

Bird & Bird

Report of Trade Mark Cases

For the CIPA Journal

November 2022



Trade mark decisions

Decisions of the General Court (GC) and Court of Justice (CJ)

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-669/20</p> <p><i>Pluscard Service-Gesellschaft für Kreditkarten-Processing mbH v EUIPO</i></p> <p>2 March 2022</p> <p>Reg 2017/1001</p> <p>Reported by: <i>Amelia Barling</i></p>	 <ul style="list-style-type: none"> – payment card services; creation and management of credit card accounts, in particular processing of credit card applications, providing of data for issuing institutions on computer systems for online retrieval, transmission on electronic storage media or in printed form, processing of transactions and providing of credit card balances, etc (36) – telephone services and paging; (telephone or other means of electronic communication, in particular via a call centre, in particular customer service for credit and customer card issuing institutions and credit card holders and customer card holders (38) 	<p>The GC upheld the BoA's decision that the mark was descriptive for the services applied for under article 7(1)(c).</p> <p>Pluscard's argument that the services did not all relate to payment cards was rejected – it did not specify which services it considered had no connection with cards, or why they did not form a homogenous group.</p> <p>The BoA had been correct to find that the whole word PLUSCARD was descriptive of the characteristics of the services applied for. It could have been understood by the relevant public as referring to a card that provided extra gain or advantages – that was a clear and meaningful expression to describe the subject matter of the services. The word 'plus' merely accentuated the classification given to the services at issue by the word 'card'.</p> <p>The stylisation and figurative elements of the device were common and did not diminish the descriptive meaning of the mark. The parallelograms may have been perceived as representations of a card tilted to the right, thus highlighting the meaning of the word elements.</p>
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-316/21</p> <p><i>Worldwide Machinery Ltd v EUIPO; Scaip SpA</i></p>	 <ul style="list-style-type: none"> – self-propelled machines for creating oil pipelines, gas and water conduits; land 	<p>In revocation proceedings on the grounds of non-use under article 58(1)(a), the GC upheld the decision of the BoA that genuine use had been proven for the goods in question.</p> <p>The BoA had been correct to take into account evidence that was either undated or was dated</p>

1 June 2022 Reg 2017/1001 Reported by: <i>Raphael Kelion</i>	vehicles, namely self-propelled equipment for placing pipes; kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes; sifting buckets; suction cups for lifter; hydraulic chucks; self-propelled pipe bending machines (12)	outside the relevant period, where that evidence substantiated other evidence that fell within the relevant period. For example, an undated catalogue showing a padding machine corroborated an instruction manual for padding machines that was dated during the relevant period. Further, although most of the evidence specifically showed use in Italy, the owner also submitted evidence that the mark was used in the yearbook of an international association, so it was deduced that the use was not confined to Italy.
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Ref No.	Application (and where applicable, earlier mark)	Comment
GC T-363/20; T-355/20 <i>Krasnyj Ocityabr v EUIPO; Pokój</i> 1 June 2022 Reg 2017/1001 Reported by: <i>Jason White and Nia Lewis</i>	 <p>— confectionery; candy; fudge (30)</p>  <p>— confectionery; candy; fudge (30)</p> <p>KOPOBKA KOROUKA</p> <p>— confectionery; sweetmeats; chocolate; pralines; waffles; pastries; cakes (30)</p> <p>(International Registration designating Germany, Greece and Spain)</p>	<p>In the context of applications for declarations of invalidity under article 60(1)(a), the GC upheld the BoA's decision that there was no likelihood of confusion with the earlier figurative mark.</p> <p>The GC agreed with the BoA's findings that the relevant public was the German, Greek and Spanish general public with an average degree of attention (at most), and that the goods in issue were identical.</p> <p>As regards the first contested mark, the GC held that none of the word elements were dominant, and 'krówka', 'mleczna' and 'fudge' had a normal degree of distinctiveness. In the second contested mark, the word 'krówka' the device featuring the word 'pokój' were dominant and distinctive, although there were also other weakly distinctive figurative elements in the mark. In the earlier mark, the words 'kopobka' and 'korovka' were distinctive.</p> <p>The GC confirmed that the contested marks were not visually or conceptually similar to the earlier mark, but they were phonetically similar to a low degree. It agreed with the BoA's conclusion that the visual aspect of the marks was key when</p>

		viewing the marks as a whole and conducting a global assessment, because the purchasing act for the goods in question was primarily visual. The phonetic similarity therefore could not offset the lack of visual similarity.
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Ref No.	Application (and where applicable, earlier mark)	Comment
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<p>GC</p> <p>T-26/21 to T-28/21</p> <p><i>Apple Inc. v EUIPO; Swatch AG</i></p> <p>8 June 2022</p> <p>Reg 2017/1001</p> <p>Reported by: <i>Maisie Briggs</i></p>	<p>THINK DIFFERENT</p> <ul style="list-style-type: none"> computers, computer terminals, keyboards, display units, terminals; modems; disc drives; computer peripherals; communications equipment; adapters, adapter cards, connectors and drivers; blank computer storage media, computer programs, operating systems, computer hardware, software and firmware; computer memory devices; data recordings; cameras; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; electronic communication equipment and instruments; interactive products comprising or for use with any of the aforesaid goods; parts and fittings for all the aforesaid goods (9) 	<p>In revocation proceedings, the GC upheld the BoA's decision to revoke the registrations for lack of genuine use pursuant to article 58(1)(a).</p> <p>Some of the evidence of use predated the relevant period by 10 years, so could not be taken into account. Further, the GC affirmed the BoA's decision to not consider the sales figures for iMac desktop computers sold under the mark during the relevant period on the ground the figures were provided in a witness statement from the director of Apple's legal department; there was no further objective evidence of these figures and they had not been verified by a third party.</p> <p>Secondly, the GC held that even if the BoA had not considered the high level of attention of the relevant public when purchasing personal computers and other goods covered in class 9, Apple had failed to show that this consideration would have changed the BoA's decision. The evidence of use did not show the mark being used as a badge of origin because it was placed next to the barcode and in a small font, so it did not draw the consumer's attention in any way. The GC therefore held that the consumer would have likely perceived the mark as a promotional message rather than as a trade mark.</p>
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<p>GC</p> <p>T-739/20</p>	<p>WATERFORD</p> <ul style="list-style-type: none"> glassware, earthenware, chinaware and porcelain (21) 	<p>In invalidity proceedings under article 58(1)(c), the GC upheld the BoA's decision that it had not been proved that the mark would</p>
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<p><i>Unite the Union v EUIPO; WWRD Ireland IPCO LLC</i></p> <p>22 June 2022</p> <p>Reg 2017/1001</p> <p>Reported by: <i>Aneesah Kabba-Kamara</i></p>		<p>have misled the public as to the geographical origin of the goods in consequence of the use that had been made of it by WWRD.</p> <p>Unite's argument was that the relevant public would have been misled into associating the registered goods with Waterford, the place where such goods used to be manufactured and which Unite argued had a reputation for crystal manufacturing. Since the production of such goods had been outsourced to eastern Europe, Unite argued that the use of the mark for glass that had not been manufactured in Waterford was liable to mislead the public as to the geographical origin of the goods.</p> <p>The GC held that Unite had not proved that fact by evidence. It held that the results of a poll provided by Unite in support of its application lacked probative value because the methodology used to select the poll's panel was not specified, nor was it representative of the whole of the population.</p>
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Marks capable of being used descriptively and distinctively infringed

Match Group, LLC & Ors v Muzmatch Ltd & Shahzad Younas (Caddick K.C. sitting as a Deputy High Court Judge; [2022] EWHC 941 (IPEC), 20 April 2022 and [2022] EWHC 1023 (IPEC)*, 4 May 2022)

The use of Muzmatch for a dating service targeted at Muslims infringed the trade marks MATCH.COM and match with a heart device registered for dating services. The claimants also succeeded in passing off. Both the defence that the marks lacked distinctiveness and that there had been honest concurrent use failed. Katharine Stephens reports.

Background

Match has provided on-line dating services in the UK since 2001 and is the proprietor of a number of trade marks, in particular:

- MATCH.COM registered in 1996 in Class 42 for information and consultancy services in the nature and field of on-line dating and introduction services;
- MATCH.COM registered in 2017 in Classes 9, 42 and 45 for, inter alia, software in the nature of a mobile application for internet-based dating, a social media website and dating services; and
- the device mark  registered in 2015 in Class 45 for, inter alia, dating agency services.

The evidence clearly established that by 2011 (the date on which Muzmatch started its use), the 1996 MATCH.COM mark had a very significant reputation and was clearly known by a very substantial part of the public concerned with dating services and was in fact the dominant force in the market.

Muzmatch was a dating service targeted at Muslims and was founded by the second defendant, Mr Younas, in 2011. The aim was to provide Muslims with the opportunity to find marriage partners via a website which specifically sought to be compatible with Islamic values. Over time, the branding changed, but included the following uses:



Used from 2011-2015



Used from 2020 to the present

From 2012 to 2020, Muzmatch also used some 132 keywords containing the word "match" in its search engine optimisation (SEO) activities such as "match-muslim" and "muslimmatch" designed to increase the number of customers visiting the Muzmatch website. In 2015 Mr Younas added "muslim-tinder", "tinder" and "halal-tinder" to the list. Match also owns registered trade marks for TINDER and, prior to trial, Muzmatch submitted to judgment in relation to use of the word "tinder".

Match became aware of Muzmatch's activities in 2016. Following correspondence, there were without prejudice discussions, but these broke down and proceedings were issued.

Section 10(2)

The Judge held that the average consumer would be a member of the general public who is or may be interested in looking for a partner by means of an on-line dating service. They would pay a higher level of attention than for normal consumer items given that users of dating services have to provide a significant amount of personal data.

The services provided by Muzmatch were identical or clearly complementary to those for which the Match marks were registered such that there was a relatively high level of similarity. As to the marks, there was a medium level of similarity, albeit that it was slightly greater in some cases than others. The average consumer would see that the word "match" was being used as a brand, and the addition in Match's marks of .com and the heart device and, in Muzmatch's marks of "muz" or "muslim" and the butterfly device did not make the marks dissimilar.

Muzmatch argued that there was no likelihood of confusion because the common elements in its and Match's marks was the descriptive word "match". The Judge, in reviewing the authorities, noted that although such facts made it more difficult to conclude that there was a likelihood of confusion, it was not impossible. He was fully satisfied that Match had acquired a very substantial degree of distinctiveness by 2011 and would have been well aware that the word "match" in the context of on-line dating services was capable of being used and was being used both descriptively and distinctively as, for example, in "I met my perfect match on Match". This would also have been the case from 2015 (for the purposes of the infringement case in relation to the device mark) and 2017 for the second of the MATCH.COM marks.

In the case of the SEO keywords, the use of "match" was less obviously distinctive. The Judge could see that some users could use the keywords descriptively, but the word "match" could also be used distinctively. The issue was therefore whether the result of the search allowed the average consumer to distinguish if it came from Match or a third party. Although there was no evidence of the results such searches would produce, the Judge was satisfied that they would have shown a link to the Muzmatch website and therefore to have featured the "muzmatch" signs. If so, the average consumer would not (or not without difficulty) have been able to ascertain whether the link originated from Match (or a undertaking economically linked with Match) or a third party.

As a consequence, the Judge held that there was a likelihood of confusion. The lack of evidence of actual confusion did not change his view and could be explained by the fact that both parties' services were provided via websites and apps. As had been pointed out in previous cases, it would therefore be hard to see how or why any confusion that there might be in the customer's mind would come to light.

Section 10(3)

The Judge held there was also infringement under Section 10(3). MATCH.COM had a very significant reputation by 2011, extending to people within the Muslim community. The marks were similar and the use of Muzmatch gave rise to a link with Match's marks. Further, the use took unfair advantage of Match's marks. Although the Judge accepted that Mr Younas did not, when he chose the mark, intend to make a link to or take any benefit from MATCH.COM since he believed the word "match" was descriptive, the objective effect of the

use of the "muzmatch" signs was that Muzmatch benefitted from the reputation of the Match marks, which was further demonstrated by Muzmatch's SEO strategy. Given these findings and the fact that Match was not seeking to prevent descriptive uses of "match", Muzmatch had not established that its conduct was with due cause.

The device mark did not have a reputation at 2015 when it was registered, but would have rapidly acquired its own distinctiveness and reputation after that date. Therefore, the Judge also found that the use of the "muzmatch" signs also took unfair advantage of the device mark.

Honest concurrent use

The Judge noted that in the cases on honest concurrent use, the use relied upon did not appear to be infringing use when it started, in distinction to Muzmatch's use. Therefore, in the absence of estoppel or statutory acquiescence, Muzmatch did not have a defence.

Passing off

For the reasons already given, the Judge held that Muzmatch's activities amounted to passing off and that Muzmatch could not raise the defence of honest concurrent use.

Postscript

The Judge commented that a case of this length and complexity was not really suitable for the IPEC. The fact that Counsel's oral submissions were limited to half a day, meant that writing his judgment had been made a far lengthier and more difficult task. The parties should either have attempted to narrow the issues or applied for a transfer to the High Court.

Breach of embargo

Very shortly before the formal handing down of the judgment, Counsel for Match emailed to notify the Judge that Match had been approached by journalists who were aware of the outcome of the case and asking Match for comments.

Mr Younas had been the source of journalists' information. He had prepared and sent a press release to those journalists who had agreed to hold the information confidential until the judgment was handed down. He had done so despite the lengths that his solicitors (to whom no criticism attached) had taken to ensure that he was aware of the terms of the embargo.

Although this was a serious breach, as Mr Younas had apologised unreservedly and provided a full description and explanation of his actions, the Judge accepted that it was a genuine mistake and there was no need to take any further steps. However, he would consider at the form of order hearing Match's request that their costs of dealing with the matter should be summarily assessed on an indemnity basis since Mr Younas's actions amounted to an abuse of the Court's process and/or were objectively unreasonable.

The CJ and GC decisions can be found at https://curia.europa.eu/jcms/jcms/j_6/en/. Cases marked with a * can be found at <http://www.bailii.org/>.



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