

World Trademark Review Daily

**Pinterest fails to prevent registration of PINTEREST by UK firm
European Union - EIP**

**Examination/opposition
International procedures**

January 20 2014

In *Pinterest Inc v Premium Interest Ltd* (Opposition No B 2 009 309), the Opposition Division of the [Office for Harmonisation in the Internal Market](#) has dismissed *Pinterest Inc's* opposition against the registration of the mark PINTEREST by Premium Interest Limited.

On January 31 2012 Premium Interest, a London-based social news aggregator, applied to register the mark PINTEREST as a Community trademark. The mark was opposed by Pinterest, which operate an online “tool for collecting an organising things you love” from the website ‘www.pinterest.com’. The opposition was based upon Article 8(4) of the [Community Trademark Regulation](#) (207/2009), namely that Pinterest had prior unregistered rights in the mark that were more than of mere local significance in the European Union as a whole, and in the 27 member states individually. The Opposition Division rejected the opposition on November 5 2013, with Pinterest failing to substantiate its case.

As the decision makes clear, under Article 76(1) of the regulation, if an opposition is based on an earlier right within the meaning of Article 8(4), the opponent must provide evidence of the acquisition, continued existence and scope of that right. The Opposition Division summarised the position as requiring the opponent to “submit all the information necessary for the decision, including identifying the applicable law and providing all the necessary information for its sound application”.

Despite these requirements, in the case of 26 of the 27 member states, Pinterest merely asserted a reliance upon unfair competition and comparable causes of action. This statement was found not to “constitute concrete legal argument to prove its claim”.

In the case of the United Kingdom, the case was further substantiated, but as it will be clear from the details below, the evidence was by no means enough to satisfy the requirements of the objection.

Pinterest needed to show that, prior to January 31 2012, its use of the mark in the course of trade in the United Kingdom was more than mere local significance. Pinterest were also required to do this for numerous classifications (that in the decision run to around a third of the page). Despite this cut-off date, the summary of the submitted evidence in the decision indicates the inclusion of numerous copies of webpages which date from *after* the relevant date.

For the evidence that was relevant, the majority was summarised by the Opposition Division as:

“merely mention[ing] the name of ‘Pinterest’ as a social network or explains its functionality, without showing any indication of use or knowledge of it by the relevant public in the United Kingdom. Mere references to the website ‘Pinterest’ by, inter alia, United Kingdom newspapers and media do not mean that the public at large, to whom the services of the mark are addressed, are aware of ‘Pinterest’ to a sufficient extent to conclude that the non-registered mark is used in the course of trade of more than local significance.”

Overall Pinterest's evidence was said to:

“not provide a convincing picture of use of the opponent's sign at the time of the filing of the contested trademark in the relevant territory. The Opposition Division cannot adduce the economic dimension of the mark from its mere presence on internet blogs or newspapers. The earliest data mentioning United Kingdom users appear only after the relevant date of filing of the contested sign, that is January 31 2012, and refers to the number of visitors during January 2012, which coincides with the abovementioned date.” (emphasis added)

Further evidence was adduced, however this was not taken into account as it was submitted after the time limits for submission had expired.

While, according to the decision, Pinterest's evidence may have been thin in terms of use in the United Kingdom before the relevant date (and non-existent for the other 26 member states involved), the decision in itself paints a picture of a generally high hurdle for successful Article 8(4) oppositions. Readers are directed to the quotation above and also the fact that the opposition division put little weight on the evidence of Pinterest's deputy general counsel:

“the Opposition Division finds that statements drawn up by the interested parties themselves or

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their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter.”

The Internet is a wonderful tool and enables a legal team to generate information on past use of a client's marks (or indeed of infringing use of another mark) for evidential purpose. However, even with the so-called Wayback Machine Internet Archive, this research can only take a case so far. In terms of the decision at issue, the type of material that is likely to be preserved online will not go far enough for an Article 8(4) opposition. The need to keep records (and organised and accessible records) of the use of any mark (unregistered or otherwise) therefore is vital, as companies such as Pinterest (now with an estimated value of £3.8 Bn) will never know when they might need that evidence, and will never know how much it might cost them when they discover that they cannot prove their case and are faced with the prospect of having to change their branding across Europe. Furthermore, the decision indicates that a successful opposition under Article 8(4) could require a statement from an independent expert to explain how the preserved evidence shows the relevant use of the unregistered mark in each of the classifications relied upon.

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