











TRADE MARKS

Decisions of the CJ and GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-75/15 <i>Rod</i> <i>Leichtmetallräder GmbH v OHIM;</i> <i>Rodi TR, SL</i> (21.01.16)</p>	 <p>- light metal wheel rims, tyres (12) - trading in motor vehicle rims and accessories except chains (35) - vehicle maintenance and repair services (37)</p>  <p>- vehicles and their accessories and spare parts, specially tyres (12) - repair and maintenance and installing spare parts and accessories for vehicles, specially tyres, vehicle breakdown assistance, lubrication, polishing and washing of vehicles (37) - distribution, transport and storage of vehicles and their accessories and spare parts, specially tyres, breakdown recovery and towing services, vehicle-rental services (39) (Spanish 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 BoA had not erred in finding the goods in Class 12 and the services in Class 37 were identical and that the retail services in Class 35 covered by the mark applied for had an average degree of similarity to 'accessories and spare parts' in Class 12 covered by the earlier Spanish mark.</p> <p>The marks were visually similar. The dominant element in the earlier Spanish mark was the word 'rodi', not the figurative elements. Further, the colours of the Spanish mark were an element of decoration that would not particularly attract the attention of the relevant public.</p> <p>The marks were phonetically similar, having the first syllable and beginning of the second syllable of the Spanish mark in common. The BoA was further correct that neither of the two marks had a meaning in Spanish so a conceptual comparison was not possible. The relevant Spanish public would not associate 'rodi' with the English word 'roadie'.</p> <p>The BoA was therefore entitled to find that there was an average degree of similarity between the marks and that there was a likelihood of confusion.</p>
<p>GC T-802/14 <i>Laboratorios Ern, SA v OHIM;</i> <i>michelle maynard GmbH – Berlin cosmetics</i> (21.01.16)</p>	<p>LEHAN. C - household cleaning products, various cosmetics products and toiletries (3) - various medical, pharmaceutical and veterinary products (5) LEMA - pharmaceutical and veterinary</p>	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was correct to find that at least some of the relevant products were identical. As regards the comparison of the marks, the BoA was correct to find that: (1) there was a low degree of visual similarity between the</p>

	<p>products, products for medical use, fungicides and herbicides (5) (Spanish mark)</p>	<p>marks on the basis that there were significant visual differences despite the marks sharing the same first, second and fourth letters; (2) there was an average degree of phonetic similarity between the marks; and (3) there was no conceptual similarity on the basis that the mark applied for had no meaning and the earlier mark meant 'motto' or 'slogan' in Spanish.</p> <p>The BoA was correct to find that there was no likelihood of confusion even for the identical goods.</p>
<p>GC T-194/14 <i>Bristol Global Co. Ltd v OHIM; Bridgestone Corp.</i> (28.01.16)</p>	<p> - vehicles, apparatus for locomotion by land and by air, automobile tyres, various other accessories for wheels and tyres of vehicles, cycles and their parts (12) STONE - vehicle parts, namely shock absorbers, tires, wheels for vehicles, inner tubes, rims and covers for vehicle wheels, bicycles (12)</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 BoA was correct to find that, despite 'aero' being positioned at the beginning of the mark applied for, the element 'stone' had a least equal weight. In particular, English-speaking consumers would perceive the mark applied for as the association of the prefix 'aero' with the noun 'stone'. The figurative elements of 'aero' were negligible.</p> <p>The visual differences between the marks (i.e. length, colour, font and figurative details) did not outweigh the common element 'stone', which also created partial phonetic identity between the marks. The BoA did not therefore err in finding the marks visually and phonetically similar.</p> <p>For English-speaking consumers, 'stone' would retain a semi-independent role over the 'aero' prefix in the mark applied for. There was therefore a conceptual similarity between the marks for these consumers.</p> <p>Given further the identity and similarity of the goods in question, the BoA was correct to conclude that there was a likelihood of confusion between the marks under Art 8(1)(b).</p>
<p>GC T-170/13 T-171/13 <i>Benelli Q.J. v</i></p>	<p></p>	<p>In revocation proceedings, the GC upheld the BoA's findings that both the marks should be revoked for lack of genuine use, pursuant to Art 51(1)(a).</p>

<p><i>OHIM; Demharter GmbH</i> (02.02.16)</p>	<p>MOTOBI</p> <ul style="list-style-type: none"> - scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking, life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, sound recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire extinguishing apparatus (9) - vehicles; apparatus for locomotion by land, air or water; motor bicycles; motorcycles; motor scooters (12) - clothing, footwear, headgear (25) 	<p>The BoA was correct to find that the evidence produced by Benelli was insufficient to establish genuine use of the marks.</p> <p>Most of the documents produced by Benelli were devoid of evidential value in so far as they were undated or bore a date before or after the relevant period, or did not refer to the marks at issue, or were undated photographs which could not be cross-referenced with other documents (such as product catalogues or lists of references). None of the documents contained data regarding the turnover or the number of sales of the goods bearing the marks during the relevant period.</p> <p>Benelli's reply to an order for 26 scooters bore a date at which Benelli had just been informed that Demharter was about to bring revocation proceedings and fell within the three months preceding the filing of the revocation action and therefore could not be taken into account.</p>
<p>GC T-169/13 <i>Benelli Q.J. v OHIM; Demharter GmbH</i> (02.02.16)</p>	<div style="text-align: center;">  </div> <ul style="list-style-type: none"> - crash helmets for motorcyclists (9) - vehicles; apparatus for locomotion by land, air or water (12) - clothing, footwear, textile headgear (25) <div style="text-align: center;">    </div> <p>non-registered Italian marks for motorcycles and clothing</p>	<p>The GC upheld the BoA's decision which rejected the opposition to the mark applied for on the basis that Benelli had not established that the earlier marks were well known in Italy within the meaning of Art 6 bis of the Paris Convention for the purposes of Art 8(2)(c).</p> <p>The GC noted that although Benelli had not included any market survey evidence from which the public's perception could be deduced, it could not be inferred solely from the absence of such a survey that Benelli was unable to establish well known character of the earlier marks by other means.</p> <p>The GC held that the mere fact that Benelli submitted more than 40 documents did not, of itself, establish that the earlier marks were well known. The value of the evidence depended on the quality and relevance of the documents rather than the volume. Furthermore, evidence drafted in a language other than the language of the proceedings could not</p>

		<p>be taken into account.</p> <p>Therefore it could not be inferred that the marks were well known for motorcycles or clothing by a significant part of the Italian public.</p>
<p>GC</p> <p>T-541/14</p> <p><i>Antica Azienda Agricola Vitivinicola Dei Conti Leone De Castris Srl v OHIM; Vicente Gandía Pla SA</i></p> <p>(02.02.16)</p>	 <p>- wine (33)</p> <p>CASTILLO DE LIRIA</p> <p>- alcoholic beverages, in particular wine and sparkling wine (33)</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 identity of the goods was not challenged by Antica. The GC held that as regards the similarity of the marks the figurative element of the mark applied for and the word element 'castillo de' of the earlier mark were insignificant to the point of not having to be taken into consideration. The GC noted that according to settled case law in relation to wines, 'castillo de' was a generic element with weak distinctive character (T-458/07 and T-345/09, reported in <i>CIPA Journal</i> May 2011).</p> <p>The BoA was correct to find a low degree of visual similarity between the marks. Phonetically, there was a medium degree of similarity and the conceptual comparison was neutral.</p> <p>The BoA was correct to find a likelihood of confusion between the marks. The GC noted that particular importance should be attributed to the phonetic aspect (wine was often purchased in bars or restaurants in which the level of noise could affect aural perception).</p>
<p>GC</p> <p>T-247/14</p> <p><i>Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v OHIM; Salumificio Fratelli Beretta SpA</i></p> <p>(04.02.16)</p>	 <p>- meat, poultry and game (29)</p> <p>- services for providing food and drink (43)</p> <p>MINI WINI</p> <p>- various goods including meat products and charcuterie, meat and sausage preserves, fish, poultry and game, all in ready-to-eat, preserved, marinated and</p>	<p>The GC upheld the BoA's decision to reject the opposition under Art 8(1)(b) in relation to the goods in Class 29 but annulled its decision to reject Meica Ammerländische Fleischwarenfabrik Fritz Meinen's ('Meica') submissions in relation to the services in Class 43.</p> <p>The BoA has been correct to find no likelihood of confusion existed between the marks in relation to the goods in Class 29. The visual and phonetic similarities between the marks were low as the relevant public's attention would be drawn to the word elements 'beretta' and 'stick'</p>

	frozen form (29)	<p>in the mark applied for. Meica's evidence was insufficient to show that the earlier mark had an above average distinctive character.</p> <p>However, the BoA had been wrong to reject Meica's submissions in relation to the services in Class 43 as inadmissible on the basis they widened the scope of the appeal and were not made in accordance with Art 60. Whilst the submissions had been made by way of response to Salumificio's appeal (rather than by way of a separate notice of appeal), the BoA had infringed Art 8(3) of Regulation 216/96 by refusing to consider them.</p>
<p>GC T-135/14 <i>Kicktipp GmbH v OHIM; Società Italiana Calzature Srl</i> (05.02.16)</p>	<p>KICKTIPP - clothing (25)</p> <p>KICKERS - clothing, footwear, headgear (25) (Italian mark)</p>	<p>The GC annulled the BoA's finding that there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The GC upheld the BoA's assessment that the relevant public was the general public in Italy and that likelihood of confusion was to be assessed by reference to the not inconsiderable part of that public who did not have knowledge of English or German. For this group, the BoA was correct to find that neither the 'kick' nor the 'tipp' elements of the mark applied for had a more distinctive character than the other.</p> <p>The BoA had erred in finding the marks had moderate visual similarity. The last part of each mark - 'tipp' and 'ers' respectively - were completely different and the 'pp' element of the mark applied for was held to be unusual in Italian. As such, the GC held the marks had low visual similarity.</p> <p>The GC rejected the BoA's finding that the marks were phonetically similar and held there was low phonetic similarity between the marks. The GC agreed it was not possible to carry out a conceptual comparison.</p> <p>Despite the identity of the goods, the GC held that the overall impression given by the marks was sufficiently dissimilar to rule out a likelihood of confusion.</p>

Infringement rights afforded by unregistered licence

***Youssef Hassan v Breiding Vertriebsgesellschaft mbH* (CJ (Seventh Chamber); C-163/15; 04.02.16)**

Following a reference from the German Higher Regional Court, the CJ held that the licensee of a CTM might bring proceedings alleging infringement of a CTM which is subject of the licence, even though the licence had not been entered in the Register of CTMs, and that **Article 23(1)** should be interpreted accordingly.

Breiding was the holder of a licence relating to the CTM for the word mark ARTKIS owned by KBT & Co Ernst Kruchen agenzia commercial società and registered in respect of, amongst other goods, bedding and blankets. Under the licence, Breiding had the consent of KBT & Co to bring proceedings for infringement of the trade mark. However, the licence had not been entered in the Register. Mr Hassan offered several duvets for sale under the ARTKIS mark and undertook to refrain from using the ARKTIS mark for bedding pursuant to a cease and desist agreement entered into with Breiding.

Mr Hassan subsequently offered duvets for sale under the ARTKIS mark. Breiding brought proceedings for trade mark infringement and the Court found the cease and desist agreement to be valid. Mr Hassan appealed. The referring court deemed the success of the appeal to be dependent on whether Breiding could, with the consent of the trade mark proprietor and pursuant to **Article 22(3)**, bring trade mark infringement proceedings against Mr Hassan even though the licence had not been entered in the Register.

The CJ's reasoning for concluding that a licensee of a CTM might bring infringement proceedings, even though the licence had not been entered into the Register was as follows:

- The legal acts referred to in the first sentence of **Article 23(1)** covered the transfer of a CTM (**Article 17**), the creation of rights *in rem* over a CTM (**Article 19**) and the grant of a licence (**Article 22**). Read in isolation, one interpretation of that sentence could be that the licensee could not, if the licence had not been entered in the Register, rely on the rights conferred by that licence, vis-à-vis third parties. However, in interpreting that sentence, consideration also needed to be given to its context and the objectives pursued by the rules of which it was part.
- Pursuant to **Article 22(3)**, a licensee's right to bring proceedings for infringement of a CTM was, without prejudice to the provisions of the licence itself, subject only to the proprietor's consent. Neither **Article 19** nor **Article 22** contained analogous restrictions to that found under **Article 17(6)** which precluded a successor in title from invoking the rights arising from the CTM registration as long as a transfer of the CTM had not been entered on the Register.
- The restriction under **Article 17(6)** would serve no purpose if **Article 23(1)** prevented third parties from relying on the legal acts referred to in **Articles 17, 19** and **22** as long as they had not been entered in the Register.
- Looking to the purpose of the rule in the first sentence of **Article 23(1)**, taking into account the rest of **Article 23(1)** and **Article 23(2)**, the lack of effects vis-à-vis third parties of the legal acts referred to in **Articles 17, 19** and **22** which had not been entered in the Register intended to protect a person who had or may have had rights in a CTM as an object of property.
- **Article 23(1)** did not therefore apply to a situation in which a third party, by infringing the mark, infringed the rights conferred by a CTM.

CJ dismisses appeal from GC decision on Adidas stripes position mark

Shoe Branding Europe BVBA v OHIM; Adidas AG (CJ (Sixth Chamber); C-396/15; 17.02.16)

The CJ dismissed the appeal from the GC's decision in *adidas v OHIM* (T-145/14, reported in *CIPA Journal*, June 2015) by reasoned order, pursuant to **Art 181** of the **Rules of Procedure** on the basis that the appeal was partly inadmissible and partly unfounded.

Shoe Branding filed an application for a CTM in respect of footwear in Class 25 (below left). The application claimed protection for the number and positioning of the stripes on the shoe but not the shape of the shoe itself. Adidas opposed the application pursuant to **Article 8(1)(b), 8(4)** and **8(5)** and relied on its earlier CTM registration for the mark shown on the right below. Adidas' appeal from the BoA's decision which rejected the opposition was upheld by the GC.



Shoe Branding's first ground of appeal, which challenged the GC's findings that: (1) the average consumer did not demonstrate a high level of attention; and, (2) sports footwear were everyday consumer goods, and also alleged that the GC had failed to take into account the fact that sportswear may serve an advertising purpose, was inadmissible as it disputed the GC's finding of fact and therefore fell outside the CJ's jurisdiction.

The CJ dismissed the remainder of the first ground of appeal, which claimed GC had erred in holding that the average consumer was not observant and was not able to distinguish between brands, as partly inadmissible and partly unfounded.

The CJ held that, as Shoe Branding had not advanced the argument that coexistence of the two marks at issue over several decades had not led to confusion on the part of the average consumer before the GC, the GC was correct not to acknowledge this factor in its decision.

The CJ dismissed the second ground of appeal as partly inadmissible and partly unfounded and found that the GC had conducted an overall assessment, and had taken account of the difference in the length of the stripes resulting from their angle when deciding that the difference did not influence the overall impression produced.

The third ground of appeal was also unfounded. Once proof of the reputation of the mark had been made out, it was irrelevant to prove the inherent distinctive character of that mark in order to obtain a finding that it had distinctive character. The GC had taken into account the BoA's analysis that proof of the earlier mark's reputation had been made out, which made an assessment of the mark's inherent distinctive character irrelevant.

Court of Appeal dismisses Glee Club's appeal and holds 'wrong way round' confusion potentially relevant under Sections 10(2) and 10(3)

Comic Enterprises Ltd ("CEL") v Twentieth Century Fox Film Corporation ("Fox")* (Arden, Kitchin & Lloyd Jones LLJ; [2016] EWCA Civ 41; 08.02.16)

The CA (**Kitchin LJ** giving the lead judgment) unanimously dismissed Fox's appeal from the decision of **Roger Wyand QC** sitting as Deputy Judge of the High Court ([2014] EWHC 185 (Ch), (reported in *CIPA Journal*, March 2014). Although the CA heavily criticised the Deputy Judge's judgment, it upheld his finding that Fox had infringed CEL's marks under

Sections 10(2) and 10(3). CEL's cross-appeal on the basis that the Judge ought to have found that Fox had committed passing off was also dismissed.

Background

The proceedings concerned a dispute regarding the right to use the word 'glee' as the name for Fox's musical comedy TV drama series. CEL operated a number of entertainment venues in the UK, which included stand-up comedy acts, live and recorded music, and nightclub and cabaret entertainment. CEL had two registered Marks that included the words 'the glee CLUB' and were registered for various services in Class 41. It was accepted for the purposes of the appeal that nothing turned on the differences between the Marks, as shown below:



Infringement under Section 10(2)

The CA found that the Deputy Judge had erred in three respects in considering the question of infringement under **Section 10(2)**. Firstly, while **Mr Wyand** had referred to evidence of wrong way round confusion, the CA found that he had relied on it without explaining why it had any probative value. It was therefore necessary for the CA to review that evidence for itself. It rejected Fox's argument that wrong way round confusion was not admissible as a matter of law, but said that it must be assessed with care along with all the other evidence to determine whether it was of any assistance in answering the statutory question. Nevertheless, in doing so, the CA found that CEL's evidence of wrong way round confusion showed that the similarity between the mark and the sign and the similarity between the relevant services had led a significant number of people to believe that the two were connected.

Secondly, the CA found that the Deputy Judge had not considered the similarity between the relevant services, which amounted to a material deficiency which vitiated his conclusion that they were similar. Thirdly, he had also failed to consider the significance of the context of use which amounted to a further material error.

Re-evaluating the issue of infringement under **Section 10(2)**, the CA found that the relevant services were ultimately similar; the nature of services could overlap, as comedy shows were often televised and a TV series about a singing club could give rise to all kinds of associated activities. The purpose and method of use of the services were found to be similar in that they were all directed at members of the public of a similar age, seeking entertainment, and who enjoyed musical theatre and comedy. Furthermore, live music and comedy shows would be complementary to the glee TV series, as evidenced by the fact that Fox had already sanctioned two world concert tours. This, along with the fact that Fox had not proved that its use of the word 'glee' would be understood by the average consumer as denoting a singing club, was relevant context to be taken into account. Taking all matters into account, the CA found that there was a likelihood of confusion.

Infringement under Section 10(3)

The CA rejected Fox's contention that **Section 10(3)** infringement could only be 'right way round'. The evidence of wrong way round confusion demonstrated that the use by Fox of the sign glee was such that the average consumer would make a connection between the sign and the Mark. The CA also held that the protection afforded to a mark with a reputation extended beyond existing customers. The Deputy Judge was therefore entitled to find that CEL's potential customers were changing their economic behaviour and that CEL's mark was suffering detriment because it was being swamped by Fox's use of its sign. On the question of

due cause, **Kitchin LJ** acknowledged that Fox had adopted the sign 'glee' in good faith and that the TV series was a creative work. However, the likelihood of confusion and the likelihood of significant detriment to CEL's mark led him to agree with **Mr Wyand** that Fox had not shown that its use of the sign was with due cause.

Passing Off

Kitchin LJ found that **Mr Wyand** had been right to dismiss CEL's claim in passing off because the damage suffered by CEL was not the consequence of any misrepresentation by Fox.

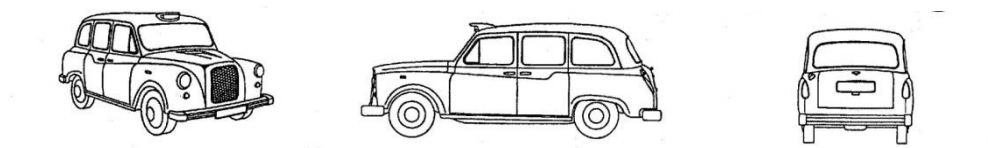
High Court cancels London taxi marks

***The London Taxi Corporation Limited ("LTC") v Frazer-Nash Research Limited ("FNR") & Anr** (Arnold J; [2016] EWHC 52 (Ch); 20.01.15)**

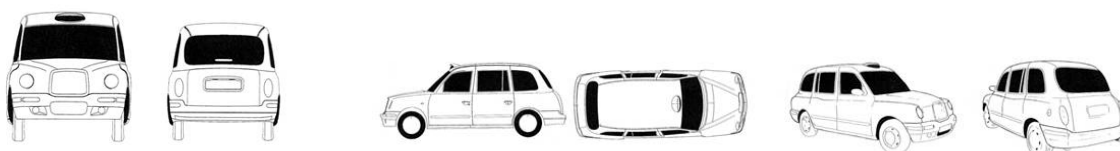
Arnold J held that LTC's trade marks for the shape of London taxis were invalid for lack of distinctive character and because they consisted of shapes which gave substantial value to the goods. **Arnold J** also held that, even if the trade marks were valid, they would not have been infringed by FNR and the second defendant, Ecotive's, new taxi model.

LTC was the successor in title to the manufacturer of a number of models of taxis, including the Fairway, TX1, TXII and TX4. FNR and Ecotive were the successors in title to the manufacturer of the Beardmore, Oxford and Metrocab taxis.

LTC owned a 3D CTM for the following:



together with a 3D UK registered trade mark as shown below:



together the "Marks".

LTC claimed that FNR and Ecotive threatened to infringe the Marks under **Articles 9(1)(b)** and **9(1)(c)** and commit passing off by marketing a new taxi model called the 'new Metrocab'. The Defendants counterclaimed for invalidity of the Marks relying on **Articles 7(1)(b)**, **7(1)(e)(iii)** and (in the case of the CTM only) for revocation for non-use under **Articles 15(1)** and **51(1)(a)**. LTC argued that the Marks had acquired distinctive character under **Article 7(3)**.



New Metrocab

Distinctive Character

Arnold J held that the Marks would be perceived by the average consumer as merely a variation of the typical shape of a taxi/car. Even if the shape did depart significantly from the norm, it would not have been perceived as identifying the origin of the goods. This would have been the case whether the average consumer was a taxi driver (as **Arnold J** held) or a consumer of taxi services. The Marks were therefore held to lack inherent distinctive character.

In relation to acquired distinctiveness, **Arnold J** held that taxi drivers would have relied on the word or figurative trade marks under which the vehicles were sold, rather than the shapes of the vehicles. Alternatively, consumers of taxi services would not have placed any relevance on the manufacturer of the taxi whatsoever. The evidence adduced by LTC was therefore insufficient to show that the Marks had acquired distinctive character.

Substantial value

The shape which was the subject of the UK trade mark was also registered as a design. **Arnold J** applied *Hauck vs Stokke C-205-13*, and held that the registered design was a relevant consideration since the purpose of **Article 7(1)(e)(iii)** was to prevent trade marks from being used to extend the protection of other intellectual property rights (potentially indefinitely). The UK trade mark was therefore invalid. While the shape of the CTM was not protected by a registered design, it could have been, and therefore the CTM was held invalid on the same basis.

Non-use

The CTM had only been used in relation to used vehicles, and sales were modest and almost exclusively in the UK. This amounted to a recirculation of goods which had already been put on the market under the CTM long beforehand. Therefore **Arnold J** held that there was no genuine use. Destroying goods bearing the trade mark (when taxis were sold for scrap) was held not to constitute trade mark use.

Infringement

In case he was wrong as to the invalidity of the marks and the grounds for revocation, **Arnold J** went on to consider the question of infringement. LTC did not argue that there was a likelihood of confusion on the part of taxi drivers. Even if the average consumer was a user of taxi services, **Arnold J** held there would still have been no likelihood of confusion because of the lack of distinctive character of the Marks and the low degree of similarity. The claim under **Article 9(1)(b)** therefore failed.

The claim under **Article (9)(1)(c)** also failed and the Judge held that FNR would have had a defence under **Article 12(b)** in any event. The claim for passing off was also rejected, the Judge finding that LTC had not established that certain features of the taxi models it relied upon denoted a particular source of London taxis.

ISPs ordered to block access to websites which infringe trade marks

***Cartier International Ltd & Anr v British Telecommunications Plc & Ots** (Judge Hacon; [2016] EWHC 339 (Ch); 23.02.16)**

Judge Hacon granted a website-blocking order requiring the defendant internet service providers to block access to certain websites which were being used by their operators to infringe the trade marks of Cartier and the second defendant, Montblanc.

Cartier and Montblanc owned registered trade marks which they used for the advertising and sale of their luxury goods, such as CARTIER for watches and MONTBLANC for pens. The defendants were the five main internet service providers in the UK. The websites in question ('www.perfectwatches.cn', 'www.pursevalley.cn', 'www.montblancbay.com', 'www.montblanc.c

om.co' and 'www.replicawatchestores.co.uk) were being used by their operators to market cheap copies of Cartier and Montblanc's goods.

The Judge was satisfied that the principles set out in **Arnold J's** judgment in *Cartier International AG v BskyB* ("*Cartier I*") (reported in *CIPA Journal*, November 2014) were satisfied. There, **Arnold J** had held that the Court had the power to grant website-blocking injunctions in the context of trade mark infringement pursuant to **Section 37(1) Senior Courts Act 1981**, as interpreted in accordance with the **IP Enforcement Directive**.

Although none of the defendant service providers appeared or were represented, a written note was submitted on their behalf. However, **Judge Hacon** rejected their objections in relation to the third and fourth threshold conditions laid down by **Arnold J** in *Cartier I*. In relation to the third condition ("ISPs' services must be used to infringe"), he found that the mere fact of access to the infringing websites was sufficient and it was not necessary for Cartier and Montblanc to show that the ISPs' services had in fact been used to infringe the trade marks. In relation to the fourth condition ("actual knowledge by the ISPs"), it was sufficient that the ISPs had had knowledge of the potential for their services to be used to access the relevant websites, even if not knowledge of actual instances of such use. The Judge also rejected the ISPs' argument that this type of application required full and frank disclosure.

On the question of proportionality, assessing the comparative importance of the rights engaged, the Judge held that the visibility of the websites in question added to the public knowledge of the widespread availability of the fake products sold under the trade marks which was in itself likely to damage the functions of the marks. He also rejected the ISPs' argument that Cartier and Montblanc had made insufficient efforts to have the relevant websites blocked by other means. As regards the requirement for efficiency and dissuasiveness, there was no requirement for Cartier and Montblanc to show that blocking access to the target websites was likely to reduce the overall infringement of their trade marks by other websites. He also rejected the argument that a blocking order was liable to affect the sale of lawfully marketed goods on websites which shared an IP address with the target websites, finding that the practical solution was to make an order requiring Domain Name System (DNS) blocking in such circumstances.

As the defendant ISPs' appeal in *Cartier I* was due to be heard by the Court of Appeal in April 2016, **Judge Hacon** indicated that he would grant the defendant ISPs permission to appeal in this case.

High Court does not have jurisdiction to hear appeals from UDRP decisions

***Yoyo.email Ltd v Royal Bank of Scotland Group Plc & Ots** (Judge Dight; [2015] EWHC 3509 (Ch); 02.12.15)**

Judge Dight struck out Yoyo's claim for a declaration that it had not committed any wrongdoing in registering the domain names 'rbsbank.email', 'rbs.email', 'natwest.email' and 'coutts.email'. The Judge held that the court had no jurisdiction to act as an appeal body from decisions of the dispute resolution panel operating under the UDRP regime. Had he not struck out the claim, the Judge said he would have granted reverse summary judgment in the defendant banks' favour.

The defendant financial institutions were respectively owners of the trademarks RBS, RBSBANK, NATWEST and COUTTS. Upon discovering that Yoyo had registered the eponymous domain names, the banks successfully filed a complaint to WIPO pursuant to ICANN's Unified Dispute Resolution Policy. The domain names were ordered to be transferred to the defendants, and Yoyo commenced proceedings in the High Court.

Judge Dight concluded that, adopting the reasoning of **Sonia Proudman QC** (as she then was) in *Patel v Allos Therapeutics*, clause 4k of the UDRP did not give rise to a separate cause of action in favour of Yoyo, nor did it afford any jurisdiction to the High Court to act as an appeal or review body from decisions under the UDRP. He therefore struck out Yoyo's claim.

As regards the banks' application for summary judgment on their counterclaim for trade mark infringement and passing off by the mere registration by Yoyo of the domain names, **Judge Dight** held that registration of the domain names constituted passing off. Applying the reasoning of **Aldous LJ** in *British Telecom v One in a Million & Ots*, the mere registration of a domain name constituted a representation to persons who consulted the domain name register that the registrant was connected or associated with the names registered and was thus the owner of the goodwill in the names. The Judge rejected Yoyo's argument that the reasoning of **Aldous LJ** was out of date because the internet had developed to such an extent since *One in a Million* (or that the public had become significantly more sophisticated) that the reasoning no longer held good.

As the first act of passing off had occurred on the day of registration of the domain names, there was no need for the Judge to analyse the claimant's proposed business model and intended use of the domain names. Royal Bank of Scotland was entitled to summary judgment.

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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