

# Bird & Bird & IP Case Reports

January 2018



# Trade mark decisions

## Decisions of the General Court

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC <b>T-815/16</b> <i>For Tune sp. z o.o. v EUIPO; Simplicity trade GmbH</i></p> <p>(12.12.17) Reg 207/2009</p> <p><b>Reported by:</b> Emma Green</p>	 <ul style="list-style-type: none"> <li>- paper, cardboard and goods made from these materials, not included in other classes, printed matter; book-binding material, photographs, plastic materials for packaging (16)</li> <li>- advertising; business management; business administration; office functions (35)</li> <li>- education; providing of training; entertainment; sporting and cultural activities (41)</li> </ul> <p><b>OPUS</b></p> <ul style="list-style-type: none"> <li>- goods made from paper and cardboard (16)</li> <li>- advertising; business management services; business administration; office functions; organization of fairs and exhibitions for commercial or advertising purposes; business management and organisation consultancy... (35)</li> <li>- providing of training, entertainment; presentation of live performances, arranging and conducting of seminars, arranging and conducting of workshops (training)...(41)</li> </ul>	<p>The GC upheld the BoA's finding of a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA had been correct to find that the level of attention of the relevant consumer varied across the goods and services at issue. There was no requirement for them to assess likelihood of confusion in relation to each specific class in light of the particular characteristics of the relevant consumer for that range of goods or services; it was sufficient to conclude that the level of attention could vary from average to high and that the relevant public consisted of general public and consumers with specific knowledge.</p> <p>The identity and similarity of the goods and services was not disputed. The BoA was correct to find that the marks were visually, phonetically and conceptually similar. The word 'opus' was the dominant element in the mark applied for; the existence of both the graphic element and the additional word 'aeternatum' played a subordinate role, due to their position and size and, in relation to the word 'aeternatum', its difficult pronunciation.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-700/16 <i>Laboratorios Ern, SA v EUIPO; Ascendo Medienagentur AG</i>  (13.12.17) Reg 207/2009  <b>Reported by:</b> Emma Green	 <ul style="list-style-type: none"> <li>- dietary supplements and dietetic preparations Dietary supplements and dietetic preparations; Hygienic preparations and articles; Medical and veterinary preparations and articles' (5)</li> </ul> <p><b>DYNAMIN</b></p> <ul style="list-style-type: none"> <li>- dietetic foods adapted for medical use in any shape or form (5) (Spanish mark)</li> </ul>	<p>The GC upheld the BoA's finding that there was no likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA was correct to identify that the relevant Spanish professionals and general public had a high level of attention in relation to the goods for medical use which directly affected the health of the user, and as average or normal in relation to goods which did not have the same immediate impact on health.</p> <p>The GC endorsed the BoA's conclusion that 'dietetic foods adapted for medical use in any shape or form' were different from 'hygienic preparations and articles' – similarity could not be established merely because both were sold in pharmacies and may be used to have an impact on health. However, 'dietetic foods adapted for medical use in any shape or form' were similar to 'dietary supplements and medical and veterinary preparations and articles' covered by the mark applied for.</p> <p>'DYNAMICS', the dominant element of the mark applied for, differed from the earlier mark in the final letters 'CS' which afforded the marks low visual similarity. The BoA had erred in finding that the signs were not conceptually similar, as the relevant Spanish public may understand both marks to evoke the idea of 'dynamism'. Nevertheless, the BoA had concluded that the similarity of the mark was no more than low to average. The decision that there was no likelihood of confusion was upheld.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-792/16 <i>N &amp; C Franchise Ltd v EUIPO; Eschenbach Optik GmbH</i>  (14.12.17) Reg 207/2009  <b>Reported by:</b> Rebekah Sellars	 <ul style="list-style-type: none"> <li>- sunglasses; sunglasses frames; clip-on sunglasses; frames for sunglasses; lenses for sunglasses; straps for sunglasses; cases for sunglasses; chains for sunglasses; frames for spectacles and sunglasses; optical lenses for use with sunglasses; eye glasses; spectacles [glasses]; children's eye glasses (9)</li> <li>- cloths for eye-glasses; wiping cloth for wiping eye glasses (21)</li> <li>- repair of sunglasses (37)</li> </ul> <p><b>OIO</b></p> <ul style="list-style-type: none"> <li>- spectacles, spectacle frames, optical apparatus and instruments (9)</li> </ul> <p>(International registration designating the EU)</p>	<p>The GC upheld the BoA's finding of a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA was correct to find that there was a higher than average degree of visual similarity given both marks contained almost identical word elements. The figurative element of the mark applied for was not more distinctive or dominant than the word element, which had a greater impact on the consumer.</p> <p>The marks were also phonetically similar as the words 'ojo' and 'oio' would be pronounced the same in Slovenian.</p> <p>Therefore given the identity or similarity of the goods covered by the marks and the higher than average level of attention of the relevant public, there was a likelihood of confusion between the marks.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p><b>T-912/16</b></p> <p><i>RRTec sp. z o.o. v EUIPO; Mobotec AB</i></p> <p>(14.12.17)</p> <p>Reg 207/2009</p> <p><b>Reported by:</b> Rebekah Sellars</p>	 <p>– various goods and services in Classes 4, 7, 9, 11, 37, 39, 40 and 42</p> <p><b>ROFA</b></p> <p>– various goods and services in Classes 11, 37 and 42</p>	<p>The GC upheld the BoA's finding of a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA was correct to find a high degree of visual similarity between the marks. The differences between the marks (being extra 'r', the blue colour and the 'rr' in bold in the mark applied for) were insufficient to eliminate the strong visual similarity.</p> <p>The BoA was also correct to hold that the marks were phonetically identical for at least a significant part of the relevant public who were unlikely to pronounce the marks differently due to the additional 'r' in the mark applied for.</p> <p>A conceptual comparison was irrelevant given the words 'rrofa' and 'rofa' were devoid of any meaning.</p> <p>Therefore given the identity or high similarity of the goods and services covered by the marks and the average distinctive character of the earlier mark, the BoA was entitled to find a likelihood of confusion between the marks.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-304/16</p> <p><i>Bet365 Group v EUIPO; Robert Hansen</i></p> <p>(14.12.17)</p> <p>Reg 207/2009</p> <p><b>Reported by:</b> Rebekah Sellars</p>	<p><b>BET 365</b></p> <p>– various goods and services in Classes 9, 28, 35, 36, 38, 41 and 42</p>	<p>The GC partially annulled the BoA's decision that the mark was descriptive under Art 7(1)(c) and had not acquired distinctiveness through use.</p> <p>In its assessment of acquisition of distinctive character, the BoA erred in law by not taking into account evidence showing use of the mark including in combination with several word elements, as part of figurative marks, as a domain name, as the name of a website and as a company name. The BoA also wrongly disregarded certain evidence including press articles, turnovers, stake figures and advertising investment.</p> <p>Therefore the BoA had not sufficiently substantiated its decision which the GC annulled in relation to gambling and betting services in Class 41 but dismissed the action in relation the remaining goods and services.</p>

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