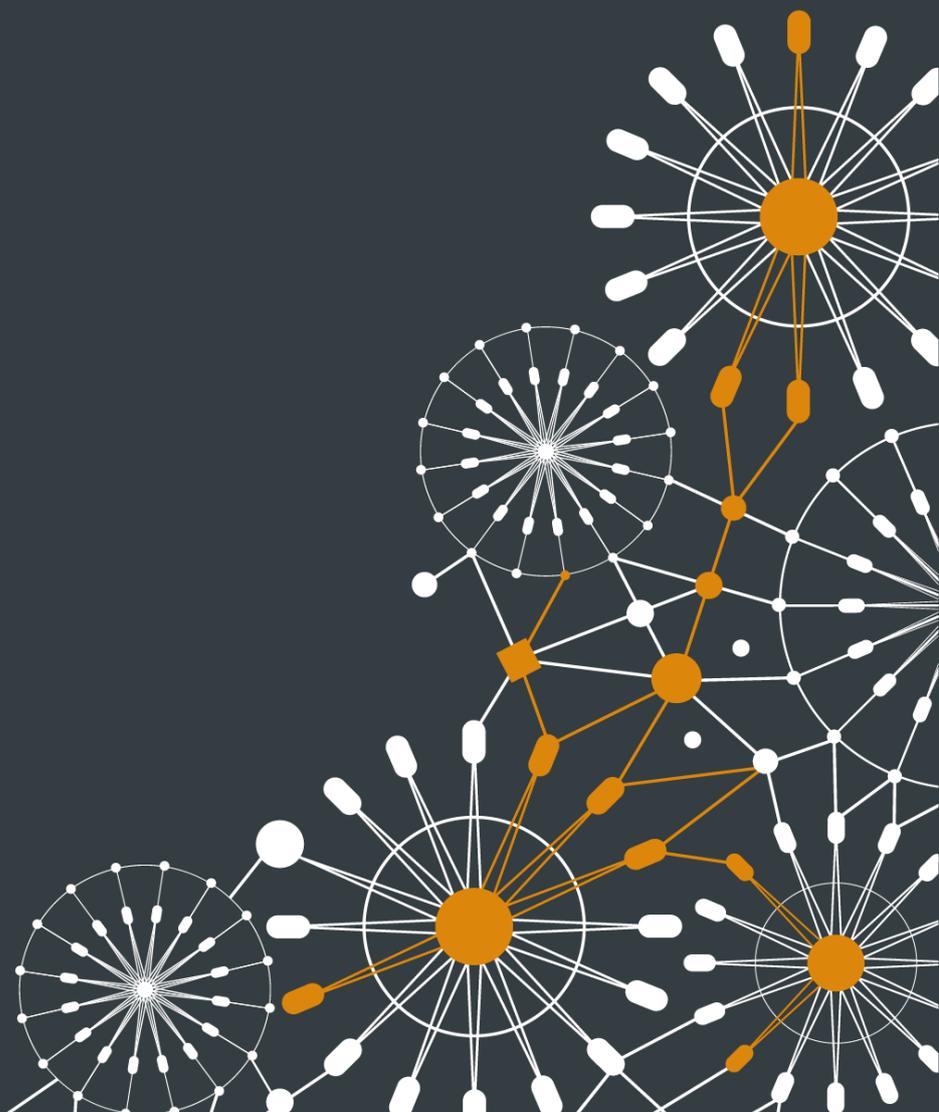


# Bird & Bird & IP Case Reports

October 2018



# 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-438/16</b> <i>Altunis-Trading, Gestão e Serviços, Lda v EUIPO; Hotel Cipriani Sarl</i>	<b>CIPRIANI</b> - beers; mineral and aerated waters and other non-alcoholic drinks; fruit beverages and fruit juices; syrups and other preparations for making beverages (32) <b>HOTEL CIPRIANI</b> - hotels, hotel reservation, restaurants, cafeterias, public eating places, bars, catering; delivery of drinks and beverages for immediate consumption (43)	The GC upheld the BoA's decision that there had been genuine use of the earlier mark in relation to bar and restaurant services and that there was a likelihood of confusion under Art 8(1)(b). The GC held that the bar and restaurant services were not ancillary to hotel services and instead had independent economic value. Hotel Cipriani was not obliged to prove that the earlier mark had been used independently from any other marks, such that evidence of use of the earlier mark alongside other marks could be relied on to demonstrate genuine use. The GC endorsed the BoA's assessment that the goods and services were complementary as bar and restaurants necessarily used the goods in question. The element 'hotel' in the earlier mark did not play a dominant role in the mark, as it was descriptive of the services provided by or in a hotel.
1 March 2018 Reg 207/2009		
<b>Reported by:</b> <i>Megan Curzon</i>		
Ref no.	Application (and where applicable, earlier mark)	Comment

GC <b>T-112/17</b> <i>Pelikan Vertriebsgesellschaft mbH &amp; Co. KG v EUIPO; NBA Properties, Inc.,</i>		The GC upheld the BoA's decision that there was no likelihood of confusion under Art 8(1)(b). As regards the visual comparison of the marks, the BoA was correct to find that NEW ORLEANS was the dominant element of the mark applied for: although PELICANS in the mark applied for was similar to the word PELIKAN in the earlier marks, that element only played a secondary role. As such, the BoA was correct to find that the marks were not visually similar.
12 September 2018 Reg 207/2009	- various goods and services in classes 9, 16, 18, 25, 28 and 41	
<b>Reported by:</b> <i>Mark Livsey</i>		As regards the phonetic comparison, the GC agreed that the mark applied for would be pronounced as either NEW ORLEANS or NEW ORLEANS PELICANS. As the word PELICAN also played a secondary role from a phonetic perspective, the BoA was correct to find that the marks were not phonetically similar.
	<b>PELIKAN</b> - various goods and services in classes 9, 16, 18, 25, 28 and 41 <b>(EUTM and German marks)</b>	As the mark applied for contained stylisations which represented both New

Orleans and basketball, it was conceptually different from the earlier marks.

As the marks were dissimilar, the claim based on Art 8(5) was dismissed.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-905/16</b> <i>Chefaro Ireland DAC (Chefaro) v EUIPO; Laboratoires M&amp;L SA</i>	<b>NUIT PRECIEUSE</b> - soaps; perfumes; cosmetics; hair products; beauty products (3)  <b>EAU PRECIEUSE</b> - soaps; perfumes; cosmetics; hair products; beauty products (3) <b>(French mark)</b>	In invalidity proceedings under Art 53(1)(a), the GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).  Having established that the relevant public was French, the BoA correctly assessed the distinctive elements of the marks. In both marks the first elements, NUIT and EAU, respectively, were intrinsically linked to the second element, PRECIEUSE, as the marks would be perceived as complete phrases (namely, precious night and precious water). The BoA was right to find that the earlier mark had a low level of inherent distinctive character in relation to perfume related goods.  The GC endorsed the BoA's assessment of visual and phonetic similarity. Although the identical element PRECIEUSE was the longest word in each of the marks, this was offset by the fact that NUIT and EAU, respectively, appeared at the beginning of each mark.  The marks were conceptually different as the French public would not perceive the elements of each mark independently.  Chefaro failed to indicate how the BoA had erred in its assessment on enhanced distinctiveness: the appeal on this ground was therefore inadmissible.
12 September 2018 Reg 207/2009		
<b>Reported by:</b> <i>Charlotte Peacock</i>		

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-584/17</b> <i>Przedsiębiorstwo Produkcyjno-Handlowe "Primart" Marek Łukasiewicz "Primart" v EUIPO; Bolton Cile España, SA</i>	  - sugars, natural sweeteners, sweet coatings and fillings, bee products, coffee, teas, cocoa and substitutes therefor, ice, ice creams, frozen yogurts and sorbets, salts, seasonings, flavourings and condiments, baked goods, confectionery, chocolate and desserts, processed grains, starches and goods made thereof, baking preparations and yeasts, crackers (30)	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).  The BoA's assessment that the goods were identical, highly similar or similar to an average degree was not disputed. The BoA was correct to find that the Spanish general public would have an average or lower than average level of attention as the goods were everyday foodstuffs of low value and frequently purchased.  The GC confirmed that the word PRIMART was the dominant and distinctive element of the mark applied for, due to the size and stylisation and its predominant position within the sign as a whole. The figurative elements were purely decorative and the words 'marek
12 September 2018 Reg 207/2009		
<b>Reported by:</b> <i>Ciara Hughes</i>		

### PRIMA

- sauces and condiments, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, edible ices, honey, treacle, yeast, baking-powder, salt, mustard, pepper, vinegar, ice (30)

(Spanish mark)

lukasiewicz' were barely legible due to the smaller italicized font and positioning beneath the word PRIMART.

Visually the signs were similar to an average degree as the mark applied for incorporated the entirety of the earlier mark. Although the GC accepted that the letter 't' would be pronounced and maybe even emphasised in the mark applied for, the coincidence of the first sounds 'pri' and 'ma' gave rise to a higher than average phonetic similarity. The GC endorsed the BoA's finding that the marks were not conceptually similar. Submissions that the BoA had erred in finding PRIMA had no meaning in relation to the goods at issue were unfounded, as Primart had failed to raise the argument before the EUIPO.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-104/17</b> <i>Apple Inc. v EUIPO; Apo International Co. Ltd</i>  13 September 2018 Reg 207/2009  <b>Reported by:</b> <i>George Khouri</i>	  - projector; projection equipment; cameras; camcorders; slide projector; movie machine; camera strap; camera equipment box (9)  - laboratory lamps; stage lamps and lanterns; lamp glasses; lighting apparatus for vehicles; vehicle headlights; lamps; lamp reflectors; burners for lamps; projector lamps; lights for automobiles (11)  - advertising; import and export agent services; online shopping; the retail and wholesale of electrical appliances (35)    <b>APPLE</b>  - goods and services in classes 1 to 12, 14 to 18, 20 to 33, 35 to 45	<p>The GC annulled the BoA's decision to dismiss the opposition pursuant to Art 8(1)(b) on the basis that the BoA had erred in its assessment of the similarity of the marks.</p> <p>The GC held that the figurative element of the mark applied for would be perceived by a significant part of the relevant public as the representation of a part of an apple and was therefore visually similar to the earlier figurative mark to a certain degree. The mark applied was not, however, held to be visually similar to the earlier word mark APPLE.</p> <p>Phonetically, the GC annulled the BoA's finding and concluded that a certain degree of phonetic similarity existed between the word element APO and the earlier word mark APPLE.</p> <p>Conceptually, the BoA had found no similarity between the signs at issue. The GC also disagreed with this assessment, finding a conceptual similarity to the extent that the marks at issue evoked the concept of an apple.</p> <p>The GC therefore concluded that the BoA erred in rejecting the opposition on the basis that the marks were dissimilar. The BoA's decision was annulled in its entirety.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC <b>T-418/17</b> <i>Eduard Meier GmbH v EUIPO; Calzaturificio Elisabet Srl</i></p> <p>13 September 2018 Reg 207/2009</p> <p><b>Reported by:</b> <i>Aaron Hetherington</i></p>	<p><b>SAFARI CLUB</b></p> <ul style="list-style-type: none"> <li>- game bags, backpacks (18)</li> <li>- clothing for hunting, clothing and hunting boots (25)</li> </ul>  <ul style="list-style-type: none"> <li>- leather and imitations of leather; trunks and travelling bags (18)</li> <li>- clothing; sweaters; cardigans; rain boots (25)</li> </ul> <p><b>(Italian mark)</b></p>	<p>The GC partially upheld the BoA's decision and dismissed the opposition in relation to hunting goods on the basis there was no likelihood of confusion under Art 8(1)(b).</p> <p>The GC held that SAFARI was descriptive in relation to the hunting-related goods in classes 18 and 25, but was not descriptive of the remaining goods in those classes.</p> <p>In relation to hunting goods, SAFARI had weak distinctive character and the relevant public's attention would be drawn to the WALK and CLUB elements, which carried greater weight. WALK and CLUB were not visually or conceptually similar.</p> <p>The positioning, size and stylisation of the 'WS' element in the earlier mark did not render that element any more prominent than the word elements of that mark. Consumers would simply have perceived 'WS' as an abbreviation of 'Walk Safari' and would refer to the mark using those words rather than the figurative element. On account of the shared SAFARI element, the marks were phonetically similar to an average degree. The GC held that the overall impression of the marks was different for those goods.</p> <p>There was therefore no likelihood of confusion in relation to hunting goods and the BoA's decision was partially annulled.</p>
<p>GC <b>T-94/17</b> <i>ACTC GmbH v EUIPO; Taiga AB</i></p> <p>13 September 2018 Reg 207/2009</p> <p><b>Reported by:</b> <i>Louise O'Hara</i></p>	<p><b>TIGHA</b></p> <ul style="list-style-type: none"> <li>- clothing, footwear, headgear; suits; dresses, gloves; shirts; trousers, jackets; jerseys; headgear for wear; underwear; coats; outer clothing; ear muffs; parkas; ponchos; waterproof clothing; shows; footwear (25)</li> </ul> <p><b>TAIGA</b></p> <ul style="list-style-type: none"> <li>- clothing; outerclothing; underwear; footwear; headgear for wear and headgear; work shoes and boots; working overalls; gloves; belts and socks (25)</li> </ul>	<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>The GC noted that where a mark has been registered for a broad category of goods and services capable of encompassing a number of subcategories, proof of genuine use in relation to only some of the goods or services afforded protection only for the subcategory to which the goods or services belonged. However, it accepted the BoA's conclusion that this principle should not result in the trade mark proprietor being stripped of all protection for goods which, although not strictly identical, were not essentially different to those for which genuine use had been demonstrated. Evidence of use for weatherproof clothing was therefore not limited to only protecting a subcategory of goods in class 25.</p> <p>The marks were highly visually similar as they shared four out of five letters in almost the same position and were</p>

identical in length. The GC agreed that the marks were also phonetically identical: ACTA GmbH had failed to adduce any evidence that the sound of the first and second syllables ('ti'/'tai' and 'gha'/'ga') were not identical. There was no conceptual similarity: although 'taiga' referred to an area of coniferous forests, ACTA failed to demonstrate that the word had a clear and specific meaning that the relevant European public could grasp immediately.

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC  
**T-238/17**  
*Alexander Gugler v EUIPO; Gugler France*



25 September 2018  
 Reg 207/2009

**Reported by:**  
*Ciara Hughes*

- light protection devices, namely awnings, folding shutters, roller blinds of metal (6)
- sound-proofing materials, namely rockwool and foam plastic elements (17)
- windows, roofing, doors, gates, shutters, roller blind boxes of glass and plastic; glazings, namely conservatories, conservatory roofs; light protection devices, namely folding shutters and roller blinds of plastic (19)
- light protection devices, namely awnings of plastic (22)
- window construction services, namely fitting of doors, gates and windows (37)
- transportation (39)
- window construction services, namely planning of doors, gates and windows (42)

**GUGLER FRANCE**

- purchasing, trade in, selling and fitting building-closing devices, by any and all means or processes

**(French company name)**

In invalidity proceedings, the GC annulled the decision of the BoA which had held that the mark was invalid pursuant to Arts 53(1)(c) and 8(4).

The GC reiterated that the relevant date at which to assess likelihood of confusion was the filing date of the figurative mark. On the relevant date, Gugler France had been the distributor of Gugler GmbH's goods in France, in a business relationship which dated back to 2000.

As such, at the relevant date, any consumer who considered that the goods and services provided under the marks came from economically-linked undertakings would not have made an error as to their origin. This precluded any likelihood of confusion existing at the relevant date. Contrary the BoA's decision, the GC held that the relevant consumer did not have to be aware of the economic link between the parties. It was not necessary for the consumer to be aware of whether or not they were mistaken in believing that the goods and services in question came from the same or economically-linked undertakings.

The BoA's decision was annulled in its entirety.

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC  
**T-180/17**  
*EM Research Organization, Inc., v EUIPO; Christoph Fischer GmbH & Ots*

- EM**
- chemical preservative compositions; antioxidant food preservative compositions; rust inhibitors for industrial use; plant growth preparations; soil conditioners; fertilizers and compost (1)
  - agricultural and horticultural

In invalidity proceedings, the GC upheld the BoA's decision that the mark was descriptive and lacked distinctive character pursuant to Arts 53(1)(a), 7(1)(b) and 7(1)(c).

It was not disputed that the relevant public for the chemical goods in Class 1 were professionals. As regards the other goods at issue, the GC confirmed that the

25 September 2018 Reg 207/2009 <b>Reported by:</b> <i>Robert Milligan</i>	products; foodstuffs for animals (31)	<p>relevant public was members of the general public with an interest in gardening or those who own pets or other animals.</p> <p>The BoA was correct to find that the relevant public would find the mark descriptive of the goods at issue, as it was an acronym for 'effective microorganisms'. This was the same for both the English and German speaking public. Sufficient evidence had been adduced by the interveners to demonstrate that the mark was already, or was capable of being, understood as a descriptive indication for the goods at issue. Evidence included scientific studies, extracts from publications, printouts from Internet sites, press articles and statements from professionals, traders and consumers.</p> <p>On the basis of the descriptive nature of the mark, the BoA was not obliged to consider invalidity on the basis of Art 7(1)(b).</p>
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Ref no.	Application (and where applicable, earlier mark)	Comment
GC <b>T-182/17</b> <i>Novartis AG v EUIPO; Chiesi Farmaceutici SpA</i>	<b>AKANTO</b> - pharmaceutical preparations, excluding pharmaceutical preparations for the treatment of burns, scars, injuries and consequences of surgical intervention (5)	<p>The GC upheld the BoA's decision that there was a likelihood of confusion under Art 8(1)(b).</p> <p>The BoA was correct to find that the goods at issue were identical to those of the earlier registration.</p> <p>The BoA was correct in its assessment that the relevant public was composed of the public at large as well as a specialised public in the pharmaceutical and medical fields which displayed a high degree of attentiveness.</p> <p>Visually and phonetically the marks were highly similar given their common elements, namely the letters 'k', 'a', 'n', 't' and 'o'.</p> <p>Therefore, given the identity of the goods at issue and the high similarity of the marks, the BoA was correct in finding a likelihood of confusion between the marks.</p>
25 September 2018 Reg 207/2009 <b>Reported by:</b> <i>Robert Milligan</i>	<b>KANTOS</b> - pharmaceutical products for human use for sale with a medical prescription (5)	

## Distinctive character of marks which could be surface patterns

***Birkenstock Sales GmbH ("Birkenstock") v EUIPO (CJ, Tenth Chamber; C-26/17 P; 13 September 2018)***

The CJ considered the criteria for assessing the distinctive character of marks which could be applied to the surface of a product. Case law relevant to the assessment of distinctive character of three-dimensional marks consisting of the appearance of the relevant goods also applied to two-dimensional marks capable of use as a surface pattern on goods. The CJ upheld the GC's decision that the mark could be applied as a surface pattern to the goods at issue and lacked distinctive character, save for specific goods in Class 8 and 10. *Charlotte Peacock reports*.

### Background

Birkenstock filed an IR designating, inter alia, the EU for the following figurative mark in respect of a range of goods in classes 10, 18 and 25:



The EUIPO refused to grant protection in the EU for all of the goods concerned on the basis that the mark lacked distinctive character under Article 7(1)(b). The BoA held that the mark displayed a repetitive sequence that could extend in all four directions of the square and that the relevant public would be likely to perceive the mark as a simple surface pattern rather than an indication of origin.

The GC partially annulled the BoA's decision in respect of artificial limbs, eyes and teeth and suture materials; suture materials for operations in class 10 and animal skins, hides in class 18 holding that it is only when the use of a surface pattern is unlikely in light of the nature of the products at issue that such a sign may not be considered a surface pattern in respect of those products. Otherwise the GC endorsed the BoA's assessment of the mark.

### Criteria for assessing distinctive character

The CJ confirmed that the case law which had developed in relation to three-dimensional marks consisting of the appearance of the relevant goods also applied in cases where the mark consisted of a two-dimensional representation of the relevant goods or a design applied to the surface of the relevant goods. The key question was whether the mark was indissociable from the appearance of the relevant goods.

The CJ agreed with the opinion of AG Maciej Szpunar (6 June 2018) that there was an inherent probability that a mark consisting of a repetitive sequence of elements would be used as a surface pattern and would therefore be indissociable from the appearance of the relevant goods. The GC had not erred in law when applying the criterion of whether the mark was "possible and not unlikely" to be used as a surface pattern in relation to the relevant goods, and it was not necessary to apply the criterion of "most likely use" submitted by Birkenstock.

### Standards and usual practices for the relevant goods

The GC was not to be criticised for failing to determine the standards and usual practices of the sectors of the relevant goods when assessing the distinctive character of the mark.

In assessing whether the case law relating to signs that were indissociable from the appearance of the goods was applicable, the GC had analysed whether each category of the goods concerned was likely to display a surface pattern. The GC had also assessed whether the mark departed significantly from the standards of usual practices of the relevant sectors and concluded that the mark was a simple pattern.

The CJ confirmed that the burden is on the trade mark applicant to demonstrate that the mark had an intrinsic distinctive character or had acquired distinctive character through use. In this case, the GC held that the images of footwear provided by Birkenstock were not capable of establishing that the mark applied for was a significant departure from the standards and usual practices of the footwear sector.

## Geographical names used on souvenirs

### ***Bundesverband Souvenir – Geschenke – Ehrenpreise eV v EUIPO; Freistaat Bayern (CJ; Fifth Chamber; C-488/16 P, 6 September 2018)***

The CJ upheld the GC's decision that the word mark NEUSCHWANSTEIN was not indicative of the geographical origin of the goods and services covered by the mark. As such, the mark did not infringe Article 7(1)(c) and was capable of registration in relation to the goods at issue. *George Khouri reports*.

The CJ confirmed that Neuschwanstein Castle, a 19<sup>th</sup> century palace in southwest Bavaria, Germany, was first and foremost a museum location, which did not primarily manufacture or market souvenir products or provide services, but was engaged in heritage conservation. The Castle was not famous for the souvenir items it sold or the services it offered.

The fact that the goods at issue were sold as souvenir items was irrelevant for the purpose of assessing the descriptive character of the mark. The souvenir function ascribed to a product was not an objective characteristic inherent to the nature of that product, since that function would be determined by the free will of the buyer and their intentions. The fact that the goods constituted souvenirs through the affixing of the mark did not make the mark, in itself, an essential descriptive characteristic of those goods. It was not reasonable to conclude that the public would interpret the mark as an indication of an essential characteristic.

With regard to the submission that NEUSCHWANSTEIN was descriptive of the geographical origin of the goods and services covered by the mark, the CJ held that, whilst an indication of the geographical origin of a product usually indicates the place where that product was manufactured, the connection might depend on other ties such as where a product was conceived and designed. Following AG Wathelet's opinion (January 2018) the CJ held that it was not necessarily implied that the place of marketing served as a tie connecting the goods and services covered by the contested trade mark with the place concerned, even in the case of souvenirs.

Neuschwanstein Castle was not famous for its souvenirs but for its unusual architecture. It was not apparent that the contested mark was used to market specific souvenirs or services for which it would be traditionally known. It was possible that that any of the goods or services offered could be sold beyond the Castle's surroundings.

As such, it was not reasonable to conclude that, in the mind of the relevant public, the place of marketing to which the name Neuschwanstein related was a description of quality or an essential characteristic of the goods and services at issue. The GC therefore did not err in law in finding that the mark could not be regarded as indicative of the geographical origin of the goods and services, as Neuschwanstein Castle was not a place where goods were produced or services were rendered. In light of the above, the CJ upheld the GC's decision and dismissed the appeal in its entirety.

### ***Sky Plc & Ots v Skykick, UK Ltd & Anr\* (Kitchin & Floyd LJJ; [2018] EWHC 155 (Ch); 6 September 2018)***

The CA (Floyd LJ giving the lead judgment) refused Sky's application for permission to appeal from two judgments of Arnold J in an action for trade mark infringement and passing off in which he decided several issues of law and fact but referred questions of EU law to the CJEU. Although Floyd and Kitchin LJJ were of the view that the CA had jurisdiction to entertain an appeal at this stage, they declined to do so. *Hilary Atherton reports*.

Sky alleged that Skykick had infringed four of its EU trade marks and one UK trade mark comprising the word SKY by use of the sign SkyKick and variants thereof, and that it had committed passing off. SkyKick used the sign SkyKick in relation to a product which automated the process of migrating a business's email accounts from Microsoft Office to Microsoft Office 365. SkyKick denied infringement and passing off and counterclaimed for a declaration that the SKY marks were wholly or partially invalid because their specifications lacked clarity and precision and that the marks were registered in bad faith. Arnold J referred several questions to the CJEU concerning whether a registered EU trade mark can be declared invalid on the ground that it is registered for goods and services that are not specified with sufficient clarity and precision, and whether it can constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services.

The CA agreed with Sky that there was no obstacle to it hearing an appeal in which it was asked to decide that the relevant EU law was *acte clair* and/or that the reference was unnecessary. As Arnold J could have declined to make a reference and give final judgment, so too could the CA. However, as the litigation before Arnold J was at an interim stage and he had not yet made all relevant findings of fact, it was not appropriate for the CA to do so in the circumstances. If the CA considered it necessary to refer the same questions to the CJEU then costs would be expended on an exercise which would gain nothing and which risked delaying resolution of the reference. Alternatively the CA might conclude that it did not need to refer any questions, but that it did not have the necessary findings of fact to conclude that the marks were valid, or that the likelihood of confusion was established on the basis of that part of the mark which was validly registered. The matter would then have to be remitted to the High Court for those determinations to be made, leaving open the unattractive prospect of a further appeal. Floyd LJ was of the view that this invited unnecessary procedural complexity and that it was far better to let the reference take its course and, if necessary, hear an appeal to the CA when the final outcome became known.

***Andrew Alexander Cooper v Consolidated Developments Limited ("CDL")\** (Carr J; [2018] EWHC 1727 (Ch); 6 July 2018)**

Carr J dismissed Mr Cooper's appeal and CDL's cross-appeal from the Hearing Officer's decision to revoke in their entirety three registered trade marks for TIN PAN ALLEY for non-use and partially revoke a fourth mark. Carr J found that new evidence advanced by Mr Cooper was inadmissible as it could and should have been obtained before the first hearing and would not have had an important influence on the result of the case. *Georgie Hart reports*.

The Appellant, Mr Cooper, had been employed in businesses on or connected with Denmark Street in Soho (which had been colloquially referred to as "Tin Pan Alley" for many years) for over 35 years and he also had close associations with the Tin Pan Alley Traders Association, a group of business owners with a common goal of promoting Denmark Street under the name Tin Pan Alley. Mr Cooper was the registered proprietor of four marks for TIN PAN ALLEY.

The Respondent and Cross-Appellant, CDL, was the owner and landlord of a number of business premises in and around Denmark Street. CDL had applied to revoke Mr Cooper's four marks on the ground that they had not been put to genuine use during a five-year period between September 2011 and September 2016. The Hearing Officer revoked three of the marks in their entirety, but maintained the fourth mark in respect of services in class 35 relating to the provision of advertising space on websites for others.

Mr Cooper appealed the Hearing Officer's decision to revoke three of the marks and sought to introduce additional evidence to demonstrate recent use of the marks, submitting that, while the Hearing Officer was entitled to reach the conclusions that he had on the evidence before him, had the Hearing Officer seen the additional evidence, he would have found that the marks had been used for a much wider range of goods and services. Mr Cooper's explanation for not filing the additional evidence earlier was that the severe depression he was suffering, as a result of financial and personal problems, rendered him unable to consider what evidence he might have sourced from third parties in response to the revocation applications. CDL opposed the admission of the new evidence and cross-appealed against the Hearing Officer's decision to revoke its three marks.

**Mr Cooper's appeal**

Having found that Mr Cooper's appeal fell within the statutory right of appeal under Section 76, Carr J went on to consider whether the Court should exercise its discretion to admit fresh evidence on appeal. He held that: (i) the same principles applied in trade mark appeals as in any other appeal under CPR Pt 52 but, given the nature of such appeals, additional factors might be relevant; (ii) the factors set out in *Ladd v Marshall* [1954] 1 W.L.R. 1489 were to be applied in the light of the overriding objective; and (iii) it was useful to have regard to the factors set out in *Hunt-Wesson Inc's Trade Mark Application* [1996] R.P.C. 233. Applying the same, Carr J held that the additional evidence should not be admitted. It was known to Mr Cooper and could have been filed before the IPO hearing and, whilst Mr Cooper's account of the difficulties he had experienced and his explanation for the late filing of the evidence were accepted, there was no medical evidence to establish his mental state and the required causality. Although the additional evidence was relevant and credible, if it had been before the Hearing Officer, he would likely have reached the same conclusions as set out in his decision. CDL would be significantly prejudiced if the additional evidence were to be admitted and would have to fight for a second time the case which the Hearing Officer had already decided.

**CDL's cross-appeal**

Carr J held that the Hearing Officer was entitled to accept Mr Cooper's evidence as regards use of the fourth mark in relation to advertising services hosted on a website and had given adequate reasons for his decision. Appeals from the IPO were not to be regarded as opportunities to run the same arguments for a second time, in the hope of obtaining a better result. Generally, a distinct and material error of law or principle had to be identified and no such error was identified in the instant case.

***Massimo Osti S.r.l. v Global Design and Innovation Limited ("GDI") & Anr\** (Master Clark; [2018] EWHC 2263 (Ch); 30 August 2018)**

Master Clark rejected Massimo Osti's application to set aside an order made of the Court's own initiative transferring the claim to the IPEC. The Master held that the claim was suitable for the IPEC and ought not to be retained in the High Court. *Georgie Hart reports*.

Massimo Osti maintained the archive of an influential fashion designer and offered fashion and design consultancy services under the name Massimo Osti Archive. It owned an EUTM for the word mark MASSIMO OSTI and an international registration for a figurative mark comprising the words MASSIMO OSTI ARCHIVE, both registered in respect of goods in class 25 for clothing, footwear and headgear (together, the "Marks"). GDI made and sold clothing under the MA.STRUM brand in the UK, with the second defendant Mr Sharp being its sole director.

Massimo Osti issued a claim in the High Court against both defendants for breach of an implied licence under which Massimo Osti claimed it had consented to GDI's use of the Marks in exchange for royalty payments which, it said, had not been paid. Massimo Osti also claimed for trade mark infringement in relation to use of the Marks on goods co-branded with the MA.STRUM mark after the expiry of the implied licence.

### Considerations for transfer to IPEC

Master Clark considered each of the factors listed in paragraph 9 of CPR PD30 relating to whether a claim should be transferred to the IPEC, including whether a party could only afford to bring or defend the claim in the IPEC and whether the claim was appropriate to be determined by the IPEC having regard to (i) the value of the claim, (ii) the complexity of the issues and (iii) the estimated trial length. He also referred to the 2016 IPEC Guide and the Chancery Masters Guidelines for the Transfer of claims (20 May 2015).

The Master was not satisfied that GDI could not afford to litigate in the High Court so found this to be a neutral factor. As regards the value of the monetary relief sought, he held that if Massimo Osti succeeded in all its factual allegations that had a real prospect of success, the total royalties payable (after amounts already paid by the defendants had been deducted) amounted to £313,581, which was well within the maximum value of damages awardable by the IPEC. No significant value was attributed to either the injunctive relief or the value of Massimo Osti's marks because there was no evidence that GDI were still making products bearing the Marks.

As regards the complexity of the issues, the Master held that none of the four main issues to be heard were of sufficient complexity as to make them inappropriate for determination by the IPEC: the issue of the implied licence relied on determination of facts which required limited disclosure of documents (purchase orders for manufacture of and sales records of co-branded products); the issue of whether Massimo Osti's consent to the manufacture of co-branded items during the term of the licence exhausted its rights in respect of those items relied on legal arguments as to the construction and effect of the licence; the issue of whether GDI's use of the Marks was descriptive was an issue commonly addressed in the IPEC and did not give rise to significant factual complexity; and the issue of trade mark invalidity was also an issue the IPEC was well accustomed to dealing with. Given all of the other factors, the Master held that the claim could be heard within the usual two days required for an IPEC case. As such, the claim was suitable for the IPEC and Massimo Osti's application was rejected.

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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