

Bird & Bird & Reports of Trade Mark Cases for CIPA Journal



January 2019








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-359/17 <i>Aldo Supermarkets v EUIPO; Aldi Einkauf GmbH & Co. OHG</i></p> <p>25 October 2018 Reg 207/2009</p> <p>Reported by: <i>Ning-Ning Li</i></p>	<p>ALDI</p> <ul style="list-style-type: none"> - advertising, business management, retailing, including via the internet, in relation to foodstuffs, laundry preparations (35)  <ul style="list-style-type: none"> - import-export agencies, business management, marketing studies, business investigation (35) <p>(Bulgarian mark)</p>	<p>The GC upheld the BoA's decision dismissing the opposition on the basis that Aldo had failed to substantiate the existence of its earlier mark pursuant to Art 19(2).</p> <p>To substantiate the opposition, Aldo had submitted a 'copy' of the registration certificate of the earlier mark in black and white. As the earlier mark contained colour, the black & white copy certificate did not provide the EUIPO with reliable proof of the existence of the mark and to enable it to verify the existence and scope of protection of the earlier mark. Documents to substantiate the opposition had to be identical in all respects to the original held by the owner of the mark, including the same colours as the original.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-59/18 <i>Endoceutics, Inc., v EUIPO; Merck KGaA</i></p> <p>22 November 2018 Reg 2017/1001</p> <p>Reported by: <i>Ning-Ning Li</i></p>	<p>FEMIVIA</p> <ul style="list-style-type: none"> - pharmaceutical preparations for the prevention and treatment of breast and uterine cancer, Alzheimer's disease, medical conditions related to menopause, bone loss, muscle loss, type 2 diabetes, fat accumulation, osteoporosis, hot flushes, skin atrophy, memory loss, and cognition loss (5) <p>FEMIBION INTIMA</p> <ul style="list-style-type: none"> - pharmaceutical preparations (5) 	<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>Although the goods were targeted at consumers throughout the EU, the BoA was entitled to assess the similarity of the marks by reference to Spanish-speaking public for reasons of procedural economy. 'FEM' was likely to be understood by the relevant Spanish public to refer to 'femenino', meaning 'feminine', describing one purpose of some of the goods at issue, namely those intended to treat typical medical conditions related to menopause.</p> <p>The element 'INTIMA' had weak distinctive character and did not offset any similarity between the marks. 'FEMIBION' was the most distinctive element of the earlier mark. The marks were visually and conceptually similar to a low degree and shared average phonetic similarity, particularly due to the pronunciation of the letter 'v' as 'b' in Spanish.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-372/17 <i>Louis Vuitton Malletier ("LVM") v EUIPO; Bee-Fee Group Ltd</i></p> <p>29 November 2018 Reg 207/2009</p> <p>Reported by: <i>Adeena Wells</i></p>	 <ul style="list-style-type: none"> - energy drinks; non-alcoholic beverages; fruit beverages and fruit juices (32) - advertising (35) - services for providing food and drink; catering (43)  <ul style="list-style-type: none"> - goods made of leather or of imitations of leather; bags (18) - clothing, underwear, footwear (25) 	<p>In invalidity proceedings, the GC annulled the BoA's decision that LVM had failed to demonstrate reputation of the earlier mark pursuant to Art 53(1)(a), holding that the BoA had failed to conduct a complete assessment of the evidence.</p> <p>The GC agreed with the BoA that evidence from Wikipedia was not to be deemed a reliable source given that the content can be anonymously changed. However, the BoA erred in discounting evidence that did demonstrate reputation of the earlier mark, included the mark as part of a monogram canvas and alongside the word mark LOUIS VUITTON.</p> <p>The BoA ought to have taken into account the previous EUIPO decisions cited by LVM, in which reputation of the earlier mark had been found.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment

<p>GC T-373/17 <i>Louis Vuitton Malletier ("LVM") v EUIPO; Fulia Trading Ltd</i></p> <p>29 November 2018 Reg 207/2009</p> <p>Reported by: <i>Adeena Wells</i></p>	 <ul style="list-style-type: none"> - cards; board games; amusement apparatus for use in arcades (28) - marketing services; advertising (35) - gaming house facilities, games equipment, casino services (41)  <ul style="list-style-type: none"> - goods made of leather or of imitations of leather; bags (18) - clothing; underwear; footwear (25) 	<p>The GC annulled the BoA's decision that LVM had failed to demonstrate evidence of the reputation pursuant to Art 8(5), holding that the BoA had failed to conduct a full and proper assessment of the evidence.</p> <p>The BoA erred in discounting evidence that demonstrated the earlier mark's reputation including the mark as part of a monogram canvas and with the word mark LOUIS VUITTON. The BoA ought to have taken previous EUIPO decisions cited by LVM into consideration, in which reputation of the earlier mark had been found. As such, the BoA distorted the clear sense of that evidence.</p> <p>With regards to Art 8(5), the BoA also erred in its assessment of similarity of the marks, which was average not 'at most very low'. Having failed to properly assess the evidence, the BoA also erred in its assessment of the strength of the reputation of the earlier mark. As a result, the BoA's analysis regarding the existence of a link was also flawed.</p>
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Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-763/17 <i>Septona AVEE v EUIPO; Intersnack Group GmbH & Co. KG</i></p> <p>29 November 2018 Reg 207/2009</p> <p>Reported by: <i>Ciara Hughes</i></p>	 <ul style="list-style-type: none"> - rice cakes; rice-based snack food; cereals; cereal bars; cereal-based snack food; muesli; cake dough; rusks; natural sweeteners (30)   <ul style="list-style-type: none"> - processed vegetable and potato products for snacks (29) - processed tapioca, manioc, rice, maize, wheat or other cereal products for snacks; savoury biscuits and pretzels; muesli bars; chocolate and chocolate products; sauces (30) - unprocessed nuts (31) 	<p>The GC annulled the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The marks had low visual and phonetic similarity: the first lower case letter 'w' differed significantly from the upper case letter 'k'. The differences between the commonplace figurative elements further distinguished the marks. The goods at issue were identical or similar.</p> <p>For a large part of the relevant public, being average consumers in the European Union with a lower than average level of attention for the goods in question, the signs were conceptually different. The fact that the word elements looked and sounded English and might be perceived by some consumers as 'fanciful terms' only gave rise to a neutral conceptual comparison for this part of the public.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-214/17 <i>Out of the blue KG v EUIPO; Frédéric Dubois; MFunds USA LLC</i></p> <p>29 November 2018 Reg 207/2009</p> <p>Reported by: <i>Aaron Hetherington</i></p>	<p>FUNNY BANDS</p> <ul style="list-style-type: none"> - precious metals and their alloys, jewellery (14) - plastics in extruded form for use in manufacture; packing, stopping and insulating materials; rings of rubber (17) - advertising; business management; business administration; office functions (35) 	<p>In invalidity proceedings, the GC annulled the BoA's decision that the mark was not descriptive under Art 7(1)(c).</p> <p>Although the two words in isolation had a clear meaning to the public, the BoA incorrectly held that the combination of the two words created a perceptible difference.</p> <p>The GC considered that the term 'funny' was capable of describing a characteristic of the goods designated by the term 'bands'. The definition of 'band' as 'a flat, thin strip or loop of material, used as a fastener, for reinforcement, or as decoration', did not limit those goods to having any particular decorative appearance nor did it preclude those goods from being perceived by the relevant consumer as 'funny', on account of a special design or shape, unusual colours or humorous motifs.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-459/17 <i>Fifth Avenue Entertainment LLC v EUIPO; Commodore Entertainment Corp ("CEC").</i></p> <p>6 December 2018 Reg 207/2009</p> <p>Reported by: <i>Mark Livsey</i></p>	<p>THE COMMODORES</p> <ul style="list-style-type: none"> - series of musical sound recordings, series of musical video recordings, downloadable musical sound recordings, downloadable music video recordings featuring music and entertainment, audio-visual recordings featuring music and entertainment (9) - entertainment in the nature of live performances by a musical artist (41) 	<p>The GC annulled the BoA's decision to refuse registration of the mark pursuant to Art 8(4).</p> <p>Pursuant to a 1978 partnership agreement governed by Nevada State law, the members of the Commodores had assigned their rights to a company which subsequently merged with CEC. The BoA failed to examine the reversion of rights clause, under which rights to the name were re-assigned to the founding members following the expiry of the seven year term of the agreement.</p> <p>As a result, the BoA infringed Art 8(4) in its assessment that that CEC owned the common law rights to the mark as, due to the expiry of the agreement, CEC did not have the right under the English law of passing off to prohibit the use of the mark applied for.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment

GC
T-665/17
China Construction Bank Corp. v EUIPO; Groupement des cartes bancaires

6 December 2018
Reg 207/2009

Reported by:
Daniel Anti



- banking; financial evaluation; financing services; credit card services; deposits of valuables; antique appraisal; brokerage; guarantees; fiduciary (36)



- insurance and finance; financial affairs, monetary affairs, banking; management of banking and monetary flow by electronic means; electronic purse services; electronic payment; card payment services; authentication and verification of parties involved; financial information (36)

The GC held that the BoA did not infringe Art 75 in its assessment of similarity of the marks and finding a likelihood of confusion pursuant to Art 8(1)(b).

The BoA correctly exercised its discretion to refer to a previous decision to support its own assessment of reputation of the earlier mark.

The GC endorsed the BoA's assessment that the marks were similar, as they carried similar pronunciation (differing only in an additional 'C') and were visually similar due to the shared letters 'CB'. The services at issue were identical.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-681/17 T-682/17 T-683/17</p> <p><i>Khadi and Village Industries Commission ("KVIC") v EUIPO – BNP Best Natural Products GmbH ("BNP")</i></p> <p>29 November 2018 Reg 207/2009</p> <p>Reported by: <i>Francesca Rivers</i></p>	<p>KHADI</p>  <p>KHADI AYURVEDA</p> <p>- personal care products and cosmetics (3)</p>	<p>In invalidity proceedings, the GC upheld the BoA's decision to dismiss the invalidity application pursuant to Art 7(1)(g), notwithstanding the BoA's failure to take into account additional evidence filed before it in support of the absolute and relative grounds relied on by KVIC.</p> <p>The application for a declaration of invalidity based on Arts 52(1) and 7(1)(g) relied on the submission that 'khadi' had a known meaning in India. KVIC had filed additional evidence in support of its claim before the BoA, which had been dismissed as irrelevant and inadmissible pursuant to Rule 50(1). As Rule 50(1) did not apply to invalidity proceedings, the BoA erred in failing to take this evidence into account.</p> <p>However, the new evidence was still irrelevant and inadmissible as it related to the historic context of the term 'khadi' in India and did not demonstrate awareness of the term by the relevant public in the EU. As such, notwithstanding the BoA's error, the decision to dismiss the invalidity application was well founded.</p>

Terms designating geographical origin

J. Portugal Ramos Vinhos SA ("JPRV") v Adega Cooperativa de Borba BV (CJ; Fourth Chamber; C-629/17; 6 December 2018)

The CJ considered the registrability of signs made up of terms designating geographical origin and terms commonly used to designate the facilities or site in which products were produced. Louise O'Hara reports.

Background

In invalidity proceedings, JPRV applied to cancel the national Portuguese mark ADEGABORBA.PT designating wine products. The application was dismissed at first instance before the Tribunal da Propriedade Intelectual (Intellectual Property Court, Portugal) and at appeal before the Tribunal da Relação de Lisboa (Lisbon Court of Appeal).

Both Courts held that the sign ADEGABORBA.PT, when adopted by a producer from the Borba region in Portugal, was not prohibited from registration pursuant to Article 223 of the Código da Propriedade Industrial (the Portuguese Industrial Property Code, or "CPI"), which excluded from protection:

"signs which consist exclusively of indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time or means of production of the goods or of rendering of the services, or other characteristics of the goods or services"

JPRV appealed to the Supremo Tribunal de Justiça (Supreme Court, Portugal). It was noted that the mark ADEGABORBA.PT was used by a legal person whose name included the term 'adeга'. It also noted that, unlike Article 3(1)(c) of Directive 2008/95, Article 223(1)(c) of the CPI identified the 'means of production' as a characteristic of goods and services.

Scope of Article 3(1)(c)

The Supreme Court referred a question to the CJ on whether Article 3(1)(c) of Directive 2008/95 required that a word mark which designated wine products and included a geographical name must necessarily be refused if that mark contained a term commonly used to designate facilities or sites in which wine was produced and also contained part of the business name of the applicant seeking to register the mark.

The CJ held that, whilst Article 3(1)(c) contained a list of characteristics excluded from protection, the list was not to be considered exhaustive and other characteristics of goods and services may also be taken into account. The term 'characteristic' designated a

property of the goods or services in respect of which protection was sought which was easily recognisable to the relevant public. It followed that a sign may be refused registration on the basis of Article 3(1)(c) only if it was reasonable to believe that it would be recognised by the relevant public as a description of one of the characteristics of the goods/services at issue.

The word 'adega' has two meanings in Portuguese, referring to both the underground premises in which wine was stored and also the premises or facilities in which wine was produced. In the present case, the CJ held that 'adega' was capable of being understood by the relevant public as a designation of a property of the goods, and therefore was prohibited from registration pursuant to Article 3(1)(c) regardless of the interpretation afforded to it.

Consequently, the CJ held that, where a sign associated two word elements, namely a descriptive term and a geographical name (in this case 'Borba') relating to the origin of the goods, the sign as a whole must be found to be descriptive and devoid of distinctive character.

It was not relevant whether or not the geographical name constituted a protected designation of origin under Article 102 of Regulation No 1308/2013. Furthermore the fact that the term used to designate a place of production of goods (or a facility in which the goods are produced) was part of the corporate name of the applicant was irrelevant for the purposes of examining the descriptive character of that term, given that the analysis was to be carried out by reference to the goods for which registration was sought.

Series marks

***Cadbury UK Limited v The Comptroller General of Patents Designs and Trade Marks** (Floyd, Henderson & Baker LJJ; [2018] EWCA Civ 2715; 5 December 2018)**

The Court of Appeal upheld the decision of Deputy Judge John Baldwin QC ([2016] EWHC 796 (Ch), reported in CIPA Journal, May 2016) that Cadbury's UK trade mark registration for the colour purple was not a series mark and could not be altered under Section 41. Rebekah Sellars reports.

Background

Cadbury was the proprietor of a UK registered trade mark which consisted of a swatch of the colour purple along with the following description: "The mark consists of the colour purple (Pantone 2685C) as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods".

Another of Cadbury's registrations with a different number but the same description had been found invalid (*Société des Produits Nestlé S.A. v Cadbury UK Ltd* [2013] EWCA Civ 1174, reported in CIPA Journal, November 2013) following long running opposition proceedings brought by the intervener, Nestlé. This was on the basis that, properly interpreted, the mark did not constitute "a sign" that was "graphically represented". Seeking to head off a potential invalidity attack against the registration in issue on this appeal, Cadbury had applied to the registrar to delete the expression "or being the predominant colour applied to the whole visible surface" from the description of the mark, thereby limiting the mark to a sign consisting of the colour purple applied to the whole visible surface of the packaging of the goods. It claimed that this was permissible under Section 41 because the registration consisted of a series of two marks, i.e. (i) the colour purple (Pantone 2685C) applied to the whole visible surface of the packaging of the goods; and (ii) the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of goods. In the High Court, Deputy Judge Baldwin had upheld the decision of the registrar that the proposed amendment was not permissible because the existence of the two alternatives in the description of the mark did not mean that the registration constituted a series under Section 41.

Decision

On appeal, it was common ground that, if the registration was for a single mark, then Section 44(1) would prohibit any alteration to the register to delete the "predominant" wording from its description. The main question was whether it was open to the registrar to accept an application to alter a registered trade mark so as to delete part of its description which has been held to render it invalidly registered, by treating it as a "series" of trade marks.

Floyd LJ, giving the decision of the court, agreed with the registrar that the reader would understand that the registration could not possibly satisfy the requirements for a series of marks. If allowed to be the predominant colour rather than restricted to the whole surface, the registration could cover uses of purple in extravagantly different ways. For example, as long as some criterion of predominance was observed, the mark could appear as stripes, spots, a large central blob, or in any other form. These alternatives could not begin to satisfy the requirement that marks in a series must "resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark". Even if the whole surface wording was accepted as being tolerably clear, the reader would consider that the predominant colour wording inevitably covered representations which could differ materially and create a different identity. It followed that no series mark had been defined. Floyd LJ concluded that the various alternatives covered by the description were not intended to identify separate marks, but were parts of a generalised but imprecise description of a single mark.

Floyd LJ was also unable to accept Cadbury's alternative argument that, if the registration was not a series, it was nevertheless a permissible registration of more than one mark within a single registration, thus allowing Cadbury to surrender all but the whole surface mark. Floyd LJ said that this was a very bold argument which suggested that an applicant could register any unconnected

"job lot" of marks under a single registration and pay one fee. It was tolerably clear from the Act that the only opportunity to register more than one mark under a single registration was the series registration under Section 41.

Floyd LJ stated that the reader would conclude that the registration was an attempt to register a single mark which fell foul of the requirements of clarity and precision. He said that whilst one could feel sympathy for Cadbury that it was its adherence to the Guidance which had given rise to the breach of these requirements, it would be a potentially far reaching step to allow the lack of clarity to be read, instead, as an attempt to register a number of marks. Floyd LJ agreed with the registrar that such an approach to interpretation would give rise to grave difficulties for the examination of trade marks. He said that it must be for the applicant to state clearly the type of monopoly for which it contends.

The reported cases marked * can be found at <http://www.bailii.org> and the CJ and GC decisions can be found at http://curia.europa.eu/jcms/jcms/j_6/hom

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