

## BOOK REVIEW

### TRADE MARK LAW AND SHARING NAMES: EXPLORING USE OF THE SAME MARK BY MULTIPLE UNDERTAKINGS

*Ilanah Simon Fhima (ed)*

Cheltenham: Edward Elgar, 2009, 209pp, £59.95, ISBN 978-1847202796 (hbk)

Name sharing is a situation when a trade mark owner and another trader or manufacturer use or share the same (or at least a similar) trade mark at the same time. This could be willingly with the consent of the trade mark owner or unwillingly without the trade mark owner's consent (which is called the "infringement-type"). Sharing names in trade marks is a very interesting subject because it impacts upon every aspect of trade mark law – from registration to litigation and other transactions related to trade marks.

This book is edited by Ilanah Simon Fhima, Lecturer and Co-Director, Institute of Brand and Innovation Law, University College London, UK, and has eleven other contributors. The book uses, to good effect, historical and interdisciplinary perspectives to examine both theoretical and practical implications of name sharing for the parties of the process. The book is divided into four parts. The first is an overview in which Fhima introduces the legal issues that the book addresses and presents an outline of the book in general. In this part Fhima notes that the interests of trade mark owners are mainly in getting legal recognition for the ways that they voluntarily share their trade marks and to protect their trade marks from involuntary sharing which could occur from other traders using their trade marks without their consent. In this part sharing names is also looked at from an economic perspective by Andrew Griffiths. He discusses the issue of sharing names and its effect on the essential function of the trade mark and he distinguishes between the economic effects of voluntary and involuntary name sharing.

The second part of the book deals with the registration issues concerning name sharing. Starting with the rise and fall of honest concurrent use, Philip Johnson discusses the origins of this rule, its development and finally its death after the enactment of the United Kingdom's *Trade Marks Act 1994*. An important issue discussed in this part is the "Coexistence in Community" trade mark dispute. The impact of coexistence on the outcome of the dispute is examined, like its impact on the likelihood of confusion in addition to its impact on actions based on damage caused to, or on unfair advantage taken of, the repute or distinctive character of the earlier trade mark. The impact of coexistence on the earlier mark's scope of protection is discussed by Arnaud Folliar-Monguiral and his point of view is that the indirect impact of the coexistence is more important than the direct impact recognised by the courts.

The approach of the UK-IPO to co-ownership of registered trade marks is highlighted by Edward Smith who reaches the conclusion that the registry does not see itself as the guardian of the essential function of the trade mark or the consumers, "but instead, regards consent as determinative and thus coexistence as natural" (p. 78).

Part three of the book, “Shared Name Litigation”, starts with the rule of the specialty principle in passing off and its rule in the case of registered trade marks. Fhima here states that, even though there is more flexibility in the specialty rule, the trade marks owners are still forced to share their names in a significant number of situations.

An important question arises under the shared names litigation which is: is there an own-name defence in the common law tort of passing off? At variance of the case in relation to registered trade marks, in passing off the existence of own-name defence is not clear. This question is discussed by Christopher Wadlow and he reaches a conclusion that this defence does not exist in the common law of passing off.

Part four of the book deals with shared name transactions. The first matter discussed in this part is co-branding, as one of the examples of voluntary name sharing it should be said that it is a safe and a good thing to do to expand trade by reaching more markets and gaining more reputation. But it should be noted that co-branding may also involve some sort of risk. This risk comes from the fact that any change in the reputation of one partner will lead to a change in the other partner’s reputation. The same thing goes in the case of harm. When one partner’s trade mark is harmed this will also cause harm to the other partner’s trade mark. Because of this, choosing a co-branding partner is very important. The co-branding issue is discussed by Spyros Maniatis and Stefan Schwarzkopf who adopt both legal and marketing approaches. They outline the types of co-branding, consider the advantages and disadvantages of co-branding, and give the legal steps for drafting a co-branding agreement.

Another important matter discussed in this part of the book is splitting trade marks and the competition laws. Thomas Hays goes through this matter in detail specifically from the competition law point of view by examining if splitting trade marks leads to competition law violations or not. Sublicensing is also discussed in this part of the book, mainly regarding the quality control aspect. Although not all legal systems recognise them, the quality control measures undertaken by the trade mark owner are very important since the trade mark owner is concerned about the quality of the goods or services using his own trade mark and since his investment needs to be protected. In addition the trade mark owner in these cases will not be dealing with direct licensee that he originally selected, but will be dealing rather with his licensee’s licensee which he does not have a direct relation with to control the quality of the goods or services that are being produced. This matter is discussed by Nile Wilkof in this part of the work.

This book is filled with very interesting and important parts on trade marks and sharing names that are of interest to postgraduate students in law, intellectual-property-specialised academics and legal practitioners.

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