

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

January 2021



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-309/19 T-310/19 <i>BRF Singapore Foods Pte Ltd v EUIPO; Tipiak</i></p> <p>25 November 2020 Reg 207/2009 (now Reg 2017/1001)</p> <p>Reported by: <i>Sophie Stoneham</i></p>	 <p>SADIA</p> <ul style="list-style-type: none"> – prepared meals, snacks; ready meals primarily with meat, fish, seafood or vegetables (29) – rice; flour; pastry; prepared meals excluding meals which contain couscous (30) – food retail services; retail services relating to foodstuffs; information, advisory and consultancy services in relation to the aforesaid (35) <p>SAIDA</p> <ul style="list-style-type: none"> – couscous (semolina) (30) <p>(proof of use was successful to this extent only)</p> <p>(French registration)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion under article 8(1)(b).</p> <p>The GC held that all the goods in classes 29 and 30 were similar to couscous to at least a very low degree. Among other reasons, all the goods were foodstuffs designed for human consumption, meaning they had the same nature and purpose. The exclusion of couscous in class 30 did not preclude a finding of similarity between the goods.</p> <p>The BoA was correct in finding that there was an average degree of similarity to food retail services since couscous fell under the generic category of foodstuffs and was thus complementary to retail services. The related information services were similar to a low degree because they were inherent to the retail services.</p> <p>The marks were visually and phonetically similar to a high degree, which offset the at least low degree of similarity between the goods and services.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-26/20 <i>Forex Bank AB v EUIPO; Coino UK Ltd</i></p> <p>2 December 2020 Reg 40/94 (now Reg 2017/1001)</p> <p>Reported by: <i>Stephen Allen</i></p>	<p>FOREX</p> <ul style="list-style-type: none"> – coded and uncoded magnetic cards, in the form of bank- and debit cards; apparatus for cashing money and information about transfer of funds (cash dispensers); computers, computer peripheral devices and registered software for transfer of funds and information about funds; apparatus for money exchange and currency exchange (9) – - printed forms; printed matter, printed information material, printed publications (16) 	<p>In the context of invalidity proceedings, the GC upheld the BoA's decision that the mark was descriptive of the intended purpose or characteristics of the goods pursuant to article 7(1)(c).</p> <p>Forex argued that the public's degree of attention was high in the context of financial services. The GC held this was irrelevant since such services were not covered by the registration, nor were the relevant goods comparable.</p> <p>The GC held that FOREX was understood as an abbreviation of 'foreign exchange market' by the professional public and part of the general public. Forex had not provided satisfactory evidence there was no such understanding amongst the general public, and in any case they had not demonstrated that the remaining</p>

professional public represented a negligible part.

The GC held that FOREX indicated to consumers that the class 9 goods in question related to the cashing and transfer of currency, which was specific enough to cover goods used for foreign exchange transactions. The GC also held that the relevant public would have perceived FOREX as a description of the characteristics of the printed goods in class 16, namely their subject matter.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-687/19 <i>inMusic Brands, Inc. v EUIPO; Equipson, SA</i> 2 December 2020 Reg 2017/1001 Reported by: <i>Alexander Grigg</i>	<p>MARQ</p> <ul style="list-style-type: none"> – electric lights; electric lighting fixtures; lighting apparatus for theatres, clubs and discotheques; lighting fixtures; theatrical stage lighting apparatus; outdoor lighting; lighting tubes; lighting and lighting reflectors (11)  <ul style="list-style-type: none"> – speakers, amplifiers, sound and lighting mixers, electrical cables, connectors, headphones (9) <p>(Spanish and International Registration designating Benelux, Germany, France, Italy, Portugal and the UK)</p>	<p>In the context of invalidity proceedings, 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 held that the BoA was correct to find that the goods in question were similar, to a low degree, to the 'lighting mixers' covered by the earlier mark: the goods were complementary and could be produced and sold by the same manufacturers and retailers respectively.</p> <p>Noting that, in principle, the verbal elements of a composite mark were more distinctive than the figurative elements, the GC agreed that there was an average degree of visual similarity between the marks. The GC also confirmed that the marks were phonetically identical, but disagreed with the BoA's finding that a conceptual comparison was not possible. Instead the GC held that the lack of meaning of the contested mark meant that the marks were conceptually different. Despite this, the GC also concluded that there was a likelihood of confusion.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-819/19 <i>Man and Machine Ltd v EUIPO; Bim Freelance Corp.</i> 9 December 2020 Reg 207/2009 (now Reg 2017/1001) Reported by: <i>Laura Goold</i>	 <ul style="list-style-type: none"> – provision of training (41) – Subsequent request to restrict to: – provision of training relating to building information modeling for engineers, constructors, architects and other technical experts (41) 	<p>The GC annulled the BoA's decision and held there was no likelihood of confusion under article 8(1)(b).</p> <p>After the BoA's decision, Man and Machine restricted its services (shown left). The GC held that the restriction could not be considered because it changed the subject matter of the dispute by altering the composition of the relevant public and their level of attention.</p> <p>The GC held, contrary to the BoA's findings, that the level of attention of the average consumer was high whether they be the public at large or the professional public. This was because the training services were aimed at expanding knowledge and skills, usually requiring</p>




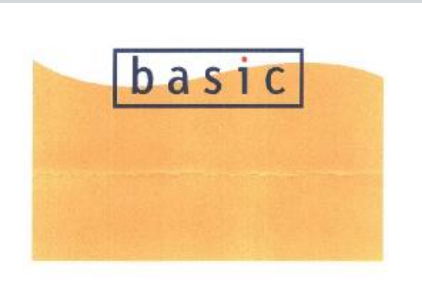
- educational centre services; creation of educational content relating to engineering, architecture and construction (41)

(International TM and EUTM)

time and resource commitments by the public.

The GC also held the degree of visual similarity was very low, rather than average as held by the BoA, in view of the differences in the second word elements, figurative elements, colours and typefaces used.

The GC concluded that the signs were similar to a low degree. The identity of the services was offset by the high level of attention of the relevant public. Thus, there was no likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-722/18</p> <p><i>Repsol, SA v EUIPO; Basic AG Lebensmittelhandel</i></p> <p>9 December 2020 Reg 216/96</p> <p>Reported by: <i>Emma Ikpe</i></p>	 <ul style="list-style-type: none"> – commercial retailing of tobacco, press, batteries, playthings (35) – distribution of staple foodstuffs, pastry and confectionery, ices, prepared meals, tobacco, press, batteries, playthings (39)  <ul style="list-style-type: none"> – goods and services in classes 29, 30, 32, 33, 35, 42, 43 <p>basic basic AG</p> <ul style="list-style-type: none"> – retail of foodstuffs, drugstore articles, organic and other consumer products, restaurant services <p>(unregistered signs used in Germany and Austria)</p>	<p>The GC annulled the decision of the BoA to grant a declaration of invalidity, on the grounds that the reallocation of the case to the BoA, following the judgment of the GC in <i>Repsol YPF v EUIPO; Basic (BASIC)</i> (T-609/15), infringed article 1(d) of Reg 216/96.</p> <p>The GC noted that the provision on which the case should have been reallocated to the BoA was article 1(d) of Reg 216/96, read in conjunction with articles 80 and 81 of Delegated Reg 2017/1430, as proceedings were still pending at the date on which the latter came into force. Under Reg 216/96, the decision to reallocate a case to the BoA had to be taken by the Presidium of the Boards of Appeal. In the present case the decision was taken by the President of the Boards of Appeal, who lacked the necessary competence to do so.</p> <p>It was immaterial that the Presidium had been informed of, and did not object to, the President's decision. Further, the fact that the Presidium would have reallocated the case to the BoA in any event was not relevant, as the Presidium could have reallocated to a different BoA, including the one that took the original decision which was annulled by the GC, so the decision may have been substantively different.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-438/18</p> <p><i>Pareto Trading Co., Inc. v EUIPO; Elżbieta Korbut Bikor and Bikor Professional Colour Cosmetics</i></p>	<p>BIKOR EGYPTIAN EARTH</p> <ul style="list-style-type: none"> – cosmetics, oils and essential oils for cosmetic purposes, sun-tanning preparations, eyeshadows, cosmetic blusher, lipsticks, mascara (3) – -organisation, arranging and conducting of exhibitions, shows, conferences, educational demonstrations and training in the field of cosmetics (41) 	<p>The GC upheld the BoA's decision that the conditions for invalidity under article 52(1)(b) had not been met, as Pareto had not proved that Bikor were acting in bad faith when they filed the application.</p> <p>The GC highlighted that even if a mark was considered to be descriptive, it could still have been applied for in bad faith. However, the facts that Pareto had a distributor in Europe which was</p>

Malgorzata
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EGYPTIAN EARTH
– cosmetics
(unregistered sign)

16 December 2020
Reg 207/2009

Reported by:
Charlotte Addley

authorised to use the mark EGYPTIAN EARTH and that Bikor were a client of this distributor, did not establish that Bikor had knowledge of Pareto's use of the mark.

Further, the GC noted that Bikor owned other marks using the same terms in different language versions, indicating that they did have a genuine commercial rationale for the application. Finally, the addition of the distinctive term BIKOR also suggested a lack of bad faith on Bikor's part when they applied for the mark.

Genuine use

Ferrari SpA v DU (CJEU; Fourth Chamber; C-720/18 & C-721/18; 22 October 2020)

The Court held that use of a mark for replacement parts can constitute genuine use, not only for the replacement parts themselves but for the goods covered by the mark. The resale of second-hand parts can also constitute genuine use of the mark. Robert Milligan reports.

Background

Ferrari was the proprietor of an International Registration designating Germany for the mark "testarossa" (as depicted below)(the "Mark") for 'vehicles; apparatus for locomotion by land, air or water, in particular motor cars and parts thereof' in class 12, and a German national registration for the Mark covering 'Land vehicles, aircraft and water vehicles and parts thereof; motors and engines for land vehicles; car components, i.e. tow bars, luggage racks, ski racks, mudguards, snow chains, air deflectors, head restraints, seat belts, child safety seats' in class 12:



Ferrari sold a sports car model under the Mark between 1984 and 1991 and sold follow-up models (the 512 TR and F512 M) until 1996. Ferrari also produced a one-off sports car with the model designation Ferrari F12 TRS.

The Regional Court in Düsseldorf ordered the cancellation of Ferrari's two registrations on the grounds that the Mark had not been put to genuine use during a continuous period of five years in Germany and Switzerland. Ferrari appealed the decision to the Higher Regional Court in Düsseldorf.

According to the Higher Regional Court, during the period relevant to the assessment of use of the Mark, Ferrari had used it to identify replacement and accessory parts for the very high-priced luxury sports cars previously sold under the Mark. However, the Higher Regional Court was doubtful whether such use for very high-priced luxury sports cars – which was a very narrow subset of vehicles and motor cars – would constitute genuine use in the mass market for motor cars and parts thereof. The Higher Regional Court, therefore, referred various questions to the Court of Justice.

Can use of a mark for a particular market segment (i.e. high-priced luxury sports cars and parts thereof) constitute use of the mark for the entire market (i.e. motor cars and parts thereof)? Does use of a mark for parts of a product constitute use of the mark for the product itself where the product is no longer sold but there are still sales of accessory and replacement parts?

The Court held that the fact that a mark was not used for goods newly available on the market but rather for goods that were sold in the past did not mean that its use was not genuine. The requirement was that the proprietor made actual use of the same mark for component parts that were integral to the make-up or structure of the goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.

Therefore, use of a mark for replacement parts forming an integral part of the goods could constitute genuine use, not only for the replacement parts themselves but for the goods covered by the mark. The Court held that it was irrelevant that the registration of that mark covered not only entire goods but also replacement parts thereof.

The Court further held that, whilst it was true that cars referred to as sports cars were high-performance cars and therefore were capable of being used in motor sports, this was only one of the possible intended uses for such cars, which were also capable of being used, like any other car, for the transport by road of people and their personal effects.

Therefore, the mere fact that the cars in respect of which a mark had been used were referred to as sports cars was not sufficient to consider that they belonged to an independent subcategory of cars. Further, the concept of luxury used by the Higher Regional Court could be relevant to several types of cars and so was insufficient for them to be regarded as an independent subcategory of cars.

The Court found therefore, despite the low number of products sold under the Mark, the use made of the Mark by Ferrari was not token and constituted genuine use of the Mark.

Did the sale of used goods already placed on the market in the EEA constitute use of the mark by the proprietor?

The Court noted that the resale of second-hand products bearing a mark did not mean that mark was being used as the mark was used when the proprietor affixed the mark onto the new product when that product was first put on the market.

However, the Court found that if the proprietor used the mark, in accordance with its essential function of origin when reselling second-hand goods, such use was capable of constituting genuine use of that mark.

When assessing genuine use should consideration be given to whether the proprietor offered services which did not use the mark but were intended for the goods already sold?

The Court found that a mark was put to genuine use where its proprietor provided certain services connected with the goods previously sold under that mark, on condition that those services were provided under that mark.

Does the burden of proof that a mark has been put to genuine use rest on the proprietor of that mark?

The Court held that the proprietor was best placed to adduce evidence in support of genuine use and so the burden of proof rested on the proprietor.

Importance of considering mark as a whole in global assessment

Ace of Spades Holdings LLC ("Ace of Spades") v EUIPO; Gerhard Ernst Krupp and Elmar Borrman (General Court; T-620/19 – T-622/19; 9 December 2020)

The Board of Appeal's failure to consider all aspects of Ace of Spades' earlier filed marks in determining visual similarity and, consequently, likelihood of confusion, amounted to an error of assessment which rendered its decisions vitiated by an infringement of article 8(1)(b) and prompted the General Court to annul the decisions. Louise O'Hara reports.

Facts

Messrs Krupp and Borrmann applied for three different EU trade marks in class 33 covering 'wine of French Origin, namely Champagne; in accordance with the specifications of the protected geographical indication "Champagne":



The "Rose Mark"



The "Silver Mark"



The "Gold Mark"

In three related cases, Ace of Spades opposed the Rose, Silver and Gold Marks on the basis of articles 8(1)(b) and (5). The earlier marks were as follows:



"Mark 1"



"Mark 2"



"Mark 3"



"Mark 4"



"Mark 5"



"Mark 6"

The opposition to the Rose Mark was based on Marks 1-5, the opposition to the Silver Mark was based on Marks 1-3 and Mark 6, and the opposition to the Gold Mark was based on Marks 1-3. All of the earlier marks were filed in class 33 covering "alcoholic beverages (except beers), in particular wines, sparkling wines and champagnes", save for Mark 1, which covered "wines with registered designation of origin Champagne".

In respect of Mark 3, the GC held that, as Ace of Spades' claims centered on the shape of the bottles and as Mark 3 was a position mark, Mark 3 was not relevant to the analysis. The GC therefore held that the BoA's assessments were not disputed insofar as they related to Mark 3.

The relevance of weakly distinctive elements to visual similarity

In coming to its decisions, the Board of Appeal found that, in respect of the earlier marks, the shape of the bottle, their colours, the foil, the fact that a logo was affixed to the neck or centre of the bottle and the shiny effect present in some of the marks had very little, if any, impact on the overall impression created by the marks. Importantly however it did not categorise those elements as negligible, instead it contrasted them with the most distinctive elements of the earlier marks (i.e. the figurative spade with or without the letter A and, in the case of Mark 1, the words armand de brignac).

In determining whether there was visual similarity between the marks, the Board of Appeal focused only on the differences between the earlier marks and the marks applied for. For example, Marks 1, 2 and 4-6 were found to differ from the marks applied for in the figurative elements on the neck of the bottles. Marks 2 and 4-6 further differed as a result of the presence of distinctive word elements in the marks applied for. Additionally, Mark 1 and the marks applied for contained different descriptive word elements and the shiny appearance of the opaque coloured foil covering the marks applied for was not present in Mark 2. It thus rejected the oppositions under article 8(1)(b).

Due to this focus on differences, the General Court held that the Board of Appeal had failed to take the earlier marks into consideration as a whole when carrying out the global assessment of the similarity between them and the marks applied for. As a result, the Board of Appeal's decisions were vitiated by an error of assessment; it had erred in finding that the earlier marks and the marks applied for created different overall visual impressions. Consequently, the decisions were annulled.

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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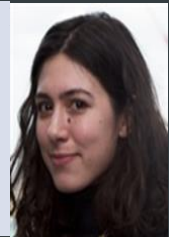
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