

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

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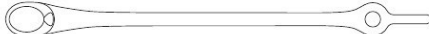
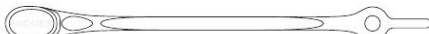
Trade mark decisions

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

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-690/18 <i>Sony Interactive Entertainment Europe Ltd v EUIPO; Vieta Audio, SA</i></p> <p>19 December 2019 Reg 207/2009</p> <p>Reported by: <i>Daniel Anti</i></p>	<p>Vita data carriers containing programs, computer software; audio and/or image carriers (not of paper), in particular magnetic tape cassettes, audio tapes, audio compact discs, DAT (digital audio tape) cassettes, videodiscs, videotapes, exposed films, lithographs (9)</p>	<p>In revocation proceedings based on article 51(1)(a), the GC annulled the decision of the Fourth BoA in its entirety because it had failed to comply with an earlier judgment of the GC and therefore fulfil its obligation under article 65(6).</p> <p>The GC had annulled an earlier decision of the Fifth BoA (in which it upheld the decision of the cancellation division; the mark being revoked for non-use) on the grounds that it had provided an inadequate statement of reasons (T-35/16). The case was then referred to the Fourth BoA. The Fourth BoA did not hand down a fresh decision on all the relevant issues and instead wrongly considered itself bound by the findings of the Fifth BoA.</p> <p>In its earlier decision, the GC had not examined Sony's arguments alleging infringement of article 51(1)(a). Since the force of <i>res judicata</i> concerned only the statement of reasons as an essential procedural requirement and not its substantive legality, the Fourth BoA was required to hand down a fresh decision on all the relevant issues for the application of article 51(1)(a).</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-239/19 <i>Vinos de Arganza, SL ("Vinos") v EUIPO; Nordbrand Nordhausen GmbH</i></p> <p>29 January 2020 Reg 2017/1001</p> <p>Reported by: <i>Robert Milligan</i></p>	 <p>wine (33)</p> <p>BELCANTO alcoholic beverages (except beers) (33) (Earlier German mark)</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 BoA was correct to find visual and phonetic similarity between the marks on account of the fact that six of the seven letters in the applied for mark were contained in the earlier mark, and the marks coincided in the syllables 'can', 'to' and the sound 'e' in the first syllable. The additional figurative elements and typography of the 'ENCANTO' word element in the applied for mark did not alter this assessment.</p> <p>Vinos' assertion that 'belcanto' would be understood by the relevant public as a musical genre in 19th century Italian opera was correctly dismissed by the BoA on the basis that a significant part of the German public, not being vocal art students or opera enthusiasts, would not</p>

understand the term 'belcanto'.

On the basis that the goods were identical and there was visual and phonetic similarity between the marks, the GC upheld the BoA's decision that there was a likelihood of confusion on the part of the German public.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-559/19 <i>Julius Sämann Ltd v EUIPO; Maharishi Vedic University Ltd</i>		The GC upheld the BoA's decision to reject the opposition in its entirety on the basis that a cumulative requirement of articles 8(1)(b) and 8(5) was not present, namely the marks at issue were not similar.
30 January 2020 Reg 2017/1001	bleaching preparations and other substances for laundry use (3) pharmaceutical and veterinary preparations, air deodorising preparations (5)	A phonetic comparison of the purely figurative marks was irrelevant. Even if a phonetic comparison of the marks had been possible, no concrete word could have been immediately attributed to the marks. The generic word "tree" was not specific enough to refer to the particular types of tree represented by the marks.
Reported by: <i>Robert Rose</i>		The marks were also visually and conceptually dissimilar because the shapes referred to different types of tree.
	air fresheners; air freshening preparations (5)	
		
	cosmetics, disinfectants (3) products for improving the air, disinfectants (5)	
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-573/18 <i>Hickies, Inc., v EUIPO</i>		The GC upheld the BoA's decision that the mark was devoid of distinctive character pursuant to article 7(1)(b) for all of the goods applied for other than shoe eyelets and shoe hooks.
5 February 2020 Reg 207/2009		The GC refused to admit certain additional evidence submitted before the Court for the first time because the documents were a comment on the facts and did not speak to the legality of the decision.
Reported by: <i>Louise Vaziri</i>		The mark applied for was limited to a combination of purely decorative or functional elements. All the goods for
	shoe laces; shoe ornaments made of plastic; laces for footwear; accessories for apparel, sewing articles and	

decorative textile articles; shoe eyelets; shoe buckles; shoe hooks; shoe fasteners (26)

which the mark was rejected were capable of falling within a generic category of shoe fastening products.

Since the shape of the mark applied for was a variant of a shoe fastening system, it may have been relevant to those goods. Further, the shape did not depart significantly from the norms and customs of the footwear sector. Accordingly the BoA was entitled to find that the mark was devoid of any distinctive character.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-135/19 <i>Corporació Catalana de Mitjans Audiovisuals, SA v EUIPO; Stéphane Dalmat</i></p> <p>6 February 2020 Reg 207/2009</p> <p>Reported by: <i>Nicholas Puschman</i></p>	<p>LaTV3D telecommunication services (38) education, entertainment and sports; publishing and reporting; translation and interpretation (41)</p> <p>TV3 telecommunication services; radio and TV broadcasting; cable TV; transmissions via satellite; press agency services; information agency; services (news); supply of discussion forums by global informatics networks(38) edition and production services of radio and television programs; montage and production of radio and television programmes; movies (films) production; reporter services; sports and cultural services; on-line electronic publications of books and newspapers(41)</p> <p>(Earlier Spanish mark)</p>	<p>The GC partially annulled the BoA's decision that there was no likelihood of confusion under article 8(1)(b) in relation to any of the services applied for.</p> <p>The BoA was correct in finding that there was no similarity between the services protected by the earlier mark and 'translation and interpretation' services. There could therefore be no finding of a likelihood of confusion as regards these services.</p> <p>However, the BoA had been wrong to find a low degree of visual, phonetic and conceptual similarity between the marks. The GC found the degree of similarity between the marks to be average. Consequently, and despite the weak distinctive character of the common element "TV3", there was a likelihood of confusion in relation to the remaining services.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-598/18 <i>Grupo Textil Brownie, SL v EUIPO; The Guide Association</i></p> <p>30 January 2020 Reg 207/2009</p> <p>Reported by: <i>Megan Curzon</i></p>	<p>BROWNIE trunks and travelling bags; handbags; music cases; purses (18) clothing; footwear; headgear; gloves (25) retailing and wholesaling in shops and selling via the internet of women's clothing and articles and accessories for wear (35)</p> <p>BROWNIES BROWNIE (Series mark as registered) key rings (6) rucksacks; daysacks; bags for children (18) articles of clothing, all for girls (25) badges; emblems; embroidery; shoulder</p>	<p>In the context of opposition proceedings based on article 8(1)(b), the GC upheld the BoA's decision that The Guide Association had made genuine use of the earlier mark.</p> <p>The BoA had been correct to find that there was sufficient evidence to establish genuine use of the earlier mark during the relevant period</p> <p>Use of a figurative representation of the earlier word mark was considered proof of use of the earlier mark as registered, because the figurative elements were not capable of altering the distinctive character of the word mark BROWNIES. The word BROWNIES was clearly legible in the figurative mark, and the figurative elements of the mark had no inherent semantic content which would lend the mark distinctive character or designate the goods concerned.</p>

patches (26)
organisation of group activities in the
education, cultural, training and
entertainment fields (41)

Since the BoA had adopted the grounds
of the Opposition Division, the
opposition itself was partially upheld
under article 8(1)(b) (that is in relation
to the goods and services listed herein)
and was rejected as to the remainder.



(Form of the mark used)

Relevance of social context in determining accepted principles of morality

Constantin Film Produktion GmbH ("CFP") v EUIPO (CJ; C-240/18 P; 27 February 2020)

Setting aside the GC's judgment and annulling the decision of the BoA, the CJEU held that the relevant social context indicated that the German-speaking public did not perceive the sign 'Fack Ju Göhte' as being contrary to accepted principles of morality under article 7(1)(f) of Council Regulation (EC) No 207/2009. Ciara Hughes reports.

CFP produced a highly successful German film comedy called 'Fack Ju Göhte' in 2013, and two sequels sharing the same title in 2015 and 2017. In 2015, CFP applied to register this title as a word mark at the EUIPO, for various goods and services in classes 3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38 and 41. CFP's EUTM application was refused as the EUIPO considered the mark applied for to be contrary to 'accepted principles of morality' under article 7(1)(f). CFP appealed this decision to the BoA.

Rejecting CFP's appeal, the BoA held that the relevant German-speaking public recognised the English expression 'Fuck you' in the first part of the mark applied for and noted that this phrase was vulgar and offensive. The addition of the word 'Göhte' did not vitiate this vulgarity in the BoA's view. Based on CFP's evidence of the success of the film 'Fack Ju Göhte' and its first sequel, the BoA accepted that it could be presumed that the relevant German-speaking at large had either seen or, at the very least, heard of the comedies. However, the BoA considered that the wide success of the films did not indicate that the relevant public would not be shocked by their title.

The GC upheld the BoA's decision. CFP appealed to the CJEU.

The CJEU confirmed that the test to be applied under article 7(1)(f) was whether the relevant public would perceive the sign as being contrary to fundamental moral values and standards of society as they existed at the time. Further, the CJEU held that the assessment had to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, considering the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the EU concerned. The CJEU therefore observed that any factors which indicated the perception of the relevant public, such as legislation and administrative practices, public opinion and the way in which the relevant public had previously reacted to the same sign or a similar sign, were relevant.

As a result, both the GC and the BoA had erred in confining themselves to an abstract assessment of the sign, and focusing, in particular, on the assimilation of the first part of the sign with the English expression 'Fuck you', without taking account of the relevant contextual factors. The CJEU considered that whilst the success of the films was not conclusive of the social acceptance of its title, it was at least indicative of such acceptance, particularly as the title did not appear to provoke any controversy among the audience and the films had been approved for viewing by young people in schools and used by the Goethe Institute for educational purposes. The CJEU further noted that the perception of the English phrase 'Fuck you' by the German-speaking public was not necessarily the same as that of the English-speaking public, even if its meaning was well-known and understood, because "sensitivity in the mother tongue may be greater than in a foreign language".

In light of the absence of concrete evidence to explain why the German-speaking public would perceive the sign as being contrary to fundamental moral values and standards, particularly when the aforementioned contextual factors consistently indicated that the German-speaking public did not perceive the title as morally unacceptable, the EUIPO had failed to demonstrate the requisite legal standard for the application of article 7(1)(f).

Finally, the CJEU held, contrary to the GC's finding, that freedom of expression had to be taken into account when applying article 7(1)(f).

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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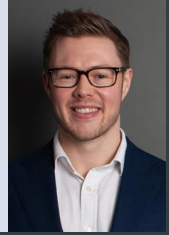
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