

TRADE MARKS

Decisions of the GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-554/12 <i>Oracle America, Inc., v OHIM; Aava Mobile Oy</i> (27.03.14)</p>	<p>AAVA MOBILE</p> <ul style="list-style-type: none"> - scientific apparatus and instruments, wireless internet devices, mobile devices, mobile computing and operating platforms (9) - telecommunications (38) - scientific and technological services and research, design and development of mobile devices (42) <p>JAVA</p> <ul style="list-style-type: none"> - scientific apparatus and instruments, wireless data communications hardware (9) - leasing of access time to computer networks and databases (38) - scientific and technological services and research, computer services (42) 	<p>The GC upheld the BoA's decision to reject the opposition under Art 8(1)(b) and Art 8(5).</p> <p>Visually, the marks were not similar. Although the letters 'ava' were common to both signs, the relevant public would note the difference between the first letters of the marks (intensified by the unusual repetition of the letter 'a' at the beginning of AAVA) and MOBILE in the mark applied for.</p> <p>The marks were phonetically dissimilar. The letters 'j' and 'a' at the beginning of the marks were pronounced differently irrespective of the EU language.</p> <p>AAVA had no meaning for most of the relevant public (other than in Finland where it meant 'expansive') and the relevant public would associate JAVA with the island. Therefore the marks were not conceptually similar.</p> <p>Although it was not disputed that the relevant goods and services were identical, overall the marks were dissimilar and there was no likelihood of confusion between the marks at issue. Furthermore, despite the substantial reputation of the earlier mark, the lack of similarity between the marks meant there was also no infringement of Art 8(5).</p>
<p>GC T-356/12 <i>Debonair Trading Internacional LDA v OHIM; Ibercosmetica, SA de CV</i> (04.04.14)</p>	<p>SÔ :UNIC</p> <ul style="list-style-type: none"> - bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices (3) 	<p>The GC upheld the BoA's decision to reject the opposition under Art 8(1)(b).</p> <p>For a likelihood of confusion to exist based on a family of earlier marks, Debonair Trading had to firstly prove use of a number of marks constituting the family of marks and second, that the mark applied for displayed characteristics capable of associating</p>

	<p>SO...? ONE SO...? CHIC</p> <p>(and 24 other marks containing the word element 'SO...?' in Class 3)</p>	<p>it with the family of marks. The GC agreed with the BoA that the second condition had not been met (partly because of the difference between 'SÔ:' and 'SO...?'), and accordingly there was no likelihood that the relevant public would confuse the mark with the family of marks. As the two conditions were cumulative, the BoA was not obliged to check whether the first condition was met.</p>
<p>GC T-568/12 <i>Sofia Golam v OHIM; Derby Cycle Werke GmbH</i> (04.04.14)</p>	 <p>- clothing, shoes, headgear (25)</p> <p>FOCUS</p> <p>- clothing, footwear, headgear (25)</p>	<p>The GC dismissed the appeal from the BoA's decision to allow the opposition, finding a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>Contrary to Sofia Golan's submission, the BoA had correctly applied Art 8(1)(b) by considering the goods covered by the marks, not those actually marketed (dietary supplements).</p> <p>As the sole element of the earlier mark was the dominant element of the mark applied for, the marks were visually similar to an above average degree. Sofia Golan's submission that consumers would pronounce all the words of the mark applied for ('focus extreme') did not preclude the marks from being phonetically similar. The marks were also similar conceptually.</p> <p>Given, further, the identity of the goods, a likelihood of confusion could not be excluded.</p>
<p>GC T-249/13 <i>MHCS v OHIM; Ambra SA</i> (09.04.14)</p>	 <p>- alcoholic beverages (except beers) (33)</p> 	<p>The GC upheld the BoA's finding that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was correct to find that the use of labels consisting of two bands intersecting at an angle with a circular element where the bands crossed was not uncommon in the alcoholic beverages sector and was therefore only weakly distinctive.</p> <p>The BoA was also correct to find that, due to the contrast between the black letters and the white background, the word element of the mark applied for was the dominant element of that mark.</p>

	 <p>- alcoholic beverages (except beers) (33)</p> <p>(Community and French trade marks)</p>	<p>Visually, phonetically and conceptually the signs were dissimilar; the GC noted that the public would not attribute any specific conceptual meaning to the presence of the label in the shape of a tie.</p> <p>Given the identity of the goods, there was no likelihood of confusion.</p>
<p>GC</p> <p>T-288/12</p> <p><i>EI du Pont de Nemours and Company v OHIM; Enrique Zueco Ruiz</i></p> <p>(09.04.14)</p>	 <p>- apparatus and instruments for producing or controlling electricity, used for renewable energies (9)</p> <p>- vehicles and apparatus for locomotion (12)</p> <p>- installation, assembly and maintenance of motor and electric vehicles (37)</p> <p>ZYTEL</p> <p>- synthetic resin plastics in the form of powders and granules (1)</p> <p>- plastics in extruded form for use in the manufacture of artificial and synthetic resins, nylon resins and glass fibre reinforced nylon resins (17)</p> <p>(Community and well-known marks)</p>	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b) since the goods and services differed.</p> <p>The goods in Classes 1 and 17 related to plastic or synthetic products which were used as a raw material, whereas the goods in Classes 9 and 12 were finished products. Furthermore, the goods had different intended purposes, with those covered by the earlier mark intended to be turned into other products, while the goods designated by the mark applied for were intended to control electricity or transport persons or objects. Finally, the goods were directed at different publics: moulders and converters (Classes 1 and 17), the general public or specialised public in the automotive sector (Classes 12 and 37) or field of renewable energies (Classes 9 and 37). There was no similarity between the Class 37 services and the goods covered by the earlier marks.</p> <p>There was also no infringement of Art 8(5). It was unlikely that the public targeted by one mark would be confronted with the other mark, or that a link could be established, such that the mark applied for would take unfair advantage of any reputation in the earlier marks.</p>
<p>GC</p> <p>T-501/12</p> <p><i>Farmaceutisk Laboratorium Ferring A/S v OHIM; Tillots Pharma AG</i></p> <p>T-502/12</p> <p><i>Ferring BV v OHIM; Tillots Pharma AG</i></p> <p>(09.04.14)</p>	<p>OCTASA</p> <p>- preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract (5)</p> <p>PENTASA</p> <p>- pharmaceutical preparations (5)</p> <p>(various Benelux and</p>	<p>The BoA's decisions that there was no likelihood of confusion under Art 8(1)(b) between the mark applied for and the earlier marks were annulled.</p> <p>The relevant public was composed of medical professionals and consumers of products designed to treat diseases of the gastro-intestinal tract in general.</p> <p>The BoA erred in concluding that the suffix 'asa' was descriptive of the goods as it referred to '5-ASA', an</p>

	national marks)	<p>acronym for mesalazine (the active ingredient of the products in respect of which the earlier marks were being used). The BoA had not established descriptive character from the perspective of the end-users.</p> <p>The BoA was also incorrect to find that the marks were not similar. The differences between the marks ('pen' and 'oc') were not capable of negating a degree of visual and phonetic similarity. There was a weak conceptual similarity for those users who recognised that the beginnings of the signs referred to Greek numbers. Otherwise the conceptual similarity was neutral.</p>
<p>GC T-623/11 <i>Pico Food GmbH v OHIM; Bogumil Sobieraj</i> (09.04.14)</p>	 <p>- chocolate-covered and glazed fruit, pastry and confectionery, chocolates (30)</p>   <p>- chocolate bars, chocolate products, sweets, drops, toffees, in particular made by using milk, cream and/or butter (30)</p> <p>(German marks)</p>	<p>The GC upheld the BoA's decision to reject the opposition under Art 8(1)(b).</p> <p>The GC held that the mere fact of making an impulse purchase did not mean the relevant public's level of attention was lower than that of an average consumer.</p> <p>Visually, the BoA was correct to find that the mark applied for differed from the earlier marks as the former had a yellow background with white stripes. There were also other visual differences between the marks (the number of frames in the image and the word elements). The BoA was correct to find that the cow element of the marks had an allusive character in relation to the goods at issue and thus had a weak distinctive character. Therefore, the marks contained significant visual differences.</p> <p>The marks were not phonetically similar. Conceptually, the marks were dissimilar. Although the marks included a representation of a cow, the mark applied for contained the word 'milanówek', which would be understood either as a Polish town or an invented word.</p> <p>Overall, the marks contained significant differences so that, despite the identity of the goods, there was no likelihood of confusion.</p>

COPYRIGHT

Jurisdiction for copyright infringement actions

***Hi Hotel HCF SARL v Uwe Spoering* (CJ (Fourth Chamber)); C-387/12; 03.04.14)**

The CJ has given guidance on the application of **Article 5(3)** of **Regulation 44/2001** in situations where there were several perpetrators of damage allegedly caused to the rights of copyright protected in the member state of the court seised.

Mr Spoering took photographs of various rooms in a hotel run by Hi Hotel in Nice. Mr Spoering granted Hi Hotel the right to use the photographs in advertising brochures and on its website. Phaidon-Verlag was a Berlin based publisher, with a sister company established in Paris. Hi Hotel made Mr Spoering's photographs available to Phaidon-Verlag in France, following which Phaidon-Verlag published a book containing reproductions of nine of the photographs and offered it for sale in Germany. Mr Spoering sued Hi Hotel for copyright infringement in Germany.

The court of first instance allowed Mr Spoering's claim and an appeal by Hi Hotel was unsuccessful. Hi Hotel brought a further appeal to the Bundesgerichtshof (German Federal Court of Justice), which stayed the proceedings and referred a question to the CJ for a preliminary ruling. It asked whether, in circumstances where there were several perpetrators of alleged damage to a right owner's copyright that was protected in the court seised with a claim, **Article 5(3)** allowed special jurisdiction to be established with respect to one of the perpetrators who did not commit the alleged tortious act within the jurisdiction of that court.

The CJ re-iterated that following *Melzer* (**Case C-228/11**), the expression 'place where the harmful event occurred or may occur' under **Article 5(3)** was intended to cover (a) the place of the causal event giving rise to the damage; and (b) the place where the damage occurred, so that the defendant may be sued, at the option of the applicant, in the courts for either of those two places.

In relation to (a), the CJ held that the causal event committed by Hi Hotel (making the photographs available to Phaidon-Verlag) occurred in France, which was outside the jurisdiction of the German court. Consequently jurisdiction could not be established under (a).

Turning to (b), the CJ held that Hi Hotel supplying the photographs to Phaidon-Verlag in France gave rise to the reproduction and distribution of the photographs and therefore to the possibility that the damage alleged in Germany may occur. Therefore, the jurisdiction of the German court could be established under **Article 5(3)** on the basis of (b). The CJ noted, however, that a court seised on the basis of the place where the damage caused only had jurisdiction to determine the damage caused in the territory of the member state to which that court belongs.

National legislation on private copyright levies

***ACI Adams BV and Ots v Stichting de ThuisKopie and Anr* (CJ (Fourth Chamber)); C-435/12; 10.04.14)**

The CJ has ruled that **Article 5(2)** read in conjunction with **5(5)** of the **Information Society Directive (2001/29)** prevented national legislation which did not distinguish the situations in which the source from which a reproduction for private use was made was lawful from that in which it was unlawful.

ACI Adams were importers and manufacturers of blank data media such as CDs and CD-Rs and brought proceedings before the District Court of the Hague against ThuisKopie, the body responsible for collecting remuneration and distributing it to copyright holders in the Netherlands. ACI Adams submitted that the private copying levy provided for under the Dutch Law on copyright was exclusively intended to remunerate copyright holders for acts of reproduction which were lawful and, as such, compensation for harm suffered as a result of copies of works made from unlawful sources should not be taken into account. ACI Adams' claim and first appeal was dismissed. On further appeal, the Supreme Court of the Netherlands referred questions to the CJ on the interpretation of the **Information Society Directive** and the **Enforcement Directive (2004/48)**.

Under **Articles 5(2)** and **5(5)** of the **Information Society Directive**, reproductions of copyright made by natural persons for private non-commercial use were permissible provided the rights holder received fair compensation and provided this exception did not conflict with the normal exploitation of a copyright work and did not unnecessarily prejudice the legitimate interests of the rights holder. The CJ pointed out that the result of allowing member states the option of adopting legislation (such as that at issue in the main proceedings) which allowed reproductions for private use to be made from an unlawful source would be detrimental to the proper functioning of the internal market as it would require copyright holders to tolerate infringements of their rights which might accompany the making of private copies. As such, on a proper interpretation, EU law precluded member states from adopting such legislation.

The referring court also asked whether the **Enforcement Directive** was applicable to proceedings such as those in the main proceedings in which those liable for payment of fair compensation had commenced an action for a ruling against the body responsible for collecting that remuneration and distributing it to copyright holders. The CJ ruled that the purpose of the **Enforcement Directive** was to ensure the enforcement of various rights enjoyed by the proprietors of intellectual property rights and could not be interpreted as being intended to govern the various measures and procedures available to persons who were not themselves proprietors of such rights and which did not relate solely to an infringement of such rights. Therefore it followed that the **Enforcement Directive** did not apply in such circumstances.

DESIGNS

Assessment of individual character of an unregistered Community design

***Karen Millen Fashions Ltd v Dunnes Stores & Anr* (AG Wathelet for the CJ; C-345/13; 02.04.14)**

AG Wathelet delivered his opinion in favour of Karen Millen that (i) in order for a design to be regarded as having individual character, the overall impression which that design produced on the informed user must be different from that produced on such a user by one or more earlier designs taken individually and viewed as a whole, not by an amalgam of various features of earlier designs; and (ii) in order for a Community design court to treat an unregistered Community design as valid for the purposes of **Article 85(2)** of **Regulation (EC) No 6/2002** (the 'Design Regulation'), the right holder needed to prove only when his design was first made available to the public and indicate the element or elements of his design which gave it individual character.

Karen Millen was a UK company which produced and sold women's clothing in a number of retail outlets and in its own stores in Ireland. Dunnes Stores also had a retail business in women's clothing in Ireland. Karen Millen brought proceedings against Dunnes Stores in Ireland, claiming that a black knit top, a blue shirt and a brown shirt offered for sale by Dunnes Stores under its 'Savida' label in 2006 infringed its unregistered Community designs

in garments which it had offered for sale in Ireland in 2005. The garments in issue were those shown below:



At the trial before the High Court of Ireland, Dunnes Stores did not deny that its top and shirts had been produced by copying Karen Millen's designs. However, it denied that Karen Millen was entitled to unregistered Community designs in its top and shirts on the grounds that (i) the Karen Millen garments did not have individual character, and (ii) the Design Regulation required Karen Millen to prove, as a matter of fact, that the garments had individual character. The High Court of Ireland refused to make a reference to the CJ and found that Dunnes Stores had failed to establish that Karen Millen's top and shirts did not fulfil the individual character requirement in **Article 6** of the Design Regulation. Dunnes Stores appealed to the Irish Supreme Court which referred two questions to the CJ.

By its first question, the Irish Court asked whether, under **Article 6**, individual character had to be considered by reference to whether the overall impression of the design differed from either an earlier individual design or any combination of known design features from more than one earlier design.

AG Wathelet's opinion was that Karen Millen's interpretation of **Article 6** (and that of the UK Government and the European Commission) was correct, i.e. a design had individual character if the overall impression which it produced on the informed user was different from the overall impression produced by earlier designs taken *separately*. He rejected Dunnes Stores' interpretation that a design would not have individual character if certain features of earlier designs (such as a stripe or stitch or a combination of colours) taken *together* created an overall impression that was not different from that created by the design in issue.

AG Wathelet's reasons for his conclusion were that although **Recital 14** to the Design Regulation referred to the 'existing design corpus', that concept was not used in the provision of the Design Regulation itself, and there was nothing else in the provisions to suggest the notion of a comparison between the design at issue and an assortment of specific or isolated features from a number of other designs. The notion of a comparison with a 'body' of designs seemed to AG Wathelet to imply a comparison with precisely designed objects. In addition, although CJ case law had established that the Design Regulation did not limit the assessment of potential designs to a direct comparison between designs, and an indirect comparison

could be based on a recollection of given designs, it was clear that this did not mean that the comparison could be based on an amalgam of various features from several different designs. This was not least because, when a direct comparison could be carried out, it would be a comparison of two designs each viewed as a whole.

By its second question, the Irish Court asked whether an unregistered Community design must be treated as valid under **Article 85(2)** where the right holder merely indicated what constituted the individual character of the design or was the right holder obliged to prove that the design had individual character in accordance with **Article 6** of the Regulation.

Dunnes Stores submitted that the correct interpretation of **Article 85(2)** was that Karen Millen was required to prove that the designs in issue had individual character in accordance with **Article 6** (i.e. that they created an overall impression on the informed user different from that produced by any design previously made available to the public). Karen Millen (and the UK Government and the European Commission) submitted that it merely needed to indicate what constituted the individual character of the design.

AG Wathelet's view was that Dunnes Stores' interpretation of **Article 85(2)** was contrary to the very objective of the provision. Firstly, if a right holder was required to show that its design was new and individual in character, the second part of **Article 85(2)** ('*and indicates what constitutes the individual character of the design*') would be rendered redundant. Furthermore, as **Article 11** required that all the requirements of **Section 1** were met (including the visibility of features, the non-functional nature of the design, and the design's consistency with public policy and morality), the right holder would have to show that that was the case, which would be incompatible with the very notion of presumption. Finally, Dunnes Stores' interpretation would render the option available to a defendant under **Article 85(2)** of contesting validity by way of a counterclaim largely meaningless.

ANTI-COUNTERFEITING

Powers of customs authorities

Sintax Trading OÜ ('Sintax') v Maksu- ja Tolliamet Põhja maksu- ja tollikeskus ('MTA') (CJ (Second Chamber); C-583/12; 09.04.14)

Confirming the opinion of the Advocate General (reported in *CIPA Journal*, March 2014), the CJ held that **Regulation (EC) No 1383/2003** did not preclude customs authorities from initiating and conducting the proceedings referred to in **Article 13(1)** to determine whether an intellectual property right had been infringed in the absence of such proceedings being initiated by the holder of the intellectual property right. However, to ensure the protection of the rights of the owner of the detained goods under EU law, there must be the possibility that the decisions taken could be the subject of an appeal.

OÜ Acerra ('Acerra') was the owner of a registered industrial design in Estonia for a container. Acerra informed the MTA (the Estonian customs authority) that Sintax was attempting to supply a product in Estonia in containers embodying the design. The MTA examined a shipment of goods sent to Sintax by a Ukrainian company and decided to detain the shipment. At the same time the MTA notified Acerra that it had detained the goods and asked Acerra for its evaluation of whether the goods infringed its registered design. Acerra replied in the affirmative. The MTA refused Sintax's request to release the goods and stated that the goods infringed Acerra's intellectual property rights. Sintax commenced court proceedings to obtain the release of the goods. The dispute focused on whether the process the MTA had gone through was capable of constituting the 'proceedings to determine whether an intellectual property right had been infringed' required by **Article 13(1)**. On appeal from the Tallinn Regional Court, the Estonian Supreme Court referred questions concerning whether (i) a customs authority could initiate these proceedings on its own

initiative; and (ii) the customs authority itself could be the body which made the determination of whether an intellectual property right had been infringed.

Initiation of the proceedings

The CJ observed that the Regulation sought not only to protect the private interests of the holders of intellectual property rights but also to protect the public interest. Goods infringing intellectual property rights could deceive consumers and, in some circumstances, endanger their health and safety. The Regulation did not therefore preclude customs authorities from initiating proceedings to determine whether an intellectual property right had been infringed. This was clear from **Article 14(2)** which expressly provided for situations where the proceedings had been initiated by someone other than the holder of the intellectual property right and **Article 10** which made clear that the Regulation envisaged the possibility of the proceedings being started by a customs authority.

Conduct of the proceedings

The CJ noted that under **Article 10** the question of whether an intellectual property right had been infringed was a question for the national law of the member state concerned. It followed that the question of whether a customs authority was competent to conduct those proceedings was also a question of national law, as the Regulation did not preclude that a body other than a judicial authority may be designated as the authority competent to give a decision on the merits of the case.

The CJ further observed that the provisions of the **TRIPS Agreement** formed an integral part of the EU legal order and **Article 49** of that agreement envisaged that the civil enforcement of intellectual property rights could be provided for by administrative procedures. However, under **Article 49** such administrative procedures must comply with the procedural guarantees provided for in **Article 41** of the agreement and in particular the possibility for a party to request judicial review of a final administrative decision. It was for the national courts to determine whether the decisions taken by the customs authority on the merits may be the subject of an appeal such that the rights of the owner of the detained goods under EU law were safeguarded.

Note: Regulation (EC) No 1383/2003 was repealed as of 1 January 2014 and replaced by **Regulation 608/2013/EU** which contains similar provisions regarding the initiation of proceedings under **Article 23**.

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The reported cases marked * can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at http://curia.europa.eu/jcms/jcms/j_6/home