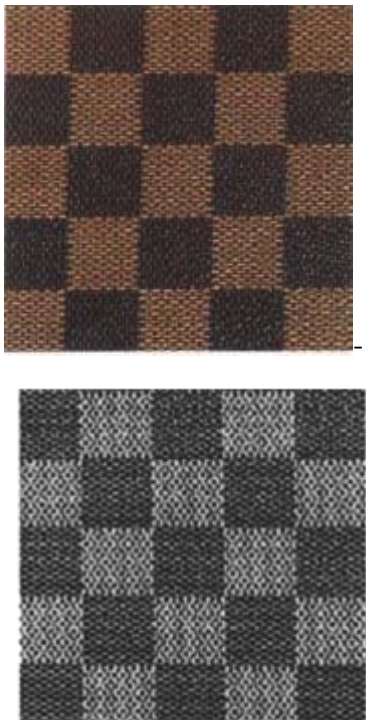



TRADE MARKS

Decisions of the GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC  <b>T-359/12</b> and <b>T-360/12</b>  <i>Louis Vuitton Malletier v OHIM; Nanu-Nana Handelsgesellschaft mbH für Geschenkartikel &amp; Co. KG</i>                      (21.04.15)</p>	 <p>- leather goods, travelling bags, rucksacks, handbags, wallets and purses, umbrellas and walking sticks (18)</p>	<p>The GC upheld two separate decisions of the BoA that two CTM registrations were invalid due to a lack of distinctive character under <b>Arts 52(1)</b> and <b>7(1)(b)</b>.</p> <p>As the marks applied for consisted of a pattern intended either to be placed on part of the goods or to cover the whole of their surface area, the BoA was correct to apply case law relating to three-dimensional marks.</p> <p>The application of the marks to the goods would not result in any notable variation to the conventional presentation of such goods. Therefore the relevant public would perceive any such goods bearing the marks as commonplace and everyday items. As such, the BoA was correct to find that both marks lacked inherent distinctive character.</p> <p>The BoA was also correct to find that the evidence filed by Louis Vuitton did not prove that distinctive character had been acquired through use. The two CTM registrations were therefore invalid.</p>
<p>GC  <b>T-282/13</b>  <i>Iglotex SA v OHIM; Iglo Foods Group Ltd</i>                      (23.04.15)</p>	 <p>- various food goods in Classes 29 and 30  <b>IGLO</b>                      - various food goods in Classes 29 and 30</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under <b>Art 8(1)(b)</b>.</p> <p>It was not disputed that (i) the relevant public consisted of average consumers with a normal to low degree of attention; and (ii) the relevant goods were either identical or highly similar.</p> <p>The GC rejected Iglotex's submission that the depiction of a penguin was dominant within the mark applied for. Although the depiction of the penguin could not be overlooked because of its</p>

		<p>size and position in the sign, it did not dominate the overall impression of the mark. The GC noted that the word element of the mark applied for was capable of attracting the consumer's attention.</p> <p>Visually there was a certain similarity between the marks, as the sole component of the earlier mark was entirely contained within the mark applied for. The marks were also found to be phonetically and conceptually similar.</p> <p>The earlier mark had a weak distinctive character as the relevant public could link the mark to a description of one of the characteristics of the goods at issue, namely frozen or refrigerated food goods. Despite this, the BoA was correct to find that there was a likelihood of confusion between the marks.</p>
<p>GC</p> <p><b>T-717/13</b></p> <p><i>Chair Entertainment Group LLC v OHIM; Libelle AG</i></p> <p>(29.04.15)</p>	<p><b>SHADOW COMPLEX</b></p> <p>- computer game software for personal computers and home video game consoles (9)</p> <p><b>BUSINESSSHADOW</b></p> <p>- computer software (recorded) (9)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to <b>Art 8(1)(b)</b>.</p> <p>The GC rejected Chair Entertainment's submission that the earlier mark would be understood as a single word. The average consumer would break down the mark into words familiar to them ('business' and 'shadow').</p> <p>The BoA was correct to find that the 'shadow' element of the marks was the most distinctive element and was not descriptive when combined with 'business' or 'complex'.</p> <p>The GC found there was an average (rather than low) degree of phonetic similarity, in particular because of the more distinctive character of the element 'shadow'. There was also a visual similarity and a conceptual similarity (for the English speaking public) between the marks.</p> <p>Therefore the BoA was correct to find a likelihood of confusion between the marks.</p>

## COPYRIGHT

### TV Catchup paused as Court of Appeal makes second reference to the CJEU

***ITV Broadcasting Ltd & Ots (the "Broadcasters") v TVCatchup & Ots ("TVC")\****  
**(Arden, Kitchin and Underhill LJ; [2015] EWCA Civ 204; 26.03.15)**

The CA (**Kitchin LJ** giving the lead judgment) considered that it was necessary to make a second reference to the CJEU seeking a preliminary ruling as to the scope of **Article 9 of Directive 2001/29/EC** (the "**Infosoc Directive**").

#### Background

TVC operated an internet-based live streaming service of broadcast television programmes including films and broadcasts in which the Broadcasters owned the copyright. The service allowed the public to watch UK television on computers, smart phones and games consoles when they signed up as members. Upon choosing a stream of the programme being broadcast, the user would be shown one of TVC's advertisements and then the live streaming would begin.

An earlier reference had been made by the High Court to the then ECJ for guidance on the meaning of "communication to the public" within **Article 3(1)** of the **Infosoc Directive**. The ECJ held that this included retransmission of copyright works included in a terrestrial television broadcast via a third party's website streaming service even if that party's subscribers were within the area of reception of the terrestrial broadcast and could lawfully receive the broadcast on a television receiver. As a result of the ECJ judgment, the High Court held that TVC infringed the copyright in the films and broadcasts by communicating them to the public.

In the High Court, TVC had pleaded that it had a defence under **Section 73 CDPA** which permitted certain acts to be carried out in relation to copyright works where a wireless broadcast was made from within the UK and received and immediately re-transmitted by cable. **Floyd J** (as he then was) held that the **Section 73** defence could only apply to the re-transmission by TVC of "qualifying services" provided using the internet to end users within the intended reception area of those services. This was held to include instances where the final leg of the transmission took place by WI-FI but not where the re-transmission was for reception by mobile telephone.

Both parties appealed to the Court of Appeal; the Broadcasters alleging that the **Section 73** defence was restricted to dedicated cable transmissions and did not include internet transmissions, and TVC cross appealing on the basis that the **Section 73** defence extended to a re-transmission for reception by mobile telephone.

#### Decision

**Kitchin LJ** held that, despite its legislative history, "cable programme" and "cable programme service" were not limited to programmes and services provided on dedicated cable networks. Thus the scope of **Section 73** was sufficiently broad to include the services provided by TVC which would have been "cable programme services". However, he concluded that the case raised a difficult question as to the scope of **Article 9** of the **Infosoc Directive** and whether it permitted the retention of **Section 73**. **Article 9** provided that the **Infosoc Directive** operated without prejudice to provisions concerning (among other things) "*access to cable or broadcasting services*". **Kitchin LJ's** preliminary view was that the scope of **Article 9** encompassed exceptions of the kind described in **Section 73** and that it was unlikely that the EU legislature intended by the use of the term "cable" to exclude provisions concerning retransmissions made over the internet, but found that a reference to the CJEU was necessary.

**Kitchin LJ** went on to reject TVC's appeal, finding that TVC was responsible for transmissions that started at TVC's servers and ended with the individual mobile telephone users. He held that there was no foundation in **Section 73** for the contention that it was sufficient if the retransmission took place substantially by cable. Furthermore, it was not possible to divide those transmissions into parts and argue that some parts constituted restricted acts and others did not, or that TVC were responsible for some parts but not others, or that some parts but not others were entitled to the defence afforded by **Section 73**.

**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: Emily Mallam, Mark Livsey, Mohammed Karim, Rebekah Sellars and Toby Bond.

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.euro.pa.eu/jcms/jcms/j\\_6/home](http://curia.euro.pa.eu/jcms/jcms/j_6/home)