body of copyright works or unregistered UK design rights due to the speed and ease with which such rights come into existence.[6] Therefore, copying is a necessary component in determining whether UIPRs have been infringed.

1 D Burk 'Law and Economics of Intellectual Property: In search of first principles' (2012) UC Irvine School of Law Research Paper No 60. See also, M Lemley 'Ex Ante v Ex Post Justifications for Intellectual Property' (2004) 71 *University of Chicago Law Review* 129.

2 For UK registered designs, the UKIPO's form DF2A and guidance notes requires an applicant to state exactly what the design is (section 6) and provide illustrations in the form of line drawings, CAD or photographs showing the design as it appears to the eye (section 7). Applicants may also include a limitation or disclaimer (section 8). A patent application filed at the UKIPO must include an abstract, drawings, a description and the claims.

3 See, for example, Martin Howe QC, James St. Ville and Ashton Chantrielle, *Russell-Clarke & Howe on Industrial Designs* (Sweet & Maxwell, 9th Edn, 2016) at [4–098].

4 For example, section 62 of the Patents Act 1977 states that no order for damages or an account of profit shall be made against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.

5 Richard Posner, 'The Law & Economics of Intellectual Property' (2002) 131 *Daedalus* 5.

6 Of course, certain copyright works, such as literary, dramatic and musical works carry fixation requirements and artistic works are, by their very nature, physically embodied. Unregistered UK design rights must also be fixed, whether in an article or design document.

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As stated, one of the justifications for the distinction between UIPRs and RIPRs in terms of evidencing copying is that RIPRs are available for inspection. It is clear whether a *prima facie* right exists because it is visible in black and white. However, it is submitted that the boundaries of RIPRs are not so clear. The precise scope of the legal monopoly is not entirely ascertainable from the register. Rather, a party must look elsewhere in order to determine the scope of the right being claimed. This article will examine the grey area that surrounds RIPR: the rights beyond the registration.

Patents

In the UK, a patent confers a 20-year legal monopoly over an invention. The patentee has the exclusive right to prevent third parties from doing certain things in relation to that invention. In exchange for the 20-year monopoly, the patentee discloses the invention to the world in technical detail, thereby disseminating information and enriching the pool of knowledge available to third parties. This social bargain is predicated on the patentee clearly specifying the limits of the legal monopoly that they are claiming,[7] as monopolies stifle competition. The grant of an exclusive, anticompetitive right is justified by the detailed disclosure, which allows the person skilled in the art to work the invention: what has been termed the 'exchange for secrets' theory.[8]

A patent application filed at the UK Intellectual Property Office (UKIPO) must include an abstract, any drawings used to illustrate the invention, a description and the claims. The claims summarize the technical features over which legal protection is sought. At first blush, the boundaries of the patented subject matter appear to be relatively clear and precise. Indeed, if the invention is not disclosed clearly enough and completely enough for it to be performed by a person skilled in the art, the patent is vulnerable to revocation.[9] Long argues that objective and verifiable characteristics lower the information costs incurred in understanding the boundaries of what is claimed for the purposes of avoiding infringement.[10] Articulating the invention's boundaries through necessary and sufficient characteristics acts as a content notice.[11] For this reason, any actual knowledge of and/or intention to copy the patented invention is irrelevant to determining infringement, save for in limited circumstances.[12] A party must, therefore, incur increased costs in searching the patent register to ensure freedom to operate.[13]

However, patented inventions have blurred boundaries. The legal monopoly resides over those technical attributes of the invention that are listed in the claims. Given those attributes are confined to writing, their breadth must be construed. Claim construction is necessary for the purposes of determining validity, by comparing what is claimed with the prior art, and for determining infringement, by assessing whether certain acts fall within the scope of the claims. The European Patent Convention provides that the protection conferred by a patent shall be determined by the claims, as interpreted using the description and drawings,[14] such that claim construction occupies a middle ground between two extremes: a strict, literal interpretation and treating the claims as mere guidelines.[15] Ultimately, the claims convey to the public what monopoly the patentee has chosen to obtain.[16] The patentee is perfectly free to claim less than the patent teaches, but not more.

The UK has favoured a purposive approach to claim construction, requiring the skilled person to consider what the patentee was claiming in light of background facts.[17] However, in *Actavis v Eli Lilly*, the Supreme Court held a patentee's rights cover not only subject matter falling within a literal interpretation of the claims but also immaterial variants.[18] In his leading speech, Lord Neuberger stated that, when interpreting whether a variant falls within the claims, the correct approach is to ask: (i) notwithstanding that it is not within the literal meaning of the relevant claim, does the variant achieve substantially the same result in substantially the same way as the invention?; (ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same

7 See *Terrell on the Law of Patents* (Sweet & Maxwell, 2021) at [1–91].

8 See Fisher's comprehensive analysis of the theories that underpin the patent system in, Fisher 'Classical Economics and Philosophy of the Patent System' (2005) 1 *IPQ* 1.

9 Section 72(1)(c) of the Patents Act 1977.

10 Long, 'Information costs in patent and copyright' (2004) 90 *Virginia Law Review* 465 at 469.

11 Fromer, 'Claiming Intellectual Property' (2009) 76 *The University of Chicago Law Review* 719.

12 *Terrell on the Law of Patents* (Sweet & Maxwell, 2021) at [14–52] to [14–55], which includes (i) an offer of a process for use; (ii) claims that are limited by the use or purpose of the product and (iii) indirect infringement through the supply of means essential for putting the patent into effect.

13 Long, 'Information Costs in Patent and Copyright' (2004) 90 *Virginia Law Review* 465 at 469.

14 Article 69(1) of the European Patent Convention, 17th edition 2000.

15 Article 1 'General Principles' of the Protocol of the European Patent Convention, 17th edition 2000. Section 130(7) of the Patents Act 1977 has been framed so as to have the same effect in the UK.

16 Laddie J in *Merck & Co Inc v Generics (UK) Ltd* [2004] R.P.C. 31 at [38].

17 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, *Improver Corp v Remington Consumer Products Ltd* [1990] FSR 181 at 189, *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183.

18 *Actavis UK Limited & Ors v Eli Lilly and Company* [2017] UKSC 48.

way as the invention? and (iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim was an essential requirement of the invention?[19] If the answer to the first two questions is 'yes' and the answer to the third question is 'no', the variation is immaterial and falls within the scope of the claims. The Court of Appeal and High Court have since clarified that the 'literal' meaning of the claims means the normal or purposive approach to claim construction.[20]

It is important to interpret the patent's claims in the context in which they were drafted. The patentee is attempting to describe the parts of the invention over which they are seeking a legal monopoly. Often, the claims will fail to capture the inventive concept in its entirety. This is because the drafting seeks to be optimally inclusive without risking the validity of the application.[21] Nevertheless, what you see written in black and white in the body of the patent is not what you get. Rather, the patentee's rights extend to any immaterial variants, which exist in a grey area outside of what is represented in the patent document. Extending legal protection of a patented invention beyond the literal words of the claims may, arguably, compromise the public's right to notice of what acts will infringe.[22] Not only must a party scour the patent register so as to ascertain what legal monopolies exist over the technology in that field, they must also analyse which variants of the invention represented in the patent may comprise an 'immaterial variant'. This amplifies the search costs a party must incur when ensuring freedom to operate. It may also force parties to reconsider existing freedom to operate analyses that pre-date the Supreme Court's judgment in *Actavis*.[23]

Registered Designs

Following the UK's decision to leave the EU, at 11 pm on 31 December 2020, the UK–EU transition period came to an end. The UK now recognizes several different forms of registered design: (i) the UK registered design; (ii) the re-registered design, comprising a comparable UK design registration automatically created for proprietors of a registered Community design as at 31 December 2020 and (iii) a re-registered international design, comprising a comparable UK design registration automatically created for proprietors of an international design registration that designated the EU as at 31 December 2020.

In the UK, a protectable design can comprise the whole or part of a product resulting from the features of lines, contours, colours, shape, texture or materials of the product or its ornamentation.[24] There is no requirement for the design in question to have any artistic merit, in the sense that it is attractive or ugly to look at.[25] However, to be valid, the registered design must be new and have individual character: (i) an identical design must not have been made available to the public prior to the relevant date; and (ii) the design must produce a different overall impression on the informed user than the overall impression produced by any design made available to the public prior to the relevant date.[26] After grant, the proprietor may benefit from a 25-year monopoly over articles, which do not produce a different overall impression on the informed user to the design, subject to the payment of renewal fees.[27]

A registered design protects the look of the product. When issuing the application with the UKIPO, the applicant must specify what the design is and provide visual representations of the design. This may include disclaimers or limitations so as to make clear what is and is not being claimed in the visual representation as forming part of the design sought. The applicant may claim the shape of the article or product, rather than its surface pattern, or limit the scope of the design to specific features such as the handle on a cup or the lack of surface ornamentation thereof.[28] Again, copying is irrelevant for the purposes of determining infringement.[29] Where the infringing product was designed independently and the defendant was not aware, nor could reasonably have known, that the registered design existed, damages will not be awarded.[30] However, a party can inspect the register to ascertain what *prima facie* valid rights exist in

19 *Actavis UK Limited & Ors v Eli Lilly and Company* [2017] UKSC 48 at [66].

20 See Lord Justice Kitchin in *Icescape v Ice-World* [2018] EWCA Civ 2219 at [60] and Mr Justice Arnold in *Akebia Therapeutics Inc & Ors v Fibrogen Inc & Ors* [2020] EWHC 866 (Pat) at [416]. For authority as to the continuance of the UK's purposive approach, see the judgments of Mr Justice Arnold in *Generics (UK) Ltd v Yeda Research and Development Co Ltd* [2017] EWHC 2629 (Pat) at [138], Richard Meade QC in *Fisher & Paykel Healthcare Ltd v ResMed Ltd* [2017] EWHC 2748 (Ch) at [86], Mr Justice Henry Carr in *Illumina v Premaitha* [2017] EWHC 2930 (Pat) at [202], Mr Justice Birss in *Liqwd Inc v L'Oréal UK Ltd* [2018] EWHC1394 (Pat) Birss J [59].

21 Chronopoulos 'Reconstructing the Complete Patent Bargain: the Doctrine of Equivalents' (2020) 2 *IPQ* 138 at 154.

22 W Adams, 'The Doctrine of Equivalents: Becoming a Derelict on the Waters of Patent Law' (2005) 84 *Neb L Rev* 1113 at 1123.

23 Shah, Raeburn and Sheraton 'Actavis v Eli Lilly: English Supreme Court shakes up approach to patent infringement by equivalents' (2017) 39(12) *EIPR* 778.

24 Section 1(2) of the Registered Designs Act 1949.

25 *Lindner Recyclingtech GmbH v Franssons Verkstäder AB* (R 690/2007-3) [2010] E.C.D.R. 1 (OHIM 3rd Board of Appeal, 2009) at [35].

26 Section 1B of the Registered Designs Act 1949.

27 Section 8 of the Registered Designs Act 1949.

28 *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWCA Civ 1339.

29 *Russell-Clarke & Howe on Industrial Designs* (Sweet & Maxwell, 2016) at [4–098].

30 Section 24B of the Registered Designs Act 1949.

relation to the product in question. Although registered designs are subject to a less rigorous examination process than a patent, the fact that the proprietor has gone to the effort to register their design signals a willingness to take enforcement action if necessary. Nevertheless, even the ability to frame the scope of the design claimed by the proprietor does not eradicate blurred boundaries.

When it comes to assessing whether a registered design has been infringed, the most important thing for the court's analysis is what the design, the accused object and the prior art look like.[31] Articulating what each looks like takes longer than seeing what each looks like.[32] When considering infringement, the proprietor of the design has the exclusive right to use the design *and* any design that does not produce on the informed user a different overall impression.[33] For the purposes of determining whether a design produces a different overall impression on the informed user, the degree of design freedom in creating the design is taken into account.[34] As such, the proprietor's rights extend beyond an exact imitation of the design that is visible on the register. The monopoly captures anything that is too close in terms of similarity to the registered design, assessed through the eyes of the 'informed user'. The informed user is a legal fiction, comprising an individual with knowledge of the design corpus and features normally included in the relevant sector, who is interested in the products and has a high degree of attention when using them.[35] It is only when considering the registered design through that lens that a defendant can appreciate the scope of the rights belonging to the proprietor.

Furthermore, the scope of those rights is influenced by the degree of design freedom available to the designer. Where the degree of design freedom is limited, smaller differences will be enough for the defendant's product to create a different overall impression on the informed user and, thereby, not infringe. However, where the degree of design freedom is broad then a greater number of differences are required to take the product outside of the scope of the rights in the registered design. Similarly, novel or striking registered designs create a greater overall impression on the informed user where they are not surrounded by kindred prior art.[36] The protection afforded to such designs is greater than that afforded to a design that is only incrementally different to the prior art.[37] The degree of design freedom may be something that is limited by the technical specification of the product embodying the design.[38] In the circumstances, a party must analyse the design corpus and assess (1) how pioneering the design actually is when compared with the prior art and (2) whether certain features are limited by the degree of design freedom before they can understand the scope of the rights in the design. Surprisingly, the Supreme Court's judgement in *PMS v Magmatic* ('Trunki') was decided differently in the sense that an 'original and clever' product was deemed not to have been infringed due, in part, to the specific visual representation of the design.[39]

As well as being criticized by commentators,[40] the decision in *Trunki* has further blurred the boundaries of registered design rights, albeit to the detriment of proprietors. The Supreme Court interpreted the tonal shading in a CAD drawing representation of the design as an important feature that was not present in the defendant's product. As a result, where the visual representation of the design contains tonal colour contrast, it must be taken into account in limiting the scope of the design.[41] This has created unpredictability as to how the visual representation of the design may be interpreted by the courts going forward. Line drawings offer the widest scope of protection but are vulnerable to attacks on validity, whereas a detailed CAD drawing has more specificity but with narrower rights.[42] The current UKIPO guidance is that apparently incidental features that appear in CAD drawings or other representations may very well be taken into account by a court or tribunal so as to restrict the scope of the rights claimed.[43] Where the precise boundary of the rights lie is something which the parties are not easily able to ascertain *ex ante*.

It is clear that the proprietor of a registered design has rights that extend beyond what is represented in black

31 *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited* [2007] EWCA Civ 936 at [3] and *Dyson Limited v Vax Limited* [2011] EWCA Civ 1206 at [8] and *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWCA Civ 1339 at [28].

32 *Philips v Remington* [1998] RPC 283 at 318.

33 Section 7(1) of the Registered Designs Act 1949.

34 Section 7(3) of the Registered Designs Act 1949.

35 Case C-281/10P *Pepsico Inc v Grupo Promer Mon Graphic SA v. OHIM*, ECLI:EU:C:2011:679 at [59] to [62].

36 HHJ Fysh's remarks in *Woodhouse v Architectural Lighting Systems* [2006] RPC 1 at [58].

37 *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited* [2007] EWCA Civ 936.

38 *Dyson Limited v Vax Limited* [2011] EWCA Civ 1206 at [19].

39 *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12 at [57].

40 See Sara Ashby, 'The UK Supreme Court and the Trunki case: Missed Opportunities, Mysteries and Misunderstood' (2016) 38(9) *EIPR* 527–32 and David Stone, 'Trunki – How did Things Go So Wrong?' (2016) 11(9) *JIPLP* 662–81.

41 *Shnuggle Limited v Munchkin Inc and Lindam Limited* [2019] EWHC 3149 (IPEC) at [37].

42 Trimmer and Parsons, 'Trunki's crazy (registered design) ride: PMS International Group Plc v Magmatic Ltd' (2016) 38(7) *EIPR* at 458.

43 Paragraph 12 of the UKIPO Statutory Guidance, DPN1/16: Guidance on the use of representations when filing Registered Design applications, published by the Office on 1 June 2016.

and white on the register. Those rights encompass any design that does not produce a different overall impression on the informed user, factoring in the design corpus and the striking or pioneering nature of the design when compared with the prior art. Those rights exist in a grey area outside of what is represented on the register. Similarly, following the Supreme Court's judgment in *Trunki*, the visual representation of the design may be such that apparently incidental features act to constrict the design. In those circumstances, the rights are constrained to a grey area somewhere within what is contained in the register. Either way, the precise boundaries are blurred.

The analysis a party must consider when determining the scope of the rights must also cover registered designs subsisting in products that are different in nature to that which the party is considering launching. Specifically, the rights in the registered design apply to *any* sort of product even where the registration contains an indication of the type of article for which the design is intended.[44] By way of example, the design rights in the handle of a gun[45] could be infringed by the design of the handle of an umbrella,[46] despite the fact that the products have completely different uses.

Trade Marks

Trade marks differ to registered designs and patents in the sense that, ordinarily, they are self-contained. What is protected exists independently of any physical object and is not embodied in any product or article, save for where the trade mark comprises the shape of the good itself and/or the relevant packaging for the good. Traditionally, the trade mark is affixed to packaging, marketing and/or other such advertising material for the purposes of indicating the trade origin of the goods and/or services in question. In the UK, a trade mark is a sign. The sign may consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging. Crucially, the sign must be capable of (1) being represented in the register in a manner that enables third parties to determine the clear and precise subject matter of the protection and (2) distinguishing goods or services of one undertaking from those of other undertakings.[47] Previously, a sign needed to be represented graphically, which the case law of the Court of Justice of the European Union determined as requiring the sign to be clear, precise, self-contained, easily accessible, intelligible, durable and objective.[48] Graphic representation has been replaced by the need for the sign to be clear and precise.[49] A sign that fails to satisfy these requirements shall not be registered under the absolute grounds of refusal.[50]

The requirement that the subject matter of the protection be clear and precise suggests that, *prima facie*, the boundaries of the proprietor's rights are clearly defined. Indeed, a sign that is capable of many permutations will be either rejected or vulnerable to validity attacks post-registration. Unorthodox signs such as colours *per se*,[51] shapes[52] or smells[53] most often fall foul of this requirement, but the threshold applies equally to all signs including words and figurative device marks. However, like patents and registered design rights, what is represented in the register is not a holistic representation of the proprietor's rights. Rather, the boundaries of those rights extend beyond the registration.

The proprietor of the trade mark is entitled to prevent third parties from using identical signs in relation to identical goods and services, where that use adversely affects the trade mark's function.[54] This 'double identity' infringement protects against third party use of precisely what is ascertainable from the register, in black and white. However, the proprietor is also entitled to prevent third parties from using *similar* signs in relation to *similar* goods and services where that use causes consumer confusion.[55] Additionally, where the trade mark in question is reputable, the proprietor is entitled to prevent the use of *similar* signs where that use takes unfair advantage of or is detrimental to the distinctive character or reputation

44 *Russell-Clarke & Howe on Industrial Designs* (Sweet & Maxwell, 2016) at [2–030].

45 A projectile weapon in Class 22–01 of The Locarno Classification, established by the Locarno Agreement (1968).

46 Class 03–03 of The Locarno Classification, established by the Locarno Agreement (1968).

47 Section 1 of the Trade Marks Act 1994.

48 C-273/00, ECLI:EU:C:2002:748 *Sieckmann v Deutsches Patent- und Markenamt*.

49 The reform was introduced through Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of Member States relating to trademarks, OJ L 336/1, 23 December 2015.

50 Section 3(1) of the Trade Marks Act 1994.

51 See, for example, Case C-104/01, ECLI:EU:C:2003:244 *Libertel Groep BV v Benelux-Merkenbureau* (regarding the colour orange), Case C-49/02, ECLI:EU:C:2004:384 *Heidelberger Bauchemie GmbH* (regarding the colours blue and yellow), *Glaxo Wellcome UK Ltd & Anr v Sandoz Ltd* [2017] EWCA Civ 335 (regarding the colour purple applied to an inhaler).

52 See C-321/03 ECLI:EU:C:2007:51 *Dyson Ltd v The Registrar of Trade Marks* (a transparent collecting bin) and *JW Spear & Son Ltd & Ors v Zynga Inc* [2013] EWCA Civ 1175 (a tile).

53 (C-273/00, ECLI:EU:C:2002:748) *Sieckmann v Deutsches Patent- und Markenamt* (an olfactory mark).

54 Section 10(1) of the Trade Marks Act 1994. (C-206/01, ECLI:EU:C:2002:651) *Arsenal Football Club Plc v Reed*, (C-48/05, ECLI:EU:C:2007:55) *Adam Opel AG v Autec AG*, (C-236/08, ECLI:EU:C:2010:159) *Google France Sarl v Louis Vuitton Malletier SA*, (C-487/07, ECLI:EU:C:2009:378) *L'Oreal SA v Bellure NV.*

55 Section 10(2) of the Trade Marks Act 1994, *Datacard Corp v Eagle Technologies Ltd* [2011] EWHC 244 (Pat) at 266, *Interflora Inc v Marks & Spencer Plc* [2014] EWCA Civ 1403.

of the mark.[56] In both instances, the scope of the rights reaches beyond the terms of the register and captures a constellation of actual or hypothetical signs and potentially related goods or services.[57] This grey area has been described in US proceedings as a penumbra.[58]

For the purposes of determining infringement, the assessment of the similarity of the goods and services and whether consumers are likely to be confused must be conducted through the eyes of the average consumer of the goods and services in question.[59] The average consumer is a legal construct. They are deemed to be reasonably well-informed and reasonably circumspect and observant but rarely have the chance to make direct comparisons between marks and must, instead, rely upon the imperfect picture in their mind, and whose attention varies according to the category of goods or services in question.[60] In this sense, any freedom to operate analysis to determine whether a proposed sign will infringe a registered trade mark must be conducted through the eyes of the average consumer. How the average consumer perceives the sign and the mark, in relation to the goods and services in question, is not something that can be determined simply by looking at the register. For instance, it may require consideration of how the proposed sign is going to be used in the market and/or in relation to the good or service.

Similarly, for the purposes of determining whether the average consumer is likely to be confused by the use of a similar sign in relation to similar goods or services, the court must take into account the distinctiveness of the trade mark.[61] There will be a greater likelihood of confusion where the trade mark has a highly distinctive character either per se or as a result of the use which has been made of it.[62] This is a real-life, practical issue. Third parties must consider whether a mark has acquired enhanced distinctiveness through use, which is not capable of determination simply by reviewing what is contained in the register.[63] For the purposes of section 10(3)[64] infringement, the trade mark must have a reputation. That reputation must exist in a significant part of the territory concerned.[65] Whilst, in some instances, establishing that a trade mark carries a reputation in the relevant territory may not be evidentially onerous,[66] it is something a third party can only ascertain by analysing the market, not the register. Of course, the proximity of the relevant goods and services and the familiarity with the market may mean that a third party is aware of a trade mark's reputation in any event. Nevertheless, it is an attribute of a trade mark that sits outside the register.

It is clear that, when considering the scope of the proprietor's rights in a registered trade mark, a party must look further than what is visible in black and white. Those rights extend into a grey area or penumbra, requiring a detailed consideration of factors that exist beyond the registration.

Conclusion

This article has considered three types of RIPRs: patents, registered designs and trade marks. Each of these RIPRs encompass more than what is visible in black and white on the relevant register. The relevant registers are freely available for public inspection. This is one of the reasons why, unlike UIPRs, copying is not an evidential requirement for establishing infringement. For RIPRs, a party has the opportunity to carry out a detailed review of the relevant databases and make an informed decision as to how best to proceed. This requires the party to incur search costs. Yet, the register is not the complete picture. The rights of the proprietor extend further into a penumbra, requiring a more detailed analysis when determining freedom to operate. This amplifies the search costs a party must incur in exploring that grey area, where rights exist beyond the registration. A comprehensive analysis of whether the law should extend the boundaries of RIPRs into said grey area is beyond the scope of this article. Nevertheless, it is submitted that said grey area is necessary to strike a fair balance between protecting the contribution in which rights are claimed by the proprietor and the freedom of third parties to compete without straying into the boundaries of a claimant's legal monopoly.

56 Section 10(3) of the Trade Marks Act 1994, (C-487/07, ECLI:EU:C:2009:378) *L'Oreal SA v Bellure NV, Interflora v Marks & Spencer* [2014] EWCA Civ 1403.

57 Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2004) 51 *UCLA L. Rev*. 621, at 624.

58 Judge Hand in Lander, *Frary & Clark v. Universal Cooler Corp*., 85 F.2d 46, 48 (2d Cir. 1936).

59 See Chapter 3 in *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 2020) for a more detailed discussion of the concept of the 'average consumer' in trade mark law.

60 *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at [128].

61 *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 2020) at [16–102].

62 (C-39/97) ECLI:EU:C:1998:442 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*.

63 *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24.

64 S 10(3) Trade Marks Act 1994.

65 (C-375/97)ECLI:EU:C:1999:408 *General Motors v Yplon*.

66 Arnold J (as he then was) in *Och-Ziff Management Europe Ltd v OCH Capital LLP* [2010] EWHC 2599 at [125].