




## TRADE MARKS

## Decisions of the CJ

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>CJ <b>C-285/13</b> <i>Bimbo SA v OHIM;</i> <i>Café do Brasil SpA</i> (12.06.14)</p>	 <p>- flour confectionery, ices, yeast, baking-powder (30)</p> <p><b>BIMBO</b></p> <p>- cereals, milling industry, baking, pastry and starch (30)</p> <p>(unregistered well known Spanish mark)</p>	<p>The CJ dismissed as inadmissible Bimbo's appeal from the GC's decision to reject the opposition under <b>Arts 8(1)(b)</b> and <b>8(2)(c)</b> (reported in <i>CIPA Journal</i>, April 2013).</p> <p>Bimbo's submission that the BoA had failed to take into account the existence of an earlier Spanish registered mark, was rejected because this was a new argument which could not be raised at this stage. Similarly, other submissions were rejected because they were not put before the GC or BoA.</p> <p>Bimbo's submission that the GC erred in its assessment of the goods and services at issue was rejected because factual assessments of the GC are not usually subject to a review by the CJ.</p>
<p>CJ <b>C-448/13</b> <i>Delphi Technologies, Inc. v OHIM</i> (12.06.14)</p>	<p><b>INNOVATION FOR THE REAL WORLD</b></p> <p>- motor vehicle fuel management, ignition and control systems (7)</p> <p>- GPS navigation systems, radios, audio and sound systems (9)</p> <p>- medical apparatus and instruments for vital signs monitoring, controlling infusions, and for improvement of the respiratory function (10)</p> <p>- motor vehicle braking, suspension, steering systems and components, air bags, seat belts, shock absorbers and drive units (12)</p>	<p>The CJ dismissed the appeal from the GC's decision to refuse registration, finding a lack of distinctive character pursuant to <b>Art 7(1)(b)</b> and <b>Art 7(2)</b> (reported in <i>CIPA Journal</i>, July 2013).</p> <p>Delphi criticised the GC for finding the relevant public to be the general public, but did not cite an error of law. It did not allege that facts or evidence were distorted and merely sought a new assessment of facts, which was manifestly precluded under appeal.</p> <p>Likewise, in its submissions that the mark had distinctive character in the same way as the CJ found in <i>Audi C-398/08</i> (reported in <i>CIPA Journal</i>, February 2010), the CJ found that Delphi had misread the GC's judgment and the case law cited in it. There was no indication as to how the GC had erred in law.</p>
<p>CJ <b>C-670/13 P</b></p>	<p><b>BOOMERANG</b></p> <p>- cable and television</p>	<p>The CJ dismissed the appeal from the GC's decision (reported in <i>CIPA Journal</i>, November 2013) in its</p>

<p><i>The Cartoon Network Inc., v OHIM; Boomerang TV SA</i> (19.06.14)</p>	<p>broadcasting services, broadcasting programmes directed to children and young adults (38)</p> <p>- cable and television entertainment programmes directed to children and young adults (41)</p>  <p>- cinema and recording studios, hire of videos, competitions (recreation), installation of televisions and radios, production of films (41)</p>	<p>entirety, and upheld the opposition due to a likelihood of confusion between the marks under <b>Art 8(1)(b)</b>.</p> <p>The GC provided a proper statement of reasons to support its determination that the common relevant public for the two marks at issue for the purposes of assessing a likelihood of confusion consisted of professionals. The GC did not err in holding that children and young adults were not part of the relevant public. Film production services of the earlier mark were intended solely for professionals in the audio visual sector.</p>
<p>CJ <b>C-675/13</b> <i>Zoo Sport Ltd v OHIM; K-2 Corp</i> (15.07.14)</p>	<p><b>zoo sport</b></p> <p>- clothing, maillots, footwear, sports shoes (25)</p>  <p>- clothing, footwear, headgear (25)</p> <p>- retailing of sports clothing and equipment (35)</p> <p>- sport sponsorship (36)</p> <p>- providing information on sports competitions/events via the internet (41)</p>	<p>The CJ upheld the GC's decision that there was a likelihood of confusion under <b>Art 8(1)(b)</b> between the marks (reported in <i>CIPA Journal</i>, November 2013).</p> <p>The CJ rejected as inadmissible Zoo Sport's submission that the GC incorrectly defined the relevant public. An appeal had to indicate precisely the contested elements of the judgment which the appellant sought to have set aside as well as the legal arguments advanced in support of the appeal. Zoo Sport had not indicated how the GC had erred in law, but had merely reproduced its submissions to the GC.</p> <p>Zoo Sport's submission that the GC erred in law by finding that the dissimilarity of the marks was not sufficient for there to be no likelihood of confusion was also inadmissible. The GC had exclusive jurisdiction to find and appraise the relevant facts and evidence save where they were obviously distorted.</p>
<p>CJ <b>C-468/13</b> <i>MOL Magyar Olaj-és Gázipari Nyrt v OHIM; Banco Bilbao Vizcaya Argentaria SA</i> (17.07.14)</p>	<p><b>MOL BLUE CARD</b></p> <p>- purchase and transaction management (35)</p> <p>- services regarding credit cards, debit cards, processing of payments (36)</p> <p><b>BLUE</b></p>	<p>The CJ dismissed MOL's appeal, upholding the GC's decision that there was a likelihood of confusion between the marks under <b>Art 8(1)(b)</b> (reported in <i>CIPA Journal</i>, August 2013).</p> <p>The GC had not wrongly or inappropriately declared as inadmissible MOL's general</p>

	<p><b>BLUE BBVA</b>  <b>TARJETA BLUE BBVA</b>  - various business and financial services in Classes 35 &amp; 36.</p>	<p>submissions in its application initiating proceedings. MOL had failed to identify either the specific points of its application which it wished to supplement by the general reference made by it, or the annexes in which those submissions were set out. A general reference to other documents didn't make up for the absence of essential arguments in law which must appear in the application.</p> <p>The GC had been correct to find that the evidence included in the application was inadmissible in so far as it was presented for the first time before it.</p> <p>The GC had correctly assessed the similarity of the services in issue, and the visual, phonetic and conceptual similarity of the marks, so as to find a likelihood of confusion.</p>
<p>CJ  <b>C-490/13</b>  <i>Cytochroma Development, Inc. v OHIM</i>  (17.07.14)</p>	<p><b>ALPHAREN</b>  - pharmaceutical and veterinary preparations containing magnesium iron hydroxy carbonate or hydrotalcite for use in renal dialysis (5)  <b>ALPHA D3</b>  - pharmaceutical preparation for regulating calcium (5)  (Hungarian, Lithuanian and Latvian marks)</p>	<p>The CJ dismissed the appeal from the GC's judgment annulling the earlier decision of the BoA (reported in <i>CIPA Journal</i>, August 2013) on the basis that Cytochroma had not challenged the operative part of the GC's decision in accordance with <b>Art 169(1)</b> of the <b>Rules of Procedure of the Court of Justice</b>.</p> <p>The annulment of the BoA's decision was the operative part of the GC's judgment. An appeal to the CJ could therefore only seek to challenge that annulment. Cytochroma sought to challenge certain reasons for the annulment given in the GC's judgment, but not the annulment itself, meaning its appeal was manifestly inadmissible.</p>

### High Court finds clothing sub-brand infringes figurative PINK marks

***Thomas Pink Ltd v Victoria's Secret UK Ltd\** (Birss J; [2014] EWHC 2631 (Ch); 31.07.14)**

**Birss J** held that the use of the word PINK by Victoria's Secret on its clothing and as the name of its retail outlets infringed Thomas Pink's figurative UK and Community marks.

Thomas Pink sold formal shirts and a range of other clothing and accessories under figurative UK and Community marks for the word PINK (shown below). The Community mark was registered in, among others, Class 25 for 'Clothing, footwear, headgear' and in Class 35 for retail services. The UK mark was registered in Class 25 for, *inter alia*, specific items of clothing in Class 25.

PINK  
THOMAS PINK  
JERMYN STREET LONDON



In 2004 the Victoria's Secret group launched a clothing sub-brand in the USA called PINK aimed at the "college girl", i.e. females aged between around 18-25. In 2012, Victoria's Secret began opening retail outlets in the UK. Some outlets were branded VICTORIA'S SECRET whilst others were branded PINK. The PINK outlets sold a variety of casual clothing marked with the word PINK, sometimes prominently. All of the products were also marked with the words VICTORIA'S SECRET, although, in some cases, this was only visible on neck labels and swing tags. Examples of the exterior fascia, casual clothing and swing tag are shown below:



### Infringement

**Birss J** found that the use of PINK by Victoria's Secret was similar, or very similar to Thomas Pink's marks. He went on to find there was a likelihood of confusion under **Article 9(1)(b)** and **Section 10(2)** in relation to products emblazoned with the word PINK and the use of PINK on the shop fascia of the PINK stores. In reaching his conclusion **Birss J** commented that, whilst evidence from 13 of Thomas Pink's staff did not provide positive evidence of actual confusion, it was enough to prevent Victoria's Secret from contending that there was no evidence of actual confusion in the UK or the EU. However, **Birss J** held that there was no likelihood of confusion in relation to the use of PINK on swing tags and neck labels for clothing or on a Facebook page as, in this context, PINK was always used in combination with the words VICTORIA'S SECRET. In each of these cases there was sufficient emphasis on VICTORIA'S SECRET to counteract a likelihood of confusion.

**Birss J** went on to find infringement under **Article 9(1)(c)** and **Section 10(3)**. This infringement included the cases where he had not found a likelihood of confusion (i.e. use on swing tags and neck labels). Whilst the average consumer familiar with Thomas Pink's reputation would be older than those targeted by Victoria's Secret with its PINK range, that average consumer would still encounter goods in the PINK range, either when purchasing for themselves or as gifts for others. **Birss J** held that the average consumer would perceive a link between the marks and Victoria's Secret's use of PINK and that the use would cause detriment to repute and the distinctive character of Thomas Pink's marks. Detriment to repute would be caused by associating the marks with a brand with a sexy, mass market appeal, thereby reducing their luxurious reputation and leading to a change in the economic behaviour of Thomas Pink's customers. The Judge also found that there would be detriment to the distinctive character of the marks and a real risk that this would lead to a change in the economic behaviour of consumers.

**Birss J** held that the use of PINK by Victoria's Secret was without due cause as, distinguishing *Leidseplein Beheer v Red Bull* (**Case C-65/12**, reported in *CIPA Journal*, March 2014), Victoria's Secret was unable to rely on its earlier use of PINK in the USA as due cause for its current use.

### Validity

Despite its figurative nature, the UK mark was not inherently distinctive and was descriptive of a characteristic of clothing, i.e. its colour. However, Thomas Pink's extensive use of PINK had been sufficient for the UK mark to acquire a distinctive character. **Birss J** held that the mark had acquired a distinctive character despite the fact it had not been used precisely in the form it was registered.

Victoria's Secret's claim for partial revocation of the Community mark also failed. The mark had been used in relation to a sufficiently wide range of kinds and styles of items to justify the term 'clothing' as a fair description of the goods in Class 25 for which the mark had been used. However, the use of the mark in relation to wellington boots was not sufficient to support a registration for 'footwear'. A fair specification in that case was 'wellington boots'.

## **PASSING OFF**

### **Inquiry as to damages**

#### ***Colin Lindridge Harman v Henry John Burge\** (Judge Hacon; [2014] EWHC 2836 (IPEC); 29.07.14)**

In an inquiry as to damages following judgment for Mr Harman in respect of allegations of passing off and unlawful interference, **Judge Hacon** awarded Mr Harman £39,701 in damages and interest.

Mr Burge owned "Cloud Farm" and ran a holiday business (Doone Valley Holidays ("DVH")) from there until 2003 when the business was sold to Mr Harman along with a 7 year lease to Cloud Farm. One of the assets purchased was a website with the domain name 'www.doonevalleyholidays.co.uk' (the "Website"). Though given no attention at the time, Mr Burge remained registrant of the Website. In his 7 years at Cloud Farm, Mr Harman made considerable financial investment in DVH, including the expansion and improved sophistication of the Website which played an important role in the growth of the business. After 7 years, Mr Harman took steps to inform his customers that he would be leaving Cloud Farm. However, Mr Burge took control of the Website so that none of the former content could be accessed, and published the following notice: "Doone Valley Holidays. Announcement. Doone Valley Holiday ay Cloud Farm Look forward to seeing you in 2010", thus implying that the DVH business would continue at Cloud Farm. The announcement went on to say that Mr Harman would be moving to new premises which "will only have limited facilities and availability for this season..." Mr Burges transferred the Website back to Mr Harman 2 weeks later, after proceedings were issued. In 2012, **Judge Birss** gave judgment for Mr Harman on admissions.

The damages claim fell into the following 3 categories:

#### Loss of Profits

Mr Harman's expert witness calculated his loss of profit to be £98,442 before interest. **Judge Hacon** commented that this was the type of case in which it was necessary to consider a counterfactual history of events in which the Website was not disrupted by Mr Burge, assessing the net profits that the DVH business would have made, and then subtracting the net profits that were actually made in the same relevant period. Although the Judge held that Mr Burge's control of the Website for 2 weeks must have caused some short-term harm, Mr Harman had not produced direct evidence that the disruption had any long-term effect. The Judge was of the view that Mr Harman should have produced at least comparative Google searches and website analyses showing how the ranking and profile of the Website had altered during the relevant period. The Judge found that he had instead sought to assess loss of profit by inference.

### Losses from cancelled listing and advertising

As there were no invoices to support the sum claimed, no damages were awarded in respect of links to the Website rerouted to Mr Burge's 'Announcement' page so that listings and advertisements paid for by Mr Harman had to be cancelled.

### Cost of mitigation

A total amount of £9,490 was awarded to Mr Harman in respect of the cost of new links to directories and listing sites, the costs of a Google AdWords campaign to recover the profile of the Website, and fees paid for carrying out this work.

The total sum awarded to Mr Harman was £39,701.

### **Katharine Stephens, Zoe Fuller and Hilary Atherton**

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The reported cases marked \* can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at [http://curia.europa.eu/jcms/jcms/j\\_6/home](http://curia.europa.eu/jcms/jcms/j_6/home)