








TRADE MARKS


Decisions of the CJ and GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-84/14 T-97/14 T-711/13 T-716/13 <i>Harrys Pubar AB & anr v OHIM; Harry's New York Bar SA & anr</i> (18.02.16)</p>	<p>HARRY'S NEW YORK BAR HARRY'S BAR</p> <ul style="list-style-type: none"> - various items of clothing (25) - various foodstuffs (29) - coffee, tea and various foodstuffs (30) - non-alcoholic beverages and preparations for making beverages; beers; mineral and aerated waters; fruit drinks and fruit juices; syrups (32) - alcoholic beverages (excluding beer) (33) - establishments selling beverages (43)  <ul style="list-style-type: none"> - clothing; footwear; headgear (25) - serving and supplying of food and drink through restaurant, pub and café services (42, now 43) (Swedish marks) 	<p>The GC upheld the BoA's findings of a likelihood of confusion between the marks in respect of certain goods and services pursuant to Art 8(1)(b).</p> <p>The BoA was correct to find that the word element 'harrys' was dominant in the earlier marks, whereas the additional word elements had no distinctive character.</p> <p>The marks were visually, phonetically and conceptually similar insofar as they corresponded to the common first name, Harry.</p> <p>Contrary to the decisions of the BoA, the GC held that there was a certain degree of similarity between the foodstuffs and beverages covered by the marks applied for and the 'serving of food and drink' services covered by the earlier marks. The relevant goods in Classes 29, 30, 32 and 33 may have been offered for sale in places where food and drink were served which rendered those goods complimentary to the services at issue.</p> <p>Therefore, given the similarity or identity of the remaining goods and services, there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p>
<p>GC T-30/15 <i>Infinite Cycle Works Ltd v OHIM; Chance Good Ent. Ltd</i> (19.02.16)</p>	<p>INFINITY</p> <ul style="list-style-type: none"> - bicycles; bicycle parts; bicycle accessories (12) - exercise bicycles (28)  <ul style="list-style-type: none"> - reflectors exclusively for bikes (9) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks at issue under Art 8(1)(b).</p> <p>The GC agreed with the BoA that the goods at issue were in part identical and in part similar. In particular, the GC noted that the fact that 'exercise bicycles' were in a different class to 'bicycles' was irrelevant; the similarity depended on the objective comparison</p>

	<p>- lights exclusively for bikes; headlight for bicycle, flashlight, lantern, bicycle reflectors for attachment to spokes; direction indicators for cycles (lamps for-), headlamps for use on cycles (11)</p> <p>- bicycles; bicycle rims; rear view mirrors; lateral view mirrors; shock absorbers for vehicles (12)</p>	<p>of the goods.</p> <p>The marks were visually similar as the mark applied for reproduced the word element of the earlier mark in full. The figurative element of the earlier mark was not the dominant element, as the simple geometric shapes were frequently used in the relevant market sector and were therefore commonplace and banal. The sole phonetic difference between the signs, being the 'ty' element of the sign applied for, did not preclude a finding of phonetic similarity. The BoA had not erred in finding that the marks were conceptually identical in Belgium and France as the French word <i>infini</i> was the root of the English word 'infinity'.</p>
<p>GC T-411/14 <i>The Coca-Cola Company v OHIM</i> (24.02.16)</p>	<div data-bbox="507 840 742 1191" data-label="Image"> </div> <p>- common metals and their alloys; metal building materials; ironmongery, small items of metal hardware; goods of common metal not included in other classes; metallic bottles (6)</p> <p>- household or kitchen utensils and containers; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; glass and plastic bottles (21)</p> <p>- beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages (32)</p>	<p>The GC upheld the BoA's decision that the three-dimensional sign applied for was devoid of distinctive character under Art 7(1)(b) and had not acquired distinctive character through use under Art 7(3).</p> <p>The BoA was correct to conclude that the sign did not depart significantly from the norms and customs of the beverage sector such that the average consumer in the EU was not able to immediately and directly identify the commercial origin of the goods. The relevant public would perceive the sign applied for merely as a variant of the 'normal' shape and packaging of the goods covered by the application.</p> <p>The GC held that the BoA had erred in doubting the reliability of survey evidence submitted to support the claim under Art 7(3), but that those errors did not affect the legality of the contested decision. The GC agreed that the evidence submitted was not capable of proving that the sign had acquired distinctive character through use throughout the EU in respect of a significant part of the relevant public, given that the surveys had only been carried out in 10 Member States. The secondary evidence, containing sales and advertising, was also insufficient to establish acquired distinctive character as it was unreliable, inconsistent and unclear as to whether</p>

		such evidence related to the sign applied for.
<p>GC T-816/14 <i>Tayto Group Ltd v OHIM; MIP Metro Group Intellectual Property GmbH & Co. KG</i> (24.02.16)</p>	 <p>- potato crisps; real potato crisps; potato products and potato preparations prepared in the form for use in making snack foods; snacks in the form of real potato crisps (29)</p> <p>- shaped or extruded savoury snack foods prepared from cereal preparations and/or potato flour (30)</p>  <p>- potato crisps; potato fritters; (29)</p> <p>- wheat, rice and corn products for food; savoury snacks (30) (German national mark)</p>	<p>The GC upheld the BoA's finding that there was a likelihood of confusion between the marks pursuant to Art 8(1)(b).</p> <p>The BoA was correct to find that the terms 'real' and 'quality' were not descriptive of the products, and that the earlier mark was inherently distinctive. The BoA correctly assessed that 'real' was the dominant element of the mark applied for and the earlier mark. The marks at issue were similar despite differences introduced by other elements. The figurative elements and the words 'hand cooked' and 'quality' were negligible due to their relative size and likely to be overlooked by the relevant German public.</p> <p>The BoA was correct to find that the signs had an average visual similarity, an above average phonetic similarity and were conceptually similar. The goods at issue were found to be identical or similar.</p> <p>The GC confirmed that the Tayto Group Ltd's rights had not been limited when the Opposition Division had replaced the Class headings in the specification with the full alphabetical list proper to each Class and rejected Tayto Group Ltd's submission as inadmissible that the BoA had acted <i>ultra vires</i> in this regard.</p>
<p>GC T-40/09 <i>Advance Magazine Publishers, Inc v OHIM; Pelling Selecciones Americanas, SA</i> (01.03.16)</p>	 <p>- clothing; footwear; headgear; parts and fittings for all the aforesaid goods (25)</p>  <p>- corsetry articles, strips, supports and any similar garment (25)</p>	<p>Following the retroactive cancellation of the earlier Spanish figurative mark for VOGUE STUDIO, it was not necessary for the GC to adjudicate on the BoA's assessment of the likelihood of confusion between the mark applied for and this earlier mark.</p> <p>As regards the earlier Spanish figurative mark for VOGUE, the revocation of the registration by the same court only took effect as at the date of that decision, such that the mark still produced effects at the date of the contested decision which upheld the opposition against the mark applied for. It was therefore</p>

	 <p>- corsetry and underwear for men, women and children, including pyjamas, stockings, tights and socks; clothing and sporting articles for men, women and children (not included in other classes), swimsuits (25)</p> <p>(CTM application and Spanish national registrations)</p>	<p>necessary for the GC to examine whether genuine use of this mark had been established under Art 43(2).</p> <p>The GC held that the BoA had been correct to find genuine use of this earlier mark.</p> <p>The BoA had not erred in rejecting Advance Magazine Publisher's request for suspension of the opposition proceedings pending the outcome of separate opposition proceedings against the earlier CTM application under Rule 20(7) of Regulation No 2868/95. The BoA had appropriately justified its decision to not exercise its discretion to suspend proceedings, as the opposition to the mark applied for did not solely rest on the earlier CTM application (the contested decision could be maintained on the basis of the earlier Spanish mark for Vogue).</p>
<p>GC T-778/14 <i>Ugly, Inc. v OHIM; Group Lottuss Corp., SL</i> (03.03.16)</p>	<p>COYOTE UGLY</p> <p>- entertainment, discotheques, dance halls and cultural activities (41)</p> <p>- bars, excluding any other service belonging to this class (43)</p> <p>COYOTE UGLY 14, 16, 21, 25, 32, and 34 (revoked)</p> <p>COYOTE UGLY</p> <p>- records, tapes and discs; CDs; DVDs (9)</p> <p>- precious metals and their alloys (14)</p> <p>- paper, cardboard and goods made from these materials (16)</p> <p>- household or kitchen utensils and containers (21)</p> <p>- clothing(25)</p> <p>- alcoholic beverages (33)</p> <p>- tobacco; smokers' articles (34)</p> <p>- education; providing of training; entertainment; nightclub services (41)</p> <p>- providing food and drink; restaurant, bar and catering services (42)</p>	<p>The GC upheld the BoA's decision to reject the opposition pursuant to Art 8(4) and (5). Ugly, Inc relied on an earlier CTM registration, a non-registered mark used in the course of trade and a well known mark within the meaning of Art 6 bis Paris Convention all for COYOTE UGLY.</p> <p>As the earlier CTM had been revoked before the opposition had been filed, the BoA was correct to conclude that the CTM did not constitute a valid basis in the opposition proceedings.</p> <p>In relation to the non-registered mark, the BoA was correct to find the evidence submitted as proof of use in the EU, based on the film COYOTE UGLY and a US chain of bars, was insufficient. The BoA had not erred in rejecting the opposition based on Art 8(4).</p> <p>The BoA was also correct to find that the evidence did not show that Ugly, Inc's chain of bars in the US were well known in the EU or that the film of that name was widely associated with Ugly, Inc's business at the filing date of the mark applied for. COYOTE UGLY could not therefore be said to be a well known mark for the purposes of Art 8(5).</p>

	(unregistered marks)	The appeal was dismissed in its entirety.
<p>GC T-160/15 <i>LG Developpement v OHIM Bayerische Motoren Werke AG</i> (10.03.16)</p>	 <p>- apparatus for locomotion by land, namely trailers (12) MINI - land vehicles; parts, components and accessories (12) for all the aforesaid goods</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 identity between the goods, as 'trailers' covered by the mark applied for were part of the broader category of 'land vehicles' covered by the earlier mark.</p> <p>The visual differences between the marks, namely the 'cargo' suffix and figurative elements, did not outweigh the common element 'mini'. These differences were not capable of dominating the overall impression created by the sign applied for and the BoA was correct to find an average degree of visual similarity between the marks.</p> <p>There was also an average phonetic similarity between the marks as a result of the first two syllables of both marks being pronounced identically.</p> <p>The BoA had erred in finding that there was an average conceptual similarity. Although both signs shared the 'mini' element, this operated as an adjective whereas 'cargo', a noun, determined the main meaning of the mark applied for. As such, the GC held the marks had a low conceptual similarity, however, this did not affect the finding that there was an average degree of similarity between the marks as a whole.</p> <p>Taking all factors into account, the BoA was entitled to find a likelihood of confusion between the marks.</p>
<p>GC T-201/14 <i>The Body Shop International plc v OHIM; Spa Monopole, compagnie fermière de Spa SA/NV</i> (16.03.16)</p>	<p>SPA WISDOM - perfumes; soaps; shampoos; cosmetics; hair colourants; hair conditioners; hair dyes; hair lotions; hair styling preparations; non-medicated talcum powder for toilet purposes; sun-tanning preparations; cosmetics; non-medicated massage preparations; shaving preparations; nail care preparations; bath oils; bath salts;</p>	<p>The GC upheld the BoA's decision that there was a risk of dilution of the earlier mark under Art 8(5).</p> <p>The Body Shop did not dispute the BoA's finding that the earlier mark enjoyed a high reputation in respect of the goods in Class 32 by a significant part of the relevant consumers in the Benelux.</p> <p>There was an average degree of visual phonetic and conceptual similarity</p>

	<p>essential oils; beauty masks; nail varnish; cotton wool for non-medical purposes; pot-pourri (3)</p> <p>SPA</p> <p>- mineral water and aerated waters and other non-alcoholic beverages, syrups and other preparations to make beverages (32)</p> <p>(Benelux registration)</p>	<p>between the marks. There was also a certain link between the goods covered by the marks at issue; the GC noted that there was a connection between the activity of producing mineral water and the marketing of cosmetics and, further, that mineral water might be used as ingredients in cosmetics. Therefore, given the high reputation of the earlier mark, the BoA did not err in finding that the relevant public was likely to establish a link between the marks.</p> <p>The earlier mark conveyed an image and a message relating to health, beauty, purity and richness in minerals, and it was common ground that the same image and message might also apply to cosmetics. Overall the BoA was correct to conclude there was a risk of a free-riding transfer of the advertising effort made by the Spa Monopole as proprietor of the earlier mark in favour of The Body Shop.</p>
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CJ provides preliminary ruling on definition of 'use' in Article 5(1)

Daimler AG v Együd Garage Gépjárműjavító és Értékesítő Kft. (CJ (Second Chamber)); C-179/15; 03.03.16)

Following a reference from the Budapest Municipal Court, the CJ held that **Article 5(1)(a)** and **(b)** should be interpreted such that a third party named in an online advertisement which contained a sign identical or similar to a trade mark so as to give the impression that there was a commercial relationship between that third party and the trade mark proprietor does not make 'use' of that sign if: (1) the advertisement was not placed by the third party or on his behalf; or (2) the advertisement was originally placed by or on behalf of the third party with the consent of the proprietor but the third party subsequently expressly requested the removal of the advertisement or reference to the trade mark and the operator of the website refused to do so.

Mercedes Benz Hungaria, a subsidiary of Daimler, concluded a contract with Együd Garage for the supply of after-sales services, under which Együd Garage was entitled to use the Mercedes-Benz mark and to describe itself as an 'authorised Mercedes-Benz dealer' in its own advertisements. During the contract period, Együd Garage ordered an online advertisement from advertising services company, MTT, which described Együd Garage as an 'authorised Mercedes-Benz dealer'.

On the termination of the contract, Együd Garage tried to end all use of the mark and asked MTT to remove the reference an 'authorised Mercedes-Benz dealer' from the advertisement. Együd Garage also wrote to several other websites which featured the advertisement, with which it had had no direct or indirect dealings, to request the removal of the advertisement. The advertisement continued to be distributed online by these third parties. Subsequently, Daimler brought trade mark infringement proceedings against Együd Garage. The Budapest Court stayed the proceedings and made a reference to the CJ concerning the interpretation of **Article 5(1)**.

In reaching its conclusion, the CJ held that:

- (1) where a website provider fails to comply with an advertiser's request to remove an advertisement or reference to a mark contained therein, the publication of that advertisement or reference could no longer be regarded as 'use' of the mark by the advertiser;
- (2) an advertiser could not be liable for the independent actions of other economic operators, such as a referencing website operator, acting on their own initiative and in their own name and with whom the advertiser had no direct or indirect dealings;
- (3) the ordinary meaning of 'use' should be applied in the interpretation of **Article 5(1)**, and necessarily involved active behavior and direct or indirect control of the act constituting use, (**Article 5(3)** provided a non-exhaustive list of types of use which referred exclusively to active behaviour on the part of a third party); and
- (4) the purpose of Article 5(1) was to enable a trade mark proprietor to prohibit or prevent use of his trade mark without his consent, but only a third party with direct or indirect control of the act constituting use would be able to comply with that prohibition.

DESIGNS

***PMS International Group Plc v Magmatic Ltd** (Lords Neuberger, Sumption, Carnwath, Hughes & Hodge; [2016] UKSC 12; 09.03.16)**

The Supreme Court (**Lord Neuberger** giving the lead judgment with which **Lords Sumption, Carnwath, Hughes** and **Hodge** agreed) dismissed Magmatic's appeal against the CA's finding that its registered Community design ("RCD") was not infringed by PMS' Kiddee Case product.

Magmatic alleged that PMS' Kiddee Case products infringed the RCD (see images below), which protected its Trunki product.



Images from the RCD

One of the Kiddee Case designs

In the High Court, **Arnold J** found that the RCD was infringed on the basis that the RCD and the Kiddee Case designs created the same overall impression (reported in *CIPA Journal*, August 2013). However, this decision was overturned by the CA, which found that there was no infringement (reported in *CIPA Journal*, March 2014). Magmatic appealed to the SC.

(i) The 'horned animal' appearance

The SC agreed with the CA that the overall impression created by the RCD was that of a horned animal. The SC noted that **Arnold J** had failed to mention the significance of the

horns when addressing the RCD's overall impression and the SC concluded that he had therefore wrongly overlooked this important feature of the RCD.

(ii) The impact of surface decoration/ornamentation

The CA took the view that the fact that the RCD was unadorned reinforced the overall impression it created (i.e. that of a horned animal). Further, the surface decoration of the Kiddee Case (e.g. its colouring and spots) also influenced the overall impression it created: in one design to give the impression of a ladybird with antennae, in another a tiger with ears.

As *obiter*, the SC agreed that absence of surface decoration *could*, as a matter of principle, be a feature of a registered design. Whether it was in fact a feature of a given registered design turned on the proper interpretation of the representations used in the registration. Referring to *Procter & Gamble v Reckitt Benckiser* [2007] EWCA Civ 936, the SC noted that whilst each registered design must be interpreted in its own context, representations by way of line drawings were much more likely to be interpreted as not excluding surface decoration than a CAD (i.e. a CAD representation was generally more likely to be interpreted as including a lack of surface decoration as a feature of the design). This was consistent with *Apple v Samsung* [2012] EWHC 1882 (Pat) and [2012] EWCA Civ 1339 in which the lack of surface decoration was considered to be a feature of the asserted design.

Turning to the question of whether a lack of surface decoration was a feature of the RCD in this particular case, the SC thought there were arguments both ways, but decided it did not need to reach a conclusion, given that the CA had not done so either.

(iii) The impact of the colour contrast

The SC noted that the CADs used in the RCD clearly showed a (non-specific) colour contrast between the body of the case on the one hand and the wheels and the strap on the other. Absent any other plausible reason for this, the SC agreed with the CA that the RCD did not protect just the shape alone, but also the colour contrast between these features. **Arnold J**, on the other hand, had viewed the RCD as just protecting the shape alone and had not taken account of the colour contrast (which was absent in the Kiddee Case) when comparing the designs.

In conclusion, the SC agreed with the CA that **Arnold J** had materially misdirected himself in these three respects, and agreed that the CA was entitled to reconsider the question of infringement and reach its own conclusion. Because the CA had done so on the correct basis in law, the SC should be reluctant to interfere with the conclusion reached and indeed it would not do so. Magmatic's appeal was therefore dismissed and the CA's decision that there was no infringement was upheld.

COPYRIGHT

Access by one third party insufficient to establish copyright infringement by issuing or communication to the public or database infringement by extraction or reutilisation

***Ultrasoft Technologies Ltd v Hubcreate Ltd** (Judge Hacon; [2016] EWHC 544 (IPEC); 16.03.16)**

Judge Hacon dismissed Ultrasoft's claim that Hubcreate had infringed its copyright and database rights by issuing or communicating copies of Ultrasoft's database files to the public, or by extracting or utilising all or a substantial part of the contents contained in the files.

Ultrasoft and Hubcreate each created and marketed software, and competed in selling their respective software to organisations that provided serviced office space. It was common ground that Hubcreate had copied on to its system computer programs which were protected by copyright and database rights owned by Ultrasoft. However, Ultrasoft further alleged that

Hubcreate had infringed its copyrights in its two database files by (i) issuing copies of the files to the public contrary to **Section 18 CDPA**, and (ii) communicating the files to the public contrary to **Section 20**. Ultrasoft also alleged that Hubcreate had infringed its database rights by (i) extracting and (ii) re-utilising all or a substantial part of the contents of the databases contained in the database files contrary to **Regulation 16** of the **Copyright and Rights in Databases Regulations 1997**.

Judge Hacon dismissed Ultrasoft's claims. The parties agreed that each of the claims depended on whether the public had had access to the relevant files while they remained on Hubcreate's server. Although one client of Hubcreate (UBC) had inadvertently been granted such access, the evidence showed that it had not been possible for any customer other than UBC to gain access to Ultrasoft's files. Although there was no consensus between the parties as to what scale of access translated into infringement, it was agreed that it must be more than just UBC. As only UBC had had access to Ultrasoft's files (having been given system administrator access to the Hubcreate server in error), the Judge found that Hubcreate had not infringed Ultrasoft's rights beyond the infringements already admitted.

High Court finds an eight-second clip can be a substantial part of a broadcast/film

***England and Wales Cricket Board ("ECB") & Anr ("Sky") v Tixdaq Ltd & Anr** (Arnold J; [2016] EWHC 575 (Ch); 18.03.16)**

Arnold J held that the use of an App offering the ability to upload and view clips featuring highlights of cricket matches infringed copyright in the TV broadcast and films contained within that broadcast.

The ECB and Sky were the copyright owners in television broadcasts of cricket matches organised by the ECB, and films made during the course of such broadcasts (for example, action replays). The Defendants developed an App which allowed users to upload screen captured clips of broadcast footage and to add commentary to the clips they uploaded. The content could then be shared with other users.

The ECB and Sky alleged that, by using the App, users committed acts which infringed copyright, and that the Defendants were jointly liable with the users for such acts. The Defendants did not dispute the issue of joint liability, subject to the impact of mere conduit/hosting defences under **Articles 12 and 14** of **Directive 2000/31/EC** (the **E-Commerce Directive**). As some of the clips were made and uploaded by the Defendants' employees and contractors, the Defendants were also said to be primarily liable for infringement. The Defendants also relied on the fair dealing defence of reporting current events under **Section 30(2) CDPA**.

Substantial Part

Arnold J noted that broadcast and film rights had no requirement for originality in order for copyright to subsist. Nonetheless, **Arnold J** held that an approach parallel to the "intellectual creation" test set out in **Case 5/08 (*Infopaq I*)** should be applied. This meant that parts of films and broadcasts were protected if they contained elements reflecting the rationale for their protection i.e. the investment made by the broadcaster or producer. This required both a quantitative and qualitative assessment of the part of the work reproduced.

The clips used by the Defendants were (at most) eight seconds long taken from broadcasts or films which were around two hours long. Quantitatively this was not a large proportion. However from a qualitative perspective the clips were typically of highlights of the matches such as wickets and appeals and therefore were of interest and value. **Arnold J** held that this meant each such clip substantially exploited the Claimants' investment in producing the relevant broadcast or film and therefore constituted a substantial part.

Fair dealing

Arnold J held that a sporting event such as a cricket match was a “current event” within the meaning of **Section 30(2)** therefore, as the majority were uploaded "near-live" in relation to matches, the clips qualified as being in relation to a current event. This was not the case in respect of interviews or analysis of matches. However, **Arnold J** held that the clips were presented for consumption because of their value, rather than to inform the audience about current events and for this reason the infringing acts were not "for the purpose of reporting". **Arnold J** also held that, in any event, the use was not fair dealing because, amongst other things, it conflicted with the ECB and Sky's exploitation of the works.

Mere conduit / hosting

The App service did not merely involve transmission of information but also storage, meaning the mere conduit defence was inapplicable. Many of the clips uploaded to the App were subject to editorial review by the Defendants, or even uploaded by the Defendants' employees, and **Arnold J** held that the hosting defence was not available to the Defendants in respect of these clips. Although the point was not fully argued, **Arnold J** took the provisional view that the hosting defence would be available in respect of user-posted clips which were not editorially reviewed.

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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.euro.pa.eu/jcms/jcms/j_6/home