

TRADE MARKS

Decisions of the GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-59/14 <i>Blackrock, Inc. v OHIM</i> (29.01.15)</p>	<p>INVESTING FOR A NEW WORLD</p> <p>- providing information and analysis relating to economic market data, providing business and market research services to individual and institutional financial investors and financial professionals, business management consultation, market analysis (35)</p> <p>- investment management services, investment advice, financial risk management, mutual fund services, asset management and other financial related services (36)</p>	<p>The GC upheld the BoA's decision that the mark was devoid of distinctive character pursuant to Art 7(1)(b).</p> <p>The combination of common English words was a banal expression which could easily be understood by the relevant public. Furthermore the mark did not constitute a play on words, nor did it include any imaginative, surprising or unexpected elements capable of conferring distinctive character on it in the mind of the relevant public.</p> <p>The fact that the mark could have a number of different meanings was not a decisive factor in establishing distinctive character. Even as a laudatory slogan, the relevant public would immediately associate the mark with the services concerned and would not require interpretation or analysis.</p> <p>The BoA had correctly stated that Blackrock had not put forward any evidence that showed that the mark had a reputation, therefore distinguishing the case from <i>Audi v OHIM (C-398/08</i> reported in <i>CIPA Journal</i>, February 2010), in which the registration of a mark which was a widely known slogan used by Audi for many years was allowed.</p>
<p>GC T-609/13 <i>Blackrock, Inc. v OHIM</i> (29.01.15)</p>	<p>SO WHAT DO I DO WITH MY MONEY</p> <p>- providing information and analysis relating to economic market data, providing business and market research services to individual and institutional financial investors and financial professionals, business management consultation, market</p>	<p>The GC upheld the BoA's decision that the mark was devoid of distinctive character pursuant to Art 7(1)(b).</p> <p>The combination of words, which was in conformity with the rules of English grammar, conveyed a clear and unequivocal message which was immediately apparent and did not require interpretation for English speaking consumers.</p> <p>The BoA was correct to find that the</p>

	<p>analysis (35)</p> <ul style="list-style-type: none"> - investment management services, investment advice, financial risk management, mutual fund services, asset management and other financial related services (36) 	<p>question inherent in the mark merely raised a general demand for the relevant services on the part of the relevant public. The mark was a banal expression and consumers would make a direct link with the services covered by the mark.</p> <p>The BoA had correctly followed <i>Audi v OHIM</i> (C-398/08 reported in <i>CIPA Journal</i>, February 2010). The BoA did not reject the mark on the grounds that it was a promotional slogan but rather because, beyond its promotional meaning, there was nothing in it which would enable the relevant public to perceive it as an indication of the commercial origin of the services.</p>
<p>GC T-665/13 <i>Zitro IP Sàrl v OHIM; Gamepoint BV</i> (29.01.15)</p>	 <ul style="list-style-type: none"> - automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, software for games, electronic games, action skill games (9) - opportunities for the playing of games (41) - design and development of computer software in connection with games (42) <p>ZITRO SPIN BINGO</p> <ul style="list-style-type: none"> - automatic vending machines and mechanisms for coin-operated apparatus, computer hardware and software for bingo halls, casinos, automatic slot machines, electronic equipment for arcade and gaming rooms, betting terminals (9) - entertainment, online game services (41) 	<p>The GC upheld the BoA's decision to reject the opposition as there was no likelihood of confusion under Art 8(1)(b).</p> <p>Zitro IP Sàrl contested the BoA's conclusion that 'spin bingo' was descriptive of an essential characteristic of the goods and services, calling into question the BoA's assessment that there was a low degree of visual, phonetic and conceptual similarity between the marks. The identity/similarity of the goods and services was not in dispute.</p> <p>The GC agreed with the BoA that the common element 'spin bingo' was descriptive of the relevant goods and services, which was exacerbated by the presence of the reel in the figurative element of the mark applied for.</p> <p>The word 'bingo' was a commonly known game, which, in combination with the word 'spin', would lead the relevant public to perceive 'spin bingo' as a specific version of the game of bingo. The GC held that the combination of the words 'spin' and 'bingo' was not so unusual that it produced an impression that was unusual enough to make it a sum of its parts.</p>

<p>GC T-278/13 <i>Now Wireless Ltd v OHIM; Starbucks (HK) Ltd</i> (30.01.15)</p>	 <p>- information provided online from a computer database or from the Internet, installation and maintenance of computer software, provision of access to the Internet, provision of Internet services, provision of access to sites on an electronic information network, provision of access to various databases, hiring, rental and leasing of computer programs, computer terminals, modems, computer peripherals, any other Internet devices (42)</p>	<p>In revocation proceedings, the GC dismissed the appeal from the BoA's decision and upheld the finding of genuine use of the mark under Arts 51(1)(a) and 51(2).</p> <p>The GC held that it was arbitrary to divide the services into sub-categories. The services at issue all met the same need, namely electronic network access services for an end-user who wished to access such networks. Furthermore, such services would be sought by consumers as a bundle, and not as individual services.</p> <p>Starbucks had relied on acts of use of the mark by its licensee to help establish genuine use. The consent granted by Starbucks to its licensee to use the mark was not limited to 'wireless broadband services' by the licence agreement between the parties. Further, Starbucks and its licensee were subsidiaries of the same parent (they were economically linked), and use of the mark by the licensee was presumed to be with the proprietor's consent.</p> <p>The BoA was correct to find that the mark had been put to genuine use in London and the Thames Valley. Use in this geographical area was sufficient to constitute genuine use in the EU. Significant weight should be assigned to use in London, which was the largest city in the UK and the largest urban area in the EU.</p>
<p>GC T-372/12 <i>El Corte Inglés, SA v OHIM; Apro Tech Co. Ltd</i> (04.02.15)</p>	 <p>- bicycles and bicycle parts and accessories, bicycle frames, folding bike, front fork, cranks, brakes, derailleur, brake levers, handlebar, pedals, chain rings, rim for wheels of bicycles, gear wheels, handlebar stems, saddles, seat post, grips, water bottle cages, hubs, bicycle gear, derailleur gear units, bicycle free wheel, quickly disassembled device, electric bicycle (12)</p>	<p>The GC dismissed the appeal from the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The GC agreed with the BoA that the goods were partially identical and partially similar.</p> <p>The GC found that the BoA had erred in its comparison with the earlier figurative mark in considering the 'by Boomerang' element to be negligible in light of the dominant 'b-pro' element. Both elements must be considered in the context of overall impression, especially in light of the relevant public's perception which was not disputed to be higher than average</p>

	 <p>- bicycles (12) - vehicles, vehicles for locomotion by air, land or water (12)</p> <p>PRO MOUNTAIN - vehicles, apparatus for locomotion by air, land or water (12)</p> <p>PRO OUTDOOR (application) - vehicles, vehicles for locomotion by air, land or water (12) (Spanish and Community marks)</p>	<p>in this case.</p> <p>Considering the differentiators of colour, the hyphen and 'by Boomerang' elements in the earlier figurative mark there was a low degree of visual similarity. Conceptually, the marks would either be considered different (the 'Boomerang' element of the earlier mark would likely be perceived as an indicator of origin) or fanciful such that a comparison could not be made. The 'boomerang' element also accentuated phonetic differences between marks. There was therefore a low degree of similarity between the mark applied for and the earlier figurative mark.</p> <p>The earlier word marks were found to be considerably different from the mark applied for, visually and phonetically. Conceptually, the marks were found different or neutral.</p> <p>Given this, there was no likelihood of confusion between the marks.</p>
<p>GC T-570/10 RENV <i>Environmental Manufacturing LLP v OHIM; Société Elmar Wolf</i> (05.02.15)</p>	 <p>- machines for professional and industrial processing of wood and green waste, professional and industrial wood chippers and shredders (7)</p>   <p>various French, Spanish, Portuguese marks covering Classes 1, 5, 7, 8, 12 and 21.</p>	<p>Rehearing this case which was referred back to it by the CJ, the GC annulled its previous decision (reported in <i>CIPA Journal</i>, June 2012) and found that there was no risk of dilution or of free riding on the reputation of the earlier marks within the meaning of Art 8(5).</p> <p>Applying the CJ's finding that a change in economic behaviour on the part of the relevant public was required to establish dilution, the GC found that it had previously been wrong to conclude that there was a risk of dilution as there was no evidence which established that there had been a change in economic behaviour.</p> <p>As regards the issue of free riding (which the GC did not consider in its previous decision), the GC found that the BoA had not carried out a proper global assessment taking into account all of the relevant factors. In particular, the BoA failed to assess the likelihood of association of the mark applied for with the particular positive qualities of the earlier marks. On that basis, the BoA was incorrect to find</p>

		that there was a risk of free riding. The GC therefore found that there was no risk of dilution or of free riding within the meaning of Art 8(5) .
<p>GC T-33/13 <i>Türkiye Garanti Bankası AS v OHIM; Card & Finance Consulting GmbH</i> (05.02.15)</p>	<p></p> <p>- office functions, business management services, systematic ordering of data in computer databases, collating of data in computer databases, business administration, operating, devising and handling bonus schemes, storecard services (35)</p> <p>- insurance, financial affairs, monetary affairs, real estate affairs (36)</p> <p>- various services in Class 42</p> <p></p> <p>- various services in Classes 35, 36 and 42 (International mark)</p>	<p>The GC annulled the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA correctly stated that the relevant public was both the general public and business customers. However, the BoA was wrong to only take into account the elevated level of attention of business customers when considering the level of attention of the relevant public for the purpose of assessing the similarity of the marks.</p> <p>Contrary to the BoA's decision, at the very least, the marks had a degree of visual similarity and an average degree of phonetic similarity, due to the common element 'bonus'.</p> <p>The BoA also erred in finding the marks conceptually different. There was necessarily a conceptual similarity for a significant part of the public for whom the common element 'bonus' conveyed an identical meaning.</p> <p>Despite the weak distinctive character of the element 'bonus', it could not be regarded as being of secondary importance in relation to the other elements of the marks. The BoA was therefore wrong to find that the marks were different overall and, consequently, to find that there was no likelihood of confusion.</p>
<p>GC T-78/13 <i>Red Bull GmbH v OHIM; Sun Mark Ltd</i> (05.02.15)</p>	<p>BULLDOG</p> <p>- mineral and aerated waters; energy drinks; isotonic drinks; (non-alcoholic) aerated drinks (and beers); fruit-flavoured aerated drinks; fruit drinks and fruit juices; non-alcoholic drinks (32)</p> <p>BULL</p> <p>- non-alcoholic drinks, including soft drinks, energy drinks, whey beverages and isotonic</p>	<p>The GC annulled the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was incorrect to find that the marks had a low degree of visual and phonetic similarity and were conceptually different. Owing to the extra letters DOG in the mark applied for, the two marks had average visual and phonetic similarity. Conceptually, the GC noted that most non-English speakers would not normally be familiar with the word 'bull'. No conceptual comparison was possible</p>

	<p>(hypertonic and hypotonic) drinks (for use by sportspeople and adapted to their needs); non-alcoholic malt beverages; mineral and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages, including effervescent tablets (sherbets) and powders for non-alcoholic drinks and cocktails (32)</p> <p>(International and Austrian Marks)</p>	<p>for that part of the public. In contrast, for the English-speaking public the two marks would be known to refer to two separate animals but those signs were not devoid of a certain conceptual similarity because the bull and the bulldog conveyed the image of animals which often behaved aggressively towards their fellow creatures or human beings. However, the degree of conceptual similarity was low even for English-speakers. The marks were therefore similar overall.</p> <p>When assessing the likelihood of confusion, the GC noted that the BoA had failed to take into account the identity of the goods. As the goods were identical and the marks were similar, the GC held that there was a likelihood of confusion.</p>
<p>GC T-499/13 <i>nMetric LLC v OHIM</i> (05.02.15)</p>	<p>SMARTER SCHEDULING</p> <p>- business management systems, namely, suite of computer programs for use in the scheduling, planning, coordination, and execution of business, engineering, manufacturing, services, projects and/or supply chain activities which may include, order management, inventory management, resource allocation, and management, manufacturing processes and management, services coordination and management, maintenance coordination and management, project and portfolio coordination and management, logistics, data analysis and management (9)</p>	<p>The GC upheld the BoA's decision to reject the application on the ground that the mark was devoid of distinctive character under Art 7(1)(b).</p> <p>The BoA was correct to find that the meaning of the words 'smarter' and 'scheduling' made it clear that the mark informed the public that the software covered by the mark assisted with scheduling – the mark was therefore descriptive, and the relevant public would not regard the words as an indication of the commercial origin of the goods/services covered by the mark.</p> <p>The GC confirmed the BoA's finding that the term SMARTER SCHEDULING contained no fanciful element which, beyond its obvious promotional meaning, could enable the relevant public to memorise it easily and instantly as a distinctive mark for the goods and services concerned. As nMetric had not succeeded in demonstrating that the mark had other special characteristics capable of making it distinctive, the GC held that the BoA was correct in concluding that the mark was devoid of distinctive character under Art 7(1)(b).</p>

<p>GC T-85/14 <i>Infocit – Prestação de Serviços, Comércio Geral e Indústria, Lda v OHIM; DIN – Deutsches Institut für Normung eV</i> (10.02.15)</p>	<p>DINKOOL - various goods in Classes 7, 9 and 11</p>  <p>- various goods in Classes 1-34 (International mark with effect in Germany and unregistered German business identifier)</p>	<p>The GC upheld the BoA's decision to reject the mark applied for under Arts 8(1)(b) and 8(4).</p> <p>There was a certain degree of visual similarity between the marks for the relevant German public. The two horizontal lines in the earlier mark and the letters 'kool' in the mark applied for were not sufficient to remove the visual similarity caused by the letters 'din' in both marks. The phonetic similarity was less as the presence of 'kool' in the mark applied for would change the German pronunciation of 'din'. The BoA was not correct to find the marks conceptually dissimilar. German consumers might perceive 'din' in both marks as a reference to the Deutsches Institut für Normung (the German Institute for Standardization). The letters 'kool' could be understood as a reference to the English word 'cool' and would not remove the association with the Deutsches Institut für Normung.</p> <p>Given the similarity of the marks there was a likelihood of confusion in relation to the goods in Class 7 and those goods in Classes 9 and 11 which were identical or similar.</p> <p>In relation to the goods in Classes 9 and 11 which were dissimilar, the BoA was correct to reject the application under Art 8(4) on the basis of the earlier unregistered business identifier in Germany. German consumers might perceive the mark applied for as an indication that the goods complied with the standard set by the Deutsches Institut für Normung. This would take unfair advantage of the business identifier without due cause and was therefore prohibited under German law.</p>
<p>GC T-379/13 <i>Innovation First, Inc v OHIM</i> (10.02.15)</p>	<p>NANO - robots for educational use, namely teaching robots, and structural parts therefore; kits for constructing teaching robots (9) - toy robots, toy robot building kits, toy robots for</p>	<p>The GC upheld the BoA's finding that the mark was descriptive under Art 7(1)(c).</p> <p>The BoA had been correct to find that the relevant public were average consumers and IT professionals and that they would perceive the mark as primarily denoting goods which were</p>

	<p>educational use, robots for hobby use, namely robots for entertainment use, kits for constructing robots for entertainment use, toy bridges, toy building structures and toy vehicle tracks (28)</p>	<p>either extremely small or involved the use of nanotechnology. The word 'nano' had also acquired a meaning which extended beyond its exact mathematical definition. It would be understood by the relevant public as referring more generally to the small size of the goods applied for and would therefore describe one their possible characteristics.</p> <p>The BoA was also correct to find that nanotechnology could be used in the fields of electronics, computing and engineering which were relevant to the design and manufacture of the goods applied for. This again meant that the mark described one the possible characteristics of the goods applied for.</p>
<p>GC T-648/13 <i>IOIP Holdings LLC v OHIM</i> (10.02.15)</p>	<p>GLISTEN - cleaning preparations, cleaning, freshening, deodorant and disinfectant preparations for garbage disposals (42)</p>	<p>The GC dismissed the appeal from the BoA's decision and refused registration of the mark as it was descriptive of the relevant goods under Art 7(1)(c).</p> <p>The BoA correctly found that, rather than carrying out a grammatical analysis of the word 'glisten', consumers would focus on its meaning, namely to make objects shine.</p> <p>The GC dismissed IOIP's submission that the purpose of the goods was to clean and disinfect, rather than make objects shine. When assessing distinctive character, account must solely be taken of the point of view of the relevant public, which, in this case, would consider shininess and cleanliness to be closely associated to the point of overlapping.</p> <p>Further, the GC held that when specifically associated with the goods covered by the mark applied for, 'glisten' directly described an effect which could be achieved by using those goods.</p>
<p>GC T-395/12 <i>Fetim BV v OHIM; Solid Floor Ltd</i> (11.02.15)</p>	 <p>- building materials, not of metal, parquet flooring of</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was incorrect to find that the relevant public (all UK consumers,</p>

	<p>plastic and wood, flooring of wood, cork and laminate; subfloors; transportable floors, not of metal (19)</p>   <p>- solid wood flooring; wooden parquet flooring (19)</p> <p>- installation of wood flooring (37)</p> <p>(UK mark)</p>	<p>including the public and professionals in the field) had an average level of attention, as the goods and services at issue were relatively expensive and not bought on a frequent basis. The GC held that the level of attention was therefore higher than average.</p> <p>The BoA had correctly taken into account the word element 'solid floor' when comparing the marks. The fact that 'solid floor' was only of weak distinctive character did not mean that it could not constitute the dominant element of the marks.</p> <p>The GC concluded that the marks were visually similar and conceptually and phonetically highly similar.</p> <p>Given the partial identity and partial similarity of the goods and services and the similarity of the marks, the BoA was correct to find that there was a likelihood of confusion.</p>
<p>GC</p> <p>T-76/13</p> <p><i>Compagnie des montres Longines, Francillon SA v OHIM; Staccata Srl</i></p> <p>(12.02.15)</p>	 <p>- scientific equipment (9)</p> <p>- precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones; horological and chronometric instruments (14)</p>   <p>- scientific equipment (9)</p> <p>- precious metals and their alloys and goods made thereof or coated therewith, jewellery, precious stones, horological and chronometric instruments (14)</p> <p>(International and Community marks)</p>	<p>The GC dismissed the appeal from the BoA's decision to dismiss the opposition under Arts 8(1)(b) and 8(5).</p> <p>Under Art 8(1)(b), the degree of visual similarity between the mark applied for and the earlier marks was very low. The BoA was correct to meticulously compare the stylisation of the wings of the marks and to conclude that there was a significant difference in the forms of stylisation.</p> <p>Conceptually, the marks shared a low degree of similarity. Although there was a certain semantic analogy between the marks due to the representations of wings, it was only low in degree because the wings referred to different types of birds. The conceptual differences were further marked by the inclusion of the hourglass in the earlier marks and for Italian speaking consumers for whom 'quartodimiglio' has meaning (namely, 'quarter of a mile').</p> <p>In light of the visual differences and the undisputed fact that the marks different phonetically, the BoA was correct to conclude, irrespective of a certain conceptual similarity, that there was no likelihood of confusion,</p>

		<p>even where the goods were identical.</p> <p>It had not been proved that the earlier figurative marks which consisted of the 'winged hourglass' had a reputation for the purposes of Art 8(5). The earlier composite marks which included the word 'longines' were sufficiently different from the mark applied for to preclude the establishment of a link between the marks. The BoA's decision was upheld.</p>
<p>GC T-505/12 <i>Compagnie des montres Longines, Francillon SA v OHIM; Xiuxiu Cheng</i> (12.02.15)</p>	 <p>- optical sunglasses (9) - clothing and footwear (25)</p>  <p>- watches, watch movements, cases, faces and bands, watchmaking materials; chronometers; chronographs; apparatus for timing sports events; pendulum clocks, pendulettes and alarm clocks; all chronometric instruments, jewellery watches, jewellery; timing installations, time display devices and panels (14)</p> <p>(International mark)</p>	<p>The GC upheld the BoA's decision to reject the opposition pursuant to Arts 8(1)(b) and 8(5).</p> <p>The BoA was correct to find that the goods were dissimilar and therefore the grounds of opposition failed under Art 8(1)(b). The goods differed in their nature, their intended purpose and their method of use. Neither the fact that there may be an overlap between consumers of the goods nor the fact that in the luxury goods sector there were examples of producers which manufactured goods covered by both marks, was sufficient to find any similarity between the goods.</p> <p>The BoA was also correct to find that it had not been proved that the earlier mark had a reputation. Despite the continuous quantitative and qualitative use of a composite mark (the earlier mark together with the word 'longines') over a period of time, it was the word 'longines' which would attract the attention of the consumers and likely to be retained by them rather than the earlier mark. There was therefore no infringement of Art 8(5).</p>
<p>GC T-287/13 <i>Husky CZ s.r.o v OHIM; Husky of Tostock Ltd</i> (13.02.15)</p>	<p>HUSKY</p> <p>- cleaning products, perfumery and cosmetics (3) - glasses, sunglasses and containers for contact lenses (9) - jewellery (14) - paper, stationery and printed matter (16)</p>	<p>In revocation proceedings, the GC upheld the BoA's decision that there had been genuine use of the mark under Art 51(1).</p> <p>The GC found that the BoA had not erred in granting Husky of Tostock's (the trade mark proprietor) various requests for time extensions for filing evidence. Properly construed, Rules 71(1) and (2) of the Implementing Regulation (2868/95/EC) provided that, when a party in <i>inter</i></p>

	<p>- leather goods (18) - clothing (25)</p>	<p><i>parties</i> proceedings requested an extension of time, OHIM might, but was not required to, seek the consent of the other party. If OHIM decided not to seek the other party's consent it must take account of the circumstances surrounding the request for an extension of time. In this case, OHIM had taken proper account of the circumstances (namely Husky of Tostock's reliance on the use of the mark by its licensee) in reaching its decision. The BoA therefore had not erred in granting an extension of time without reference to the other party.</p> <p>The GC also found that the BoA was correct to take into consideration certain untranslated and undated documents when considering the evidence on genuine use.</p>
<p>GC T-257/11 <i>Pangyrus Ltd v OHIM; RSVP Design Ltd</i> (26.02.15)</p>	<p>COLOURBLIND - various goods and services in Classes 9, 16, 28, 35 and 41</p>	<p>The GC upheld the decision of the BoA dismissing an application to invalidate the mark on the ground that it was applied for in bad faith under Art 52(1)(b).</p> <p>Mr Cx was a shareholder and former director in Pangyrus. Mr Cx left Pangyrus and set up a new company (RSVP Design) which acquired Mr Cx's legal rights in the mark. The mark was then registered by RSVP Design. Pangyrus applied to invalidate the mark on the basis that there was a common understanding between the parties that the mark was the property of Pangyrus when the application was filed. The GC held that it could not be excluded that Mr Cx considered himself to have rights in the mark up until the transfer of those rights to RSVP Design and that Pangyrus made use of the mark under an implied or informal agreement. Therefore, no common understanding could be objectively inferred from the evidence.</p> <p>Furthermore, Pangyrus had failed to prove that, prior to the application date, it had used the mark in the course of trade. Therefore, its submission under Arts 53(1)(c) and 8(4) was also rejected.</p>

<p>GC</p> <p>T-388/13</p> <p><i>Costa Crociere SpA v OHIM; Guerlain SA</i></p> <p>(26.02.15)</p>	<p>SAMSARA</p> <p>- spas, Turkish baths, sauna services, health spa services, all provided on board cruise ships (44)</p> <p>SAMSARA</p> <p>- soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices (3)</p>	<p>The GC upheld the BoA's decision to allow the opposition as there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA was correct to find that the goods and services shared the same overall purpose (beauty and healthcare). Spa and sauna services often used products such as soaps and oils, therefore the distribution channels may overlap and the target public was identical. The fact that Costa Crociere provided its services on board cruise ships did not alter their overall purpose.</p> <p>Furthermore, the GC did not accept Costa Crociere's submission that Guerlain could not claim rights in the word 'samsara' because of lack of distinctiveness and its descriptive character. The GC held that most consumers would not associate the mark with its Sanskrit meaning 'eternal cycle of life'. It was more a fanciful word.</p> <p>Therefore given the average degree of similarity between the goods and services and the identity of the marks, there was a likelihood of confusion.</p>
---	--	---

Court of Appeal rules on re-branding parallel imports

***Speciality European Pharma Ltd ('SEP') v Doncaster Pharmaceuticals Group Ltd and Anr ('Doncaster')** (Arden, Floyd & Bean LJJ; [2015] EWCA Civ 54; 06.02.15)**

The CA (**Floyd LJ** giving the lead judgment) ruled on the circumstances in which a parallel importer could re-brand goods for importation from one EU member state into another. Overturning the decision of the High Court (reported in *CIPA Journal*, December 2013), the CA held that SEP's attempted enforcement of its trade mark rights in respect of Doncaster's importation of relabelled pharmaceutical products was unlawful pursuant to **Article 36** of the **Treaty on the Functioning of the European Union ('TFEU')** because it prevented Doncaster from accessing a significant portion of the market.

Doncaster imported SEP's French 20mg tiroprium chloride product, Ceris, and SEP's German 60mg tiroprium chloride product, uriVesc, into the UK and re-branded them under SEP's UK tiroprium chloride brand name, Regurin (used in relation to both doses). At first instance **Asplin J** held that replacement of the trade mark must be objectively necessary to enable the importer to have *'effective access to the market of the importing member state'* and that this requirement was not met because Doncaster would have access to a large proportion of the market under the generic tiroprium chloride label.

The CA reviewed the leading cases of *Bristol-Myers Squibb v Paranova Case C-427/93* and *Upjohn v Paranova Case C-379/97* and held that: (i) effective access was not achieved by

being able to place some goods on the market; (ii) it may be necessary to re-brand where the parallel importer was not excluded from the whole of the market, but was merely excluded from a substantial part of it; and (iii) in determining whether it was necessary to re-brand the court must consider what alternatives exist for the parallel importer.

The CA considered that there were two possible points of sale for tropsium chloride in the UK; pharmacists and doctors (when they write prescriptions). When a prescription was written for 'Regurin' (as it was in 8.62% of the time for the 20mg product and around 30% of the time for the 60mg product), a pharmacist was legally obliged to supply Regurin, rather than tropsium chloride under another brand name. This meant that Doncaster was excluded from that part of the market unless it was allowed to re-brand under the Regurin name. The CA further held that this part of the market from which Doncaster was excluded was significant.

Secondly, the CA found that **Asplin J** was wrong to hold that Doncaster could realistically compete for the whole of the market by adopting its own (new) brand and seeking to persuade doctors to prescribe by reference to this brand. The CA held that this was not a real-world alternative to re-branding the imported products given the disproportionate costs of doing so when viewed in light of the uncertain supply.

Therefore, the CA held that Doncaster's re-branding went no further than was necessary to overcome artificial barriers to effective market access, and its appeal was upheld.

SUPREME found non-distinctive for pet food

Supreme Pet Foods Ltd ('SPF') v Henry Bell & Co (Grantham) Ltd* (Arnold J; [2015] EWHC 256 (Ch); 12.02.15)

Arnold J held that SPF's word marks for SUPREME, as well as its stylised SUPREME marks, were invalid save in relation to small pet food, because they were descriptive and did not have inherent or acquired distinctiveness in relation to animal food more generally. The Judge found that Henry Bell's use of SUPREME in relation to small animal food did not infringe either of those marks, nor SPF's 'ribbon' marks, and did not constitute passing off.

SPF owned a UK trade mark for the word SUPREME, and UK and Community trade marks for both a stylised word and a ribbon device, all of which were registered in Class 31 for (among other things) 'animal foodstuffs'. SPF brought trade mark infringement and passing off proceedings against Henry Bell in relation to its use of the word SUPREME. SPF's marks and an example of Henry Bell's rabbit food packaging are shown below:



Onus of proof

The Judge revisited the onus of proof issue in double identity cases under **Article 5(1)(a)**, referring to a long line of CJEU case law, including that relating to exhaustion of trade marks, honest concurrent use, the territorial scope of injunctions, and keyword advertising. He noted that the CA in *Interflora Inc v Marks and Spencer plc* [2014] EWCA Civ 1403, in a judgment delivered by **Kitchin LJ**, had held that the onus of proof lay on the trade mark proprietor to prove that the defendant's use of the sign had an effect on the functions of the trade mark. However, **Arnold J** distinguished the CA's view in that case on the basis that it was concerned with keyword advertising rather than being an ordinary case such as the present. To the extent that the CA's dicta went beyond keyword advertising they were, in the Judge's view, obiter. Nevertheless, the Judge acknowledged that the point was unclear and stated that it was an important issue of European trade mark law which would have to be referred to the CJEU for determination, preferably sooner rather than later. However, concluding that a reference was not necessary in the present case, the Judge went on to adopt the interpretation that the defendant bore the onus of proving that its use did not affect the functions of the trade mark.

Having found that SPF's SUPREME word mark was only validly registered in respect of small animal food, the Judge went on to reject its claim under **Article 5(1)(a)** on the basis that Henry Bell's use of the sign SUPREME would be understood by the average consumer as being purely descriptive, and/or that Henry Bell had established that there was no adverse effect on the origin function of SPF's mark because its SUPREME RABBIT MIX had coexisted with SPF's use of SUPREME for 20 years without any confusion.

On SPF's claim under **Article 5(1)(b)** based on its stylised word and ribbon marks, the Judge found that while Henry Bell's use of SUPREME was identical to the SUPREME element of the marks, there was no similarity with any of the graphical elements of the marks and therefore no likelihood of confusion. Even if there might otherwise have been such a likelihood, the context of Henry Bell's use of SUPREME (which was always subsidiary to its other well-known branding) would suffice to negate such a likelihood.

On SPF's claim under **Article 5(2)** based on its ribbon marks, the Judge found that the marks enjoyed no reputation, and that even if they had, there was not the requisite link nor any likely detriment to their distinctive character, which resided in the graphical elements of those marks alone. Further, Henry Bell's use of the marks was not without due cause, it having used the sign descriptively for over 20 years.

The Judge concluded that Henry Bell would in any event have had a defence under **Article 6(1)(b)**, its use being in accordance with honest commercial practices. As it was common ground that the passing off claim stood or fell with SPF's claim under **Article 9(1)(b)**, Henry Bell was found not to have committed passing off.

Pan-European relief and publicity orders

***Enterprise Holdings, Inc v Europcar Group UK Ltd** (Arnold J; [2015] EWHC 17 (Ch); 13.02.15)**

Having found that Europcar had infringed Enterprise's CTM (reported in *CIPA Journal*, February 2015), **Arnold J** held that the geographical scope of the injunction and the inquiry as to damages or account of profits should be limited to the United Kingdom rather than having pan-European effect. He considered that the position as to financial remedies should stand or fall with the geographical scope of the injunction.

Arnold J referred to the judgment of the CJEU in **Case C-235/09 DHL Express France SAS v Chronopost SA** where it was held that a prohibition against further or threatened infringement by a CTM court must, as a rule, extend to the entire area of the EU subject to two exceptions; namely where the CTM court hearing the case found that the acts of infringement or threatened

infringement of a CTM were limited to a single Member State or to part of the territory of the European Union, in particular because: (i) the applicant for a prohibition order had restricted the territorial scope of its action in exercising its freedom to determine the extent of that action, or (ii) the defendant proved that the use of the sign at issue did not affect or was not liable to affect the functions of the trade mark, for example, on linguistic grounds. The Judge was of the view that these two exceptions were supportive of his perceived differing burdens of proof in **Article 9(1)(a)** cases on the one hand and **Article 9(1)(b) and (c)** cases on the other, and distinguished the present case from *DHL* on that basis, although he acknowledged that both exceptions were equally applicable regardless of the basis of infringement.

Also acknowledging that the above was a provisional view which was not *acte clair*, the Judge went on to find that this was a case in which the first exception applied. Although Enterprise had included a claim for pan-European relief in its Particulars of Claim, the only infringing acts which it had pleaded were acts committed in the UK and France. Moreover, it had been explicitly prohibited from relying upon infringing acts elsewhere within the EU and had not appealed against that order. In his main judgment, **Arnold J** had made no finding that there was acquired distinctive character of Enterprise's CTM in Member States other than the UK, nor that there was actual confusion in other Member States, because there was no evidence to support findings to the contrary. Accordingly, Enterprise was found to have restricted the territorial scope of its action by restricting the territorial scope of the past infringing acts upon which it relied. However, the Judge was at pains to point out that neither the present judgment nor his main judgment created any *res judicata* with regard to the allegations of infringement of Enterprise's trade marks by Europcar in any other Member State.

Thirdly, the Judge considered that the second *DHL* exception also applied because, on what little evidence there was, Europcar's use of the sign in question did not, and was not liable to, affect the functions of Enterprise's CTM in any Member State other than the UK.

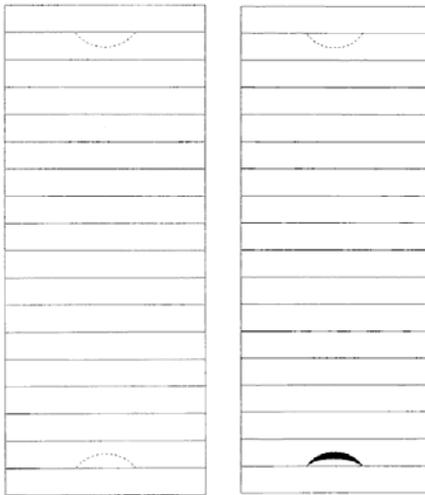
Arnold J went on to hold that it was appropriate to make a publicity order under **Article 15** of the **Enforcement Directive**. Although such orders were not to be considered automatic, there was good reason in the present case because there had been actual confusion on the part of consumers in the UK. Given the sporadic nature of vehicle rental services, Europcar was required to display the notice for a period of three months to allow a reasonable chance of a reasonable number of consumers seeing it.

DESIGNS

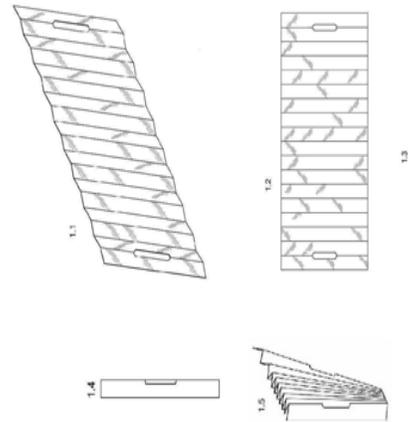
Folding cardboard sign design found to have individual character

***Argo Development and Manufacturing Ltd v OHIM; Clapbanner Ltd* (GC; T-41/14; 28.01.15)**

Clapbanner was the proprietor of a registered Community Design (reproduced below left), which was registered for advertising articles and related to signboards typically made of lightweight cardboard and may be folded like an accordion. Argo (the proprietor for earlier designs, one of which is reproduced below right) applied to invalidate the design under **Articles 4, 5, 6 and 25(1)(b)** of the **Community Designs Regulation**.



Contested Design



Earlier Design

The Invalidity Division granted the application for a declaration of invalidity on the basis that the design lacked individual character. On appeal, the BoA overturned this decision. Argo appealed to the GC which upheld the BoA's decision and found the design valid.

Article 4(2)

The GC rejected Argo's submission that, because part of the handles were not visible when the design was in use, they could not be new or have individual character. As Argo itself stated, the contested design did not constitute a complex product. Therefore, this provision did not apply.

Article 5

Argo's submission that the contested design differed from the four earlier designs in only immaterial detail was rejected. The GC agreed with the BoA that the differences could not be considered immaterial since they were perceptible when the earlier designs and the contested design were placed side by side. The GC upheld the BoA's decision that the contested design was new within the meaning of **Article 5**.

Article 6

The GC also rejected Argo's submission that the contested design could not be considered to have individual character. The rectangular shape and the accordion-like foldable pleats were two factors of the design in which the designer had only a very limited degree of design freedom. On an overall assessment, taking into account this limited degree of design freedom, the BoA was correct to find that the aspects of the handles in the contested design were sufficiently different from the handles in the earlier designs so as to produce a different overall impression on the informed user.

Finally, Argo's submission that the contested design was registered in bad faith was dismissed as having no legal basis.

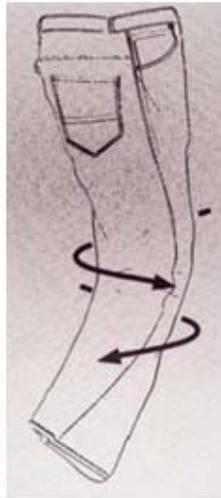
Accordingly, the GC upheld the BoA's decision that the contested design was new, possessed individual character and was thus valid.

Unregistered design rights in denim jeans designs found infringed

***G-Star Raw CV v Rhodi Ltd & Ots** (Richard Spearman QC; [2015] EWHC 216 (Ch); 06.02.15)**

Richard Spearman QC (sitting as a Deputy Judge) held that Rhodi's jeans (the 'Rhodi styles') infringed G-Star's unregistered UK design rights its design of a pair of jeans known as the 'Arc Pant'.

G-Star designed, manufactured and distributed clothing and fashion accessories and was one of Europe's leading denim fashion brands. It claimed that its Arc Pant design was a departure in 3D denim design; its designer gave compelling evidence of the design process which it claimed had resulted in the creation of a 'highly architectural cut' featuring 'a low crotch and straight hip, with an asymmetric tapered leg' that turned around the human leg, thanks to twisted side seams and inseams. The result was a silhouette that looked built for a 3D human being, as shown below:



In considering whether any of the Rhodi styles were made substantially to the Arc Pant designs, the Judge said that it was clear that the test of infringement of unregistered design right was different to that of infringement of copyright (the latter requiring that a substantial part of the work is copied, the former requiring that the design is copied so as to produce articles exactly or substantially to the design). However, he said that the extent to which the two tests would produce different results would depend on how the design right was framed. Therefore, he was of the view that in the case of unregistered design rights the question of 'part' came in at the stage of subsistence of the right, rather than at the stage of infringement. Accordingly, it would not be appropriate to apply the copyright test of infringement to the law of unregistered design right, given that a claimant is able to tailor the design relied upon to the specific part of the product which is alleged to infringe. Nevertheless, the Judge said that he found the Rhodi styles to have been made substantially to the Arc Pant designs not on the basis of this reasoning, but because a large amount of detail present in the Arc Pant designs was also present in the Rhodi styles.

In the Judge's view, the similarities between the Arc Pant and the Rhodi styles were striking. This, coupled with Rhodi's opportunity for access to the Arc Pant designs, raised a rebuttable presumption of copying. The Judge found that Rhodi had fallen far short of rebutting the inference of copying: (i) neither the main designer nor the CAD designer of the Rhodi Styles were called to give evidence, and the so-called designer who *was* called had no training, was bad at drawing and could not make material use of a computer; (ii) there was evidence that a sample of the Arc Pant was used to communicate design ideas to Rhodi's manufacturers; and (iii) having been through previous proceedings against G-Star concerning alleged design infringement, the absence of a paper trail which Rhodi would be expected to have kept to protect itself from future possible claims was notable and indicated bad faith. The Judge therefore found that the similarities between the Arc Pant and the Rhodi styles arose from copying and that G-Star's unregistered design rights in its Arc Pant design were therefore infringed.

COPYRIGHT

Equitable ownership found under agreement to assign copyright in a future work

Fresh Trading Ltd ('Fresh') v Deepend Fresh Recovery Ltd ('Deepend Fresh') & Anr* (Robert Englehart QC; [2015] EWHC 52 (Ch); 26.01.15)

Robert Englehart QC (sitting as a Deputy Judge) held that Fresh was the beneficial owner of the copyright in the 'Innocent' smoothie logo which consisted of cartoon depiction of a face with a halo, and made a declaration accordingly.

Fresh was the company behind the well-known brand of Innocent smoothies. Deepend Design was a design agency from which Fresh commissioned the logo under a consultancy agreement in the late 1990s. Deepend Design had later gone into liquidation, and its purported interest in rights in the logo and other works produced under the agreement was purchased by a third party. That party then assigned the interest to Deepend Fresh (a holding company) which subsequently obtained a declaration of invalidity of Fresh's Community trade mark registration for the logo, based on the holding company's purported ownership of copyright in it.

Neither party to the proceedings had been able to produce a copy of the signed consultancy agreement, under which Fresh was entitled to the copyright in all works created by Deepend Design which were subsequently approved by Fresh. In the absence of a signature the Judge found that there had been no effective legal assignment of the copyright as it did not comply with the formality requirements of **Sections 90 and 91** of the **CDPA**. Further, the fact that copyright in works created by Deepend Design vested in Deepend Design upon creation meant that **Section 91** did not apply in any event, because it was only upon subsequent approval of works by Fresh that the copyright was transferred.

However, the Judge went on to find that this amounted to an equitable assignment. Such approval had undoubtedly occurred, and the fact that Deepend Design had not received the remuneration (in the form of shares) provided for in the agreement did not negate the assignment. The Judge added that, even if he had not found an express assignment on the facts, he would have found that there was an implied assignment, as this was the only arrangement that made commercial sense.

Furthermore, the Judge stated that even if Fresh had not owned the copyright, Deepend Fresh would have been estopped from enforcing its copyright at such a late stage after Fresh had built up a substantial business based on the logo.

Effect of unreasonable behaviour on stage cost caps in IPEC

Kemal Akhtar v Bhopal Productions (UK) Ltd* (Judge Hacon; [2015] EWHC 154 (IPEC); 03.02.15)

Judge Hacon held that the stage costs cap applicable to proceedings in the IPEC continued to apply even where there was unreasonable behaviour.

Mr Akhtar brought proceedings for copyright infringement relating to a film called 'Bhopal: A Prayer for Rain' about the severe industrial accident which took place at the Union Carbide facility in Bhopal, India. **Judge Hacon** considered that Mr Akhtar had acted unreasonably in filing Particulars of Claim and, subsequently, Amended Particulars of Claim that he found to be 'wholly inadequate'.

Referring to costs principles derived from IPEC cases to date, **Judge Hacon** held that the stage costs cap could not be lifted without 'unusually bad behaviour' on the part of the offending party. On the present facts, while Mr Akhtar's behaviour was unreasonable, it did not give rise

to the exercise of the court's discretion to lift the stage cap, nor did it amount to an abuse of process.

Referring to *Gimex v Chill Bag Company* [2012] EWPC 34 where **Judge Birss** held that where there are several defendants in the same proceedings they share the overall costs cap, **Judge Hacon** found that this principle applied equally to the overall cap and to the caps on stage costs. He was of the view that it would also make no sense to have separate caps for stage costs and a single cap for total costs.

Katharine Stephens, Zoe Fuller and Hilary Atherton

Reporters' note: We are grateful to our colleagues at Bird & Bird LLP for their assistance with the preparation of this report: Ahalya Nambiar, Toby Bond, Tom Darvill, Mark Livsey, Mohammed Karim, Rebekah Sellars, Henry Elliott, Ning-Ning Li, Toby Sears and Will Smith.

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