


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

March 2021




# Trade mark decisions



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

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-817/19</b> <i>Olimp Laboratories sp. z o.o., v EUIPO; OmniVision GmbH</i>	 <ul style="list-style-type: none"> <li>– various medical related goods including medical preparations (5)</li> </ul>	<p>In opposition proceedings, the GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to article 8(1)(b).</p> <p>The BoA was correct to find that the marks at issue had an average degree of visual similarity, a high degree of phonetic similarity and were conceptually similar in part for the relevant public who understood the term 'vision'.</p> <p>The BoA was correct to find that the earlier mark had an average degree of distinctiveness as a whole, even though the 'vision' element had weak distinctive character.</p> <p>Therefore, given the identity between the goods and the similarities between the marks at issue, the BoA was correct to find a likelihood of confusion.</p>
27 January 2021 Reg 207/2009	<b>Hylo-Vision</b>	
<b>Reported by:</b> <i>Rebekah Sellars</i>	<ul style="list-style-type: none"> <li>– dietary supplements and dietetic preparations; medical and veterinary preparations and articles'(5)</li> </ul>	

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-382/19</b> <i>Turk Hava Yollari AO v EUIPO; Sky Ltd</i>		<p>In the context of invalidity proceedings pursuant to article 60(1) read in conjunction with article 8(1)(b), the GC upheld the BoA's decision that there was a likelihood of confusion.</p> <p>The GC agreed with the BoA that the goods and services covered by the marks were either identical or similar. The marks at issue were visually, phonetically and conceptually similar to an average degree, since those marks shared the word 'sky'; the addition of the word 'life' did not rule out similarity. Conceptually both marks referred to 'sky', and 'life' further defined the sky as an area capable of accommodating living beings, e.g. birds or passengers of a flight.</p> <p>The GC held that, in combination with the normal distinctiveness of the earlier mark, there was a likelihood of confusion.</p> <p>The invalidity action was not limited by acquiescence on the part of Sky under article 54(1). Turk Hava Yollari had not submitted sufficient evidence that Sky had been aware of their use of the SKYLIFE mark after its registration.</p>
27 January 2021 Reg 2017/1001		
<b>Reported by:</b> <i>Charlotte Addley</i>	<ul style="list-style-type: none"> <li>– training and education services, organising symposiums, conferences, congresses and seminars, publication services for magazines, books, journals and other printed matter, entertainer services, film production, photography, production of radio and television programmes (41)</li> </ul>	
	<b>SKY</b>	
	<ul style="list-style-type: none"> <li>– printed matter (16)</li> <li>– education except for boarding schools and education in relation to dental services provided to dentistry businesses; providing of training except for providing of</li> </ul>	

training in relation to dental services provided to dentistry businesses; entertainment (16)

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-261/19</b> <i>Stada Arzneimittel AG v EUIPO; Optima Naturals Srl</i>		In opposition proceedings, the GC upheld the BoA's decision that there was no likelihood of confusion under article 8(1)(b). The GC held that as the goods covered by both marks were aimed at treating infections, in particular those of the respiratory system, the goods covered by the marks were similar to a low degree.
20 January 2021 Reg 2017/1001	– medicated dental rinses (5)	The GC also held that the earlier mark had a low degree of distinctiveness because the German public would have understood 'mar' as referring to the sea, and it was a well-known fact that nasal sprays could be manufactured from sea water.
<b>Reported by:</b> <i>Stephen Allen</i>	<b>MAR</b> – medicated nasal sprays (5) <b>(German registration)</b>	The marks were found to be visually similar to a low degree on account of the mark applied for being a composite mark, made of up a non-negligible figurative element and the additional word element 'Opti'. They were phonetically similar to a low or average degree at most, due to the pronunciation of 'mar', and conceptually similar to an average degree because 'mar' referred to the sea.
		In light of this, there was no likelihood of confusion on the part of the relevant German consumers, particularly because that public displayed a high level of attention when purchasing such medicinal goods.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-117/20</b> <i>El Corte Inglés, SA v EUIPO; MKR Design Srl</i>		In opposition proceedings, the GC upheld the BoA's decision that there was no likelihood of confusion under article 8(1)(b). The GC upheld the BoA's finding that the marks were not visually similar due to the presence of the black feline in the two earlier figurative marks, which obscured a significant part of the word elements. Other visual differences included the fonts used and the upper-case letter 'P' in the second figurative mark, among others points of distinction.
10 February 2021 Reg 2017/1001	– clothing, headgear (25)	The GC also agreed that the marks were conceptually different, stating that the mark applied for was a fanciful word without any meaning, whereas the earlier marks were associated with the concept of a black feline.
<b>Reported by:</b> <i>Alexander Grigg</i>		
	– stockings, socks, shirts, knitted clothing and clothing in general	

for men, women and children  
(25)

(Spanish registration)



- knitwear and polo shirts (25)

However, it was held that there was a high degree of phonetic similarity, at least for those consumers who were able to identify the word 'panther' in the earlier figurative marks. This was irrespective of the fact the word elements ended differently.

Overall, the GC held that, particularly since clothing purchasing decisions were generally made visually, there was no likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-157/20</b> <b>T-153/20</b> <i>Gabriele Bachmann v EUIPO</i>  10 February 2021 Reg 2017/2001  <b>Reported by:</b> <i>Lauren Kourie</i>	<p><b>T-157/20:</b> <b>LICHTYOGA</b></p> <ul style="list-style-type: none"> <li>- Recorded data; data carriers (9)</li> <li>- Printed matter; electrical or electronic data storage devices; optical devices and equipment, amplifiers and correctors; glasses, sunglasses and contact lenses (16)</li> <li>- Education, entertainment and sport services (41)</li> </ul> <p><b>T-153/20:</b> <b>LIGHTYOGA</b></p> <ul style="list-style-type: none"> <li>- Recorded data; data carriers (9)</li> <li>- Printed matter; electrical or electronic data storage devices; optical devices and equipment, amplifiers and correctors; glasses, sunglasses and contact lenses (16)</li> <li>- Clothing (25)</li> <li>- Education, entertainment and sport services (41)</li> </ul>	<p>In both cases, the GC upheld the decisions of the BoA finding that the marks were descriptive pursuant to article 7(1)(c).</p> <p>The GC found the two components of each mark, "light" and "yoga", as well as their combination together, automatically indicated a special sub-form of yoga, which is specifically practiced using properties of light (i.e. using the appropriate supply of light for therapeutic reasons). The GC disagreed with the applicant that the marks would be understood as an imaginary concept.</p> <p>The GC held that the goods and services claimed related directly to the subject, function, use or purpose that the term "light yoga" describes. The GC found the BoA was therefore right to conclude that "light yoga" was descriptive of the goods and services applied for, save for a very limited number of terms in classes 9, 41 and 25.</p> <p>The GC also stated that registration of the marks would have led to a monopoly of goods and services in this field of yoga and would prevent other providers of this form of yoga from appropriately naming their service.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment

GC  
**T-329/19**  
*12seasons GmbH v EUIPO*



20 January 2021  
Reg 207/2009

**Reported by:**  
*Emma Ikpe*

- Goods made of leather and imitations of leather, namely briefcases, beach bags, wallets, shopping bags, handbags, bags; trunks and travelling bags (18)

In invalidity proceedings, the GC upheld the BoA's decision that there was a likelihood of confusion with an earlier French word mark under article 8(1)(b).

The BoA was correct in determining 'BE EDGY' formed the dominant part of the mark; 'BERLIN' likely being perceived as a place of origin and the triangles as decorative features. Further, the co-dependent word 'edgy' shared its first two letters with the earlier word mark. The BoA had therefore been correct

- Clothing, in particular belts; footwear, in particular insoles; headgear (25)

**EDJI**

- Various goods and services in classes 9, 14, 18, 25 and 35

**(French registration)**

when finding that the signs were visually similar to an average degree at most.

Regarding the phonetic comparison, the signs at issue were similar to at least an average degree, despite the preceding 'BE' in the mark applied for, because the signs would be pronounced identically in French or in a very similar way. They were also conceptually similar because the earlier mark had no specific meaning in French.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-253/20</b> <i>Oatly AB v EUIPO</i>	<b>IT'S LIKE MILK BUT MADE FOR HUMANS</b>	The GC annulled the BoA's decision that the mark was devoid of any distinctive character under article 7(1)(b).
20 January 2021 Reg 2017/1001	<ul style="list-style-type: none"> <li>- dairy substitutes; milk substitutes; milk substitutes containing oats; oat milk; dairy substitutes cheese products (29)</li> <li>- oat-based cake mixes, oat-based biscuit mixes; pancakes; waffles; pancake batter; oat-based pancakes; oat-based waffles; oat-based pancake batter; oat-based liquid batter for making pancakes (30)</li> <li>- preparations for making beverages; oat-based beverages (32)</li> </ul>	The GC held that the word "but" in the middle of the mark caused consumers to perceive an opposition between the first part of the mark and the second part of the mark. The result was that the mark called into question the commonly accepted idea that milk is a key element of the human diet. Consequently, the mark conveyed a message that was easy to remember and was capable of distinguishing Oatly's goods from other goods.
<b>Reported by:</b> <i>Carina Rodriguez</i>		The GC also held that the BoA wrongly disregarded the evidence put forward by Oatly showing the relevant public's perception of the mark in territories of the EU (including Denmark, the Netherlands, Finland and Sweden) where English is widely understood.

## Service out of the jurisdiction

### ***Lyle & Scott Ltd v American Eagle Outfitters, Inc\** (Miles J; [2021] EWHC 90 (Ch); 20 January 2021)**

*In a claim concerning breach of contract and passing off, where the former concerned a contract whose governing law was that of Pennsylvania, Miles J explored the factors which should be considered when deciding whether the courts of England and Wales were the most appropriate forum for bringing a claim. In the result, he dismissed the application to set aside an order permitting the claim to be served out of the jurisdiction. Zara Dheera reports.*

#### Facts

Both Lyle & Scott and American Eagle use a branded flying eagle image on their clothing (see below).

*AE's eagle*

*L & S's Eagle*



In 2005, Lyle & Scott became aware of American Eagle's sale of goods in the UK and EU bearing the American Eagle device. Lyle & Scott argued that American Eagle had infringed its registered trade mark rights in the UK and EU, and that the use of the eagle device could confuse customers. The parties' representatives met in London to negotiate use of the eagle image, and a hand-written memorandum was drawn up, setting out an agreement that, among other terms, American Eagle would sell clothing featuring the branded device only in American Eagle Outfitters stores, or stores within stores, or on its website.

After the meeting, the parties exchanged various draft agreements, however negotiations broke down without an agreed text. American Eagle argued that the written memorandum constituted a valid and binding agreement, and sought a declaration in the Pennsylvania District Court for specific performance that American Eagle's use of its eagle logo would not infringe Lyle & Scott's US trade marks. American Eagle were successful, and Lyle & Scott appealed. On appeal, The United States Court of Appeals for the 3rd Circuit upheld the decision of the judge that the memorandum constituted a valid and binding agreement.

Lyle & Scott discovered in May 2020 that American Eagle were selling clothing with the American Eagle device via third-party UK online retailers ASOS and Zalando, giving rise to a breach of contract and passing off claim. On 4 August 2020, Lyle & Scott served the claim out of the jurisdiction in Pennsylvania, having been granted permission by Master Clark. American Eagle applied to set aside the order.

#### Serving the claim form out of the jurisdiction

The relevant principles to be applied when seeking permission to serve a claim out of the jurisdiction are set out in CPR 6.37 and are as follows:

- a) That there is a serious issue to be tried on the merits (the first limb);
- b) That there is a good arguable case falling within one of the jurisdictional gateways (the second limb); and
- c) The courts of England and Wales are clearly or distinctly the appropriate forum for the trial of the dispute, and in all the circumstances the court should exercise its discretion to permit service of the proceedings out of the jurisdiction (the third limb).

The first limb was satisfied; Miles J concluded that the two images were closely similar and that there was potential for confusion between them.

Lyle & Scott identified four separate jurisdictional gateways, none of which required further comment from the Court and as such the second limb was not in issue.

Miles J went on to discuss whether the courts of England and Wales were the appropriate forum. A variety of factors went into deciding that this limb was satisfied as follows.

#### Governing law under Rome II

Miles J found that it was likely that the governing law would be English Law. He found that the passing off claim fell within Article 6(2) of Rome II (unfair competition) rather than Article 8 (infringement of intellectual property rights). His reasoning was that Recital 26 of Rome II gave examples of the "rights" that Article 8 is concerned with, which included copyright and related rights including the *sui generis* right for the protection of databases. Miles J held that the cause of action in a passing off claim was not an intellectual property right since the cause of action protected the goodwill of traders and goodwill was not an intellectual property right. Rather, such an action for passing off fell more readily under Article 6.

He further held that the act of unfair competition affected a specific competitor, namely Lyle & Scott and consequently the general rules on the applicable law under Article 4 applied. American Eagle argued that the passing off claim fell under Article 4(3) and that the tort was manifestly more closely connected with the state of Pennsylvania because of the pre-existing relationship between the parties. However, Miles J disagreed, holding that, *inter alia*, the passing off claim itself did not arise under the agreement between the parties, rather the claim concerned goodwill with the jurisdiction of the Court and alleged infringements within the

jurisdiction. Accordingly, the default rule in Article 4(1) applied; the governing law was probably (and by some distance) English law.

#### Interplay between passing off and breach of contract claim

Miles J held that there were two different governing laws for the two parts of the claim; the contract claims were governed by the law of Pennsylvania and the passing off claim was governed by English law. Miles J considered that the governing law of the contract between the parties was a feature pointing away from this jurisdiction but that the significance of this should not be overstated. Miles J agreed with Lyle & Scott that that the English Court would have relatively little difficulty understanding the relevant principles of Pennsylvania law. Furthermore the "weightiest" feature of the case was that it concerned a claim for passing off in which relief was sought in the form of injunctive relief in the UK. Accordingly, the features relating to the passing off claim outweighed the main feature of the case which favoured Pennsylvania, namely the governing law of the contract claims and American Eagle's application was dismissed.

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](http://curia.europa.eu/jcms/jcms/j_6/hom)

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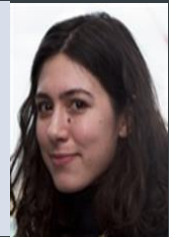
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