

TRADE MARKS

Decisions of the GC and CJ

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-567/14 <i>Group OOD v EUIPO; Kosta Iliev</i> (29.06.16) Reg 207/2009</p>	 <p>- advertising and business management services (35) - transportation services (39) - providing accommodation and food and drink (41)</p>  <p>- transport services (39) (unregistered mark used in the course of trade in Bulgaria, Czech Republic, Hungary, Poland and Slovenia)</p>	<p>The GC annulled the BoA's decision to reject an opposition under Art 8(4) because of a lack of evidence of the applicable national law.</p> <p>The BoA confirmed the decision to dismiss the opposition on the basis that Group OOD had failed to submit proof of the applicable national law and relevant provisions on which it based its opposition.</p> <p>The GC confirmed that the BoA should have taken into consideration the reference Group OOD had made to Article 12(6) of the national Bulgarian Law within its Grounds of Appeal.</p> <p>Reg 207/2009 did not mandate the manner in which the content of national legislation must be identified and Rule 19(2)(d) did not provide an exhaustive list of documents which may support a claim under Art 8(4).</p> <p>The BoA was therefore incorrect to restrict the exercise of its discretion under Art 72(6) and the GC annulled the contested decision on the basis that Group OOD had fulfilled its obligation to produce elements of national law.</p>
<p>GC cases T-429/15 and T-567/15 <i>Monster Energy Company v EUIP, MadCatz Interactive, Inc</i> (14.07.16)</p>	  <p>- clothing, footwear, headgear (25)</p>  	<p>The GC upheld the BoA's finding that there was no likelihood of confusion between various combination marks under Art 8(1)(b) and Art 8(5).</p> <p>The GC held that the marks were visually dissimilar or at best had a low degree of visual similarity. Comparing the marks as representations of claw marks was insufficient to establish visual similarity as this required intellectual effort on the part of the relevant public. Such effort was unlikely to be made as a result of the significant and unusual differences between the marks. A phonetic comparison could not be made. Conceptually, whilst the</p>

	 <p>- clothing, headgear (25) (EUTM and International registration designating the EU)</p>	<p>marks applied for may be perceived as a series of scratches by the Anglophone part of the relevant public it was probable that they would be perceived as white paint strokes on a black background. Overall, the marks were therefore conceptually different.</p> <p>The BoA was correct to find that there was no likelihood of confusion under Art 8(1)(b) and the GC endorsed the BoA's decision to dismiss the appeal on the basis of Art 8(5) on the basis that the marks lacked similarity.</p>
<p>GC T-371/15 Preferisco Foods Ltd v EUIPO; Piccardo & Savore' Srl (14.07.16)</p>	 <p>- food products, namely edible oils, processed and dried vegetables, antipasto; processed and dried fruit and nuts, jam and fruit spreads (29)</p> <p>- food products, namely pasta, lasagne, flour-based gnocchi, pasta sauces, tomato sauces, spices, capers, rice, cornmeal, biscuits, bread sticks; baking products, namely Italian specialty yeasts; mustard; condiments (30)</p> <p>- non-alcoholic beverages, namely, fruit nectars, fruit juices and mineral water (32)</p> <p>I PREFERITI</p> <p>- meat, fish, poultry and game; preserved, frozen, dried and cooked fruits and vegetables; edible oils and fats (29)</p> <p>- flour and preparations made from cereals, bread, pastry and confectionery; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices (30)</p> <p>- alcoholic beverages (except beers) (32)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b) as regards the goods in Classes 29 and 30.</p> <p>The GC endorsed the BoA's decision that the marks were visually similar. The letter 'i' at the start of the earlier mark was not particularly distinctive, such that the dominant element was 'preferiti'. The figurative elements of the mark applied for were insufficient to prevent it being perceived by the relevant consumers as containing the word 'preferisco', which coincided with the first seven letters of the earlier mark. The marks were also phonetically similar: the differences between the marks would not change the intonation or rhythm of pronunciation of the common element 'preferi'. A conceptual comparison of the marks was not possible as neither mark carried a meaning for the relevant public. No evidence had been presented which suggested otherwise.</p> <p>In light of the similarity of the marks, the similar or identical nature of the goods in Class 29 and 30 and the average level of distinctiveness of the earlier mark and the mark applied for, the BoA had been correct to find a likelihood of confusion.</p>

<p>GC T-742/14 <i>Alpha Calcit Füllstoffgesellschaft mbH v EUIPO; Materis Paints Italia SpA</i> (19.07.16) Reg 207/2009</p>	<p>CALCILITE</p> <ul style="list-style-type: none"> - paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins (2) - pargets (19) <p>CALCILIT</p> <ul style="list-style-type: none"> - crystalline calcium carbonate as a filler (CCCF) (1) - marble in the form of granules, grains and powders (19) 	<p>The GC partially upheld an appeal against the BoA's refusal to invalidate the mark applied for on the basis of a likelihood of confusion between the marks pursuant to Art 8(1)(b) and Art 8(5).</p> <p>The BoA's conclusions regarding insufficient proof of use of the earlier mark in respect of Class 19 goods were upheld. The arguments regarding Art 8(5) were rejected as inadmissible as they had not been raised before the BoA.</p> <p>The GC endorsed the BoA's reasoning that there was no similarity between CCCF and raw natural resins as they had different industrial functions and were not in competition. CCCF was deemed to be different to pargets as these goods did not share the same relevant public.</p> <p>The BoA erred in its assessment that CCCF was a raw material intended for industrial use whereas the remaining Class 2 goods at issue (namely 'paints, varnishes, lacquers; preservatives against rust and deterioration of wood; colourants; mordants') were finished products intended for use by end consumers. The fact that goods were described as finished products did not mean they may not be used in an industrial process for the manufacture of other products. The BoA therefore failed to correctly identify the relevant public for the purposes of assessing the likelihood of confusion, which did not extend beyond professionals in the industrial sector. As a result of this failure, the BoA incorrectly concluded that there was no similarity between the remaining Class 2 goods and CCCF.</p> <p>In light of this assessment, the GC upheld the appeal regarding the remaining Class 2 goods on the basis of a likelihood of confusion for the relevant public, but rejected the remainder of the appeal.</p>
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<p>GC T-745/14 TeamBank AG Nürnberg v EUIPO; Easy Asset Management AD (20.07.16) Reg 207/2009</p>	 <p>- financial affairs, monetary affairs, insurance, real estate affairs (36)</p> <p>- providing and transmission of data, information, news, music and images for access via computer and telecommunication networks (38)</p> <p>(international registration designating the EU)</p>  <p>- insurance services, financial services, monetary affairs, real estate affairs (36)</p> <p>- telecommunication services (38)</p> <p>(Bulgarian mark)</p>	<p>In invalidity proceedings, 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 parties had not disputed the BoA's finding that the services at issue were identical. The BoA was correct to find a strong visual similarity between the marks. The figurative elements of the earlier mark were of lower importance because of the size, position and purely decorative shape. The fonts were very common and, due to their size and position, the word elements of the marks could not be regarded as negligible.</p> <p>The GC confirmed the BoA's decision that the marks were phonetically identical. The word elements, being the only elements of the marks at issue likely to be pronounced, were identical as the symbol '@' would easily be understood and pronounced as the letter 'a'.</p> <p>The BoA was also correct to find that the signs at issue were conceptually identical as the figurative elements had no conceptual meaning and the word elements were identical. This assessment applied irrespective of the relevant Bulgarian public's knowledge of English.</p>
<p>GC T-804/14 Tadeusz Ogrodnik v EUIPO; Aviário Tropical, SA (21.07.16) Reg 207/2009</p>	 <p>- veterinary, therapeutic, disinfecting and sanitary products and preparations for use in aquaristics, terraristics, fauna breeding and flora cultivation (5)</p> <p>- food in the form of flakes, granulates, grains, extrudates and tablets, dried and lyophilised natural food for fauna, especially for fish, ornamental fish, birds, reptiles, amphibians and bred small animals, food for fauna containing nutritives, products and preparations for the</p>	<p>The GC annulled the BoA's decision that there was a likelihood of confusion between the marks under Art 53(1)(a) and Art 8(1)(b).</p> <p>The BoA had been wrong to find that the list of goods in Class 31 for the contested mark could be reduced to the general category 'food for fauna'. The use of the word 'especially' in the specification did not denote all the goods subsequently listed as examples of the preceding category. In particular 'products and preparations for the cultivation of plants and aquarium plants' was a distinct category of goods from 'food for fauna'.</p> <p>The BoA had also not been entitled to conclude (on basis of the evidence before it) that the goods in Class 5 for</p>

	<p>cultivation of plants and aquarium plants and for the breeding of fish, ornamental fish, birds, reptiles, amphibians and bred small animals, excluding bird feed and bird treats (31)</p> <p>TROPICAL</p> <p>- food for fish, live fish and live plants (31)</p> <p>(Portuguese mark)</p>	<p>the contested mark were similar to those listed in Class 31 for the earlier mark. Whilst the same category of persons may in fact purchase both categories of goods, this on its own was not sufficient evidence to entitle the BoA to conclude that the goods were similar.</p> <p>The BoA had correctly found the marks to be similar but the finding of a likelihood of confusion was invalidated in the light of the incorrect assessment of the similarity of the goods. The GC confirmed that the BoA should have also taken into account Mr. Ogrodnik's submissions in relation to co-existence of the marks as a relevant factor in its assessment of the likelihood of confusion. The BoA's decision was vitiated by a failure to state reasons and was therefore annulled.</p>
<p>CJ</p> <p>C-226/15 P</p> <p>Apple and Pear Australia Ltd; Star Fruits Diffusion v EUIPO; Carolus C. BVBA</p> <p>(21.07.16)</p> <p>Reg 207/2009</p>	<p>ENGLISH PINK</p> <p>- fresh fruit and vegetables (31)</p> <p>PINK LADY</p> <p>- agricultural, horticultural products, including fruit, grains, plants and trees, in particular apples and apple trees (31)</p>  <p>- fresh fruit; apples, fruit trees; apple trees (31)</p>  <p>- agricultural, horticultural products, including fruit, grains, plants and trees, in particular apples and apple trees (31)</p>	<p>The CJ endorsed the GC's finding that the principle of res judicata did not mean that the BoA was bound in opposition proceedings by the decision on infringement of the Brussels Commercial Court.</p> <p>In infringement proceedings before the Belgian court, the Benelux mark ENGLISH PINK was annulled and Carolus C. BVBA was ordered to refrain from using the mark in the EU.</p> <p>In opposition proceedings, the GC annulled the BoA's decision (reported in <i>CIPA Journal</i>, April 2015) to reject the opposition on the basis that there was no likelihood of confusion and held that the BoA had failed to take the judgment of the Belgian court into account. However, the GC refused to alter the decision of the Opposition Division.</p> <p>The CJ confirmed that the conditions for res judicata were cumulative, namely the identity of the parties, the subject matter and cause of action. The GC had not erred in its decision as the subject matter of the proceedings before the Belgian court and those before the EUIPO were different.</p> <p>The CJ dismissed the appeal in its entirety.</p>

Relevant considerations for evidence submitted out of time

EUIPO v Xavier Grau Ferrer (CJ (First Chamber) Case C-597/14; 21.07.16)

The CJ has held that the EUIPO should have considered whether evidence submitted to support proof of genuine use was 'supplementary' before rejecting such evidence on the basis that it was submitted out of time.

Mr Grau Ferrer opposed an application by J.C. Rubio Ferrer and A. Rubio Ferrer for the registration of the following figurative sign, which included the word elements 'Bugui va' in respect of goods and services in Classes 31, 35 and 39.



The opposition relied on two earlier figurative marks which included the word element 'Bugui'.



(EUTM and Spanish national mark)

The opposition was partially upheld but, on appeal, the BoA rejected the opposition in its entirety on the basis that: (1) no evidence to support the existence of the earlier Spanish mark had been produced and (2) the evidence produced in respect of the earlier EUTM was insufficient to show that the earlier mark had, during the relevant period, been put to genuine use in the form registered and in relation to the relevant goods and services. The GC annulled the decision of the BoA on the basis that the EUIPO had failed to exercise its discretion under **Article 76(2)** or to give reasons for its refusal to take account of the earlier Spanish mark. The GC further held that the BoA had erred in its decision to dismiss evidence submitted in respect of the earlier EUTM - the evidence contained a sign which only differed from the earlier EUTM by negligible elements and was therefore sufficient to demonstrate genuine use of that mark.

The CJ confirmed that, when proof of use of a mark is not submitted within the time limit set by the EUIPO, the opposition must automatically be rejected. Where evidence was submitted within the time limit, the production of supplementary evidence remained possible. The CJ found that the GC had erred in law in its decision that the BoA had failed to exercise its discretion to decide whether or not it was appropriate to take additional evidence into consideration, but had been correct to find that the actions of the BoA infringed **Article 76(2)** as it had rejected the evidence at issue without examining whether it could be regarded as 'supplementary'. The CJ therefore dismissed the appeal in its entirety.

IPEC refuses to overturn PLAYBOY UDRP decision

Michael Ross v Playboy Enterprises International, Inc. ("PEI")* (Amanda Michaels; [2016] EWHC 1379 (IPEC); 13.06.16)

Amanda Michaels (sitting as a Deputy Enterprise Judge) refused Mr Ross's application for a declaration that he had not infringed PEI's PLAYBOY trade marks or passed off by registering the domain name 'playboy.london' (the "domain name").

PEI wrote to Mr Ross claiming that the PLAYBOY trade mark had come to be associated by the general public with PEI. However, Mr Ross responded that the definition of a "playboy" was "*a man who pursues a life of pleasure without responsibility or attachments, especially one who is of comfortable means*", and claimed that he had been described as a playboy. He denied having registered the domain name in bad faith as PEI claimed, and denied that there was any likelihood of confusion or deception. As he stated that he did not (and was prepared to undertake not to) use the trade mark PLAYBOY in relation to any goods or services, he refused to transfer the domain name to PEI and cease all use of the PLAYBOY mark as PEI had requested.

PEI subsequently filed a complaint under the UDRP, which was upheld. The sole panellist held that Mr Ross had been aware of the PLAYBOY mark at the time he registered the domain name, and had failed to prove that he was known by the name 'playboy' or that he had any other bona fide reason for registering the domain name. The panellist noted that even the passive holding of a domain name could amount to use of it in bad faith.

Amanda Michaels held that the Court did not have jurisdiction to overturn the panellist's decision. While it may have had the power to determine the substantive dispute between the parties, no separate cause of action had been identified and, therefore, to grant such a declaration would amount to granting an appeal against the panellist's decision. Nor was there, in her view, any basis for finding that the panellist was not entitled to reach the decision he did.

In relation to Mr Ross's claim that PEI's letter to him had constituted an unjustifiable threat under **Section 21**, **Amanda Michaels** accepted PEI's contention that Mr Ross was not "a person aggrieved" within the meaning of that provision. As any trade mark infringement proceedings could only have related to use of the domain name in relation to goods or services, Mr Ross could not be "a person aggrieved" as he had no commercial interest in the domain name. However, the deputy judge said that if she was wrong on this point, she would have found that PEI's letter constituted an unjustified threat.

Nevertheless, she found that registration of the domain name by Mr Ross amounted to an act of passing off, and refused to grant a declaration that the registration, use and proposed use of the domain name had not infringed and would not infringe PEI's trade marks. This was on the basis that such a declaration would have the effect which **Mann J** deprecated in *Toth v Emirates* [2012] EWHC 517, i.e. it would amount to an attempt to circumvent the Court's lack of any jurisdiction to revisit the panellist's decision. Furthermore, in light of a finding of passing off, it was doubtful that such a declaration would serve any useful purpose.

DESIGNS

UK unregistered design rights in sofa found infringed but passing off claim rejected

***Raft Ltd v Freestyle of Newhaven Ltd & Ots** (Judge Hacon; [2016] EWHC 1711 (IPEC); 13.07.16)**

Judge Hacon held that Freestyle and the third defendant, Highly Sprung, had infringed Raft's UK unregistered design right in its wide-arm 'Loft' sofa. However, Raft's claims for infringement of its unregistered design rights in its skinny-arm Loft sofa, and for passing off, were dismissed. The defendants' counterclaim for infringement of another sofa design also failed.

Raft was a manufacturer and retailer of furniture with a flagship store on Tottenham Court Road in London. Freestyle was a manufacturer of sofas and Highly Sprung operated a furniture retail store in Tottenham Court Road, immediately adjacent to Raft's store.

The Judge accepted the evidence of Raft's director that he largely created the wide-arm Loft design in the process of explaining to Freestyle's managing director (Mr Horsnell) what he wanted by way of a new sofa. Although the Judge accepted that the design of sofas was a field in which competing designs could be quite close, he found that Raft's director had at the time been exercising his skill as a furniture designer in a manner that was sufficient to create an original design. However, the change in design required to produce the slim-armed sofa was found to be too minor and localised to give rise to a newly original design in the sofa as a whole.

As Freestyle admitted that it made sofas to the wide-arm Loft sofa design for supply to Highly Sprung, the Judge held that Freestyle had infringed Raft's UK registered design right. He went on to find that Highly Sprung was liable for secondary infringement through possession and sale under **Section 227**. Merely because Mr Hornsell (who became managing director of Highly Sprung) had believed that the Loft sofas were copies of another third party design did not amount to lack of knowledge or reason to believe within the meaning of **Section 227**. Therefore Highly Sprung and Mr Hornsell were found jointly liable.

Judge Hacon rejected Raft's claim that the defendants had passed off their sofas as Raft sofas by a combination of three means: (1) by selling three styles of sofa identical in shape to three styles sold by Raft, (2) by using the same names for those sofas as Raft used for its equivalent sofas (Loft, Manhattan and Lincoln); and (3) by Highly Sprung repainting the exterior of its store in a style which resembled the appearance of Raft's store next door. The Judge found nothing in the evidence which supported Raft's claim of a misrepresentation. While customers had commented to Raft that Highly Sprung's sofas were identical to Raft's but cheaper, there was no evidence that a significant proportion of the public were misled about the existence of a trade connection between Raft and Highly Sprung as retailers, or about the maker of Highly Sprung's sofas.

Finally, the Judge rejected Mr Hornsell's counterclaim that Raft had infringed his UK unregistered design right in the overall design of a sofa called 'Combi' by making and selling its 'Manhattan' sofa. Although he found that the Combi design was original and that design right subsisted in it, Mr Hornsell had created it in the course of his employment for the benefit of a former Freestyle company which had since been liquidated. As there had been no assignment of the design right to any of the defendants before it went into liquidation, none had a cause of action.

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