




Bird & Bird & Reports of Trade Mark Cases for CIPA Journal

February 2019



Trade mark decisions

Decisions of the General Court (GC) and Court of Justice (CJ)

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-105/16 <i>Philip Morris Brands Sàrl v EUIPO; Explosal Ltd</i></p> <p>1 February 2018 Reg 207/2009</p> <p>Reported by: <i>Adeena Wells</i></p>	 <p>- tobacco pouches; tobacco; smoking tobacco; tobacco, cigars and cigarettes; manufactured tobacco (34)</p>  <p>- tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, tobacco for roll-your-own cigarettes, pipe tobacco; cigarette cases (34)</p>	<p>In invalidity proceedings, the GC annulled the BoA's decision to disregard evidence demonstrating reputation of the earlier mark on the basis that it was submitted out of time and before the BoA for the first time.</p> <p>The GC confirmed that the existence of a link between two marks must be assessed globally by examining any evidence demonstrating reputation and distinctiveness as well as examining the similarities between the marks. The BoA was unable to conduct this global assessment as it did not examine evidence, which the GC held could have changed the outcome of the proceedings. Given the potential impact on the decision, the GC held that the BoA's failure to consider the out of time evidence was a procedural irregularity.</p> <p>The GC confirmed that if a trade mark owner submitted relevant evidence in support of a reputation claim, the BoA was obliged to examine the evidence on the basis that the content was relevant to the proceedings and may affect the final outcome.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-67/17 <i>Italytrade Srl v EUIPO; Tpresso SA</i></p> <p>18 May 2018 Reg 207/2009</p> <p>Reported by: <i>Daniel Anti</i></p>	<p>tèspresso</p> <p>- coffee, teas and cocoa and substitutes therefor (30)</p> <p>TPRESSO</p>  <p>- machines for the preparation of hot beverages (11) - non-medicinal infusions and teas in the form of capsules, teas; non-medicinal</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 an above-average degree of visual similarity between the marks: it was irrelevant that the marks were written in lower and upper-case respectively. The additional letters in the mark applied for was insufficient to rule out visual similarity.</p> <p>The GC also upheld the BoA's assessment of phonetic similarity: the structure of the words and the difference in pronunciation in the first part of each mark did not remove this similarity.</p>

infusions and herbal teas; tea extracts; tea-based preparations and beverages (30)

The GC however held that, contrary to the decision of the BoA, the marks were likely to be conceptually similar in that they both indicated the term 'espresso'. Notwithstanding this error, the BoA's decision was upheld.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-375/17 <i>Klaudia Patricia Fenyves v EUIPO</i> 12 June 2018 Reg 2017/1001 Reported by: <i>Aaron Hetherington</i>	 <ul style="list-style-type: none"> - soft drinks and non-alcoholic beverages, with the exception of energy drinks and isotonic sports drinks (32) - advertising (35) - entertainment services; music concerts (41) 	<p>The GC upheld the BoA's decision that the mark was descriptive of the goods in Class 32 pursuant to Art 7(1)(c).</p> <p>The GC held that 'blue' would be understood by the relevant public as referring to the colour blue. It was common knowledge that drinks manufacturers often used colours to distinguish their products and consumers were consequently likely to perceive colour as a significant characteristic of the goods, namely the colour of the product itself.</p> <p>The figurative elements were insufficient to divert the attention away from the descriptive element of the word element. The slightly rounded typeface, diagonal positioning and use of the ordinary colours blue and white had the effect of evoking that colour in the mind of the relevant consumer, thus reinforcing the descriptive message conveyed by the mark.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-657/17 <i>Gidon Anabi Blanga v EUIPO; The Polo/Lauren Company LP</i> 20 June 2018 Reg 207/2009 Reported by: <i>Rob Milligan</i>	<p>HPC POLO</p> <ul style="list-style-type: none"> - leather, imitations of leather, animal skins, hides and goods of leather; trunks and travelling bags; umbrellas; walking sticks; whips, harness and saddlery (18) - clothing; footwear; headgear; leather belts (25) <p>POLO</p> <ul style="list-style-type: none"> - leather, imitations of leather; bags; suitcases; umbrellas; walking sticks; whips, harness and saddlery (18) - clothing; footwear; headgear (25) 	<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 at issue was not disputed. The GC endorsed the BoA's decision that the marks were similar to an average degree as the later mark reproduced the earlier mark in its entirety – the additional word element 'HPC' did not alter this assessment.</p> <p>The GC affirmed the BoA's decision that the earlier mark had acquired enhanced distinctive on account of its reputation. Given the identity of goods and similarity between the signs, the BoA was correct to find a likelihood of confusion.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-556/17 <i>Staropilsen s.r.o. v EUIPO; Pivovary Staropramen s.r.o.</i> 26 June 2018 Reg 207/2009	<p>STAROPILSEN; STAROPLZEN</p> <ul style="list-style-type: none"> - beers, aerated waters and other non-alcoholic drinks; drinks and fruit juices; syrups and other preparations for making beverages (32) <p>STAROPRAMEN</p> <ul style="list-style-type: none"> - alcoholic and dealcoholic drinks of all kinds, non-alcoholic beer, beer, 	<p>In invalidity proceedings under Art 53(1)(a), the GC upheld the BoA's decision that the later registration was invalid and infringed Art 8(1)(b), as there was a likelihood of confusion with the earlier mark.</p> <p>The GC held that the relevant public comprised the general public displaying an average, and not minimal, level of attention. The BoA did not err in limiting</p>

Reported by:
Mark Livsey

extraction, essence for drink production, calorific beer, fruit juices (32)
(EUTM and Czech marks)

its assessment to the relevant public which did not speak a Slavic language. It was not disputed that the goods at issue were partly identical and partly similar to various degrees.

As the later mark comprised a word element repeated in two different language forms separated by a semicolon, the relevant public would split that mark into two, focusing its attention on one of the words. For the same reason, the relevant public would only pronounce one of the two word elements. It followed that the marks were similar to an above average degree from a visual and phonetic perspective. From a conceptual perspective, the BoA was correct to find that the marks at issue were devoid of any meaning to the non-Slavic language speaking relevant public, meaning that a conceptual comparison was not possible.

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC
T-847/16
Republic of Cyprus v EUIPO; Pagkyprios organismos ageladotrofon (POA) Dimosia Ltd ("POA")
and



- cheese; cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination), salt, rennet (29)

In joined opposition proceedings, the GC upheld the BoA's decision that the earlier mark had weak distinctive character and there was no likelihood of confusion under Art 8(1)(b).

The GC held that the BoA had been correct to rely on a 2015 decision that the word 'halloumi' is understood by the relevant public to be descriptive of the product as a speciality cheese from Cyprus (Cases T-292/14 and T-293/14, reported in *CIPA Journal* November 2015). The relevant public, namely UK consumers, did not perceive the word to indicate any certification.

T-825/16
Cyprus v EUIPO; Papouis Dairies



- cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination), rennet (29).

Due to the dominance of the words COWBOYS and PALLAS in the marks applied for and the accompanying figurative elements, they were held to lack conceptual similarity and have low visual similarity with the earlier word mark HALLOUMI. Their phonetic similarity was also low in the case of COWBOYS HALLOUMI and average in the case of PALLAS HALLOUMI.

13 July 2018
Reg 207/2009

Reported by:
Francesca Rivers

HALLOUMI

- cheese made from sheep's and/or goat's milk; cheese made from blends of cow's milk (29).

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC
T-581/17
Asics Corporation v EUIPO; Van Lieshout Textielagenturen BV



- leather and imitations of leather (18)
- textiles and textile goods (24)
- clothing, footwear, headgear (25)

The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under Art 8(1)(b), and that the mark applied for would not take unfair advantage of Asics' marks pursuant to Art 8(5), given the lack of similarity between the marks.

The BoA was correct to find that there was

16 October 2018
Reg 207/2009



Reported by:
Ning-Ning Li

- leather and imitations of leather (18)
- clothing, footwear, headgear, athletic footwear (25)



- clothing including sports shoes, sneakers and footwear in general (25)

(Spanish mark)

no similarity between the marks, regardless of whether the public's degree of attention was low, average or high.

As a consequence, the enhanced distinctiveness of the earlier marks and the fact that the goods at issue were identical were not sufficient to give rise to a likelihood of confusion between the marks.

Ref no.

Application (and where applicable, earlier mark)

Comment

GC

T-790/17

St Andrews Links Ltd v EUIPO

20 November 2018
Reg 207/2009

Reported by:
Ning-Ning Li

ST ANDREWS

- arranging and conducting entertainment conferences, events, competitions, club services, providing a website featuring information regarding conferences, events, competitions, special event planning, organisation of cultural events (41)

The GC upheld the BoA's finding that the mark was descriptive under Art 7(1)(c).

The BoA was correct to take into account the considerable reputation of St Andrews for golf sports, and the public's knowledge of that reputation, and that the Class 41 services could directly relate to golf sports and the organisation and planning of such events and competitions.

As a consequence, the BoA was correct to find a link between the mark and the Class 41 services in the mind of the relevant public, at least for golf professionals and amateurs. The mark was likely, in that public's mind, to designate the geographical origin of those services.

Ref no.

Application (and where applicable, earlier mark)

Comment

GC

T-36/18

Asahi Intec Co., Ltd v EUIPO; Celesio AG

20 November 2018
Reg 207/2009

Reported by:
Louise O'Hara

CELESON

- surgical, medical and dental apparatus and instruments, and their parts and accessories, medical catheters and their parts and accessories, stents and their parts and accessories (10)

The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).

Asahi Intec's request for a hearing had been lodged out of time and they failed to prove that the delay was a result of unforeseen circumstances. Failing to send the original copy of the request immediately after filing the fax, Asahi increased the risk of the application reaching the court late and did not demonstrate the diligence expected of a reasonably prudent person. As a result of which the GC was not required to consider the request.

CELESIO

- surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth (10)

The goods at issue were identical. The phrase "medical apparatus and instruments" was sufficiently clear and precise to determine the scope of the protection to be afforded and covered all of the specific goods identified in the application.

Whilst the relevant public were specialists in the medical and surgical field, the high

degree of visual and phonetic similarity between the marks meant that there was nevertheless a likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-9/18 <i>Addiko Bank AG v EUIPO</i>	STRAIGHTFORWARD BANKING - financial affairs; monetary affairs (36)	The GC upheld the BoA's decision that the mark was descriptive and lacked distinctive character pursuant to Arts 7(1)(b) and 7(1)(c). The BoA was correct to find that STRAIGHTFORWARD BANKING would be understood by the relevant public as a reference to the simplicity of the services. The GC agreed with the BoA that the mark was a promotional statement documenting the "easy to use" qualities of the services in question. As such, the BoA was correct to find that the term STRAIGHTFORWARD BANKING was descriptive of the services at issue.
22 November 2018 Reg 2017/1001		
Reported by: <i>Robert Milligan</i>		

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-824/17 <i>H2O Plus LLC v EUIPO</i>	 - non-medicated skin care preparations, skin care products, beauty serums, face and body creams, eye creams, anti-wrinkle creams, sunscreen creams, facial masks, facial washes, hair shampoos and conditioners, make-up remover, non-medicated bath salts, antiperspirants, cosmetic pads (3) - medicated sunscreen, namely lotions containing sunscreen, acne treatment preparations (5)	The GC upheld the BoA's finding that the mark was devoid of distinctive character pursuant to Art 7(1)(b). The relevant public would effortlessly perceive the sign as the chemical formula for water together with the mathematical sign "+". The fact that the number "2" did not appear in subscript did not affect the impact the mark has on the average consumer. The GC agreed that the overall impression of the sign was dominated by the element "H2o", not the fact the end of the sign could be seen as a Venus symbol tilted on its side. That interpretation required special imaginative effort, since the Venus sign was displayed in a form which was unusual or even unknown to the public. The graphic combination of the elements "o" and "+" would be hardly noticeable to the relevant public. The BoA also did not err in its conclusion that the sign "+" was perceived by the public as referring to a certain quality or characteristic of the goods i.e. providing better hydration.
27 November 2018 Reg 207/2009		
Reported by: <i>Louise O'Hara</i>		


Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-150/17 <i>Asolo Ltd v EUIPO; Red Bull GmbH</i>	FLÜGEL - beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for the preparation of drinks (32) - alcoholic drinks (except beers (33))	In invalidity proceedings, the GC partially annulled the decision of the BoA, finding that there was no likelihood of confusion between the goods in Classes 33 and 32. Whilst its reasoning within the decision was sufficiently clear, the BoA was incorrect to conclude that the mixing, consumption or marketing of alcoholic
4 October 2018 Reg 207/2009		

Reported by:
Megan Curzon

...VERLEIHT FLÜGEL
RED BULL VERLEIHT FLÜÜGEL
- energy drinks (32)
(Austrian marks)

drinks with non-alcoholic drinks established similarity between the goods in Classes 32 and 33 on the basis of Art 8(1)(b). The GC found that the Austrian public was aware of the difference between the drinks, and would make such a distinction. As such, there could be no likelihood of confusion between the marks, in respect of Classes 33 and 32.

The GC therefore annulled the decision of the BoA, in so far as it dismissed the appeal from the cancellation decision, which declared the mark applied for to be invalid for the goods in Class 33.

Ref no.	Application (and where applicable, earlier mark)	Comment
CJ C-340/17 P <i>Alcohol Countermeasure Systems (International) Inc. ("ACS") v EUIPO; Lion Laboratories Ltd ("LL")</i>	ALCOLOCK - devices for disabling a vehicle in response to a detection of alcohol in the blood of its purported operator; devices for disabling a vehicle in response to a measurement of alcohol in excess of a safety threshold in the blood of its purported operator; breath alcohol testers (9) - services for the installation and maintenance of the above class 9 goods (37) - compliance monitoring services in respect of the above class 9 goods (42)	In invalidity proceedings, the CJ upheld the GC's decision to invalidate ACS's registration pursuant to Arts 53(1)(a) and 8(1)(a) and (b). In its decision (T-638/15, <i>unreported</i>), the GC had upheld the BoA's decision to invalidate ACS's registration in its entirety. The CJ endorsed the GC's assessment of the evidence of genuine use, even though the evidence referred to a mark under a different registration number and even though some of the evidence showed the mark in a form different to the registered mark. The marks were identical, the goods and services were identical or similar, and there was consequently either double identity, or a likelihood of confusion between the marks.
29 November 2018 Reg 207/2009	ALCOLOCK - apparatus for testing, measuring, indicating, recording and/or analysing breath for alcohol; control apparatus for or responsive to the aforesaid apparatus; parts and fittings therefor (9)	
Reported by: Christine Danos		
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-378/17 <i>La Zaragozana, SA v EUIPO; Heineken Italia SpA</i>	 - beers; non-alcoholic beer; lagers; wheat beer; malt beer; beer; mineral and aerated waters and other non-alcoholic drinks; fruit beverages and fruit juices; syrups and other preparations for making beverages (32) - alcoholic beverages (except beers) (33)	The GC annulled the BoA's decision that there was no likelihood of confusion between the marks pursuant to Art 8(1)(b). The BoA was wrong to find that the word CERVISIA within the mark applied for was barely visible: the GC held that the relevant public would be able to recognise, although perhaps not easily, that word element in the mark applied for. The BoA was therefore wrong to place additional significance on the figurative element of the mark applied for. The GC instead held that although the figurative element was rather unusual and therefore memorable in respect of the goods at issue, the same could be said of the verbal element of that sign.
7 December 2018 Reg 207/2009		
Reported by: Thomas Pugh		


CERVISIA AMBAR

- beers (32)


(Spanish Mark)

The BoA had erred in finding that the earlier mark had weak distinctive character on the assumption that the general Spanish public was capable of easily linking the Latin word cervisia with the Spanish word cerveza. As such, the GC held that the word element CERVISIA carried a normal degree of inherent distinctive character.

In light of the similarity between the goods and between the marks, the GC held there was a likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-111/17 <i>Computer Market v EUIPO</i>	 - various goods and services in Classes 9, 37 and 42	The GC upheld the BoA's decision dismissing an appeal against its decision to refuse the application on absolute grounds. The BoA held the appeal was inadmissible as it was not filed within the prescribed time limit, pursuant to Art 60.
15 January 2019 Reg 207/2009		It was not disputed that the BoA's decision to refuse registration was deemed to have been duly notified to Computer Market on 28 May 2016. The time limit for filing an appeal was 28 July 2016.
Reported by: <i>Rebekah Sellars</i>		There was no evidence demonstrating that the notice of appeal had been submitted, even though it was clear from evidence later submitted that the document had been created in draft. The communication containing the statement of grounds of 27 September 2016 was, by contrast, not marked DRAFT, confirming that it had therefore been duly submitted.

Ref no.	Application (and where applicable, earlier mark)	Comment
CJ T-162/17 <i>Republic of Poland and Stock Polska sp. z o.o. v EUIPO; Lass & Steffen GmbH Wein- und Spirituosen-Import</i>	 - alcoholic drinks (except beers) (33)	The CJ upheld the GC's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).
16 January 2019 Reg 207/2009	LUBECA - alcoholic beverages (except beers) (33) (German mark)	The GC was correct to conclude that the word element of the mark applied for was more distinctive than the figurative element, which would be perceived by consumers as decorative and would not exercise a significant influence on the overall perception of the mark applied for.
Reported by: <i>Mark Livsey</i>		As regards visual similarity, the GC correctly concluded that the similarities between the word elements of the marks outweighed the differences in the other word and figurative elements and that, based on a global assessment, there was a likelihood of confusion pursuant to Art 8(1)(b).

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-91/18 <i>Equity Cheque Capital Corporation v EUIPO;</i> 17 January 2019 Reg 207/2009 Reported by: <i>Megan Curzon</i>	 <ul style="list-style-type: none"> - insurance services, namely travel insurance; financial services; banking and credit services; automated teller machine services; providing financial information over the internet and other computer networks; all of the foregoing expressly including credit card services in connection with the sale of jewellery products (36) 	<p>The GC upheld the BoA's decision that the mark lacked distinctive character pursuant to Art 7(1)(b).</p> <p>DIAMOND CARD would be understood by the relevant public as a card denoting value, encouraging use of the services in question. Even where the services provided did not directly relate to the use of a card, it was sufficient for a mark to indicate to the relevant public that they were entitled to a card giving them the right to benefits. As such, the mark was a mere promotional message and not distinctive in relation to the services at issue.</p> <p>The figurative element of the mark reinforced the message conveyed by the word DIAMOND, and the three horizontal lines were devoid of any distinctive features. The mark therefore did not contain any unusual elements which the public would perceive as an indication of commercial origin.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-671/17 <i>Turbo-K International Ltd v EUIPO; Turbo-K Ltd</i> 17 January 2019 Reg 207/2009 Reported by: <i>Louise O'Hara</i>	<p>TURBO-K</p> <ul style="list-style-type: none"> - chemicals used in industry, science, photography, agriculture, horticulture and forestry (1) - cleaning, polishing, scouring and abrasive preparations; perfumery; cosmetics; hair lotions (3) - advertising, business management, business administration, office functions; retail services (35) <p>TURBO-K</p>  <p>(unregistered marks)</p>	<p>The GC upheld the BoA's decision to refuse the registration of the mark applied for pursuant to Art 8(4), on the basis that the earlier marks were of more than mere local significance in the Netherlands and the UK.</p> <p>The BoA had erred by confusing Turbo-K Ltd with one of the signatories to the contractual agreements filed in evidence. Notwithstanding this error, the BoA was correct to conclude that the contracts – as they failed to address ownership of the rights in the earlier marks – were not a decisive factor in the case.</p> <p>The GC upheld the BoA's decision that, pursuant to English common law, it was not necessary for a claimant in an action for passing off to demonstrate they were the sole owner of the goodwill. The GC further endorsed the BoA's interpretation that misrepresentation was established when identical marks were used for identical or similar goods. Turbo-K International had not acquired goodwill independently of Turbo-K Ltd: its use of the mark was liable to confuse Turbo-K Ltd's customers as to the commercial origin of the goods and services.</p>

Construction of an exclusive licence

Holland and Barrett International Ltd ('H&B') & anr v General Nutrition Investment Company ('GNIC') (Arden & Kitchin LLJ & Birss J; [2018] EWCA Civ 1586; 4 July 2018)

The CA considered the construction of an exclusive trade mark licence which provided that the licensor, GNIC, was able to terminate the licence over individual marks for non-use. The CA held that, during the term of the licence, the licensor was not entitled to use any marks which were confusingly similar to those licensed. This would include any of the licensed marks where the licence had been validly terminated for non-use. *Katharine Stephens reports*.

Background

The predecessor to GNIC had granted an exclusive licence to H&B over seven trade marks all comprising the text "GNC" either alone or with various additions. All the marks were registered in class 5 for vitamins, minerals, nutritional supplements and similar products. The trade mark licence formed part of a wider agreement under which H&B has purchased the business which was then being conducted under the GNC brand.

It was common ground that H&B had used both the GNC word mark and one of the auxiliary marks since 2003, but had not used the five other auxiliary marks for 5 years preceding the trial of the matter. The licence provided at clause 5.6 that:

"If [H&B] ceases to Use the Trade Marks or any of them in respect of the Products for a continuous period of 5 years or more [GNIC] shall be entitled to terminate this Licence in respect of such Trade Mark or Trade Marks."

GNIC had purported to terminate the licence in relation to the five unused trade marks and contended it was thereafter entitled to use them. At first instance, Warren J agreed with this submission ([2017] EWHC 746 (Ch)). H&B appealed and the CA upheld the appeal.

Nature and scope of the exclusive licence

The CA noted that the exclusive licence was part of a business sale and therefore GNIC's interest in the GNC trade marks was much reduced. In contrast, the exclusive nature of the licence was critical to H&B. The exclusivity allowed H&B to bring actions for trade mark infringement against third parties using confusing similar marks. It also allowed H&B to bring a breach of contract action (not an infringement action) against GNIC for use of confusingly similar marks (*Northern & Shell v Condé Nast* [1995] RPC 117 referred to). The contractual exclusivity was co-extensive with the scope of the right to prevent infringements by third parties. If that were not so, then the exclusivity would be undermined.

As a consequence and due to the overlap between the scope of the various licensed marks, the use by GNIC of one of the auxiliary marks would be a breach of the contract because (1) it would breach the exclusivity of the licensed auxiliary mark; and (2) it would also breach the exclusivity of the licensed GNC mark. The distinction between (1) and (2) did not matter until clause 5.6 was considered.

Effect of clause 5.6 on the exclusive licence

Clause 5.6 was concerned with the risk associated with revocation for non-use. It allowed GNIC to terminate the licence over an individual mark (or indeed all of the marks) if that mark was not used.

The CA held that the termination over one unused mark did not undermine the exclusivity of the licence which remained in force. In construing the contract in this way, the CA recognised that it might not be possible to prevent the revocation of an unused mark. Although a serious issue in the abstract, GNIC placed too much weight on this point. In practice, GNIC's interests were protected due to the overlapping nature of the trade marks and the fact that the GNC mark would prevent a third party from using a sign the same as any of the auxiliary marks. In contrast, H&B's interests under the contract would be seriously harmed if GNIC acquired a right to use an auxiliary mark, even though it breached the exclusivity of the licence which remained.

Thus, on the true construction of the licence agreement, the CA held that if the licence was validly terminated under clause 5.6:

- GNIC would not acquire a right to do any act which would be a breach of the exclusivity of whatever licence remained in force; and
- provided GNIC could do so in a manner which did not breach the terms of any remaining licence, GNIC was free to use any unused mark, but not otherwise.

Defences to trade mark infringement action survive strike out / summary judgment application

***Red Bull GmbH v Big Horn UK Ltd & Ots** (Master Clark; [2018] EWHC 2794 (Ch); 12 November 2018)**

Red Bull alleged multiple procedural and substantive inadequacies in the defences and sought to strike out them out and summary judgment. Master Clark refused the applications and allowed the Defendants to proceed in defending the claim. *Thomas Pugh reports.*

Facts

Red Bull commenced infringement proceedings under Articles 9(2)(b) and 9(2)(c) against three Defendants: (i) Big Horn UK Limited ("D1"), which carried on the business of importing and selling into the UK energy drinks bearing the name "Big Horn"; (ii) Voltino Eood ("D2"), a Bulgarian company that distributed the Defendants' products in Bulgaria; and (iii) Lyubomir Benched ("D3") who was a director and sole shareholder of D1.

Strike out

During the course of the proceedings, D1 and D3 had filed more than one defence. Notwithstanding the fact that they breached a number of CPR provisions, Master Clark held that none of the breaches justified striking them out in their entirety, although parts were struck out as disclosing no real grounds for defending the claim.

Summary judgment

The surviving grounds in the defence were: dissimilarity of marks; lack of likelihood of confusion; and that there was no "link" between the marks under Article 9(2)(c). In this respect, the Defendants sought to rely upon the decision of the EUIPO in opposition proceedings where the Claimant had lost its challenge to the registration of D2's "Big Horn" mark.

The Claimant applied for summary judgment submitting that the decision of the Opposition Division was irrelevant to these proceedings because the Opposition Division had placed importance on the differences arising from the "Big Horn" element of D2's mark. In the current proceedings however the Claimant was not complaining of the use of "Big Horn", only of use of the figurative element of D2's mark.

Master Clark rejected the Claimant's application, holding that the reasoning of the Opposition Division was primarily based on the figurative dissimilarities between the marks, and the additional difference arising from the use of the word "Big Horn" was considered as an afterthought. The Defendants therefore had a real prospect of defending the claim.

First IPEC trial outside London

***APT Training & Consultancy Ltd & Anr v Birmingham and Solihull Mental Health NHS Trust** (Judge Melissa Clarke; [2019] EWHC 19 (IPEC); 9 January 2019)**

In the first IPEC trial ever to be heard outside London, Judge Melissa Clarke found that APT's registrations for RAID were infringed by the NHS Trust's use of RAID in word and stylised form in relation to the provision of mental health services and training and education in the field of mental health services under Sections 10(1) and 10(2) and Articles 9(2)(a) and (b). *Hilary Atherton reports.*

APT owned UK and EU trade marks for RAID registered for, among other things, educational services and the provision of training all relating to psychology and behavioural problems in Class 41. The mark RAID was used by APT as an acronym for 'Reinforce Appropriate, Implode Destructive', which was the underlying message of training courses that it provided for tackling challenging behaviour at source. The NHS was one of APT's biggest customers.

The NHS Trust used the sign RAID as an acronym for 'Rapid Assessment Interface and Discharge'. It described this as 'a new model for patient assessment and discharge for individuals experiencing severe mental health crises and trauma who attend at hospitals, including those presenting to accident and emergency'. However, the Judge found that the NHS Trust had also provided training programmes under the sign which were attended by its staff and acute hospital staff, as well as disseminating know-how via papers and lectures through its 'RAID Network' . As well as using RAID in plain word form, it had also used the following stylised version:



The Judge found that RAID in word form was identical to APT's marks and that the stylised version above was highly similar to APT's marks. She also found that the NHS Trust's use of the RAID signs in relation to both the training and healthcare elements of the service it provided to the relevant Birmingham hospitals was use in the course of trade. It was use "on the market" (and not just internal use) because it was used for the provision of services commissioned from the NHS Trust in a competitive marketplace with other potential providers. Further, it amounted to commercial activity with a view to economic advantage because of the payment which the NHS Trust received under its SLA with Birmingham East and North Primary Care Trust.

The Judge went on to find that the NHS Trust's use of RAID in word form in relation to (i) its training services and related materials and (ii) its RAID Network, infringed APT's marks pursuant to Section 10(1) and Article 9(2)(a). She found that the NHS Trust's provision of mental healthcare services was similar to the training services for which APT's marks were registered and that there was a likelihood of confusion in respect of the NHS Trust's use of the RAID signs in both word and stylised form for these services. Accordingly, the NHS Trust's use of the word mark in relation to the provision of healthcare services was found to infringe pursuant to Section 10(2), as was its use of the stylised RAID sign in relation to its provision of healthcare, training and RAID Network services. Although there was no evidence of actual confusion, the Judge took into account in particular that APT had been providing mental health training courses under the RAID mark for 30 years, that the NHS was one of its biggest customers, and that although the average consumer displayed a higher than average level of attention to detail, because of the close similarity of services and marks there were few details or differences for the average consumer to notice.

The reported cases marked * can be found at <http://www.bailii.org> and the CJ and GC decisions can be found at http://curia.euro.pa.eu/jcms/jcms/j_6/hom

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