





## TRADE MARKS



## Decisions of the GC and CJ

| Ref no.   | Application (and where applicable, earlier mark)   | Comment   |
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| <p>CJ</p> <p><b>C-442/15 P</b></p> <p><i>Pensa Pharma SA v EUIPO; Ferring BV and Ots</i></p> <p>22 September 2016</p> <p>Reg 207/2009</p>       |  <p>- pharmaceutical and veterinary preparations; dietetic substances adapted for medical use, food for babies; plasters; fungicides, herbicides (5)</p> <p>- medical services and consultancy in the field of pharmacy (44)</p> <p><b>PENTASA</b></p> <p>- pharmaceutical preparations (5)</p> <p>(various national registrations)</p> | <p>In invalidity proceedings, the CJ upheld the GC's decision that there was a likelihood of confusion between the marks under Article 8(1)(b).</p> <p>The CJ confirmed that it was for Pensa Pharma to file evidence to support its submission that two of the earlier PENTASA registrations had expired prior to the BoA hearing - the GC was not under a duty to examine the status of registrations relied on within the invalidity application of its own motion.</p> <p>The GC had erred in dismissing Pensa Pharma's submission that Ferring BV's arguments before the GC attempted to revise the factual and legal context of the proceedings as inadmissible. The error, however, did not have an impact on the operative part of the judgment.</p> <p>The CJ dismissed the submission that the GC had found a likelihood of confusion between the marks under Article 8(1)(b) on the basis of an artificial division of the mark and confirmed that Pensa Pharma was not entitled to obtain a re-examination of the factual assessment by the GC on appeal, which was necessarily limited to points of law.</p> |
| <p>GC</p> <p><b>T-449/15</b></p> <p><b>T-450/15</b></p> <p><i>Satkirit v EUIPO; Advanced Mailing Solutions Ltd</i></p> <p>27 September 2016</p> | <p><b>LUVO</b></p> <p><b>LUVOWORLD</b></p> <p>- mobile phones; tablets; computers; portable communication devices (9)</p> <p>- telecommunications services; providing user access to the internet (38)</p> <p><b>LUVO</b></p> <p>- design and development of computer hardware and</p>   | <p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Article 8(1)(b).</p> <p>The BoA correctly assessed the relevant public as comprising the general public and professionals, whose degree of attention fluctuated between normal and higher-than-average.</p> <p>The GC endorsed the BoA's assessment of similarity of the class 9 goods and class 42 services at issue, and confirmed they were functionally complementary,</p>   |



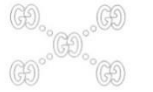

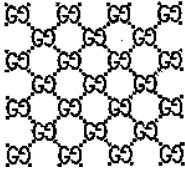
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| <p>Reg 207/2009</p>   | <p>software (42)</p>  | <p>targeted at the same relevant public and shared distribution channels, as both were frequently provided in the same specialist physical/online retail outlets.</p> <p>The BoA was therefore correct to find a likelihood of confusion, taking into account the normal level of distinctive character of the earlier mark, the weak distinctive character of the additional 'world' element and the identity/high levels of similarity between the marks.</p>   |
| <p>GC<br/><b>T-400/15</b><br/><i>Ana Isabel Pinto<br/>Eliseu Baptista<br/>Lopes Canhoto v<br/>EUIPO;</i><br/><i>University<br/>College London</i><br/>28 September<br/>2016<br/><br/>Reg 207/2009</p> | <p><b>CITRUS SATURDAY</b><br/><br/>- clothing; headgear;<br/>footwear; t-shirts; polo<br/>shirts; shirts; blouses;<br/>sweatshirts; jumpers;<br/>hooded jumpers; aprons;<br/>caps; hats; wrist bands;<br/>headbands; socks; jackets;<br/>scarves (25)</p> <p><b>CITRUS</b><br/><br/>- clothing; footwear;<br/>headgear; belts (25)</p> <p>(Portuguese mark)</p>   | <p>The GC dismissed the appeal on the basis that Ms Canhoto had failed to prove the existence, validity and scope of protection of the earlier mark as required under Rule 19 of Regulation 2868/95.</p> <p>The requirements to substantiate the earlier mark were set out precisely and exhaustively under Rule 19(2), (3) and (4) and documents submitted outside the period referred to in Rule 19(1) could only be admitted at the discretion of the BoA, pursuant to Article 76(2). That discretion was to be exercised restrictively and, in the circumstances, there was no legitimate reason for the delay in the submission the documents.</p>   |
| <p>GC<br/><b>T-476/15</b><br/><i>European Food v<br/>EUIPO; Société<br/>des produits<br/>Nestlé</i><br/>28 September<br/>2016<br/><br/>Reg 207/2009</p>   | <p><b>FITNESS</b><br/><br/>- milk; cream; butter;<br/>cheese; yoghurts and other<br/>milk-based food<br/>preparations; substitutes for<br/>dairy products; eggs; jellies;<br/>fruit; vegetables; protein<br/>preparations for human<br/>consumption (25)</p> <p>- cereals and cereal<br/>preparations; ready-to-eat<br/>cereals; breakfast cereals;<br/>foodstuffs based on rice or<br/>flour (30)</p> <p>- still water; aerated or<br/>carbonated water; spring<br/>water; mineral water; fruit<br/>drinks; fruit juices; nectars;<br/>lemonades; sodas and other<br/>non-alcoholic drinks;<br/>syrups and other<br/>preparations for making</p> | <p>In invalidity proceedings, the GC held that the BoA had erred in finding that evidence submitted for the first time during the appeal was to be regarded as out of time pursuant to Rule 37(b)(iv) of Reg 2868/95.</p> <p>European Food applied to invalidate the mark for all goods in classes 29, 30 and 32 pursuant to Article 7(1)(b) and 7(1)(c). Further evidence concerning the filing date of the mark was submitted for the first time before the BoA.</p> <p>The GC held that neither Rule 37(b)(iv) nor Reg 207/2009 imposed time limits for the submission of evidence in invalidity proceedings based on absolute grounds. An application for a declaration of invalidity needed only to include evidence to support the grounds on which it was based.</p> <p>The BoA had exercised its discretion under Article 76(2) and disregarded the</p> |

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|   | <p>syrops and other preparations for making beverages (32)</p>  | <p>later filed evidence as having been submitted out of time. The GC annulled the decision on the basis that it was not inconceivable that the later filed evidence may have modified the substance of the BoA's decision.</p>   |
| <p>GC<br/><b>T-593/15</b><br/><i>The Art Company B &amp; S, SA v EUIPO; G-Star Raw CV</i><br/>28 September 2016<br/><br/>Reg 207/2009</p> | <p><b>THE ART OF RAW</b></p> <ul style="list-style-type: none"> <li>- bags; rucksacks; purses; wallets; trunks and travelling bags; umbrellas (18)</li> <li>- clothing; footwear; headgear; belts (25)</li> <li>- retail (store) services in relation to the above goods</li> </ul> <p style="text-align: center;"></p> <ul style="list-style-type: none"> <li>- clothing, footwear (except for orthopaedic shoes), headgear, in particular boots, shoes, sandals and slippers (25)</li> <li>- retailing via global computer networks, retailing of clothing, footwear in relation to the above goods (35)</li> </ul> <p style="text-align: center;"></p> <ul style="list-style-type: none"> <li>- clothing, footwear, headgear (25)</li> </ul> <p>(EUTM and Spanish marks)</p> | <p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks pursuant to Article 8(1)(b).</p> <p>The additional word or figurative elements and the length and structure of the marks created only a remote visual similarity notwithstanding the common word 'art'. There was no phonetic similarity. The GC confirmed that the earlier mark might be understood as a conceptual reference to 'art' in general, whereas the mark applied for evoked the idea of a specific art. This difference would be understood by the relevant public, being both English and Spanish general public and business customers with professional knowledge, including those with a below average command of the English language.</p> <p>The BoA was correct to find that 'art' was a laudatory term used to promote a characteristic of artistic and pleasurable goods and therefore had weak distinctive character. As such, this element did not constitute the dominant element of the earlier marks nor was it decisive as to the overall impression.</p> <p>The identity and similarity of the goods could not offset the very low degree of similarity between the marks. A likelihood of confusion could not be established.</p> |
| <p>GC<br/><b>T-362/15</b><br/><i>The Lacamanda Group Ltd v EUIPO; Nigel Woolley</i><br/>28 September 2016<br/><br/>Reg 207/2009</p>       | <p><b>HENLEY</b></p> <ul style="list-style-type: none"> <li>- optical apparatus and instruments (9)</li> <li>-precious metals and their alloys and goods in precious metals or coated therewith (14)</li> <li>- leather and imitations of leather and goods made of these materials (18)</li> </ul>   | <p>The GC annulled the BoA's decision on the basis that it had infringed Article 8(5).</p> <p>In its assessment of whether the earlier mark had a reputation, the BoA restricted its analysis to the existence of injury only and failed to take into account the degree of similarity between marks at issue and the strength of the earlier mark's reputation.</p> <p>As a result, the BoA neither concluded that the earlier mark had a reputation</p>  |

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|  | <p><b>HENLEYS</b></p> <ul style="list-style-type: none"> <li>- t-shirts, jeans, shirts, skirts, trousers, jackets (25)</li> <li>- the bringing together, for the benefit of others, a variety of T-shirts, jeans, shirts, skirts, trousers and jackets (35)</li> </ul> <p>(EUTM and UK national marks)</p>  | <p>nor adopted the detailed analysis of the cancellation division. The GC was not entitled to assess the reputation of the mark, so annulled the BoA's decision in its entirety.</p>  |
| <p>GC</p> <p><b>T-430/15</b></p> <p><i>Flowil International Lighting (Holding) BV v EUIPO; SC Lorimod Prod Com, Srl</i></p> <p>30 September 2016</p> <p>Reg 207/2009</p> |  <p>- meat, poultry and game; meat extracts; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats (29)</p> <p>- coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; mustard; vinegar, sauces (condiments); spices; ice (30)</p> <p><b>SYLVANIA</b></p> <ul style="list-style-type: none"> <li>- various goods relating to lighting in classes 7, 9, 10 and 11</li> <li>- design services and consultation services, all relating to lighting and lighting technology (42)</li> </ul> <p>(EUTM and non-registered marks used in the course of trade - <i>Art 6 bis</i>)</p> | <p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks at issue pursuant to Article 8(1)(b) and confirmed the mark applied for did not take unfair advantage of the earlier marks under Article 8(5).</p> <p>The BoA was correct to find that the goods in classes 29 and 30 were dissimilar to the goods and services in classes 7, 9, 10, 11 and 42 covered by the earlier marks as they did not share a common nature, purpose or intended use. The goods and services were not in competition with nor complementary to each other as there was no close connection between them.</p> <p>The BoA was also correct to find that the mark applied for did not take unfair advantage of the distinctive character or the repute of the earlier marks. The GC found that although the mark applied for was similar overall to the earlier marks, the earlier marks only had a weak reputation in relation to goods in classes 9, 10 and 11. The BoA was right to conclude that a link between the marks could not be established due to a lack of any similarity between the goods and services. As such, the opposition on the basis of Article 8(5) could not be maintained.</p> |
| <p>GC</p> <p><b>T-355/15</b></p> <p><i>Alpex Pharma SA v EUIPO; Astex Pharmaceuticals, Inc.</i></p>  | <p><b>ASTEX</b></p> <ul style="list-style-type: none"> <li>- drug discovery and development services; biotechnology research; scientific analysis; providing scientific information in the field of pharmaceuticals and</li> </ul>  | <p>The GC upheld the BoA's decision that genuine use of the earlier mark had not been demonstrated pursuant to Article 42 and that, as a result, the opposition based on Article 8(1)(b) could not succeed.</p> <p>The BoA was correct to conclude that</p>   |

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| <p>30 September 2016</p> <p>Reg 207/2009</p>   | <p>clinical trials (42)</p> <p><b>ALPEX</b></p> <p>- scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services (42)</p>   | <p>whilst the evidence showed use of ALPEX in relation to research on or development of pharmaceutical products or nutritional supplements, it did not prove that Alpex Pharma SA had conducted such work for external clients. The BoA did not err in finding that the evidence was insufficient to establish genuine use of the earlier mark in relation to the class 42 services.</p> <p>It was clear from the BoA's decision that it had met the requirement to state the reasons for its decision and had met its obligations to examine all the facts, evidence and arguments submitted to it.</p>  |
| <p>GC</p> <p><b>T-549/15</b></p> <p><i>Lidl Stiftung &amp; Co. KG v EUIPO; Horno del Espinar, SL</i></p> <p>4 October 2016</p> <p>Reg 207/2009</p> | <p><b>CASTELLO</b></p> <p>- baking ingredients; foodstuffs for flavouring (29)</p> <p>- flour and preparations made from cereals, sugar, salt, cocoa, starch for food, decorative chocolate and confectionery, yeast, raising agents for baking, confectionery products (30)</p> <p>- poppy seeds, nuts and almonds of all kinds; fresh fruits (31)</p>  <p>- flour and preparations made from cereals; honey; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice (30)</p> <p>- services of distribution, storage, transport and packaging of food items (39)</p>  <p>- industrial patisserie and confectionery (30)</p> <p>(EUTM and Spanish national marks)</p> | <p>The GC partially annulled the BoA's decision that there was a likelihood of confusion in relation to class 29 goods pursuant to Article 8(1)(b).</p> <p>The BoA was correct to find a strong visual and phonetic similarity and no conceptual difference between the marks at issue.</p> <p>However, the BoA erred in finding that frozen fruits and vegetables covered by the mark applied for were similar to 'sauces (condiments)' covered by the earlier mark. The GC held that as frozen fruits and vegetables were sold in specific departments or shops and were closer to fresh goods sold in raw form than to cooked goods as a result of the limited/lack of processing used.</p> <p>As such there was no likelihood of confusion in respect of these goods.</p> |

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| <p>GC<br/> <b>T-456/15</b><br/> <i>Foodcare sp. z o.o. v EUIPO; Dariusz Michalczewski</i><br/> 5 October 2016<br/> Reg 207/2009</p>                                    | <p><b>T.G.R. ENERGY DRINK</b><br/> - non-alcoholic drinks, mineral water, cooling and energy drinks (32)<br/> <b>DARIUSZ TIGER MICHAELCZEWSKI</b><br/> - mineral water, isotonic drinks (32)</p>   <p>- goods in class 32<br/> (EU and Polish national marks)</p>  | <p>The GC upheld the BoA's decision that the mark applied for was invalid on the ground of bad faith under Article 52(1)(b).</p> <p>The BoA was correct to take into account an agreement between Foodcare and Dariusz Michalczewski (a former professional boxer) predating the application for the mark, which authorised Foodcare to use the boxer's image and nickname 'Tiger' to promote energy drinks.</p> <p>Taking into account the get-up of the Tiger Energy Drink, the GC confirmed there was a clear intention for Foodcare to circumvent its contractual remuneration obligations arising under the agreement by creating an association between the mark applied for and the Tiger Energy Drink product. Foodcare also intended to benefit from the reputation of the product. The application had therefore been made in bad faith and the GC declared the registration to be invalid pursuant to Article 52(1)(b).</p> |
| <p>GC<br/> <b>T-350/15</b><br/> <i>Perry Ellis International Group Holdings Ltd v EUIPO; CG Verwaltungsgesellschaft mbH</i><br/> 11 October 2016<br/> Reg 207/2009</p> |  <p>- clothing and accessories, namely, swimsuits, jackets, shorts, leotards, swimsuits, swim trunks, casual shirts, shorts, workout pants, warm-up shirts and suits, cover-ups, socks, sport bras, sweatshirts, sport shirts, T-shirts, underwear; headwear and footwear (25)</p>  <p>- articles for clothing (25)<br/> (German mark)</p> | <p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to Article 8(1)(b).</p> <p>The most distinctive and dominant element of the mark applied for was likely to be perceived as the letter 'p'. The marks were visually similar to an average degree because they were similar in structure and shared stylisation.</p> <p>The marks were phonetically identical if they were perceived and pronounced as a letter 'p'. A conceptual comparison was not possible.</p> <p>The GC rejected the submission that the earlier mark had weak, rather than average, distinctive character.</p> <p>Taking into account the normal level of attention of the relevant public and the identity or high degree of similarity of the goods, the BoA was correct to find a likelihood of confusion.</p>  |

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| <p>GC<br/> <b>T-753/15</b><br/> <i>Guccio Gucci SpA v EUIPO; Guess? IP Holder LP</i><br/> 11 October 2016<br/> Reg 207/2009</p> |  <p>- decorative and protective covers and cases for portable electronic devices, (9)</p>     <p>- apparatus for recording, transmission or reproduction of sound or images (9)</p> <p>- leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas and parasols (18)</p> <p>- clothing, footwear, headgear (25)</p> | <p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks pursuant to Article 8(1)(b).</p> <p>The marks at issue created different visual impressions in light of the stylisation and positioning of the elements in the mark applied for. The relevant public would retain the image of the mark applied for as a whole and would not perceive the capital letter G (represented by the earlier marks) independently from the overall impression of an abstract ornamental motif.</p> <p>As the mark applied for was a purely figurative sign, a phonetic comparison could not be carried out. Similarly, a conceptual comparison was not possible – as an abstract ornamental motif the mark applied for had no meaning and the earlier marks did not have any semantic content of their own.</p> <p>Based on the dissimilarity of the marks, it was not necessary to carry out a global assessment for the purposes of likelihood of confusion. The GC dismissed the opposition under Article 8(1)(b) and confirmed that there was no infringement of Article 8(5), given the dissimilarity of the marks.</p> |
| <p>GC<br/> <b>T-367/14</b><br/> <i>August Storck KG v EUIPO; Chiquita Brands LLC</i><br/> 18 October 2016<br/> Reg 207/2009</p> | <p><b>FRUITFULS</b></p> <p>- confectionary, chocolate, chocolate goods, pastry (30)</p>   | <p>The GC partially annulled the BoA's decision to revoke the mark for non-use in respect of confectionary pursuant to Article 51(1)(a).</p> <p>The GC held that hard fruit candies were not an independent subcategory of confectionary. Use in respect of confectionary was therefore sufficient to demonstrate genuine use of the mark in relation to the category as a whole.</p> <p>The BoA had imposed an excessive burden of proof by comparing the sales of hard fruit candies to the whole confectionary market in the EU and was wrong to have compared sales production figures in Slovenia and Germany to the wider EU market. In</p>  |

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|  |  | <p>doing so, the BoA had erred in concluding that the volume of sales was extremely low.</p> <p>It was not necessary for a mark to be used in an extensive geographic location or for its use to be a commercial success for use to be considered genuine.</p> <p>The BoA had not erred in finding that genuine use of the mark had not been demonstrated in relation to chocolate, chocolate products or pastry.</p>  |
| <p>GC</p> <p><b>T-56/15</b></p> <p><i>Raimund Schmitt Verpachtungsgesellschaft mbH &amp; Co. KG v EUIPO</i></p> <p>18 October 2016</p> <p>Reg 207/2009</p> | <p><b>BRAUWELT</b></p> <p>- various goods and services in classes 9, 16, 32, 35, 38, 41, 42 and 43</p>   | <p>The GC upheld the BoA's decision that the mark was descriptive within the meaning of Article 7(1)(c) and lacked distinctive character under Article 7(1)(b).</p> <p>The BoA was correct to find that the German word 'brauwelt' meant 'brewers' world' or 'world of brewing' and referred to a sales location or wide-ranging offer of goods and services linked to brewery activity. The BoA had examined the overall significance of the mark and was correct to find that the mark indicated the subject-matter of the goods and services. The mark was therefore descriptive of all goods and services pursuant to Article 7(1)(c).</p> <p>The BoA was therefore entitled to refuse the registration of the mark as it lacked distinctive character under Article 8(1)(b) without needing to provide a fuller statement of reasons.</p> <p>The GC was not able to restrict the category of 'magazines' to 'specialized magazines in the field of brewing' as this would change the target public and thus the factual context of the dispute.</p> |
| <p>GC</p> <p><b>T-693/15</b></p> <p><i>Clower Canyon, Inc. v EUIPO; Kaipa Sportswear GmbH</i></p> <p>20 October 2016</p> <p>Reg 207/2009</p>               | <p><b>CLOVER CANYON</b></p> <p>- tops, bottoms, shirts, pants, sweaters, headwear, shorts, swimwear, lingerie, underwear, jackets, coats, wraps, dresses, skirts, scarves (25)</p> <p><b>CANYON</b></p> <p>- woven, weft-knitted and</p> | <p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Article 8(1)(b).</p> <p>The GC endorsed the BoA's assessment that the marks were both visually and phonetically similar. Notwithstanding the additional word element 'CLOVER', the German-speaking public would largely understand the meaning of 'canyon'. The inclusion of 'clover', although less commonly-understood by</p>   |



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|  | warp-knitted clothing (25)<br>(German mark) | that public, did not preclude a finding of conceptual similarity.<br><br>The parties had not disputed that the relevant public was the general public with an average level attention, and that the goods at issue were identical. |
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## PASSING OFF

### Application to join additional defendants rejected

*Glaxo Wellcome UK Ltd & Anr v Sandoz Ltd\**

**Judge Hacon**; [2016] EWHC 2743 (Ch); 2 November 2016

Judge Hacon dismissed Glaxo's application to join two of Sandoz's group companies in its action for passing off.

Glaxo brought a claim for trade mark infringement and passing off against Sandoz relating to Sandoz's AirFluSal inhaler. In June 2016, Sandoz succeeded in an application for summary judgment on its counterclaim that Glaxo's EU trade mark was invalid ([2016] EWHC 1537 (Ch), reported in July [2016] CIPA xxx). The trade mark part of the claim was stayed pending an appeal but the passing off claim continued. Glaxo claimed that the AirFluSal inhaler passed off its Accuhaler, each of which is shown below:

The Accuhaler inhaler and packaging



The AirFluSal inhaler and packaging



Glaxo applied to join three further members of the Sandoz group in the proceedings: Sandoz International GmbH, Aeropharm GmbH, and Hexal AG. The first was joined by consent and therefore the Judge was only concerned with Aeropharm and Hexal. Glaxo applied to join the two parties because it claimed there was evidence to indicate that they had taken an active role in the creation of the design of the AirFluSal product and its packaging, and were therefore implicated as primary and/or joint tortfeasors, along with Sandoz, for passing off. In practical terms, Glaxo

wanted Aeropharm and Hexal to have to give disclosure of documents relating to the creation of the designs in issue. It was common ground that in order to join a party the court had to be satisfied that the proposed pleaded allegations against it disclosed a sufficiently arguable case.

#### Joint tortfeasance

Citing *Unilver plc v Gillette (UK) Ltd* [1989] R.P.C. 583 (CA), the Judge was of the view that an act of contributory infringement did not have to take place within the jurisdiction to amount to joint tortfeasorship. The question was whether either party had actively cooperated to bring about the sale or promotion of AirFluSal in England. The Judge found that, if by marketing AirFluSal at a medical conference in Amsterdam, Hexal had contributed anything to Sandoz's efforts to market AirFluSal in England, it was *de minimis*. Although he went on to find that Aeropharm and Hexal had, between them, facilitated the sale and promotion of AirFluSal products in England by (i) contributing to the design of the AirFluSal inhaler and its packaging, (ii) obtaining marketing authorisation in the UK through data collection, and (iii) carrying out trials as part of an EU-wide programme, as none of those amounted to actively cooperating in the sale and promotion of the product in England. Finally, the Judge held that this condition was not fulfilled by the companies actively cooperating in the sale of the inhalers in Germany to Sandoz despite the fact that it was done in the knowledge that they were destined for sale in England.

#### Alleged primary act of passing off

The Judge rejected Glaxo's argument that it was sufficient under this head that Aeropharm or Hexal had supplied the AirFluSal product to Sandoz UK anywhere in the world. He found that such supply had to be in the UK. As there was evidence that only Aeropharm supplied the AirFluSal inhalers to Sandoz UK and that title to those products passed in Germany, the Judge concluded that there was no arguable case that any primary act of passing off had been committed or threatened.

#### Additional arguments put forward by the Sandoz companies

The Judge went on to reject an argument advanced by the defendants that related proceedings in Germany against Aeropharm and Hexal prevented them from being joined in these proceedings under Article 30 of the Recast Brussels I Regulation. He also rejected an argument made by the defendants that acts of joint tortfeasance were time barred under section 2 of the Limitation Act 1980 (but likewise rejected Glaxo's submission that the Limitation Act never applied to acts of joint tortfeasance). However, having found that there was no arguable case that either Aeropharm or Hexal had committed or threatened primary acts of passing off or joint tortfeasance, the application to join them as defendants was dismissed.

### **Claim based on goodwill in get-up alone rejected**

*George East Housewares Ltd ("GEH") v Fackelmann GmbH & Co KG & Anr\**

**Miss Recorder Amanda Michaels**; [2016] EWHC 2476 (IPEC); 11 October 2016

Miss Recorder Amanda Michaels (sitting as a Deputy Judge) dismissed GEH's claim for passing off against Fackelmann and its connected company, Probus Creative Housewares ("PCH") Ltd. She found that GEH did not enjoy the requisite goodwill in the shape or other aspects of the get-up of its conical kitchen measuring cups in the absence of the trade name "Tala".

GEH was the successor in business to a long-established kitchenware manufacturer which had sold conical kitchen measuring cups under the brand name Tala in the UK since 1934. GEH had

made and distributed the Tala range including the measuring cups since 1992. The tinplate, conical shape of the cups had been broadly consistent since 1934, with measurements marked in columns on the interior. Although the exterior and interior designs had varied over time, the Tala brand name had always appeared on the exterior – GEH did not complain about the brand name on the exterior of the defendants’ cups, but claimed that Fackelmann and PCH had passed off their own conical measuring cups as GEH’s by the adoption of a similar get-up, namely: (i) shape, (ii) stripes, (iii) colours, and (iv) interior design. Although GEH’s main witness referred to it in his evidence, the overall “vintage and retro appearance” of the get-up as a feature of GEH’s goods was not pleaded as a feature of the relevant get-up.

The defendants had manufactured and sold different versions of their measuring cups. The Judge found that one, unbranded version was “extremely similar if not identical” to GEH’s cups in shape and size, and that it was clear that the interior had been copied. However, the Judge considered it relevant that another “Dr Oetker” branded version was not complained of by GEH. Examples of the parties’ products are shown below:

**GEH’s cups**



**Defendants’ unbranded cups**



**Defendants’ “Dr Oetker” branded cup**



The Judge cited the authorities which had established that it was possible - depending on the facts of the case - for features such as shape and decoration to identify a product even when the name by which it was known was missing, and for a competing product to cause passing off even when no confusingly similar name was adopted. However, although she found that GEH had a *de facto* monopoly in conical measuring cups at the relevant date, she was of the view that the evidence did not show that the public had been educated to recognise the shape of a Tala cup alone as indicative of the origin of the goods. She also went on to find that the aspects of get-up relied up by GEH, either as a whole or in one or more identifiable features, did not have the requisite goodwill.

In case she was wrong on the issue of goodwill, the Judge went on to consider whether the defendants’ use of the get-up complained of was similar to that of GEH’s product such that it

constituted a misrepresentation to consumers or the trade that their goods were those of or otherwise associated with GEH. Taking all the evidence into account, she held that it did not lead to the conclusion that either the trade or the average end-purchaser would be so confused and, if some were, they would be too few in number to satisfy the test established in *Neutrogena Corporation v Golden Ltd* [1996] RPC 473, i.e. there would be passing off if a substantial number of the claimant's customers or potential customers were deceived for there to be a real effect on the claimant's trade or goodwill. Therefore, the defendants' acts could not have caused any damage to GEH and its claim 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)