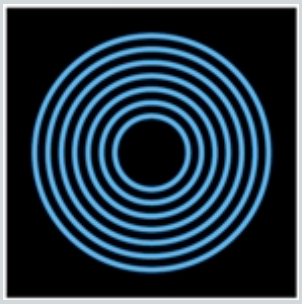
Bird & Bird &

Reports of Trade Mark Cases for CIPA Journal

November 2019

Trade mark decisions

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

Ref no.	Application (and where applicable, earlier mark)	Comment
GC **C-261/18** *Rotex AB v EUIPO; Wallmax Srl* 24 September 2019 Regulation 2017/1001 **Reported by:** *William Wortley*	 - cable and pipe penetration seals, made from plastic or rubber (17)	The GC upheld the BoA's decision that the mark was invalid on the basis that the mark consisted exclusively of the shape of goods necessary to obtain a technical result pursuant to article 7(1)(e)(ii). The GC held that the mark was the two-dimensional depiction of the leading surface of a sealing module. The GC rejected the argument that the mark did not reproduce a three-dimensional characteristic as irrelevant. The GC upheld the BoA's decision that the concentric circles were the only important characteristic of the contested sign. The GC held that the concentric circles, depicting the removable concentric layers of a sealing module, were an indispensable characteristic of the invention, forming the main technical concept on which it was based.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-404/18** *Igor Zhadanov. v EUIPO* 24 September 2019 Reg 2017/1001 **Reported by:** *Robert Rose*	**PDF EXPERT** computer application software for personal computers, mobile phones and portable electronic devices, namely, software for vieweing, editing and managing pdf documents (9)	The GC upheld the BoA's decision that the mark had not acquired distinctive character pursuant to article 7(3). Although the BoA erred in interpreting too widely the range of goods applied for under the trade mark, it was correct in finding that the applicant failed to prove that the relevant public perceived the mark as originating from a particular undertaking. The BoA was also correct in finding that the direct evidence of distinctive character provided by the applicant was insufficient because it was only relevant to the professional public, and not the relevant public (which included the general public) in its entirety. Furthermore, the BoA was correct in finding that the value of internet search statistics as evidence of a mark acquiring distinctive character was only relevant in special circumstances, which were not present in this appeal.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-492/18** *Igor Zhadanov. v EUIPO* 24 September 2019 Reg 2017/1001 **Reported by:** *Robert Rose*	**SCANNER PRO** - computer software for scanning images and documents; computer programmes for data processing; computer programs [downloadable software]; software; mobile software; computer; software; downloadable software (9) - scanning of images; digitization of documents [scanning] (42)	The GC upheld the BoA's decision that the mark had not acquired distinctive character pursuant to article 7(3). The GC rejected the applicant's submission that apps are unconventional goods and that the types of evidence to be considered and the assessment of that evidence should be different. Evidence of distinctive character acquired through use does not distinguish between goods and services and there is no distinction as to the types of evidence corresponding to each category. Furthermore, the BoA was correct in finding that the value of internet search statistics as evidence was only relevant in in special circumstances, which were not present in this appeal. The BoA was correct in finding that the mark in and of itself was not capable of identifying the applicant as the undertaking from which the goods and services originated.
Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-491/18** *Vafo Praha s.r.o. v EUIPO; Susanne Rutzinger-Kurpas* 3 October 2019 Reg 207/2009 **Reported by:** *Bryony Gold*	**Meatlove** - foodstuffs and fodder for animals (31) - retail services in relation to fodder for animals and dietary supplements, wholesale services in relation to fodder for animals and dietary supplements (35) **carnilove** - vitamin and mineral supplements for pets (5) - pet food, pet treats (31)	The GC annulled the BoA's decision that there was no likelihood of confusion under article 8(1)(b). In its assessment of conceptual similarity, the BoA incorrectly found that the earlier mark carnilove would not be broken down by the relevant public into 'carni' and 'love'. Further, the BoA wrongly disregarded certain meanings of the word element 'carni' for the English-speaking relevant public. The BoA also wrongly disregarded the meaning of the word element 'meat' for Italian- or Spanish-speaking relevant publics. The GC therefore held that the BoA had not conducted a correct examination of conceptual similarity. Accordingly the GC annulled the BoA's decision.
Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-453/18** **T-454/18** *Alessandro Biasotto v EUIPO; Oofos, Inc.* 10 October 2019 Reg 2017/1001	  - clothing; belts; hats (25)	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The GC agreed with the BoA that the word elements OOF and OO in Alessandro Biasotto's applications were the dominant and distinctive elements leading to an average degree of visual similarity. The applicant argued that phonetic

Reported by: *Adeena Wells*	**OOFOS** - footwear comprised of foam (25)	similarity was not an important factor due to consumers' focussing on the visual aspects of the marks. The GC confirmed that a lesser degree of importance of phonetic similarity did not affect the visual similarity which has already been established. The marks OOF and OOFOS were held to be phonetically similar to an average degree, and the respective marks comprising two letter O's were held to be phonetically identical. The conceptual comparison was not possible given that the marks were fanciful terms. The respective goods were considered to be similar to an average degree given the same purpose, manufacturing process, distribution channels and end consumers.
Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-700/18** *Kalypso Media Group GmbH v EUIPO; Wizards of the Coast LLC* 10 October 2019 Reg 2017/1001 **Reported by:** *Dean Rae*	**DUNGEONS** - computer game software (9) - arcade games; playing cards; toys (28) - online computer games and related information; online content (41) **DUNGEONS & DRAGONS** - interactive entertainment software; gaming devices; electrical apparatus (9) - games machines; toys (28) - education; providing of training; entertainment; sporting and cultural activities (41)	The GC upheld the BoA's decision that there was a likelihood of confusion under article 8(1)(b). The GC agreed with the BoA that the marks were highly similar visually and phonetically and moderately similar conceptually. The GC further agreed with the BoA that the relevant public displayed an average level of attention. The GC dismissed the applicant's submission that BoA had erred in its assessment of the level of attention of the relevant public; the applicant submitted that the relevant public for computer games had a high level of attention. The GC held that it was apparent from case law that, when assessing the likelihood of confusion, the public with the lowest level of attention must be taken into account. Accordingly, notwithstanding that part of the relevant public showed a high level of attention, this did not exclude that games and computer games were also intended for consumers who show a level of attention that was 'average at best.' The BoA had therefore not erred in its assessment of the level of attention of the relevant public.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC **T-628/18** *Viomichania mpiskoton kai eidon diatrofis E.I. Papadopoulos SA v EUIPO; Europastry, SA* 17 October 2019 Reg 207/2009 **Reported by:** *Katie Rimmer*	 - flour and preparations made from cereals; bread, pastry and confectionery (all frozen) (30)  - stuffed wafers in the form of cigarillos (30)	The GC upheld the BoA's decision that that there was no likelihood of confusion between the marks under article 8(1)(b). The GC held that the BoA was correct to find a low degree of visual similarity between the marks. The word 'fripan' was positioned dominantly in the contested mark and the common word 'caprice' was distinguished by its placement, typeface, size and colour in each mark. The earlier mark also contained a figurative element that did not feature in the contested mark. The phonetic similarities between the marks were held to be low. Although the word 'caprice' featured in both marks, it was merely contained in the middle of five words in the contested mark. The conceptual similarities were also held to be low because while there was no clear semantic meaning in the word 'fripan', the relevant public may have attached meaning to the remaining four word elements. Notwithstanding that, the goods in question, save for flour, were identical. The GC agreed with the BoA that the overall impression created by each mark was different.

Passing off

Glaxo Wellcome UK Ltd & Anr v Sandoz Ltd & Ots* **(Arnold LJ; [2019] EWHC 2545 (Ch); 4 October 2019)**

Arnold LJ (in his first judgment following his elevation) held that Glaxo failed in its claim that Sandoz had passed off its AirFluSal Forspiro inhaler as being connected in the course of trade with Glaxo and/or equivalent to Glaxo's Seretide Accuhaler through the use of the colour purple on its get-up and packaging. Katharine Stephens reports.

Background

In 1999, Glaxo launched the Seretide Accuhaler. It was the first product in the UK to consist of a combination of salmeterol and fluticasone for the treatment of asthma and chronic obstructive pulmonary disease ('COPD'). The packaging and the inhaler were marketed in shades of purple; different shades indicating different strengths (see below).

In November 2015, Sandoz launched a branded generic competitor under the trade marks AirFluSal Forspiro. The packaging, featuring the colours purple and white, is shown below:

It was common ground between the parties that there was no official colour convention for inhalers in the UK. However, Arnold LJ found that in November 2015, healthcare professionals would have known that some colours represented a single drug type or class. As for patients, they would understand that the different colours signified inhalers containing different type of medication for different purposes, in particular, it was widely recognised that blue indicated reliever inhalers (those containing fast-acting medication, sometimes called rescue inhalers) and brown/orange/burgundy denoted preventer inhalers (those containing long-acting medication taken regularly). Between 1999 to May 2015, Glaxo's inhalers were the only ones on the UK market coloured purple.

Glaxo advanced two cases of passing off: (i) that the get-up of the AirFluSal Forspiro was such that patients would be deceived as to trade origin; and (ii) the AirFluSal Forspiro made a misrepresentation as to equivalence with the Seretide Accuhaler.

Distinctiveness of the colour purple: Survey evidence

Glaxo relied, inter alia, upon four surveys which had been submitted to the UK Trade Marks Registry in support of its claim that the colour shade Pantone 2587C had acquired distinctive character. (Note that Glaxo's claim in this case was to the distinctiveness of any shade of purple and, indeed, to the combination of such shades.) The evidence was voluminous amounting to 15 expert reports from six experts and was quite repetitive. This was caused, in part, by the fact that the survey methodology had not been fully described at the outset. Arnold LJ urged the Registry to use its case management powers to ensure that such things did not happen in the future.

Arnold LJ held that the surveys conducted in 2015 were of no value because they did not comply with "the Whitford Guidelines" formulated by Whitford J in *Imperial Group v Philip Morris* [1984] RPC 293 and summarised by Lewison LJ in *Interflora v Marks & Spencer* [2012] EWCA Civ 1501. As for the 2016 surveys, questions 1 – 3 were reasonably reliable, but a fourth was not. More specifically, Arnold LJ found:

- There was a distinct lack of documentation in relation to both the instructions given to the interviewers and also in relation as to how all the surveys were carried out. These defects went to the probative weight to be given to the evidence.

- No attempt had been made to ensure the respondents were representative of the population in respect of age, experience, gender or size of practice/pharmacy. However, there was no reason to think that this had a material impact on the results.

- The 2015 surveys asked leading and misleading questions. This made them valueless.

- Paraphrases by the interviewers of what the respondents said were recorded and not the full answers. This did not matter in relation to some of the questions, but in relation to the fourth question in the 2016 surveys, it did. This was because it asked "How do patients typically refer to the inhaler ...". Capturing the precise answer was important because it was attempting indirectly to ascertain patient perceptions.

- This fourth question was also vague (what does "typically" mean?) and, because of the questions preceding it, the respondents would have been biased towards mentioning colour, and specifically, purple when answering.

Arnold LJ held that the surveys merely showed that GPs and pharmacists recognised the colour purple as a feature of Seretide inhalers. They did not prove that GPs or pharmacists would assume that another inhaler bearing the same shade of purple (let alone a different shade capable of being described as purple) emanated from the same trade origin, let alone an inhaler of a different design bearing different word marks. This was particularly true of the 2015 surveys when there was no other such inhaler on the market. As for the responses to the fourth question in the 2016 surveys, Arnold LJ accepted that all they showed was that patients frequently referred to their Seretide inhalers by colour. This was entirely consistent with patients finding it convenient to differentiate between their different inhalers by reference to their colour, but it did not show that they regarded the colour as being distinctive of inhalers having a particular trade origin.

Distinctiveness of specific characteristics

None of the questions in the survey were designed to show whether the colour purple was distinctive of specific characteristics of Glaxo's products. The trade witnesses were clear in that they would not rely upon the colour purple to indicate anything about, for example, the marketing authorisation of an inhaler. Furthermore, as Arnold LJ noted, there was a distinct flaw in Glaxo's case in that they marketed a second purple coloured inhaler called the Evohaler. This inhaler differed from the Seretide Accuhaler in its delivery mechanism, in the doses that it delivered and the licensed indications for the different strengths. Purple could not, therefore, indicate a particular mechanism, dosage or indicate the extent of the authorisation.

Misrepresentation

Despite the very considerable effort and resources that Glaxo had put into searching, there was no evidence of actual confusion between Glaxo's and Sandoz's products amongst patients. The first way Glaxo framed its passing off case therefore failed.

Furthermore, there was no evidence that any healthcare professionals (or indeed patients) had been, or were likely to have been, confused as to the characteristics of AirFluSal Forspiro due to the use of the colour purple. Healthcare professionals would, firstly, not assume that AirFluSal Forspiro worked in the same way as the Seretide Accuhaler because of its colour. Secondly, the use of purple did not convey a misrepresentation that AirFluSal Forspiro existed in three strengths; anyone prescribing it could not help but be aware that it only came in one strength. Thirdly, use of the colour purple did not convey that AirFluSal Forspiro (which before February 2017 was not authorised for asthma, but only for COPD) had the same extent of authorisations as the Seretide Accuhaler. Glaxo's own trade witnesses were clear that they would not make any assumption about the marketing authorisations of inhalers based on their colour. As a consequence, Glaxo's second claim also failed.

Recklessness

Arnold LJ noted that it was not a necessary ingredient of passing off that the misrepresentation was deliberate, nevertheless, a defendant's intentions could have evidential relevance. If it was proved that a defendant was aware of the risk of deception and proceeded recklessly, then that was capable of supporting the conclusion that deception was likely even if the defendant did not intend to deceive. If, however, what was proved was that a defendant was aware of the risk, but thought that sufficient action had been taken to avoid it materialising, then that was not supportive of the conclusion that deception was likely, but rather of the reverse.

The entire investigation as to whether Sandoz was reckless as to whether members of the relevant public would be deceived into thinking that AirFluSal Forspiro was connected in the course of trade with Glaxo was described by Arnold LJ as "a complete waste of time and money". Sandoz had chosen purple to signal the substance combination; it was not passing off if the similarity in colour merely reassured patients that the AirFluSal Forspiro had the same active ingredients as the Seretide Accuhaler. Further, Sandoz did not deliberately seek to make the AirFluSal product and packaging as similar as possible to the Seretide Accuhaler as could be seen just from looking at the products and packaging. There was nothing in Sandoz's

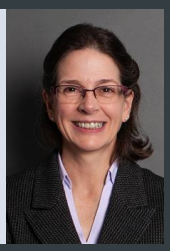
state of mind at the time of developing and launching their product that lent any support to the passing off claim.

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

Editorial team

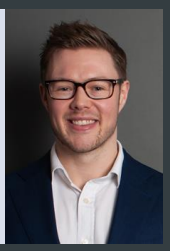
Katharine Stephens
Partner, IP

Tel: +44 020 7415 6104
katharine.stephens@twobirds.com



Thomas Pugh
Associate, IP

Tel: +44 020 3017 6873
thomas.pugh@twobirds.com



Reporters

William Wortley; Robert Rose; Bryony Gold; Adeena Wells; Dean Rae; Katie Rimmer

This report was first published in the CIPA Journal, November 2019