

Bird & Bird

Reports of Trade Mark Cases

For the CIPA Journal


February 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 T-173/20 Henry Cotton's Brand Management Co. Ltd v EUIPO; Industries Sportswear Co. Srl</p> <p>22 September 2021 Reg 2017/1001</p> <p>Reported by: Luke Wilcox</p>	<p>Henry Cottons</p> <ul style="list-style-type: none">– advertising and retail sales (35)– HENRY COTTON'S– soaps, perfumes and cosmetics (3)– spectacle cases and frames (9)– luggage and bags (18)– clothing (25)	<p>The GC upheld the BoA's decision that the EUIPO had made an 'obvious error' pursuant to article 103 in recording a transfer of ownership in the marks to Henry Cotton's.</p> <p>The GC held that a purported assignment by Industries Sportswear of the marks some years prior to being declared insolvent was not effective vis-à-vis third parties, including the liquidator, as the transfer had not been entered in the EUIPO register.</p> <p>Further, when asked to record the subsequent assignment from the assignee to the applicant, Henry Cotton's, the EUIPO had not only to consider the formal requirements of such request, it also had to take into account facts that were capable of having legal implications in relation to them, including the insolvency judgment against Industries Sportswear. Since the EUIPO had no competence to challenge the insolvency judgment, as it could not substitute itself for the national courts, it had to accept Industries Sportswear as the owner of the registrations at the time of its insolvency.</p> <p>As such, the EUIPO had made an 'obvious error' in entering the transfer to Henry Cotton's in the register.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-591/19</p> <p>Healios KK v EUIPO; Helios Kliniken GmbH</p> <p>22 September 2021</p> <p>Reg 2017/1001</p> <p>Reported by: Alexander Grigg</p>	 <p>– stem cells for scientific purposes; stem cells for research purposes, etc (1)</p> <p>– veterinary preparations; stem cells for medical purposes; cellular function activating agents for medical purposes; stem cells for veterinary purposes; surgical implants grown from stem cells, etc (5)</p> <p>– medical apparatus, etc (10)</p> <p>– custom manufacture of pharmaceuticals, etc (40)</p> <p>– medical services; medical consultations; medical information; ophthalmology services; preparation and dispensing of medications; medical screening; etc (44)</p> <p>HELIOS</p> <p>– medical and bacteriology laboratories (42)</p> <p>– hospitals, etc (44)</p>	<p>In opposition proceedings, the GC partially annulled the decision of the BoA in so far as it had found there was a likelihood of confusion for some of the goods and services under article 8(1)(b).</p> <p>The GC found that the BoA had erred in finding that Helios has submitted sufficient proof of genuine use of the earlier registration for the relevant services in class 42. However, Helios had proved genuine use for 'hospitals' in class 44.</p> <p>The GC, disagreeing with the BoA, found that a number of the goods and services covered by the contested application were not similar to 'hospitals' in class 44 of the earlier registration. The GC held that the fact some of the goods and services had medical or health purposes was too broad a connection on its own to establish similarity.</p> <p>Although the GC agreed with the BoA that the marks had a high degree of visual and phonetic similarity, it disagreed they shared a high degree of conceptual similarity because the relevant public would not have perceived 'Healios' as a misspelling of the Greek word 'Helios'.</p> <p>Overall, the GC held there was a likelihood of confusion in respect of those goods and services which were similar to those covered by the earlier registration, whilst it annulled the BoA's decision in respect of the remaining goods and services.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-417/20</p> <p>Joaquim José Esteves Lopes Granja v EUIPO; Instituto dos Vinhos do Douro e do Porto, IP (IVDP).</p> <p>6 October 2021</p> <p>Regulation 1308/2013 and Reg 207/2009</p> <p>Reported by: Maisie Briggs</p>	<p>PORTWO GIN</p> <p>– spirits [beverages] (33)</p> <p>PORTO</p> <p>(A PDO for Portuguese wines)</p>	<p>The GC upheld the BoA's decision that the sign applied for exploited the reputation of the PDO 'Porto' for Portuguese wines under article 103(2)(a)(ii) of Regulation 1308/2013, and article 8(4a) of Regulation 207/2009.</p> <p>The BoA was correct in finding that the sign applied for 'used' the PDO 'Porto'. The sign and PDO were closely similar from a visual and phonetic perspective. The additional word 'GIN' in the sign was descriptive of the goods applied for, and therefore the distinctive element was 'PORTWO'. The GC also held that the addition of a word to a contested element could not alter the conclusion concerning the use of an earlier PDO in the mark applied for.</p> <p>The GC affirmed the BoA's decision that the relevant consumer was likely to associate the sign and the PDO, particularly in view of the proximity between 'spirits' in class 33 and Port wines, and the exceptional reputation of the PDO which was not disputed by the applicant.</p> <p>The GC therefore agreed with the BoA that the sign exploited the PDO. Consumers would have been induced to believe that the spirits complied with the requirements and quality standards of the PDO; the particular image and distinctive qualities that the PDO enjoyed for wines were transferable to the goods covered by the sign.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-551/20</p> <p>Jeronimo Martins Polska S.A. v EUIPO; Rivella International AG</p> <p>24 November 2021 Reg 207/2009</p> <p>Reported by: Milena Velikova</p>	<p>Riviva</p> <ul style="list-style-type: none"> – fruit juice; vegetable juices [beverages]; fruit-vegetable juice; fruit drinks; vegetable and fruit-and-vegetable beverages; mineral water [beverages]; spring water; carbonated and non-carbonated water; non-alcoholic beverages; syrups for beverages; preparations for making beverages (32) <p>RIVELLA</p> <ul style="list-style-type: none"> – mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages (32) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b).</p> <p>The GC upheld the BoA's finding that, Rivella International's evidence of use, namely product labels and photographs of shops, proved that the earlier mark had been used in connection with 'lemonades and carbonated soft drinks' during the relevant period. Further, the GC held that Rivella International's use of the mark in a small part of France and Germany was sufficient because the use related to almost the whole of the relevant period and was sufficient in quantity.</p> <p>Although the BoA erred in considering some of the goods to be highly similar and in its finding that the marks had a below average degree of similarity, this did not affect the outcome: the GC found those goods to be identical and the marks to have an average degree of similarity so there was still a likelihood of confusion.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-434/20</p> <p>Piotr Włodarczyk v EUIPO; Ave Investment sp. z o.o.</p> <p>24 November 2021 Reg 207/2009</p> <p>Reported by: Luke Wilcox</p>	 <ul style="list-style-type: none"> – yarns and threads, for textile use (23) – textiles and textile goods; bed and table covers; textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets (24) – advertising, trade fairs, provision of business information, retail services (35) – treatment of materials; development, duplicating and printing of photographs; generation of electricity (40) 	<p>In an application for a declaration of invalidity under article 52(1)(b), the GC upheld the BoA's decision that Ave Investment had not acted in bad faith in applying to register the mark.</p> <p>The GC confirmed that for bad faith to be found an application must have been filed either with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or with the intention of obtaining an exclusive right to a mark for purposes other than those falling within the functions of a trade mark.</p> <p>The BoA was correct to find that Piotr Włodarczyk had not sufficiently established bad faith on the part of Ave Investment, and that the company had due cause to apply for the registration. The fact that Mr Włodarczyk and a third party were shareholders in another company which used the mark before Ave Investment's application was filed; that the same third party was the 100% shareholder in Ave Investment; and that Ave Investment's application was filed during a dispute between Mr Włodarczyk and this third party, was not sufficient to demonstrate bad faith based on the evidence submitted. Therefore, the application for invalidity was dismissed in its entirety.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-467/20</p> <p>Industria de Diseño Textil, SA (Inditex) v EUIPO; Ffauf Italia SpA</p> <p>1 December 2021 Reg 207/2009</p> <p>Reported by: Ayah Elomrani</p>	<p>ZARA</p> <ul style="list-style-type: none"> – preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk products; edible oils and fats (29) – rice, tapioca, sago; flour and preparations made from cereals, bread, pastry; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; rice-based snack food (30) – fresh vegetables (31) – fruit juices (32) – retailing and wholesaling in shops, selling via global computer networks, by catalogue, by mail order, by telephone, by radio and television and via other electronic means of preserved, frozen, dried and cooked fruits and vegetables, edible oils, rice, flour and preparations made from cereals, bread, vinegar, sauces (condiments) (35) – restaurant services (food), self-service restaurants, cafeterias (43) <p>LE DELIZIE ZARA</p> <ul style="list-style-type: none"> – olive oil (29) – rice, breadsticks, balsamic vinegar, sauces for pasta (30)  <ul style="list-style-type: none"> – fresh, dry, preserved, deep-frozen, ready to use pasta, all products of Italian origin (30) <p>(Italian mark)</p>	<p>The GC upheld the BoA's decision, finding that there was a likelihood of confusion in relation to the goods and services in classes 29, 30, 35 and 43, pursuant to article 8(1)(b).</p> <p>The BoA had correctly held that the invoices, and catalogues submitted by Ffauf Italia showed use of the earlier figurative mark in Italy during the relevant period.</p> <p>The GC confirmed that the relevant goods and services were similar or identical, apart from 'fresh vegetables' and 'fruit juices'. The GC noted that the word 'ZARA' was the most distinctive part of the earlier marks. In particular, 'LE DELIZIE' would be understood as referring to 'delights' or 'delicacies' and therefore had a weak distinctive character. The GC found that the earlier word mark was visually and aurally highly similar to the mark applied for; and that the earlier figurative mark was visually similar to an average degree and phonetically identical.</p> <p>Therefore, the BoA was correct to find a likelihood of confusion in relation to classes 29, 30, 35 and 43 and the appeal was dismissed in its entirety.</p>

Shape mark

The Yokohama Rubber Co. Ltd and EUIPO v Pirelli Tyre SpA (CJ (Fourth Chamber); Joined Cases C-818/18 P and C-6/19 P; 3 June 2021)

The CJ upheld the GC's decision that registration of a figurative trade mark protecting the shape of a single groove in a tyre tread was not invalid on the basis that it did not consist exclusively of the shape of tyre treads necessary to obtain a technical result. Lauren Kourie reports.

Background

Pirelli owned an EU trade mark registration for the figurative mark (shown below) covering "tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels of all kinds, vehicle wheels of all kinds, inner tubes, wheel rims, parts, accessories and spare parts for vehicle wheels of all kinds" in class 12.



Yokohama filed for a declaration of invalidity in relation to some of the goods covered by the registration – namely "tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds" – on the basis that the mark consisted exclusively of the shape of goods necessary to obtain a technical result and was therefore not registrable pursuant to article 7(1)(e)(ii). The EUIPO declared the registration invalid for those goods, as well as for "rims and covers for vehicle wheels of all kinds", finding that the mark represented a groove shape which formed an integral part of a tyre's tread.

Pirelli appealed and the BoA partly annulled the decision of the EUIPO insofar as it had declared the mark invalid for "rims and covers for vehicle wheels of all kinds" but confirmed that the mark was invalid in relation to the remaining goods, namely "tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds". Pirelli appealed the decision to the GC.

The GC upheld the appeal on the basis that the mark did not consist exclusively of the shape of the goods, or of a shape which on its own represented, quantitatively and qualitatively, a significant part of the goods (i.e. tyre treads). The GC concluded that the mark, which represented a single groove of a tyre tread, did not perform any technical function. Therefore, the GC annulled the BoA decision insofar as it had declared the registration partially invalid. Yokohama and the EUIPO appealed.

Identification of the essential characteristics of the mark

The CJ confirmed the GC's position that the BoA had departed from the shape represented by the mark, being a single groove of a tyre tread, and had modified it by adding elements which appeared on a tyre tread (which the CJ noted consisted of multiple interlacing elements), in order to find that the mark represented the shape of a tyre tread. The elements of the mark which the BoA was entitled to take into account did not allow it to conclude that the mark was a representation of a tyre tread.

An additional condition for refusal of registration

The EUIPO and Yokohama submitted that the GC had misinterpreted article 7(1)(e)(ii) by holding that for a sign to be covered by this ground for refusal, the part of a product represented by that sign must be, quantitatively and qualitatively, a significant part of that product. The CJ held that, even if that were the case, the error would not lead to the judgment under appeal being set aside. The GC found that the mark did not represent a shape which was

capable of producing a technical result on its own and this finding, following its unfettered assessment of the facts and evidence, was not, in principle, capable of being called into question on appeal.

Technical function of the shape

The EUIPO had claimed the GC made an error of law by disregarding the fact that a sign may be covered by article 7(1)(e)(ii) if it was shown that all the essential characteristics of the shape of that sign were necessary to obtain a technical result and that the shape contributed to the functioning of the product concerned, even if it was not sufficient in itself to obtain the intended technical result. According to the EUIPO, that error led the GC to consider, incorrectly, that a single groove represented by the mark at issue was not, in itself, capable of performing a technical function. However, the CJ found the complaint was based on a misreading of the judgment and dismissed it.

Use of similar tyre grooves by competitors

The EUIPO and Yokohama submitted that the protection afforded by the mark was liable to prevent Pirelli's competitors from making and marketing tyres which incorporated an identical or similar shape, even when combined with other elements to create a different overall shape.

The CJ noted that it would be possible for competitors to market tyres which combined an identical or similar shape to that of the mark with other elements to create an overall different shape. In such a situation, Pirelli could not rely on the mark to prevent the marketing of tyres incorporating that different shape.

Trade mark infringement

Lifestyle Equities CV & Anr v The Copyrights Group Limited & Ots (Smith J; [2021] EWHC 1212 (Ch); 10 May 2021)

Lifestyle Equities failed in their claim to trade mark infringement and passing off in relation to its figurative mark for 'Beverly Hills Polo Club' (the 'BH Logo') by The Copyrights Group and several related defendants for their use of multiple figurative marks for 'Greenwich Polo Club'. Louise Vaziri reports.



The BH Logo

The BH Logo, shown above, was protected by several EUTM registrations and a UK trade mark registration and was registered for various consumer goods in classes 3, 14, 18, 24 and 25. Lifestyle Equities alleged that the defendants had infringed those registrations and were liable for acts of passing off by the use of four different logos that each contained images of two polo players mounted on horses and the words 'Greenwich Polo Club'. The Copyrights Group (and companies authorised by it) used the marks on clothing, towels, bedsheets, and other similar products. They denied infringement and passing off.

Smith J noted that the evidence showed that The Copyrights Group used only one of the marks, the 'Greenwich Logo' (shown below) that Lifestyle Equities had complained about and only in Greece, Cyprus and Bulgaria. Therefore, the case in relation to the UK registration failed.



The Greenwich Logo

Although The Copyrights Group had used the Greenwich Logo in the EU, in the course of trade and without consent from Lifestyle Equities, Smith J held there was no infringement of article 9(2)(b). The figurative elements of the two marks were too visually dissimilar to give rise to similarity as between the Greenwich Logo and the BH Logo. Key to the Judge's findings were:

1. The BH Logo contained a single rider whereas the Greenwich Logo contained two riders;
2. The horses in the two logos were positioned to provide very different views of the horses;
3. The rider in the BH Logo was shown with a mallet aloft about to swing, whereas the riders in the Greenwich Logo were competing for the ball; and
4. The visual images in both logos merely evoked the sport of polo and were the least significant parts of the marks.

The word elements of the two marks were also very different: using different fonts and being placed in different positions in relation to the figurative element. Smith J found that due to those elements and when taken as a whole, the two marks were not similar.

Given there was no similarity of the marks, Smith J found the claim under article 9(2)(c) had to fail. Further, given that the trade mark claims all failed and no use was found in the UK, the passing off case also failed.

Counterclaim for passing off

Claire Stone v Alexandra Wenman (Judge Melissa Clarke; [2021] EWHC 2546 (IPEC); 22 September 2021)

In a case involving rival spiritual authors and holistic therapists using the name ARCHANGEL ALCHEMY, the Claimant's trade mark registration was held to be invalid and the Defendant's counterclaim for passing off succeeded. Rebekah Sellars reports.

Stone and Wenman were both spiritual authors and holistic therapists, using the mark ARCHANGEL ALCHEMY in respect of training and coaching courses.

Stone was the proprietor of a UK registration for ARCHANGEL ALCHEMY with effect from 3 October 2019 in respect of "training course – for soul development – yogic sciences – quantum physics – altered states of awareness – relaxation – holistic health – celestial beings – natural living" in Class 41. She had provided spiritual coaching and education services for over 20 years, both in person and online via her website but began marketing an online 'metaphysical education' course under the brand ARCHANGEL ALCHEMY in or around July 2019, which began running on 23 September 2019 and ran until 21 September 2020 ("Stone's Course").

Wenman had offered and supplied spiritual and holistic education, training and therapy services to the public, mainly in person but also online since 2011. In February 2020, Stone became aware that Wenman had been marketing and offering for sale an online course by reference to the sign ARCHANGEL ALCHEMY on Wenman's website and on her social media accounts ("Wenman's Course").

Stone sued Wenman for trade mark infringement pursuant to section 10(1). In response, Wenman sought a declaration of invalidity on the grounds that she had been offering services by reference to the signs THE ARCHANGEL ALCHEMIST and ARCHANGEL ALCHEMY (the "Signs") since around 2010 and counterclaimed for passing off.

The main issue between the parties was whether Wenman had sufficient goodwill in the Signs (as at the date of the first public marketing or offering for sale of Stone's Course – 7 September 2019) and could show misrepresentation by use of Stone's trade mark on the basis of an earlier right under the law of passing off. If she could prove sufficient goodwill and misrepresentation, then Stone offered no defence to damage so the trade mark would be invalid and the counterclaim for passing off would succeed.

The Judge found that Wenman had generated more than de minimis goodwill in the Signs by the relevant date. There was ample clear evidence, that Wenman was very busy, despite her fairly uninformative website, carrying out various events and one-to-one sessions, attending large shows, and retreats, all of which was, or drove, paid-for trade amounting to between £28,000 and £40,000 per year. Her evidence supported by documentary evidence and her witness Ms Flaherty, was that much of that involved her Archangel Alchemy processes and techniques. In oral evidence she estimated that about 15% - 25% of her work related to Archangel Alchemy. At the 2013 London Mind Body Spirit Festival, over 60% of sessions on the Sunday related to Archangel Alchemy, and Archangel Alchemy did form significant parts of various retreats and was prominent on the flyers and other promotional materials advertising such events. It attracted invitations to collaborate with musicians and appeared on third party podcasts. Even if she was exaggerating and only 5% or 1% of that work was attributable to Archangel Alchemy the Judge considered that was more than trivial and had generated sufficient actual goodwill to be capable of damage by reason of a misrepresentation.

The Judge also considered that the Signs were being used as an indicator of origin, rather than either being common figurative or poetic language used in the field in which the business operated or that Wenman's business and any goodwill arising from that business was attributable to her own name and not to the Signs.

Stone's own case was that due to the identity of the marks and services of both parties, confusion would likely work in both directions. The Judge considered it inevitable that if someone who had been to one of Wenman's Courses told another person she had been to an excellent Archangel Alchemy course without providing Ms Wenman's name, that person doing her own research might find Stone's course marketed under the trade mark and attend it, assuming that it must be connected with Wenman's Course attended by the original attendee. This would amount to a misrepresentation.

Therefore, the Judge held that goodwill and misrepresentation were established. Consequently, Stone admitted damage and invalidity under section 5(4A) and further admitted liability under the law of passing off.

Stone's trade mark registration was declared invalid pursuant to section 47(2)(b), the counterclaim for passing off succeeded and the claim for trade mark infringement was dismissed.

Equestrian companies battle over 'mercury' in the IPEC

Equisafety Ltd v (1) Battle, Hayward and Bower Ltd ("Battle") (2) Dewey (Mr Nicholas Caddick QC; [2021] EWHC 3296 (IPEC); 8 December 2021)

Mr Nicholas Caddick sitting as Deputy High Court Judge was tasked with determining a number of issues including validity, bad faith, infringement, passing off and joint tortfeasance. The end result, he held that Equisafety's mark was valid and infringed. Jon Edwards reports.

Background

Since 2015, Equisafety had sold a range of specialist high visibility products for equestrian usage under the brand name "Mercury", including high visibility and reflective jackets for riders, rugs, and horse boots. Battle also dealt in equestrian goods and between 2018 and 2019 started selling high visibility products under the name "HyVIZ Silva Mercury Reflective" (the "HVSMR label") and under the truncated variation, "Silva Mercury". An example of the HVSMR label is shown below:



On 6 June 2019, Equisafety wrote to Battle complaining of its use of the word Mercury, and the next day applied to register its Mercury mark. The registration was granted later that year in October for products in classes 9, 18 and 25, following which Equisafety issued proceedings for infringement and passing off.

Invalidity

Battle brought a counterclaim seeking a declaration of invalidity, asserting that the Mercury mark was devoid of distinctive character, descriptive and had become customary in the trade (sections 3(1)(b), (c) and (d)). However, the Judge noted that the products in question were not made of, nor did they contain, mercury, so the mark was not descriptive. The evidence suggested that the term 'Mercury' was being used by customers to reference products within Equisafety's 'Mercury range' of high visibility clothing, and not because those products exhibited similar reflective properties to the metal.

For the same reasons, the Judge held that the Mercury mark was not generic in respect of high visibility reflective clothing. If the term 'mercury' was generic, the Court rhetorically questioned why no other businesses in the industry were using the term to describe their high visibility products, noting that both parties had instead used the term "reflective silver" to describe the appearance of the relevant goods, not mercury.

Bad faith

Battle alleged that Equisafety's Mercury mark was registered in bad faith under section 3(6). This was on the basis that Equisafety had filed its application the day after it had written to Battle and had therefore filed for the purpose of instigating infringement proceedings. Battle supplemented this allegation with several arguments including that Equisafety had been using the word 'mercury' descriptively, and that its application covered a wide range of goods, some of which Equisafety had no intention of using the mark for.

Following the *Skykick* judgment ([2021] EWCA Civ 1121), the Judge held that Battle did not come close to discharging its burden in proving bad faith. The timing of the application did not support the claim of bad faith as it was clear that Equisafety were making some use of the mark at the time. Further, it was irrelevant that the application covered goods on which Equisafety was not using the mark. Those goods were not part of Equisafety's infringement claim, nor did they fall within the scope of Battle's activities.

The Judge therefore dismissed Battle's invalidity counterclaim, finding Equisafety's registration to be valid.

Infringement

Battle had never used the word 'mercury' alone. Its use was always as part of the full HVSMR label or the shortened 'Silva Mercury' version, and as such the Judge held that the two signs were not identical and there was no infringement under section 10(1).

In determining whether there was a likelihood of confusion under section 10(2), the Judge held that the range of goods concerned was either identical or highly similar, and that the two signs were moderately similar. The fact that 'mercury' formed a part of the HVSMR label gave rise to obvious visual and aural similarities. This was offset, however, by a lack of conceptual similarity: the HVSMR label conveyed the concept of a highly visible product, whereas 'mercury' alone had multiple connotations including the metal, the planet and the Roman god. However, the Judge noted that, other than 'mercury', all the elements in the HVSMR label were descriptive.

As a result, the Judge held that there was a likelihood of confusion as end consumers might consider products sold by Battle under the HVSMR label to be derived from, licensed by or co-branded with Equisafety. The Judge accepted commercial evidence submitted by Equisafety that its 'Mercury' mark had acquired a distinctive character, bolstering the Judge's finding of a likelihood of confusion.

The same factors led the Judge to conclude, under section 10(3), that Battle's use of the word 'mercury' would result in detriment to the distinctive character of Equisafety's Mercury mark, and that in relation to high visibility equestrian products, such use would diminish the ability of the Mercury mark to act as designation of origin. Further, Battle's

use took unfair advantage of the Mercury mark. The Judge criticised the lack of evidence in relation to Battle's intentions, and concluded that Battle must have been well aware of Equisafety's use of its mark.

Passing off

The Judge dealt with passing off briefly in his judgment, holding that all three elements were satisfied.

Joint tortfeasance

Mr Dewey was the Managing Director and a significant shareholder in Battle. Equisafety alleged that Mr Dewey was the controlling mind of the company and was heavily involved in its activities. The Judge held however that the evidence failed to satisfy the test summarised by Lord Toulson in *Fish & Fish v Sea Shepherd UK* [2015] AC 1229. In particular, internal company emails disclosed by Battle suggested that Mr Dewey was not aware of Battle's use of the word 'mercury'.

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/>.

Editorial Contacts



Katharine Stephens

Partner

+442074156104
katharine.stephens@twobirds.com



Aaron Hetherington

Trademark Attorney

+442074156183
aaron.hetherington@twobirds.com



Ciara Hughes

Trademark Attorney

+442074156193
ciara.hughes@twobirds.com

Reporters

Luke Wilcox; Alexander Grigg; Maisie Briggs; Milena Velikova; Ayah Elomrani; Lauren Kourie; Louise Vaziri; Rebekah Sellars; Jon Edwards

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