









## TRADE MARKS



## Decisions of the GC and CJ

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC <b>T-824/14</b> <i>Eveready Battery Company, Inc. v EUIPO; Imran Hussain and Ots</i> (18.10.16) Reg 207/2009</p>	 <p>- bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices (3)</p> <p>- hand tools and implements (hand-operated); cutlery; side arms; razors (8)</p> <p><b>EDGE</b></p> <p>- bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices (3)</p>	<p>The GC held that genuine use of the earlier mark had not been demonstrated as required under Arts 15(1) and 15(2).</p> <p>The BoA found the evidence filed, namely a sworn statement, six invoices and clippings and pictures of labels and displays relating to EDGE shaving gels, was insufficient to prove genuine use of the earlier mark between July 2005 to July 2010.</p> <p>The GC endorsed the BoA's assessment of the evidence: (1) The statement merely gave approximations of units sold and did not enable the precise sales volume of goods sold under the earlier mark to be ascertained; (2) the invoices did not show a sufficient duration and frequency of the use of the earlier mark; and (3) the copies of product offerings and images from point of sale did not provide any information regarding the duration or the extent of the use of the mark on the goods at issue.</p> <p>The GC confirmed that a change in the proprietor of the earlier mark was not a proper reason for non-use of the earlier mark and did not remove the requirement for use to be genuine and supported by solid and objective evidence of actual, sufficient use of the mark in the relevant market.</p>
<p>GC <b>T-14/15</b> <i>Lufthansa AirPlus Servicekarten GmbH v EUIPO; SC Mareea Comtur SRL</i> (20.10.16) Reg 207/2009</p>	 <p>- advertising; business management; business administration; office functions (35)</p> <p>- transportation; packaging and storage of goods; travel arrangement (39)</p> <p><b>AIRPLUS INTERNATIONAL</b></p>	<p>The GC partially annulled the BoA's decision that there was a likelihood of confusion pursuant to Art 8(1)(b) in respect of the Class 35 services.</p> <p>The BoA failed to take into account a decision issued in other proceedings before the Opposition Division in which registration of the mark applied for was refused for services in Class 35 on the basis, inter alia, of a likelihood of confusion pursuant to Art 8(1)(b) in</p>

	<ul style="list-style-type: none"> <li>- data processing equipment, computers; computer software (9)</li> <li>- advertising; business management; business administration; office functions (35)</li> <li>- insurance; financial affairs; monetary affairs; real estate affairs (36)</li> <li>- design and development of computer hardware and software (42)</li> </ul>	<p>respect of the following mark:</p>  <p>Before the BoA made its decision, this other decision became final. The BoA therefore should have declared that there was no need to adjudicate and should have freely allocated the costs by analogy with Rule 21(3) of Regulation 2868/95.</p> <p>It was no answer that the applicant did not suffer any damage. Further, it was not for the applicant to mention the other proceedings to the BoA; it was for the UKIPO to inform the parties.</p>
<p>GC <b>T-578/15</b> and <b>T-614/15</b> <i>Azur Space Solar Power GmbH v EUIPO</i> (20.10.16) Reg 207/2009</p>	 <ul style="list-style-type: none"> <li>- electronic generators using solar cells (7)</li> <li>- semiconductor devices for solar cells and solar modules, solar cells made of III-V material, solar cells having a plurality of band gaps; solar cell modules with an array of solar cells (9)</li> </ul>	<p>In both cases, the GC upheld the BoA's decisions that the figurative marks lacked distinctive character pursuant to Art 7(1)(b).</p> <p>The GC confirmed that the more closely the shape of a mark resembled the relevant products, the greater the likelihood that the mark would be devoid of distinctive character pursuant to Art 7(1)(b).</p> <p>The marks applied for would be immediately perceived by the relevant professional public in the EU as a very simple schematic representation of an array of solar panels. The fact that the marks in issue represented merely one variant of a wider variety of structural possibilities was irrelevant.</p> <p>The marks were too simple to attract the attention of the relevant public and did not have any memorable elements which endowed them with distinctive character or made it possible to identify the origin of the relevant goods.</p>
<p>GC <b>T-29/16</b> <b>T-37/16</b> <i>Caffè Nero Group Ltd v EUIPO</i> (27.10.16) Reg 207/2009</p>	<p><b>CAFFÈ NERO</b></p>  <ul style="list-style-type: none"> <li>- coffee and other hot beverages and confectionery (30)</li> <li>- online and retail store</li> </ul>	<p>The GC upheld the BoA's decision refusing the registration of the marks pursuant to Art 7(1)(c).</p> <p>The GC confirmed that the words CAFFÈ and NERO would be understood by the Italian general public as meaning 'black coffee' i.e. coffee without cream, milk or sugar – the mark was evocative of black coffee, even if coffee was not commonly referred to by colour. This meaning would also be commonly</p>

	<p>services connected with coffee and other hot beverages (35)</p>	<p>understood by the general public in other Member States.</p> <p>The BoA was correct to find that the marks were descriptive and that the figurative mark was not distinctive under Art 7(1)(b). Neither the typeface, the positioning or size of the word elements, nor the rectangular frame and background colour were sufficient to make the mark distinctive, whether taken individually or as a whole. Those elements would be common elements in the eyes of any consumer.</p>
<p>GC <b>T-579/15 P</b> <i>For Tune sp. z o.o. v EUIPO; Gastwerk Hotel Hamburg GmbH &amp; Co. KG</i> (08.11.16) Reg 207/2009</p>	<p> <b>fortune</b><sup>®</sup></p> <p>- advertising; business management; business administration; office functions and other services in this class (35)</p> <p>- education; providing of training; entertainment; sporting and cultural activities and all other services in this class (41)</p> <p><b>FORTUNE-HOTELS</b></p> <p>- advertising; business management; business administration; office work; market research; hosting of exhibitions (35)</p> <p>- entertainment; conducting of tutorials; meetings and continuing education courses (41)</p> <p>(German mark)</p>	<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 relevant German public had an average degree of attention for such services. The services at issue were in part identical and in part similar and had an average visual similarity. Both signs contained the word element FORTUNE which would be recognised by the relevant public in the overall impression created by the marks, as the word had entered the German language. FORTUNE was understood by a substantial proportion of the relevant public as signifying 'chance or luck' and would not be broken down into separate words FOR and TUNE.</p> <p>The marks had average phonetic similarity, taking into account the omission of HOTELS from the proposed mark. A certain degree of conceptual similarity could not be ruled out.</p>
<p>CJ <b>C-43/15 P</b> <i>BSH Bosch und Siemens Hausgeräte GmbH v EUIPO; LG Electronics Inc</i> (08.11.16) Reg 207/2009</p>	<p></p> <p><b>compressor technology</b></p> <p>- electrical cleaning machines and apparatus; parts for the above goods (7)</p> <p>- apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water</p>	<p>The CJ upheld the GC's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The CJ confirmed the GC had taken sufficient account of the weak distinctive character of the earlier marks during its global assessment and by concluding that the small differences in the signs were sufficient to avoid a likelihood of confusion. The CJ confirmed that a likelihood of confusion may exist in respect of marks with a weak distinctive</p>

	<p>supply and sanitary purposes (11)</p> <p><b>KOMPRESSOR</b> <b>KOMPRESSOR PLUS</b></p> <p>- electrical washing machines; vacuum cleaners; dishwashers; mixers; power generators (7)</p> <p>- gas ranges; kitchen and microwave ovens; air conditioning, purification and ventilation apparatus; refrigerators; (11)</p> <p>(national registrations)</p>	<p>character, particularly in view of the similarity of the signs and of the goods or services at issue.</p> <p>Distinctive character was one factor in the global assessment of likelihood of confusion, and should not be given such importance that it deprived the degree of similarity between the signs of any significance.</p>
<p>GC</p> <p><b>T-290/15</b></p> <p><i>Smarter Travel Media LLC v EUIPO</i></p> <p>(09.11.16)</p> <p>Reg 207/2009</p>	<p><b>SMARTER  TRAVEL</b></p> <p>- various travel services and online services in classes 35, 38, 39, and 42</p>	<p>The GC upheld the BoA's decision that the mark was descriptive and devoid of any distinctive character pursuant to Art 7(1)(b) and (c) and Art 7(2).</p> <p>The word element SMARTER TRAVEL would be understood by the relevant public as a more intelligent way to journey and was therefore descriptive when viewed in the context of the services. The mark would immediately be understood by consumers to refer to the characteristics and subject matter of those services.</p> <p>The figurative element, a suitcase modified to be reminiscent of a speech bubble, was not sufficient to confer distinctive character on the mark as a whole. Instead, it reinforced the idea of travel conveyed by the word element and was therefore incapable of diminishing the descriptive message of the mark.</p> <p>The GC dismissed the argument that the BoA had erred in its decision as other 'smarter travel' marks had been registered to the applicant. The GC noted that it was not bound by the first instance decisions at the EUIPO - each mark must be subject to a comprehensive and independent examination.</p>

<p>GC  <b>T-67/15</b>  <i>Polo Club v EUIPO; Lifestyle Equities CV</i>  (10.11.16)  Reg 207/2009</p>	 <p>- soaps; perfumes, perfumery; essential oils, cosmetics, hair lotions; dentifrices (3)</p> <p>- training, education, entertainment; arranging and conducting of conferences, colloquiums, workshops, congresses, seminars, competitions; organisation of exhibitions for cultural or educational purposes (41)</p>  <p>- soaps, perfumery, essential oils, cosmetics, lotions, creams, gels, powders, lipsticks, deodorants and antiperspirants (3)</p> <p>- education; providing of training; entertainment; sporting and cultural activities (41)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The Class 3 goods were identical and the Class 41 services were in part similar and in part identical. The GC endorsed the BoA's assessment of similarity on the whole but held that 'arranging and conducting of conferences, colloquiums, workshops, congresses, seminars, competitions' and 'organisation of exhibitions for educational purposes' covered by the mark applied for were identical, and not merely similar, to 'cultural activities', 'education', and 'providing of training' covered by the earlier mark.</p> <p>The image of a polo player and the words 'polo club' had enhanced inherent distinctiveness in relation to the Class 3 goods and normal inherent distinctiveness with regard to the Class 41 services.</p> <p>The BoA was correct to find the marks were visually and phonetically similar to a low degree and conceptually similar to at least an average degree.</p>
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### Keyword advertising

#### **Victoria Plum Ltd v Victorian Plumbing Ltd & Anr\* (Carr J; [2016] EWHC 2911 (Ch); 18.11.16)**

**Carr J** held that the defendant was liable for infringement of the claimant's "Victoria Plum(b)" trade marks by bidding on identical and similar marks as search advertising keywords which resulted in the display of sponsored advertisements which did not enable normally informed and reasonably attentive internet users, or enabled them only with difficulty, to ascertain whether the goods or services referred to by the advertisements originated from the claimant or an undertaking economically connected to it, or on the contrary, originated from a third party. The Judge also allowed the defendant's counterclaim for passing off against the claimant.

Both the claimant and defendant were bathroom retailers. The claimant had operated exclusively online under the names Victoria Plumb and Victoria Plum. The defendant operated primarily online, and each party had been trading since 2001. The claimant claimed infringement by the defendant of a number of its trade marks, including a registration for the word mark VICTORIA PLUMB which was registered for goods in Classes 11 and 20 and services in Class 35 (the

"Victoria Plumb marks"). It alleged that the defendant had infringed its trade marks and committed passing off by bidding on the term "Victoria Plumb" and trivial variations as search advertising keywords, and by displaying adverts on searches of those terms which included: (i) any of the same terms, (ii) "victoria plumbing"/"victoriaplumbing", or "victorian plumbing"/"victorianplumbing".

Applying *Google Franc Sarl v Louis Vuitton Malletier SA* (Case C-236/08), the Judge found that by bidding on the keywords concerned, the defendant had used signs identical to, or immaterially different from, the Victoria Plumb marks. He also found, and it was admitted, that the claimant had established a valuable reputation and goodwill in the name "Victoria Plumb". He went on to find that the keywords bid upon were identical or confusingly similar to Victoria Plumb marks. Given that the relevant services in question (namely the bringing together of bathroom items enabling customers to conveniently view and purchase those goods via a website) were identical, as were the types of goods offered on those websites, and that internet users who searched for the claimant's trade mark were likely to be expecting to find links to the claimant's website, the Judge concluded that confusion was likely and indeed was occurring on a significant scale. This was because the defendant's advertisements did not enable normally informed and reasonably attentive internet users, or enabled them only with difficulty, to ascertain whether the goods or services referred to by the advertisements originated from the claimant or an undertaking economically connected to it, or on the contrary, originated from a third party (*Interflora, Inc. v Marks & Spencer Plc* [2014] EWCA Civ 1403).

#### Honest Concurrent Use defence

The Judge rejected the defendant's defence based on the principle of honest concurrent use. Firstly, while he found that the defence could apply in the case of closely similar marks as well as identical marks and could entitle a defendant to continue to use its own name or mark, it could not entitle the defendant to use the claimant's mark where the two were different. Secondly, the defendant had never used the Victoria Plumb marks other than by bidding on them as keywords, which was the subject of the present complaint. Thirdly, it could not be correct that honest concurrent use could justify the defendant's use of the Victoria Plumb marks because it would then be able to apply to register as trade marks "Victoria Plum" and "Victoria Plumb". Fourthly, the defendants acknowledged that this was not a case where a mark had become a guarantee of origin of two unrelated entities so that it could not be said to be an exclusive guarantee of origin of either – the Victoria Plumb marks indicated the claimant exclusively and not the defendant. In case his conclusion was wrong, the Judge went on to consider the honesty of the defendant's use, concluding that the defendant had taken steps which exacerbated the level of confusion beyond that which was inevitable and which were not consistent with its duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

#### Statutory acquiescence

The Judge also rejected a defence of statutory acquiescence under Section 48 on the basis that: (i) the claimant was objecting to use by the defendant of the Victoria Plumb marks, to which the defendant had no earlier right, and (ii) there was no evidence of any significant trade by the defendant by the time the claimant started trading under "Victoria Plum" in 2001, and it would not therefore have had an earlier right on which to base a passing off claim at that time.

#### Counterclaim for passing off

The defendant complained of the claimant's bidding on the name "Victorian Plumbing" as a keyword so as to cause the return of sponsored links containing the text "Victoria Plum(b)". The Judge found that there was a lower likelihood of confusion amongst users searching for "Victorian Plumbing" than amongst those searching for "Victoria Plum(b)". However, as there was nothing in the claimant's advertisements to indicate the absence of a connection between the parties and a substantial proportion of the relevant public were likely to have been misled into believing such a connection existed, he found that the claimant's actions amounted to passing off.

## COPYRIGHT

### **Copyright Term Directive does not apply to copyright which lapsed under national law before 1 July 1995**

#### ***Montis Design BV v Goossens Meubelen BV* (CJ; Third Chamber; C-169/15; 08.10.16)**

The CJ confirmed that Article 10(2) of Directive 93/98 (the "Copyright Term Directive") must be interpreted such that the terms of protection do not apply to copyright initially protected by national legislation but which was extinguished prior to 1 July 1995. The Copyright Term Directive did not preclude national legislation which had initially granted copyright protection to a work but which caused that copyright to be definitely extinguished before 1 July 1995 by reason of non-compliance with a formal requirement.

Montis owned international model registrations and copyright in the 'Charly' armchair and 'Chaplin' chair. Montis failed to submit the maintenance declaration form as required under Article 21(3) of the Uniform Benelux Law (the "Uniform Law"). As a result, the international model rights and the copyright were extinguished on 18 April 1993.

In 2008, Montis brought proceedings against Goossens in the Netherlands for copyright infringement. Goossens submitted that, in the absence of a maintenance declaration, the copyright in the chairs had been extinguished. Montis claimed that its copyright should be held to have been restored by virtue of the repeal of Article 21(3) of the Uniform Law on 1 December 2003, submitting that the repeal had retroactive effect. In the alternative, Montis claimed that its copyright should be held to have been restored following the adoption of the Copyright Term Directive. The Benelux Court of Justice referred three questions to the CJ for a preliminary ruling.

The CJ confirmed that the wording of Article 10(2) of the Copyright Term Directive indicated that legal effect should be given to the situation under national law as existing precisely on 1 July 1995 and not on an earlier or later date. It was held that the first condition laid down in Article 10(2) read together with Article 13(1) must be interpreted as meaning that the terms of protection did not apply to copyright which was initially protected by national legislation, but which was extinguished prior to 1 July 1995 and which is not protected in the territory of any other Member State.

It was neither the object nor effect of Article 10(2) to determine the conditions under which that protection could be extinguished before 1 July 1995; this continued to be governed by the applicable national legislation.

### **Broadcasters not entitled to claim fees from hotels with rooms containing television sets**

#### ***Verwertungsgesellschaft Rundfunk GmbH v Hettegger Hotel Edelweiss GmbH* (AG Szpunar for the CJ; Case C-641/15; 25.10.16)**

AG Szpunar has opined on the interpretation of Article 8(3) of Directive 2006/115/EC on rental and lending rights to the extent that broadcasters should not be entitled to collect fees from hotels which have rooms containing television sets. A hotel room should not be considered a place accessible to the public against the payment of an entrance fee for the purposes of Directive 2006/115/EC - to do so would be contrary to the intention of the legislation as drafted. Consequently television broadcasts in hotel rooms were not held to be subject to the exclusive right under Article 8(3).

An isolated interpretation of Article 8(3) would lead to the conclusion that a hotel room was a place accessible to the public against the payment of an entrance fee. However, Article 8(3) was derived from Article 13(d) of the Rome Convention which defined a place accessible to the public against the payment of an entrance fee as a place where a fee was levied precisely for the purpose of viewing a television broadcast. In contrast, hotels levied a fee for the purpose of providing accommodation in a hotel room, not for the purposes of viewing a television broadcast. The availability of television broadcasts through the television sets in a hotel room was an additional service ancillary to the primary purpose of accommodation. The protection for broadcasters under Article 8(3) should not extend to hotel rooms.

### **Court of Appeal confirms FA's claim for unauthorised use of domestic satellite decoder card to show matches in commercial setting not contrary to EU law**

#### ***The Football Association Premier League Ltd ("FAPL") v Anthony Luxton\** (Tomlinson & Floyd LJJ; [2016] EWCA Civ 1097; 09.11.16)**

The CA (Floyd LJ giving the lead judgment) dismissed Mr Luxton's appeal from the decision of Rose J to grant summary judgment to FAPL in its action for infringement of copyright relating to Mr Luxton's unauthorised use of a satellite decoder card in order to show live Premier League Football matches in his pub.

Mr Luxton ran a pub in Swansea. FAPL claimed that Mr Luxton relayed live Premier League Football matches on screens in his pub which included on-screen graphics and logos which FAPL added to its live feeds (the "copyright works"). FAPL claimed that this was done without its consent because the satellite decoder card which Mr Luxton obtained from FAPL's licensed Danish broadcaster and used for this purpose was a domestic card rather than a card which entitled the user to display the broadcasts in a commercial setting.

Rose J had rejected Mr Luxton's defence under EU law, i.e. (i) that FAPL were motivated in bringing the action by a desire to enforce strict territoriality in the reception of broadcasts of its live football matches contrary to Articles 101 and/or 56 TFEU, and (ii) that his use of a domestic card in his pub was a consequence of unlawful agreements or concerted practices between FAPL and its licensed broadcasters to restrict the supply of foreign commercial cards outside the territory in which that broadcaster operated. Rose J granted an injunction and inquiry as to damages and refused Mr Luxton permission to appeal. Having initially refused it on the papers, Floyd LJ granted permission to appeal after an oral hearing.

Floyd LJ said that he did not see how the present proceedings could be described as an illicit attempt on the part of FAPL to preclude the use by Mr Luxton of a foreign decoder card to receive broadcasts from a foreign broadcaster within the EU. This was because FAPL's right as a copyright owner to prevent the unauthorised communication to the public of copyright works did not depend on the card used being a 'foreign' card. That right, Floyd LJ said, would be enforceable against a person in the UK who used in a commercial setting a domestic card issued by FAPL's UK licensee, Sky. Therefore, the enforcement of the right did not become unlawful if a foreign card was substituted for a UK card.

Floyd LJ also rejected Mr Luxton's alternative argument, i.e. that even if FAPL had lawfully brought the proceedings to prevent the use of a domestic card for commercial purposes, FAPL had a second purpose which was to reinforce its unlawful agreements or practices restricting the reception of its broadcasts to the territories of its licensees. Floyd LJ found that the right on which FAPL relied was not capable of reinforcing unlawful agreements to partition the market precisely because it was not a right which depended on the territory in which the alleged unauthorised use was being made. There was, he said, no suggestion that FAPL or its licensees



allowed the use of domestic cards for commercial purposes to proceed unrestrained provided it occurred in the territory of the relevant broadcaster. While it could be said that FAPL's elimination of use of a particular foreign domestic card in the UK was consistent with FAPL's policy of keeping the markets separate, this was insufficient to create a relevant nexus.

Floyd LJ went on to reject Mr Luxton's second argument that his use of a domestic card was a consequence of unlawful agreements or concerted practices between FAPL and its licensed broadcasters. At the time of Mr Luxton's order for a commercial card, the card reseller he approached had run out of commercial cards and therefore, unknown to Mr Luxton, installed a domestic card with the intention of exchanging it for a commercial card once one became available. Floyd LJ found that, at most, FAPL's agreements and practices provided Mr Luxton with the *occasion* for use of a domestic card, but that such use could not accurately be described as a *consequence* of FAPL's agreements and practices.

Finally, Floyd LJ found that it could make no difference to his analysis that Mr Luxton had set out to obtain a commercial card and was, unknown to him, supplied with a commercial card. Otherwise FAPL's agreements and practices would prevent FAPL from enforcing its copyrights against foreign domestic cards however obtained, and a publican who deliberately sought out a foreign domestic card would be in the same position as Mr Luxton.

The CA having found that Mr Luxton had no defence, his appeal was dismissed.

**Katharine Stephens, Hilary Atherton and Emma Green**

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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)