

Bird & Bird

Report of Trade Mark Cases

For the CIPA Journal


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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-93/21</p> <p><i>Creaticon d.o.o. v EUIPO; Paul Hartmann AG</i></p> <p>11 May 2022 Reg 2017/1001</p> <p>Reported by: <i>Aneesah Kabba-Kamara</i></p>	 <p>– creams, cosmetics, shampoos, soaps, etc (3)</p> <p>SKINTEGRITY</p> <ul style="list-style-type: none"> – pharmaceutical products for skin protection and cleansing for the purposes of personal hygiene, etc (5) – surgical, medical, dental and veterinary apparatus and instruments, etc (10) – disposable and multiple use items of working clothing for medical staff and patients (25) <p>(earlier German registration)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks within the meaning of article 8(1)(b).</p> <p>The assessment was made from the perspective of the German public displaying a high degree of attention in view of the goods in question.</p> <p>The class 5 goods of the earlier registration were found to be similar to the class 3 goods applied for because they shared the same nature and purpose (i.e., they were both applied to the skin to protect and improve it), they were capable of being marketed through the same distribution channels (e.g. pharmacies) and they were complementary.</p> <p>The GC found that SKINTEGRA visually dominated the overall impression of the opposed mark. By contrast, the hexagonal element was banal, and the words THE RARE MOLECULE were weakly distinctive and in smaller font. As such, the marks were visually, phonetically and conceptually similar, despite the differences in the endings A and ITY.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-355/21</p> <p><i>Polo Club Düsseldorf GmbH & Co. KG v EUIPO; Company Bridge and Life, SL</i></p>		<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 marks were held to be phonetically similar at least to an average degree, and conceptually highly similar. The addition in the opposed mark of the figurative</p>

<p>8 June 2022 Reg 2017/1001</p> <p>Reported by: <i>Maisie Briggs</i></p>	<ul style="list-style-type: none"> – umbrellas and parasols; walking sticks; luggage bags, wallet and other carriers, etc (18) – clothing; headgear; footwear, etc (25) <div style="text-align: center;">  </div> <ul style="list-style-type: none"> – imitation leather; umbrellas and parasols; whips, harnesses and saddlery articles; animal collars, straps and clothing (18) – clothing; headgear, footwear (25) <p>(earlier Spanish registration)</p>	<p>element, the letters P, C, D, and 'Düsseldorf' did not alter this assessment, because the word element POLO CLUB of the earlier mark was entirely contained within the opposed mark.</p> <p>The GC noted that the BoA had been correct to find that the earlier mark had at least an average degree of distinctive character in relation to the goods in classes 18 and 25. Further, the respective goods were identical and highly similar.</p> <p>Therefore, despite the notable visual differences between the figurative elements of the marks, and the fact the overall visual similarity between the marks was low, the GC held that the phonetic and conceptual similarities were enough to establish a likelihood of confusion; the visual differences did not offset this.</p>
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Evidence of reputation and goodwill

*DC Comics (Partnership) v Unilever Global IP Ltd** (Green J; [2022] EWHC 434 (Ch); 2 March 2022)

The High Court upheld the Hearing Officer's decision that DC Comics ("DC") had failed to establish reputation and goodwill in its WONDER WOMAN mark. This was not a finding that the Wonder Woman character was not well-known, or that the films under that name were not popular; but that the evidence submitted by DC had not met the legal threshold. Adeena Hussain reports.

Background

Unilever applied to register the word mark WONDER MUM for a range of cosmetic goods in class 3. DC opposed the application under sections 5(2)(b) and 5(3), relying on its earlier EUTM registration for the mark WONDER WOMAN covering classes 3, 9, 16, and 41. DC also opposed on the basis that its use would amount to passing off under section 5(4)(a). The Hearing Officer rejected DC's opposition on all grounds, so DC appealed the decision to the High Court.

Likelihood of confusion

The Hearing Officer had stated in their decision "*there is more that is different about the respective concepts of the marks than is the same*". DC submitted that this was an incorrect application of the law, and that the only question to be considered was whether the marks were similar; not whether they were both similar and dissimilar. Green J held that DC had overinterpreted this statement, and that the Hearing Officer had simply been highlighting that they had concluded there was a low degree of conceptual similarity between the marks.

DC also claimed that the Hearing Officer had failed to apply the interdependency principle in the global assessment, since some of the goods were found to be identical and others similar to a high and medium degree, which should have offset the lower degree of similarity between the marks. Green J disagreed with DC and held that the Hearing Officer had made a reasonable and balanced decision with the interdependency principle in mind. The claim under section 5(2)(b) therefore failed.

Reputation

The Hearing Officer had found that DC's evidence had been insufficient to prove that the mark WONDER WOMAN had a reputation for comics, or any other class 16 goods, because DC had submitted only general comments such as "*Wonder Woman is the most famous female comic book hero in the world with nearly 80 years of continuous use since her comic book debut in December 1941*". DC had failed to provide any UK-specific evidence, such as comic book sales figures, and simply stated "*Sales of WONDER WOMAN comics have generated significant revenues for DC Comics. The following are approximate figures for the worldwide revenue generated in the period 2009 to 2019 (the United Kingdom revenue figures will of course be less, but nevertheless a notable proportion of the whole) ...*". The "*notable proportion*" had not been quantified, and therefore lacked sufficient detail. Therefore, Green J agreed with the Hearing Officer's decision.

In an effort to prove that the WONDER WOMAN mark had a reputation for entertainment-related goods and services, DC's evidence focused on the 2017 high-profile film, 'Wonder Woman', which it submitted had grossed £19.5 million at the UK box office alone. The Wonder Woman character had also featured in two other films in 2016 and 2017, although her name had not appeared in the title of the films. The Hearing Officer held this evidence did not sufficiently prove the mark had a reputation in the UK and EU in relation to the entertainment-related goods and services. This was because DC had not shown that WONDER WOMAN had been used in a trade mark sense; instead, it had been used as a badge of artistic origin. Green J agreed, and explained that the Hearing Officer's decision had not passed judgement on whether the 'Wonder Woman' film was a success, or whether the fictional character was well-known; rather, their decision had focused on whether the mark WONDER WOMAN had a qualifying reputation in the UK and EU at the relevant date in respect of the relevant goods and services.

Passing off

The Hearing Officer also found that DC had not proven sufficient goodwill in the UK. Green J reiterated that generalised statements about goodwill or reputation were not sufficient on their own. DC had submitted evidence "*in connection with a range of goods and services for an extensive merchandising programme linked to films, publications and entertainment services.*" However, the mark was not always present on the merchandise, and there was no detail as to the number of sales of such goods. Green J agreed that DC had submitted insufficient evidence, so the Hearing Officer's decision was upheld.

Green J also upheld the Hearing Officer's decision that, even if goodwill had been established, in view of the differences between the marks WONDER WOMAN and WONDER MUM, there was no likelihood of deception or misrepresentation.

Clarity in relation to the requirements for registration of colour marks

*Société des Produits Nestlé S.A. v Cadbury UK Ltd** (Meade J; [2022] EWHC 1671 (Ch); 5 July 2022)

Cadbury's applications to register three colour marks highlighted an area of law which was uncertain and of some importance. Meade J's decision has brought clarity as to how a colour mark should be described in order to avoid the problem that the Court of Appeal found afflicted the mark in Société des Produits Nestlé S.A. v Cadbury UK Ltd [2013] EWCA Civ 1174 ("CoA 2013"). Katharine Stephens reports.

Cadbury applied to register the three marks, all for milk chocolate and drinking chocolate in class 30. They each comprised the following representation:



In addition, the first mark, Mark 1, included the following description: "the colour purple (Pantone 2685C) as shown on the form of the application, applied to the whole visible surface of the packaging of the goods".

Mark 2's description was: "the colour purple (Pantone 2685C) as shown on the form of the application, applied to the packaging of goods".

Mark 3's description was: "the colour purple (Pantone 2685C) as shown on the form of the application".

The applications for all three Marks were opposed by Nestlé under sections 3(1)(a) and 1(1). The opposition failed in relation to Mark 1, but succeeded in relation to the other two Marks. Nestlé appealed, but before the appeal was heard, settled with Cadbury. However, the Comptroller-General of Patents, Designs and Trade Marks was allowed to intervene given the importance of the issues before the Court.

The question on appeal in relation to Mark 2, was whether, because the description was silent as to how much of the visible surface of the packing must have purple applied to it, it avoided the problem identified by the Court of Appeal in CoA 2013. In relation to Mark 3, a colour mark *per se* without any reference to the manner of use, the question on appeal was whether it, too, ran into the problems identified by the Court of Appeal.

In CoA 2013, the Court of Appeal held that the application for the colour purple, for essentially the same goods covered by the Marks, did not meet the requirements for registration because it was not a "sign". The mark was described as follows: "the colour purple (Pantone 2685C) as shown on the form of the application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods". The Court of Appeal rejected the application because of the "predominant" option; the "whole visible surface" option was not objectionable in itself. It was for this reason that, although it was not in issue before him, Meade J agreed that the Hearing Officer had correctly rejected the opposition in relation to Mark 1.

In relation to Mark 2, Meade J agreed with the Hearing Officer's conclusion that it was not a single unchanging colour but would extend to a situation where there were other colours. In Meade J's view, the formulation of Mark 2's description was worse than that rejected by the Court of Appeal in CoA 2013. The appeal therefore failed in relation to Mark 2. He added, *obiter*, that Mark 2 left it significantly, undesirably and unnecessarily unclear whether combination marks including purple and other colours would be within the scope of the right applied for.

In contrast, the appeal succeeded in relation to Mark 3. The Hearing Officer was wrong to hold that the representation did not explain how the colour was to be used as a sign, whether it be on the packaging, advertising material or applied to the goods. Meade J held that it complied with the CJEU's requirements in *Libertel* (Case C-104/01) and, being a colour mark *per se*, it was a single thing conceptually. As a consequence, there was use of the same sign whether it was applied to the packaging, advertising material or the goods themselves. Ambiguity was let in by wording like "predominant", but was not let in by a *Libertel*-form mark (which Mark 3 was). On that basis, Meade J accepted Cadbury's submission that the Hearing Officer's reasoning was inconsistent between Marks 2 and 3.

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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