






TRADE MARKS


Decisions of the GC and CJ

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-149/12 <i>Investrónica SA v OHIM; Olympus Imaging Corp.</i> (16.01.14)</p>	 <p>- photographic apparatus and instruments, digital cameras, interchangeable lenses, and parts and accessories therefor (9)</p>  <p>- various products including photographic, cinematographic apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs (9) (Spanish mark)</p>	<p>The GC annulled the BoA's decision that there was no likelihood of confusion under Art 8(1)(b) between the mark applied for and the earlier mark.</p> <p>The BoA was correct to find that the relevant public was composed of both professionals in the photography sector and average consumers.</p> <p>Even assuming, as the BoA did, that 'micro' was descriptive, the word element occupied three quarters of the contested mark. The public's eyes were necessarily attracted, not by the colours used or the design, but by the word element. It could therefore only be considered as dominant. The word element 'micro' was also the dominant element of the earlier mark (and not, as the BoA found, the particular combination of colours and letters). The BoA was incorrect in finding the marks were only slightly similar. In fact, the marks were conceptually and phonetically identical, with a strong visual similarity. Given further the identity of the goods, the BoA was wrong to find that there was no likelihood of confusion.</p>
<p>GC T-383/12 <i>Ferienhäuser zum See GmbH v OHIM, Sunparks Groep NV</i> (16.01.14)</p>	 <p>- travel reservation, booking, arrangement and tour services, rental of mobile homes and caravans (39)</p> <p>- providing campsite facilities, temporary accommodation, mobile homes and tents (43)</p>	<p>The GC upheld the BoA's finding that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>Because it is sufficient for the ground of refusal existing in part of the EU, the BoA did not err in finding that the relevant public was the general public in Germany.</p> <p>The BoA was therefore correct to find that (i) the word element 'sunparks' was the dominant element of the earlier mark despite this element only having a weak degree of distinctive</p>

	 <p>- arranging and booking of travel and tours, transport rental, transfer services (39)</p> <p>- training and courses, entertainment (41)</p> <p>- temporary accommodation, hotel and holiday centre services (43)</p>	<p>character and; (ii) the marks shared a high degree of visual and conceptual similarity and an average degree of phonetic similarity.</p> <p>The BoA was therefore correct to find that there was a likelihood of confusion between the marks; the identity of the services and the high degree of similarity between the marks offset the weak degree of distinctive character of the earlier mark under the global assessment test.</p>
<p>GC</p> <p>T-528/11</p> <p><i>Aloe Vera of America, Inc v OHIM; Detimos – Gestão Imobiliária, SA</i> (16.01.14)</p>	 <p>- aloe vera juice, aloe vera gel drinks and aloe vera pulp, aloe vera juice mixed with fruit juice(s), bottled spring water (32)</p>  <p>- juices, lime lemon juices - exclusively for exportation (32)</p> <p>(Portuguese mark)</p>	<p>The GC upheld the BoA's finding that there was a likelihood of confusion between the marks under Art 8(1)(b) and that Detimos had provided sufficient proof of use under Art 42(3).</p> <p>Detimos provided 12 sample invoices covering the relevant period. Whilst the volume of sales indicated was low, those sales were continuous over approximately 26 months and were enough to discount the possibility of merely token use of the earlier mark. Detimos was not required to provide evidence containing an exact representation of the earlier mark and the BoA was correct to find that the use shown did not differ from the earlier mark so much as to alter its distinctive character.</p> <p>The relevant public was average Portuguese consumers. Knowledge of basic English was relatively widespread in Portugal and the number 4 associated with an English word would be understood as being pronounced 'for'. To such consumers the marks were phonetically and conceptually identical. The bird of prey element in the mark applied for did not dispel the slight visual similarity caused by the common letters 'ever' at the end of the marks.</p>
<p>GC</p> <p>T-113/12</p> <p><i>Bial-Portela & C^a, SA v OHIM; Probiotal SpA</i> (21.01.14)</p>	 <p>- bacterial preparations for pharmaceutical and medical purposes containing probiotic microorganisms;</p>	<p>The GC upheld the BoA's decision to reject the opposition under Arts 8(1)(b), 8(2)(c) and 8(4).</p> <p>The opposition was rejected insofar as it was based on the earlier Portuguese and International trade marks as Bial-</p>

	<p>probiotic milk ferments (5)</p> <p>BIAL</p>  <p>- pharmaceutical products, articles for dressings, disinfectants, veterinary products (5)</p> <p>- advertising services, business management (35)</p> <p>(Portuguese, International and Spanish (Class 35 only) marks and Portuguese business name, emblem and logo)</p>	<p>Portela had failed to prove genuine use of the marks. It had also failed to submit evidence that the mark BIAL was well-known in Portugal under Art 8(2)(c).</p> <p>The BoA's finding that the Class 35 services of the earlier Spanish mark were dissimilar to goods of the mark applied for was approved by the GC.</p> <p>Bial-Portela had also failed to show (under Art 8(4)) that three other earlier signs (the Portuguese emblem, business name and logo) had been used in the course of trade in Portugal, that they were of more than mere local significance and that the rights to those signs had been acquired prior to the application for registration of the PROBIAL mark.</p> <p>The GC therefore dismissed the action in its entirety.</p>
<p>GC</p> <p>T-232/12</p> <p><i>Wilmar Trading Pte Ltd v OHIM; Agroekola EOOD</i></p> <p>(21.01.14)</p>	<p>ULTRA CHOCO</p> <p>- various goods in Classes 29, 30 and 31</p> <p>ULTRA CHOCO</p> <p>- various goods in Class 29</p> <p>(Singaporean and unregistered marks)</p>	<p>The GC upheld the BoA's decision rejecting Wilmar's opposition under Art 60, as Wilmar had failed to comply with its obligation to pay the appeal fee within the prescribed time limit, and the appeal was therefore deemed not to have been filed.</p> <p>While Wilmar had filed a notice of appeal within the required period (two months of the date of notification of the decision), under Art 60 the appeal was deemed to have been filed only once the appeal fee has been paid.</p>
<p>CJ</p> <p>C-558/12</p> <p><i>OHIM v riha WeserGold Getränke GmbH & Co. KG; Lidl Stiftung & Co. KG</i></p> <p>(23.01.14)</p>	<p>WESTERN GOLD</p> <p>- spirits, in particular whiskey (33)</p> <p>WESERGOLD</p> <p>- various goods in Classes 30, 31 and 32</p> <p>(Community, International, Polish and German marks)</p>	<p>The CJ set aside the GC's judgment (Case T-278/10, reported in <i>CIPA Journal</i>, October 2012), and ruled that acquired distinctiveness was irrelevant to the assessment of likelihood of confusion between dissimilar trade marks.</p> <p>The GC had misinterpreted Art 8(1)(b) in annulling the BoA's decision on the grounds that the BoA had failed to examine the enhanced distinctiveness of the WESERGOLD marks acquired through use. Since the GC had already found the marks dissimilar, any likelihood of confusion had to be ruled out; acquired distinctiveness could not offset this. Due to this error in law, the CJ</p>

		quashed the GC's decision, and referred the case back to the GC.
<p>GC T-68/13 <i>Novartis AG v OHIM</i> (23.01.14)</p>	<p>CARE TO CARE</p> <p>- educational services, including caregivers and patient's relatives support program relating to alzheimer's disease (41)</p> <p>- medical services, including providing medical information to caregivers and patient's relatives relating to alzheimer's disease (42)</p>	<p>The GC upheld the BoA's finding that the mark was devoid of distinctive character under Art 7(1)(b).</p> <p>The relevant public were health professionals and families of patients suffering from Alzheimer's disease. It would be well known to both groups that treatment of that disease required gradual adaptation of care and may sometimes require a patient to transfer from hospital care to home care and vice versa.</p> <p>The BoA was therefore correct to find that the relevant public would consider the mark an allusion to the inherent characteristics of the services applied for. The mark was a slogan without the necessary degree of originality or resonance to enable it to be capable of indicating the commercial origin of the services. It was irrelevant that Novartis had advanced another potential meaning for the mark.</p>
<p>GC T-221/12 <i>The Sunrider Corporation v OHIM; Nannerl GmbH & Co. KG</i> (23.01.14)</p>	<p>SUN FRESH</p> <p>- beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages (32)</p> <p>SUNNY FRESH</p> <p>- herbal nutritional supplements (5)</p>	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>Sunrider owned a number of national, International and Community word and figurative marks, however, Sunrider had failed to establish genuine use for goods other than a dietary supplement based on a herbal concentrate.</p> <p>The GC agreed with the BoA's classification of the SUNNY FRESH product as only a 'herbal nutritional supplement' and not a 'beverage' as it had no thirst-quenching function.</p> <p>The GC confirmed that the goods designated by the mark applied for and herbal supplements were different in their purpose, their marketing, their outlets and their end-users, and as a result they were neither complementary nor in competition with each other. Therefore, there was no likelihood of confusion.</p>

<p>GC T-600/11 <i>Schuhhaus Dielmann GmbH & Co. KG v OHIM; Carrera SpA</i> (28.01.14)</p>	<p>CARRERA PANAMERICANA - beach bags, bags for sports, bags for campers, shopping bags, handbags, bum bags, rucksacks, particularly carry-bags (18) - clothing, footwear, headgear, belts (25)</p>  <p>- clothing, including belts and footwear (25)</p>	<p>The GC upheld the BoA's finding of a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>It was not disputed that the Class 18 goods were similar to the goods of the earlier mark and that the Class 25 goods were identical.</p> <p>The BoA was correct to find that (i) 'carrera' (meaning 'race' in Spanish) was the dominant element of the mark applied for; and (ii) and the marks were visually and phonetically similar to a medium degree to the general public and conceptually highly similar to the Spanish-speaking public.</p> <p>Schuhhaus had failed to explain how the word 'carrera' may remind even the non-Spanish speaking public of a famous sports car, thus affecting the conceptual similarity, nor had it submitted that argument before the BoA.</p>
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Independent distinctive role of words within a composite mark

Bimbo SA v OHIM; Panrico (AG Mengozzi for the CJ; C-591/12; 23.01.14)

The AG agreed with the GC's conclusion that the BoA was correct to find that there was a likelihood of confusion under **Article 8(1)(b)** between the marks applied for and the earlier mark and gave guidance on the scope of *Medion* (**Case C-120/04**, reported in *CIPA Journal*, October 2005).

Bimbo filed an application for registration of BIMBO DOUGHNUTS as a CTM for '*pastry and bakery products, specially doughnuts*' in Class 30.

Panrico opposed the mark based on a number of earlier national and international marks, including the Spanish word mark DOGHNUTS registered for '*pastry products and preparations.....round-shaped dough biscuits....*' in Class 30. The Opposition Division, the BoA and the GC upheld the opposition. Bimbo appealed to the CJ.

When considering whether the GC had erred in attributing an independent distinctive role within the mark applied for to the 'doughnuts' element of that mark, the AG firstly reviewed the *Medion* case.

In *Medion*, the CJ had held that, notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it was possible that an earlier mark used by a third party in a composite sign including the name of the company of the third party still had an independent distinctive role in the composite sign, without necessarily constituting the dominant element. Accordingly, the public may be led to believe the components were economically linked or that there was a likelihood of confusion.

The AG observed that in subsequent cases, there had been considerable difficulty in applying *Medion* resulting on it being extended beyond the few situations contemplated by that judgment. Although the terminology used in *Medion* indicated that the CJ intended to introduce an exception to well-established principles relating to the assessment of the

likelihood of confusion, the AG could see no justification for doing so for an isolated category of composite marks.

It was therefore necessary to attempt a new interpretation of *Medion*. The court in *Medion* did not take a position on the possible existence of a likelihood of confusion in that particular case, but simply answered the question referred to it. Viewed in that context, *Medion* stated that the possibility of a likelihood of confusion between an earlier trade mark, used by a third party as part of a composite sign, and that sign could not automatically be ruled out in cases where the earlier trade mark, albeit not the dominant element of the composite sign, retained a role in that sign of such a kind that the origin of the goods or services covered by the composite sign was attributed by the public also to the owner of that mark. More generally, that ruling meant that, whenever the element of a composite sign, identical or similar to an earlier trade mark, significantly contributed to (but did not dominate) the image of that mark which remained in the public's memory, notwithstanding the fact that another element of the sign might be more prominent, the former element had to be taken into consideration for the purposes of appraising the similarity between the composite sign and the earlier trade mark and was therefore relevant for the purposes of assessing the likelihood of confusion.

Looking then at the facts of this present case, the AG considered that the GC did not err in law by linking the independent distinctive role of 'doughnuts' within the mark applied for to its degree of distinctiveness and the fact that it did not combine with 'bimbo' to form a conceptually distinct whole. Further, the GC had not automatically inferred from the finding that 'doughnuts' had an independent distinctive role such that there was a likelihood of confusion.

The GC had found that there was a likelihood of confusion based on an overall assessment including visual and phonetic similarity, the identical nature of the goods, the average distinctiveness of the earlier mark, the nature of the goods in question and the low level of attention of the public when purchasing such goods. The AG proposed that the CJ dismiss the appeal.

Extended passing off

***Fage UK Ltd & Anr v Chobani UK Ltd & Anr** (Longmore, Lewison & Kitchin LJ; [2014] EWCA Civ 5; 28.01.14)**

The Court of Appeal (**Kitchin LJ** giving the lead judgment) dismissed Chobani's appeal from the decision of **Briggs J** in which he found that the sale in the UK by Chobani of its American-made yoghurt product under the description 'Greek yoghurt' constituted extended passing off ([2013] EWHC 630 (Ch), reported in *CIPA Journal*, April 2013).

Briggs J found that a substantial proportion of those persons in the UK who bought Greek yoghurt thought that it was made in Greece and that this mattered to them such that the use of the phrase 'Greek yoghurt' to describe yoghurt not made in Greece involved a material misrepresentation. Therefore, he found that FAGE's claim to restrain Chobani from passing off its American-made yoghurt as yoghurt made in Greece by the use of the phrase 'Greek yoghurt' succeeded, and he granted a permanent injunction to that effect.

Extended Passing Off

Kitchin LJ reviewed the law on 'extended passing off', i.e. cases in which it was alleged that a geographical name has become so distinctive of particular goods made in that geographical area that its use in relation to other goods amounted to a misrepresentation which was calculated to lead to the deception of members of the public and to cause damage to those traders who enjoyed a goodwill in their businesses of supplying goods which are in fact made in that area.

Kitchin LJ rejected Chobani's argument argued that the phrase 'Greek yoghurt' was 'multivalent' and lacked the necessary singularity which neither the description 'thick and creamy' nor the specification could remedy as they did not adequately define a class of products to which the phrase could be applied, nor a class of traders who could use it.

Kitchin LJ referred to **Briggs J's** finding that a substantial part of the relevant part of the public did recognise Greek yoghurt with its characteristic thick and creamy texture as being special and as coming from Greece. The phrase meant to these people a particular and singular product which they considered desirable and there was a goodwill associated with it. The fact that this reputation and goodwill did not extend to all potential customers was neither here nor there. What mattered was that it existed amongst a significant section of the relevant public. To these persons the phrase was no longer purely descriptive and had come to denote a product of a particular kind. **Kitchin LJ** also held that the class of traders of whose products the phrase 'Greek yoghurt' had become distinctive had been defined with reasonable precision.

Kitchin LJ went on to find that the use of the phrase by Chobani in relation to yoghurt not made in Greece was calculated to cause deception and confusion and to lead members of the public to buy it thinking they were buying the genuine article, i.e. yoghurt having the characteristics with which they were familiar and which had been made in Greece. It was an activity upon which Chobani had embarked with the intention of taking advantage of the cachet attaching to the phrase which has been generated by FAGE and other traders, and so sold its product at the premium price which Greek yoghurt commanded. In **Kitchin's LJ's** view, this was an activity in respect of which the law ought to provide FAGE a remedy and the judge was right to hold it amounted to passing off.

Domestic law not overtaken by EU law

Kitchin LJ also rejected a new point raised by Chobani that, having regard to the provisions of **Regulation 1151/2012** concerning the protection of 'designations of origin' and 'geographical indications' for foodstuffs within the EU ('the **2012 Regulation**'), and to the ruling of the CJ in **Case C-478/07 Budejovicky Budvar NP v Rudolf Ammersin GmbH**, the court had no power to grant or was precluded from granting injunctive relief to protect geographical indications, such as Greek yoghurt, other than pursuant to and in conformity with the provisions of the 2012 Regulation. The Regulation applied only to designations of origin and geographical indications that had been registered pursuant to it. Since 'Greek yoghurt' had not been registered, Chobani argued the court had no jurisdiction to grant the injunction sought by FAGE.

Kitchin LJ pointed out that the **2012 Regulation** ensured uniform protection within the Union of the geographical denominations which it covered or, in other words, which fell within its scope. As the CJEU explained in the *Warsteiner* and *Budvar I* cases, it did not, however, preclude systems of national protection for geographical denominations which did not fall within its scope. In such a case, the national measures had to operate compliantly with **Articles 34-36 TFEU**, but in circumstances such as the present, where the national law of passing off operated to prevent confusion and deception of the public and so preserve the goodwill of legitimate traders, **Kitchin LJ** was of the view that it did. Furthermore, it did so in a manner which was entirely compliant with **TRIPS**.

Lewison LJ also gave a judgment dismissing the appeal. Commenting on the role of the trial judge in determining facts, he said: *'There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted....'*

Lewison LJ also distilled the following principles from *Chocosuisse*: (i) The fact that a phrase has more than one meaning did not of itself disqualify it from protection; (ii) It qualified if one of its meanings was more than descriptive of the place of manufacture; and

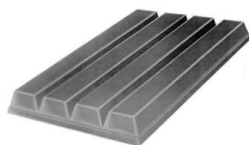
(iii) That meaning did not need to be the meaning attributed to the phrase by the public at large, provided that that meaning was attributed to it by a significant section of the public.

Questions referred to the CJ in relation to acquired distinctive character and shape marks

***Société des Produits Nestlé SA v Cadbury UK Ltd* (Arnold J; [2014] EWHC 16 (Ch); 17.01.14)**

On appeal by Nestlé and cross-appeal by Cadbury from a decision of the hearing officer, **Arnold J** referred questions to the CJ regarding the registrability of the shape of Nestlé's Kit Kat product as a trade mark.

Nestlé applied to register a sign consisting of the shape of its four-finger Kit Kat as a three-dimensional trade mark, as shown below (the 'Mark'):



Application was made in respect of the following goods in Class 30: '*Chocolate; chocolate confectionery; chocolate products; confectionery; chocolate-based preparations; bakery goods; parties; biscuits; biscuits having a chocolate coating; chocolate coated wafer biscuits; cakes; cookies; wafers*'.

Cadbury opposed the application on the basis of **Sections 3(1)(b)** (devoid of distinctive character), **3(2)(a)** (sign consisting exclusively of the shape resulting from the nature of the goods themselves) and **3(2)(b)** (sign consisting exclusively of the shape of the goods necessary to obtain a technical result).

The hearing officer held that: (i) the Mark was devoid of inherent distinctive character, and had not acquired a distinctive character, in relation to all the above goods except 'cakes' and 'pastries'; (ii) the Mark could not be registered in respect of the goods (excluding 'cakes' and 'pastries') because it consisted exclusively of the shape necessary to obtain a technical result; but (iii) the Mark was inherently distinctive of 'cakes' and 'pastries' and registration was not precluded. Nestlé appealed against the decision to uphold the opposition for all goods except 'cakes' and 'pastries'. Cadbury cross-appealed the decision to reject the opposition in respect of 'cakes' and 'pastries'.

Inherent distinctive character

Arnold J agreed with Cadbury that the Mark was devoid of inherent distinctive character in relation to 'cakes' and 'pastries' as well as in relation to the other goods applied for. The hearing officer had erred in finding that the fact that a shape was outside the norms and customs of a sector was sufficient to endow it with distinctive character.

Acquired distinctive character

Arnold J noted that the English courts had, to date, refused to accept that, in order to establish that a trade mark had acquired distinctive character, it was sufficient to show that at the relevant date a significant proportion of the relevant class of persons recognised the mark and associated it with the applicant's *goods*, in the sense that, if they were asked who marketed the goods bearing that mark, they would identify the applicant expressly or impliedly (e.g. by reference to some other trade mark used by the applicant). Rather, the English courts had required an applicant to show that a significant proportion of the relevant class relied upon the trade mark (as opposed to other marks which may also be present) as indicating the *origin* of the goods. **Arnold J** indicated that he thought the latter approach

was the correct one. However, recognising that the issue was not clear, he referred the question to the CJ.

Nature of the goods/Necessary to obtain a technical result

The hearing officer had identified the following essential features of the shape constituting the Mark: (1) the rectangular 'slab' shape including the relative proportions, (2) the presence, position and depth of the breaking grooves, and (3) the number of such grooves which determined the number of 'fingers'. He had made a 'hybrid finding' that feature 1 resulted from the nature of the goods themselves and features 2 and 3 were necessary to obtain a technical result, rather than treating them as separate and distinct objections. He had also concluded that **Section 3(2)(b)** applied to features which related to the manner in which the goods were manufactured as opposed to the manner in which the goods functioned.

Arnold J held that the hearing officer was wrong to differentiate between 'cakes' and 'pastries' on the one hand, and the remaining goods on the other. However, in order to assess whether he had erred in his application of **Sections 3(2)(a)** and **(b)**, **Arnold J** held that it was necessary to refer two questions to the CJ, namely: (i) where a shape consists of three essential features, one of which results from the nature of the goods themselves and two which are necessary to obtain a technical result, is registration precluded by **Article 3(1)(e)(i)** and/or **(ii)**; and (ii) should **Article 3(1)(e)(ii)** be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function? **Arnold J** indicated that his view was that the hearing officer had not erred in his findings on either issue.

High Court finds House of Fraser's pigeon logo infringes Jack Wills's pheasant trade marks

Jack Wills Ltd v House of Fraser (Stores) Ltd ('HoF')* (Arnold J; [2014] EWHC 110 (Ch); 31.01.14)

Arnold J found that HoF's pigeon logo, which it had used on menswear garments in its own brand 'Linea' line, infringed Jack Wills's UK and Community trade marks for its anthropomorphic pheasant logo under **Articles 5(1)(b)** and **5(2)**.

Jack Wills was a clothing retailer which sold its own brand of, mainly casual, clothing through a chain of stores in the UK, internationally, and online. Its core target market was affluent 16-24 year olds and it sought to convey a brand image of '*traditional British heritage*' combined with an '*American-influenced, casual irreverent spirit*'. It used a logo consisting of a silhouette of a pheasant with a top hat and cane which it referred to as the 'Mr Wills Logo'.

HoF operated a chain of department stores throughout the UK. As well as retailing well-known brands, it sold its own range of menswear under the brand name Linea. The average age of Linea's menswear customers was 45. It had used a logo consisting of a silhouette of a pigeon with a top hat and bow tie on a selection of Linea garments (the 'Pigeon Logo'). A comparison of the Mr Wills Logo (right) and the Pigeon Logo(left), as they appeared on Jack Wills and Linea garments, are shown below:



Arnold J identified the average consumer as a consumer of men's clothing, and casual clothing in particular. However, he held that the average consumer represented a distribution of consumers who might vary in age and socio-economic class, and a spectrum of people ranging from those wholly ignorant of the Mr Wills mark to those who knew it well. Where a mark was likely to have acquired distinctive character amongst one demographic segment of the relevant class of persons than another, that was a factor to be taken into account as increasing the likelihood of confusion amongst the first segment, but it was not appropriate to treat the average consumer as representative solely of the first segment. Accordingly, consideration could not be limited to customers who were familiar with the Mr Wills Logo (such as Jack Wills's target customers and devotees of other ages), but also included those who purchased the relevant goods for others.

The Judge found that there was a likelihood of confusion on the part of the average consumer, on the basis that the human eye had a tendency to see what it expected to see, and details such as which direction the pheasant and pigeon were facing were easily misremembered (particularly when looking in a mirror). Given the high degree of similarity (particularly conceptual) between the Mr Wills Logo and the Pigeon Logo, that Linea would not be well known to occasional menswear customers, that Linea products were not always displayed in a separate zone within HoF's stores, and that Linea labels attached to the relevant garments would not necessarily prevent initial or post-sale confusion arising, the Judge held that a significant proportion of consumers would believe that the Pigeon Logo was the same as, or a variant of, the Mr Wills Logo.

Although Jack Wills had been refused permission to amend its claim to plead an intention on the part of HoF to free ride on its reputation in the marks for the Mr Wills Logo under **Article 5(2)**, the Judge concluded that this did not mean that HoF's intentions in adopting and using the Pigeon Logo were irrelevant. He described this as '*a classic case of a retailer seeking to enhance the attraction of its own brand goods by adopting an aspect of the get-up of prestigious branded goods*'.

Earlier rights in marks

***Boxing Brands Ltd v Sports Direct International Plc & Ots** (Birss J; [2014] EWHC 91 (Ch); 28.01.14)**

Further to the substantive judgment which he handed down following trial ([2013] EWHC 2200 (Ch), reported in *CIPA Journal*, September 2013) which concerned the rights to use QUEENSBERRY as a clothing brand, **Birss J** held that certain additional items of sports equipment which Sports Direct intended to sell would have or did infringe Boxing Brands' QUEENSBERRY trade marks. Sports Direct was not entitled to an inquiry as to damages in respect of the non-infringing items, on the basis that it would not have offered those goods for sale on their own without a clothing range, which it was prohibited from doing as a result of the outcome of the trial.

At the hearing to determine the consequences of the substantive judgment, it transpired that not all matters had been dealt with at the trial so the whole dispute had not been fully resolved. Two issues in particular remained to be determined: (i) whether items which Sports Direct identified as items they were intending to sell (but which it had not previously sold – the previously sold items having been dealt with in the original trial) infringed Boxing Brands' trade marks, and (ii) whether an inquiry as to damages should be ordered in relation to goods which were covered by the interim injunction but which were ultimately held not to infringe Boxing Brands' trade marks.

Sports Direct used the following sign on its allegedly infringing equipment:



Birss J found that the sign was not identical to Boxing Brand's QUEENSBERRY word marks. However, he accepted that Sports Direct would most likely have also used the word 'Queensberry' alone had it sold the equipment. The Judge therefore found double identity with Boxing Brand's QUEENSBERRY marks and similarity with its QUEENSBERRY RULES marks.

Despite the equipment in issue being relatively specialist equipment, the average consumer of the equipment would have been amateur and professional boxers and some trainers. Therefore, **Birss J** held that while the average consumer would pay close attention to the technical specifications and quality of the products, (s)he would not pay particularly close attention to the branding. As a result, ten categories of equipment (such as head guards, jab pads and water bottles) were found to infringe Boxing Brands' trade marks, either pursuant to **Section 10(1)/Article 9(1)(a)** or based on a likelihood of confusion pursuant to **Section 10(2)/Article 9(1)(b)**. However, seven categories of items (such as punch bags, gym fitness training equipment and tote buckets) were found not to infringe (or to have infringed marks which had been found to be invalid in the earlier judgment).

However, of those seven kinds of items, only two (punch bags and corner pads) had actually been ordered by Sports Direct prior to the interim injunction being imposed. Furthermore, based on the evidence submitted, **Birss J** did not believe that Sports Direct ever intended to launch a free standing 'Queensberry' branded range of sports equipment at all but, rather, would only have launched an equipment range in conjunction with a clothing range (and in the earlier judgment the clothing range was found to have infringed Boxing Brands' trade marks). Since Sports Direct never intended to sell the remaining five categories of item (or indeed any of the 7 non-infringing items) in the absence of a clothing range, Sports Direct was found to have suffered no real damage and, in the circumstances, a costly inquiry as to damages under the cross undertaking was not warranted.

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Unlocking games consoles

Nintendo Co. Ltd & Ots ('Nintendo') v PC Box Srl & Anr ('PC Box') (CJ, Fourth Chamber; C-355/12; 23.01.14)

The CJ has given guidance on the interpretation of **Article 6** of the Copyright Directive in relation to sales of devices for unlocking games consoles.

Nintendo makes video games and consoles. The games (on cartridges or DVDs) contain encrypted information which must be exchanged with encrypted information stored in the consoles before those games could be played. These measures had the effect of preventing not only unauthorised copies of Nintendo and Nintendo licenced games ('Nintendo Games'), but also other games and multimedia content from being played on consoles.

PC Box makes devices which can be used to circumvent the blocking effect for both Nintendo Games and other games. Nintendo brought proceedings against PC Box before the Tribunale di Milano.

The referring court asked questions on the extent of the adequate legal protection which member states are required to provide under **Article 6** against the circumvention of any effective technological measures which restricts acts not authorised by copyright holders.

The CJ held that the concept of an 'effective technological measure', for the purposes of **Article 6(3)**, is capable of covering technological measures comprising, principally, equipping not only the housing system containing the protected work (e.g. the videogame) with a recognition device in order to protect it against unauthorised acts, but also portable equipment or consoles intended to ensure access to those games and their use.

Technological measures, such as those in issue in this case, which are partly incorporated in the physical housing of videogames and partly in consoles and which require interaction between them fall within the concept of 'effective technological measures' if their objective is to prevent or limit acts adversely affecting the rights of the holder protected by them.

However, the legal protection must respect the principle of proportionately; the measures must be suitable for achieving the objective of preventing or eliminating unauthorised acts and must not go beyond what is necessary for this purpose.

The CJ held that it is for national courts to examine whether other measures or measures which are not installed in consoles could cause less interference with third party activities whilst still providing comparable protection of the rightholder's rights. It is relevant to take account of the costs of different types of technological measures, the technological and practical aspects of their implementation (although the CJ noted that the effectiveness does not have to be absolute). Evidence of actual use by third parties will be particularly relevant. In particular, the national court may examine how often such devices are used in disregard of copyright and how often they are used for purposes which do not infringe copyright.

Katharine Stephens, Zoe Fuller and Hilary Atherton

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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