

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

August 2020



Trade mark decisions

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

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-333/19 <i>Christos Ntolas v EUIPO; General Nutrition Investment Co.</i>		<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 had been correct in finding that the goods in classes 5, 29 and 30 were similar or identical to the services in class 35 for which the earlier mark was registered. The GC rejected the submission that the word 'laboratories' in the mark applied for would be understood by the public as meaning that the goods had been developed by scientists, thereby enabling them to distinguish between the developer and the retailer. The analysis of similarity between the goods and services could not be affected by a word element of the mark applied for.</p> <p>The BoA was also correct to find that the marks were similar to an average degree; the shared letters, 'G' and 'N', being dominant in the mark applied for. Finally, there was a likelihood of confusion notwithstanding that the public were held to have a higher than average level of attention.</p>
28 May 2020 Reg 2017/1001	<ul style="list-style-type: none"> – dietary supplements, vitamin preparations, food supplements, not for medical purposes, with a base of carbohydrates, fats or proteins (5) – edible oils, dietetic foodstuffs, not for medical purposes, with a base of fats (29) – dietetic foodstuffs, not for medical purposes, with a base of carbohydrates (30) 	
Reported by: <i>Louise O'Hara</i>	<p>GNC</p> <ul style="list-style-type: none"> – protein for human consumption (5) – milk products (29) – - retail store services featuring health foods, dietary supplements, nutritional supplements (35) 	
Ref no.	Application (and where applicable, earlier mark)	Comment

GC T-615/18 <i>Diesel SpA ("Diesel") v EUIPO; Sprinter megacentros del deporte, SL ("Sprinter")</i>		<p>Following on from its first decision on Diesel's opposition against Sprinter's trade mark application (reported in <i>CIPA Journal</i> October 2017), the GC found genuine use of a limited number of goods covered by Diesel's first earlier mark.</p> <p>The GC held the BoA had erred in finding no genuine use of the first earlier mark (representing a capital D) in so far as it concerned footwear and men and women's denim jeans in class 25, the latter being a sub-category carved out of the wider term of clothing. The GC found advertisements from well-known magazines, corroborated by other evidence including net turnover figures</p>
28 May 2020 Reg 207/2009	<ul style="list-style-type: none"> – leather goods, bags (18) – clothing, sports shoes, headgear (25) 	
Reported by: <i>Lauren Kourie</i>		



- leather goods, travelling bags (18)
- clothing, footwear, headgear (25)

of goods bearing the earlier mark, were sufficient to prove genuine use in relation to these goods.

As to the remaining goods covered by the earlier D-shaped mark and all good covered by the angled line mark, the GC upheld the BoA's decision, generally finding that the quality and extent of the evidence filed by Diesel was insufficient to prove genuine use.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-724/18 T-184/19 <i>Aurea Biolabs Pte Ltd v EUIPO; Avizel SA</i> 28 May 2020 Reg 2017/1001 Reported by: <i>Lucy Wiles</i>	 <ul style="list-style-type: none"> - food supplements; dietary and nutritional supplements; dietary supplemental drinks; vitamin and mineral supplements (5) <p>AUREA</p> <ul style="list-style-type: none"> - soaps; essential oils; cosmetics, other than perfumes and eau de toilette; hair lotions (3) - cold cream for medical use; medicated face, body and hand creams; medicated skin creams (5) 	<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 GC found that the BoA correctly noted that the goods applied for were commonly used to protect the skin from ageing caused by ultraviolet rays and to promote a healthy tan. The goods covered by both marks therefore shared the specific common purpose of protecting and embellishing the skin when exposed to the sun. The GC also upheld the BoA's findings that the goods shared other specific purposes, as consumers bought both vitamin supplements and creams to reduce cellulite as well as to restore or maintain a healthy appearance.</p> <p>The GC noted that the fact that goods may be used together could be considered in the assessment of the similarity of goods, even if they did not possess the requisite standard of indispensability to be complementary. As such, the goods were at least similar to a low degree, and the BoA had correctly found that there was a likelihood of confusion.</p>
GC T-659/19 <i>FF Group Romania SRL ("FGR") v EUIPO; KiK Textilien und Non-Food GmbH ("KTNF")</i>	 <ul style="list-style-type: none"> - retailing of the following goods through a chain of stores: clothing, footwear, fashion accessories, goods of leather and imitations of leather, headwear, clothing and sports footwear 	<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>KTNF amended its specification of services between an earlier decision of the 4th BoA and the decision of the 2nd BoA, being the one under appeal. FGR argued that such an amendment should have led to a re-trial. However, the GC</p>

- 8 July 2020
Reg 2017/1001
- Reported by:**
Adeena Wells
- (35)
 - kik
 - retail sale services in connection with textiles, cosmetic products, toys, household products and other products for everyday use (35)
 - List of services later amended to read: retail sale services in connection with textiles, namely clothing, headgear made of textile materials, household linen, bed linen and table linen, as well as in relation to cosmetics, toys, household products and other products for everyday use (35)

(German mark)

held that the amendment constituted a limitation, not an extension. Given that the parties were invited to comment on the amended specification, FGR's right to be heard had not been infringed.

The GC also held that, as FGR had not specifically raised the point, the BoA was not obliged to re-examine the issue regarding proof of genuine use of KTNF's earlier mark following the specification amendment.

Despite FGR's arguments that their services were offered to higher-end and therefore different consumers, the GC stated that this was not reflected in the specifications. It confirmed the BoA's finding of a likelihood of confusion on the part of the relevant German public.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-633/19 <i>Essential Export SA v EUIPO; Shenzhen Liouyi International Trading Co. Ltd</i>	 <ul style="list-style-type: none"> – umbrellas, parasols, walking sticks, trunks [luggage], purses, school bags (18) 	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b).</p> <p>The GC rejected Essential Export's argument that the mark applied for would be perceived as the letters 'TOTU', upholding the BoA's decision that the relevant public would perceive the mark applied for either as an abstract figure composed of black lines and red dots, or possibly as a figurative representation of the word elements 'ro' and 'ril', as the red dots were clearly distinguishable from the black lines due to their different colour and shape.</p>
8 July 2020 Reg 2017/1001 Reported by: <i>Louise O'Hara</i>	 <ul style="list-style-type: none"> – leather and imitations of leather, trunks, travelling bags, umbrellas, parasols and walking sticks (18) 	<p>In particular, the GC held that the indication in the application form, that the mark contained the word element 'totu', was irrelevant: this indicated Shenzhen Liouyi's perception of the mark applied for, but provided no insight as to the perception of the relevant public.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-328/19 <i>Scorify UAB v EUIPO; Scor SE</i>	 <ul style="list-style-type: none"> – insurance, finance and real estate services (36) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks, in respect of the insurance and finance services applied for, pursuant to article 8(1)(b).</p>
8 July 2020 Reg 2017/1001 Reported by:	<p>SCOR</p> <ul style="list-style-type: none"> – insurance and reinsurance, 	<p>The GC upheld the BoA's finding that the general public displayed a high level of attention with respect to the services in question, as they were liable to have a direct impact on the economic and financial assets of consumers.</p>

including insurance and reinsurance advice, consultancy and information; insurance and reinsurance brokerage; actuarial services; consultancy and information relating to financial matters (36)

The BoA correctly held that the word element of the mark applied for was the dominant element, due to its size, distinctiveness and the fact that goods were more commonly referred to by their name rather than a description of the figurative elements of the mark. In addition, the figurative element was not arranged in a specific, original or elaborate manner, so would not influence the overall impression produced by the mark. The signs were therefore visually and phonetically similar to an average degree.

As a result, given the identity and similarity of the services, the BoA was correct to find that there was a likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-21/19 T-20/19 <i>Pablosky, SL v EUIPO; docPrice GmbH</i> 8 July 2020 Reg 2017/1001 Reported by: <i>Theo Cooper</i></p>	<div data-bbox="427 797 847 969" data-label="Image"> </div> <p>mediFLEX easystep</p> <ul style="list-style-type: none"> - orthopaedic footwear; boots for medical purposes (10) - clothing; headgear; footwear; health shoes (25) <div data-bbox="427 1211 932 1464" data-label="Image"> </div> <ul style="list-style-type: none"> - clothing; footwear; headwear (25) 	<p>The GC partially upheld the BoA's findings that there was a likelihood of confusion between the earlier mark and the later marks under article 8(1)(b).</p> <p>The GC considered that for the non-English speaking public, the marks were dissimilar. However, for the English speaking public, the GC held that the figurative mark applied for and the earlier mark were visually and phonetically similar to an average degree, due to the small size and positioning of the 'mediFLEX' element in the former. The word mark applied for was only phonetically and visually similar to a low degree as the additional word element made the mark notably longer than the earlier mark and added further syllables to pronounce. The GC held that there was only a low degree of conceptual similarity between the marks.</p> <p>The GC found that the public had a higher level of attention for goods that affected health, including 'health shoes', 'orthopaedic footwear' and 'boots for medical purposes'. Attaching greater importance to the visual and phonetic elements of the marks due to the marketing circumstances of the goods, and noting that the earlier mark had a low degree of inherent distinctiveness with regard to footwear, but average distinctiveness with regard to clothing and headgear, the GC held that there was a likelihood of confusion for 'clothing' and 'headgear' in class 25, but not in respect of the other goods applied for.</p>

Assessment of earlier mark's reputation under article 8(1)(b)

China Construction Bank Corp. ("CCB") v EUIPO (Groupement des cartes bancaires) (CJ; Tenth Chamber; C-115/19 P; 11 June 2020)

The CJ held that the GC had erred in law by taking the reputation of the earlier mark into account at the stage of its examination of the similarity of the signs at issue. It had also failed to give sufficient reasons for its finding that the earlier mark enjoyed a reputation and thus possessed a high degree of distinctive character for services relating to "financial affairs, monetary affairs, banking". As CCB's arguments before the GC were well-founded, i.e. the BoA had erred in these respects, the decision of the BoA was annulled. Hilary Atherton reports.

Background

CCB applied to register the figurative sign below for "Banking; financial evaluation ([insurance, banking, real estate); financing services; credit card services; deposits of valuables; antique appraisal; brokerage; guarantees; fiduciary" in class 36:



Groupement des cartes bancaires opposed the application under articles 8(1)(b) and 8(5) based on its earlier figurative EUTM, shown below, which was registered for "Insurance and finance, namely insurance underwriting, foreign exchange bureaux; issuing of travellers' cheques and letters of credit; financial affairs, monetary affairs, banking; ... management of banking and monetary flow by electronic means; ... issuing of and services relating to prepayment cards, debit cards, credit cards, cash withdrawal cards ...; electronic payment ...; financial transactions by card holders via automated teller machines; authentication and verification ...; financial information via all means of telecommunication" in class 36:



The Opposition Division upheld the opposition under article 8(1)(b). CCB filed an appeal which was dismissed by the BoA. CCB's subsequent action before the GC to have the decision of the BoA annulled was also dismissed. CCB appealed to the CJ.

Decision

The CJ held that the GC had erred in law by finding that the BoA was entitled to infer from the reputation and highly distinctive character of the earlier mark that it would be perceived as being the word element CB, that that word element was therefore dominant and that it must, in turn, dominate the assessment of the similarity of the signs at issue. It was incorrect in law to assess the similarity of the signs at issue in the light of the reputation of the earlier mark.

The CJ also held that the GC's judgment was devoid of an assessment of the reputation and distinctive character of the earlier mark in relation to "financial affairs", "monetary affairs" and "banking". It was not sufficient for the GC to have reached this conclusion merely on the basis of the importance and reputation of the earlier mark in the French payment system and in the routing of bank card transactions in France. The CJ held that that defect vitiated the overall assessment of the existence of a likelihood of confusion made by the GC and the decision of the BoA was annulled.

Online marketplace services

Wallapop, SL v EUIPO, Unipreus, SL (Opinion of AG Hogan; C-763/18 P; 25 June 2020)

In an appeal from the decision of the GC, AG Hogan in his opinion stated that online trading services relating to the operation of an online marketplace are similar to, and should be included in the notion of, retail services. Bryony Gold reports.

Background

Wallapop was an online marketplace operating via a web page and mobile application which allowed users to buy and sell items online. Unipreus is a Spanish retailer of footwear.

Wallapop applied for a figurative EU trade mark registration containing the word 'wallapop' in respect of 'online trading, namely operation of online markets for buyers and sellers of goods and services', 'providing evaluative feedback and ratings', 'providing a searchable online evaluation database' and providing related business information in class 35.



Unipreus opposed the registration on the basis of its earlier figurative Spanish trade mark which included the verbal element 'wala w' in respect of 'retailing of sporting articles' in class 35.



Unipreus was unsuccessful before the Opposition Division and on appeal to the BoA. However, the GC upheld an action for annulment of the contested decision pursuant to article 8(1)(b) of the Regulation, finding that the BoA had erroneously considered that the services at issue were not in competition with one another. Wallapop appealed.

Are online trading services relating to the operation of an online marketplace different or similar to retailing services?

The AG concluded that the GC had been right to find that the services were, at the very least, similar to a low degree.

As regards the similarity of the distribution channels of the marks, the AG applied *Tulliallan Burlington Ltd v EUIPO* (Cases C-155/18 P to C-158/18), in which it was held that services of conventional shopping arcades which were 'aimed at the consumer with a view to enabling him or her to conveniently view and purchase those goods, for the benefit of the businesses occupying the arcade concerned' in principle, came within the class 35 definition of retail services. The AG considered that retail intermediation services offered online (such as those provided by Wallapop) were analogous, as a retail online platform was, in effect, a form of 'virtual' shopping arcade. In light of changes to customer behaviour, there was no distinction between physical and online sales of goods to customers; both came within the definition of retail services. As such, a finding of dissimilarity could not be based on the online nature of intermediation services. The AG was also persuaded, as was the GC, by the fact that Unipreus' website sold the same footwear as was sold on the Wallapop platform. Consequently, Wallapop's online platform and Unipreus' retail website were similar channels of distribution.

In respect of the nature of the services in question, the AG rejected the submission that the services were dissimilar because 'online trading' only related to intermediation services relating to management of the online platform, including provision of business information, and no sales were made by Wallapop itself. Such services and provision of information ultimately had the objective of inducing the sale of goods to consumers (even if any eventual sales were made through third parties), so the nature of the services was similar, to a low degree.

The AG also found that the intended purposes and public perceptions of the online trading services at issue did not take them outside of retail services. Providing evaluative feedback and ratings of sellers' goods was no more than the provision of useful commercial information associated with the sale of the products themselves, which did not differ from what could have been provided by traditional shopping arcade owners.

Finally, the fact that purchasing goods through Wallapop's online platform could be substituted with purchasing the same goods in Unipreus' physical or online store meant that the services were in competition.

Mobile apps

PlanetArt LLC & Anr v Photobox Ltd & Anr* (Mr Daniel Alexander QC sitting as a Deputy Judge of the Chancery Division; [2020] EWHC 713 (Ch); 25 March 2020)

In this case heard under the Shorter Trial Scheme, the Deputy Judge held that the use by Photobox of its Photobox Free Prints app icon infringed PlanetArt's trade mark pursuant to sections 10(2) and 10(3). However, PlanetArt was unsuccessful in its claims for passing off and invalidity of Photobox's trade mark registration for PHOTOBOX FREE PRINTS. Hilary Atherton reports.

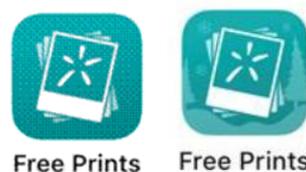
Background

PlanetArt launched an app in the UK in 2014 which provided access to a dedicated mobile phone-based photo printing service (the "FreePrints App"). Once the app was downloaded to a customer's phone or tablet from one of the well-known app stores, they could place orders to have photos on their phone or tablet printed for free, paying only delivery charges. Once the app was downloaded, the following icon (the "FreePrints Icon") appeared on a customer's screen:



PlanetArt owned a registered UK trade mark for the FreePrints Icon which encompassed both downloadable and mobile app software goods in class 9 and photographic printing services in class 40. PlanetArt had developed a range of apps which were spin offs from the FreePrints App, including "FreePrints Photobooks" and "FreePrints Cards". They shared elements of common branding although differed in primary colouring and designs for the app logos. PlanetArt's FreePrints business was highly successful and was the market leader in the UK.

In early 2019, Photobox launched the app complained of (the "Photobox Free Prints App"). It provided a similar service to the FreePrints App and in a similar way. Its associated icon is shown below on the left. A seasonal more 'Christmassy' icon with a fir tree and snowflakes in the background was used in December 2019, shown below on the right (together, the "Photobox Free Prints Icon"):



Section 10(2)

Having regard to the reputation attaching to the FreePrints Icon and the identity of the goods and services, the Deputy Judge found that the significant similarities in aural and visual elements of the signs (as well as some more limited conceptual similarities) were sufficient to give rise to a likelihood of confusion. The evidence showed that, in the case of photo printing apps, invariably the words which appeared below the app's logo were a brand rather than descriptive of the service in question. Therefore, the average consumer was likely to expect the term beneath the logo to have trade mark significance. The Deputy Judge was not persuaded that the Photobox 'starburst' logo was so readily recognised by the average consumer that it would be sufficient to dispel confusion in all the circumstances. Having considered whether there was anything about the context of presentation of the marks which negated that result, he concluded there was not. Although there was no evidence of actual confusion and the Deputy Judge thought it possible that there was very limited scope for actual operative confusion to occur, he noted that section 10(2) does not require there to be actual confusion or for use of the mark to cause a consumer to purchase the goods in question.

Section 10(3)

The Deputy Judge went on to find that the Photobox Free Prints Icon infringed PlanetArt's registered mark under section 10(3). For the reasons set out above, he concluded that the average consumer would make the requisite link and that the Photobox Free Prints Icon would benefit from the reputation and goodwill of the FreePrints Icon. The Deputy Judge stressed that this was as a result of Photobox's use of a specific combination of features, and not merely due to their use of the descriptive term 'Free Prints'.

Other signs used by Photobox

Other signs used by Photobox were found not to infringe, mainly on account of the prominent presence in those signs of the word 'Photobox'.

Defence pursuant to Section 11

Photobox's pleaded defence was found not to have any effect. When combined with 'Photobox' their use of the term 'Free Prints' was not infringing in any event, and insofar as it was not (such as in the Photobox Free Prints Icon), it was not merely descriptive and would in any event not be in accordance with honest commercial practices.

Passing Off

Planet Art's passing off claim failed because there was found to be no misrepresentation. Photobox either: (i) used PHOTOBOX branding sufficiently clearly and it was sufficiently clear that the term 'Free Prints' was used to describe the nature of the goods and services rather than their origin; or (ii) in the case of the Photobox Free Prints Icon, the absence of any evidence of actual confusion supported a finding that the circumstances of trade, taken as a whole, should not lead to customer deception.

Invalidity of Photobox's trade mark

PlanetArt applied for a declaration of invalidity of Photobox's UK trade mark registration for the word PHOTOBOX FREE PRINTS on the grounds that: (i) it was applied for in bad faith, and (ii) its use was liable to be prevented under the law of passing off. However, the Deputy Judge dismissed the application to declare the mark invalid on either ground.

Pleading article 10 of the Regulation correctly

Manchester United Football Club Ltd ("MUFC") v SEGA Publishing Europe Ltd & Anr* **(Morgan J; [2020] EWHC 1439 (Ch); 4 June 2020)**

Manchester United sought to amend its Particulars of Claim to add a new claim under Article 10. The Judge refused permission, highlighting the importance of pleading to the correct legislative provisions. Mark Day reports.

MUFC is the registered proprietor of EU trade mark registrations for the word mark MANCHESTER UNITED (the "Word Mark") and the figurative mark representing the club crest (the "Crest Mark") shown below, both registered in respect of, *inter alia*, "computer software" and "pre-recorded games on...software...".



Sports Interactive developed and SEGA Publishing published a series of football management simulation games called "Football Manager".

In 2018, MUFC issued a claim for trade mark infringement and passing off relating to the use of the Word Mark in Football Manager. Although Football Manager, as originally published, did not directly involve the use of the Crest Mark, MUFC also alleged infringement contrary to article 9(2)(a) of the Regulation.

The application

Football Manager was programmed in such a way that did not prevent the use of certain software "patches", provided by third-parties, which allowed gamers to associate graphics with the teams in the game. One such patch provider, *fmscout.com*, stated on its website that it was an 'OFFICIAL SEGA PARTNER' and patch providers, including FMScout, were promoted as 'Approved Digital Partners' by the Defendants on their websites.

MUFC sought to amend their claim to allege that (i) the provision of patches by third parties was contrary to article 10; and (ii) that the Defendants and at least one of the official patch partners had been acting in common design in relation to the patch provider's acts that fell within article 10.

The decision

The Judge noted the requirement in article 10 that a risk existed that the packaging or other means to which the identical/similar sign is affixed could be used in relation to goods/services and such use would constitute an infringement under article 9(2) or (3).

MUFC explained that the Crest Mark was affixed to the modification software provided by FMScout and that this modification software came within "any other means" in article 10. MUFC submitted that it did not matter whether there had in fact been an infringement within article 9 because article 10 merely referred to the risk of such an infringement. The Judge did not accept this submission. The new claim did not allege that the action by FMScout involved a risk that the downstream use of the modified software would constitute an infringement within article 9 since it was use by a gamer who was not using it in the course of trade.

Secondly, MUFC submitted that some gamers generated revenue through advertising, and thus operated in the course of trade. As this had not been pleaded, it did not advance MUFC's application. In any event, as the Defendants pointed out, use in relation to competitive gaming or soliciting advertising would not fall within the goods for which the Crest Mark was registered.

The third submission was that a private consumer or gamer who acquired the modification software from FMScout and applied it to Football Manager was committing an act which was intended, encouraged or facilitated by FMScout as part of a common design with the Defendants. As such, it was submitted that the individual user was acting as "the instrument" of the Defendants and FMScout, and the Defendants and FMScout were acting in the course of trade. As this had not been pleaded, it did not advance MUFC's application. As a result, the application to amend to bring in the new claim was refused and any further application to amend would be dealt with in the normal way.

Issue estoppel following tribunal invalidity proceedings

Ian Thomas v (1) Luv One Luv all Promotions Ltd (2) Winston Thomas (Judge Clarke sitting as a Judge of the High Court; [2020] EWHC 1565 (IPEC); 17 June 2020)

Following successful opposition and invalidity actions before the UKIPO relating to marks consisting of a band's names, Judge Clarke held that various claims and counterclaims relating to use of the same names were estopped on the basis of issue estoppel. Charlotte Peacock reports.

Background

Love Injection / Luv Injection was a band which formed in 1986 and continued until there was a split between members of the band in 2016. Following the split, the Claimant, Mr Ian Thomas, continued to perform, along with others, under the name Love Injection / Luv Injection. The Second Defendant, Mr Ian Thomas' half brother, Mr Winston Thomas, started to perform, along with others including former members of the band, under the name Luv Injection Sound. Both the Claimant and the Second Defendant claimed that they were performing as the original band, and that the other was performing as a new band.

In 2017 the Second Defendant applied to register the marks LOVE INJECTION SOUND and LUV INJECTION SOUND in the UK. The Claimant subsequently filed opposition and invalidity proceedings (respectively) against the marks, in both cases relying on bad faith and passing off.

The UKIPO decision

The Hearing Officer found that the Second Defendant's application and registration had both been filed in bad faith and contrary to the law of passing off. The Hearing Officer also found that the band had operated as a partnership at will and that the goodwill in the name Love Injection / Luv Injection was held as an asset of the partnership. The Hearing Officer left the issue of what happened to the goodwill following the split between the members of the band undetermined.

The Second Defendant did not appeal the decision but continued to use the marks LOVE INJECTION and LUV INJECTION.

The strike out application

The Claimant claimed passing off by the Defendants of the marks LOVE INJECTION, LOVE INJECTION SOUND, LUV INJECTION and LUV INJECTION SOUND. The Second Defendant's defence was that he was the owner of the goodwill in the band names. The Claimant contested that the Second Defendant was precluded from raising this point due to cause of action estoppel, issue estoppel and abuse of process, on the basis that it had already been raised and decided by the Hearing Officer.

Judge Clarke found that there was no cause of action estoppel arising from the opposition proceedings as, following *Special Effects Ltd v L'Oréal SA* [2007] EWCA Civ 1, the Second Defendant did not have a "cause of action" at the opposition proceedings stage.

Judge Clarke accepted the Defendants' submission that the cause of action in the invalidity proceedings, namely whether the registration was invalid in light of the Claimant's right to prevent use of the registration by virtue of the law of passing off, was not identical to the Claimant's present claim of passing off arising from the Second Defendant's use of the marks.

However, although in the invalidity proceedings passing off was not the cause of action but the issue, this led Judge Clarke to the conclusion that there was issue estoppel. The Judge confirmed that the issue estoppel arising from the invalidity proceedings estopped both the Claimant and the Second Defendant from denying the findings of the Hearing Officer, and that to do so would amount to abuse of process.

In particular, Judge Clarke noted that the matters were fully litigated before the Hearing Officer in a day-long hearing which included four witnesses on each side and the opportunity for the parties to cross-examine each witness. The Judge confirmed that there should be finality in litigation, both for the parties and for the court.

Summary judgment application

In 2017 the Second Defendant had filed a further UK trade mark for LOVE INJECTION SOUND that went unnoticed by the Claimant at the time. Judge Clarke accepted the Claimant's submission that the Hearing Officer had found that the Second Defendant was precluded by the law of passing off from using the sign LOVE INJECTION SOUND in respect of the same goods covered by the present UK registration, and gave summary judgment finding that the registration should be cancelled.

Judge Clarke confirmed that the case will continue in respect of various other of the Claimant's claims, including the determination of who the goodwill in the band names belonged to after the split.

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

Editorial team

Katharine Stephens

Partner, IP

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



Aaron Hetherington

Trainee Trademark Attorney

Tel: +442074156183
aaron.hetherington@twobirds.com



Ciara Hughes

Trainee Trademark Attorney

Tel: +442074156193
ciara.hughes@twobirds.com



Reporters

Louise O'Hara; Lauren Kourie; Lucy Wiles; Adeena wells; Robert Rose; Theo Cooper; Hilary Atherton; Bryony Gold; Mark Day; Charlotte Peacock.

This report was first published in the CIPA Journal, August 2020