


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

March 2019



Trade mark decisions


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


| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|---|---|
| GC T-109/17 <i>FCA US LLC v EUIPO; Robert Dennis Busbridge</i> 18 October 2018 Reg 207/2009 Reported by: <i>Megan Curzon</i> | VIPER - Motor vehicles and parts thereof (12) - Toy motor vehicles and motor vehicles model kits (28) - Construction, repair and maintenance of motor vehicles and parts thereof (37) VIPER - Sports cars; all included in Class 12 (12) | <p>The GC upheld the BoA's decision that the proprietor of the earlier mark had proved genuine use pursuant to Arts 57(2) and (3).</p> <p>The BoA was entitled to find that the sale of kit cars was sufficient to prove genuine use. This was despite the fact that the kits did not contain all of the parts required to build an entire car.</p> <p>The BoA had correctly taken account of the nature of the goods as well as the characteristics of the relevant market.</p> <p>Despite the fact that evidence of use submitted by the proprietor did not demonstrate a high volume of sales, the GC agreed that the mark was used publicly and outwardly in specialist publications, which was sufficient to establish genuine use.</p> |
| Ref no. | Application (and where applicable, earlier mark) | Comment |
| GC T-162/18 <i>Beko plc v EUIPO; Acer Inc.</i> 14 February 2019 Reg 2868/95 Reported by: <i>Michelle Phua</i> |  - Registration sought in classes 7, 9 and 11 ALTOS - Goods in class 9 (Maltese and Slovenian marks) | <p>The GC held that the BoA was wrong to reject an application to suspend opposition proceedings where the application was based on the existence of invalidity proceedings against the earlier marks upon which the opposition was based.</p> <p>The GC held that the BoA was incorrect to base its rejection of the application to suspend on the fact that the earlier marks were not subject to the proof of use requirement at the time when application for registration of the mark in issue was published. The earlier mark should be valid both at that date and the date on which the BoA gives decision on the opposition proceedings.</p> <p>The BoA's decision in refusing to suspend the proceedings was therefore vitiated by an error of law and by manifest error of assessment.</p> |


| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|--|---|
| GC T-287/17 <i>Swemac</i> <i>Innovation AB v EUIPO; SWEMAC Medical Appliances AB</i> | SWEMAC - Surgical and medical apparatus and instruments (10) - Research and development services relating to surgical and medical equipment, apparatus and instruments (42) | The GC upheld the BoA's declaration of invalidity under Art 53(1)(c) and Art 8(4). The applicant had not provided any evidence that it had used a company name containing the element "swemac" prior to the intervener's earlier sign. Therefore, since there was a likelihood of confusion between the earlier sign and the application, the BoA was correct. Therefore the appeal against the finding that the intervener did not have the right to invalidate the EUTM was dismissed. Furthermore, the intervener had not impliedly consented to the use of the mark and therefore the appeal against the BoA's finding under Arts 54(2) and 8(4) was also rejected. |
| 7 February 2019 Reg 207/2009 Reported by: <i>Megan Curzon</i> | SWEMAC Medical Appliances AB - Registered as a Swedish company name for "development, manufacture and sale of primary medical apparatuses." | |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|---|---|--|
| GC T-40/18 <i>Ecolab USA, Inc. v EUIPO</i> | SOLIDPOWER - Chemical products used in industry; cleaning compositions for industrial purposes (1) - Warewashing detergents; pre-soaks; rinses (detergents); rinse additives (3) - Disinfectants and sanitisers for warewashing (5) - Measuring apparatus; computerised apparatus and instruments for controlling measuring apparatus (9) - Installation, repair and maintenance of warewashing machines and dishwashers and control-systems (37) | The GC upheld the BoA's decision that the mark was descriptive and lacked distinctive character pursuant to Art 7(1)(c). The BoA was correct to find that the terms SOLID and POWER were both individually descriptive with regard to the goods and services applied for. The mark described characteristics that an average consumer could expect of the goods and services, namely that they were reliable by nature and their performance was strong and solid. |
| 17 January 2019 Reg 2017/1001 Reported by: <i>Daniel Anti</i> | | |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|--|---|
| GC T-97/18 <i>DeepMind Technologies Ltd v EUIPO</i> | STREAMS - computer software for accessing and viewing patient medical information (9) - application service provider (ASP) featuring computer software for accessing and viewing patient medical information (42) | The GC upheld the BoA's refusal to register the mark applied for on grounds of descriptiveness and lack of distinctive character pursuant to Arts 7(1)(c) and 7(1)(b). The GC held that the plural form of the word 'stream' did not differ significantly from the singular. It was sufficient that the sign could be used in a way that was descriptive of the goods and services. Accordingly the BoA was correct to conclude that the mark applied for would be perceived by the relevant public as referring to a continuous flow of data in a computing context. Furthermore, the relevant public would understand the mark applied for as describing the type and quality of the goods and services, namely that they enabled real time access to patient medical data. |
| 31 January 2019 Reg 2017/1001 Reported by: <i>Ciara Hughes</i> | | |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|---|---|
| GC T-123/18 <i>Bayer Intellectual Property GmbH v EUIPO</i> |  <ul style="list-style-type: none"> - conducting scientific studies in the field of cardiovascular diseases (42) - medical services in the field of cardiovascular diseases (44) | <p>The GC upheld the BoA's decision that the mark lacked distinctive character pursuant to Art 7(1)(b).</p> <p>The GC held that the BoA had not erred in discounting the level of attentiveness of the relevant public as this was not relevant to the assessment of inherent distinctiveness.</p> <p>The GC rejected Bayer's submission that the mark would have been perceived as the letter 'V.' The mark was visually closer to a heart due to the curved edges. Since the services concerned the heart, the relevant public would have perceived the mark as a representation of a heart.</p> <p>In light of this, and since the stylisation of the mark did not transmit a message which the relevant public could remember, the mark was held to be devoid of distinctive character.</p> |
| 14 February 2019 Reg 2017/1001 | | |
| Reported by: <i>Aaron Hetherington</i> | | |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|---|--|--|
| GC T-231/18 <i>Et Djili Soy Dzhihangir Ibryam v EUIPO; Victor Lupo</i> |  <ul style="list-style-type: none"> - jellies, jams, compotes, fruit and vegetable spreads, ground nuts, broad beans, potato chips, dried edible mushrooms, fruit preserves, vegetables, dates, beans, prepared pistachio, prepared walnuts, processed pumpkin seeds, prepared seeds, dried figs (29) <p>GILLY</p> <ul style="list-style-type: none"> - meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jamaes, compotes, eggs, milk and milk products, edible oils and fats including seeds and roasted peanuts (29) <p>(Romanian mark)</p> | <p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was correct to find that the goods at issue were in part identical and in part highly similar.</p> <p>Phonetically, the BoA was correct to find that the marks were highly similar if not identical because the relevant public (Romanian consumers) would pronounce the word elements 'gi' and 'li' of the earlier mark in almost the same way as the respective word elements 'dji' and 'l' of the mark applied for.</p> <p>The BoA was also correct to find that a conceptual comparison between the signs was not possible because the signs were meaningless for Romanian consumers.</p> <p>Taking into account that the marks at issue would be pronounced almost identically and that the goods in question were likely to be purchased or recommended orally, the BoA was correct to find that there was a likelihood of confusion.</p> |
| 12 February 2019 Reg 207/2009 | | |
| Reported by: <i>Mark Livsey</i> | | |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
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| GC T-656/17 <i>Sumol + Compal Marcas, SA v EUIPO; Ludwig Manfred Jacob</i> |  <ul style="list-style-type: none"> - Pharmaceutical preparations; | <p>The GC annulled the BoA's decision that there was a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The parties were agreed on the relevant public (average consumers and nutrition experts) and the degree of visual similarity between the marks due to the</p> |

7 February 2019
Reg 207/2009

Reported by:
Louise O'Hara

- Nutritional supplements (5)
- Jellies, jams, compotes, fruit and vegetable spreads; Oils and fats; Processed fruits (29)
- Baked goods, confectionery, chocolate and desserts (30)
- Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices (32)

dominant elements (namely "essencial", "essential" and "essentials").

The GC found that the BoA's review of the two coloured marks was incomplete. The BoA only indicated that the inclusion of the element "compal" precluded a likelihood of confusion from occurring. The BoA's failure to comment upon the impact of the other elements of the marks, particularly the colour, was an incorrect application of Art 8(1)(b).


COMPAL ESSENCIAL



- Fruit pulp (liquid fruit paste); preserved fruits and vegetables (29)
- Non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages (32)

(International and Portuguese marks)

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|--|--|
| <p>GC T-785/17 <i>Ercan Ilhan v EUIPO; Time Gate GmbH</i></p> |  | <p>In invalidity proceedings, the GC upheld the BoA's decision to disregard evidence demonstrating acquiescence under Art 54(1) on the basis that it was submitted before the BoA for the first time. Further, the BoA had correctly found the mark invalid under Arts 53(1)(a) and 8(1)(b).</p> |
| <p>24 January 2019 Reg 207/2009</p> | <ul style="list-style-type: none"> - knitwear (clothing), jeans clothing, clothing of leather, clothing of imitations of leather; track suits; shirts, jackets (clothing), denim jackets, trousers, skirts, blouses, bathing suits, beach clothes; underwear, gloves (clothing); socks; shoes, boots, slippers, babies' shoes, sports shoes, iron fittings for shoes, soles for footwear, heelpieces, for boots and shoes, stockings, shoe uppers; headgear for wear, hats, berets, caps; babies' diapers of textile, babies' jackets, bibs (not of paper); neckties, bowties, shawls, scarfs, collars (clothing), muffs, bandanas (neckerchiefs), wristbands (clothing); belts, braces for clothing (suspenders), garters (25) | <p>The GC confirmed that the BoA's function was not to examine evidence that had not been submitted at the earlier stage of the proceedings. The BoA was therefore correct in rejecting the evidence as inadmissible.</p> <p>The GC agreed with the BoA that there was a low degree of visual and phonetic similarity between the marks. Conceptually however the GC disagreed with the BoA holding that there was an average degree of similarity.</p> <p>The BoA had correctly determined that there was a likelihood of confusion. The GC explained that it was common in the fashion industry for companies to use one mark in different configurations depending on the products sold under that variation of the mark. There was therefore a risk that consumers would perceive BIG SAM as being a sub-brand</p> |

| Ref no. | Application (and where applicable, earlier mark) | Comment |
|--|---|--|
| GC T-215/17 <i>Pear Technologies Ltd v EUIPO; Apple Inc.</i> 31 January 2019 Reg 2017/1001 Reported by: <i>Daniel Anti</i> | <p>SAM - clothing, footwear, headgear (25)</p>  <ul style="list-style-type: none"> - Computers; electronic devices; apparatus for recording, transmission or reproduction of sound or images; software (9) - Providing consultancy on digital marketing; providing CRM solution and business solution design services (35) - Maintenance and updating of computer software; providing information concerning computer software(42)  <ul style="list-style-type: none"> - Computers; digital music and/or video players; MP3 and other digital format audio players; electronic devices; software (9) - Retail store and online store services (35) - Application service provider services featuring software; providing temporary internet access to use on-line non-downloadable software (42) | <p>of SAM, and that they were both owned by the same entity.</p> <p>The GC annulled the BoA's refusal of registration on the basis of Art 8(5). Contrary to the BoA's decision, the GC held that there was no visual similarity between the marks as the figurative elements of the marks were very different; one, a silhouette of an apple with a bite taken out of it and the other consisting of a large number of squares which formed a pear shape. The GC also disagreed with the BoA's assessment of the 'PEAR' word element of the applicant's mark, holding that it was not negligible in assessing the overall impression created by the mark. The GC further held that there was no conceptual similarity between the marks. Consequently, the GC held that the BoA was wrong to find a low degree of visual and conceptual similarity between the marks and therefore allowed the applicant's appeal.</p> |

High Court grants application that it does not have jurisdiction on the basis of targeting

*easyGroup Limited v Easy Fly Express Limited & Anr** (Arnold J; [2018] EWHC 3155 (Ch); 21.11.18)

Arnold J held that easyGroup had no real prospect of establishing that Easy Fly had targeted the EU, and in particular the UK, and therefore granted Easy Fly's application for an order that the High Court had no jurisdiction to hear the claim. Henry Elliott reports.

Facts

easyGroup claimed trade mark infringement and passing off based upon the similarity between the signs used by Easy Fly and easyGroup's registered trade marks, and that Easy Fly had imitated easyGroup's distinctive get-up, as set out in the table below:

| easyGroup's mark/get-up | Defendants' use of the Signs |
|---|--|
| EASYJET | EasyFly |
|  |  |
|  |  |
|  <p>(easyJet branded aeroplane)</p>  <p>(Other uses of easyGroup's distinctive house style)</p> |  <p>(photographs shown on the Defendants' Website)</p> |

In September 2017, easyGroup was granted permission to serve its claim on Easy Fly outside the jurisdiction in Bangladesh. On 1 February 2018, Easy Fly applied for an order that the High Court had no jurisdiction to hear the claim, alternatively that it should not exercise any jurisdiction it may have.

Applicable Principles

The Judge set out the principles to be applied when granting permission to serve out of the jurisdiction: (i) there must be a serious issue to be tried, i.e. a real prospect of success; (ii) there must be a good arguable case that the claim falls within one or more of the "gateways" for leave to serve out of the jurisdiction (set out in paragraph 3.1 of Practice Direction 6B); and (iii) England must clearly or distinctly be the appropriate forum for the trial of the dispute and that in all the circumstances the court ought to exercise its discretion to permit service of the proceedings out of the jurisdiction.

Real prospect of success: targeting

The Judge considered whether Easy Fly's use of its signs was targeted at the UK or elsewhere in the EU in order to be able to amount to infringement of a UK or EU trade mark, or amount to passing off. Easy Fly contended that the acts complained of were not targeted at the UK or elsewhere in the EU.

Easy Fly's evidence was that it was a small cargo airline headquartered in Bangladesh. It had undertaken a small number of regional flights outside Bangladesh but had never offered flights to anywhere in Europe and had no plans to do so. Easy Fly had never made a contract through its website or with a customer that had reached them through the website.

easyGroup's case on targeting was based on Easy Fly's website, its Facebook page and a Google search.

The Judge was unimpressed by easyGroup's reliance upon the website and Facebook page being in English. He accepted Easy Fly's evidence that English was widely spoken in business in Bangladesh. In addition, it was the dominant language used in websites globally.

References on the website to Easy Fly's network providing global reach was considered by the Judge to be mere advertising puff as it was clear from the website that it did not have such reach.

Further, the Judge found that references on the website and Facebook page to business opportunities in the international air cargo market (including Europe) and to extending Easy Fly's cargo network initially to China and the Middle-East would be perceived by the average consumer as merely identifying potential future opportunities.

There was nothing in the results of the Google search to suggest that Easy Fly's services were targeted at Europe.

easyGroup also relied on the resemblance between the Easy Fly's signs and easyGroup's trade marks and get-up. The Judge accepted that this was a factor to be taken into account, but did not find it sufficient to lead the average UK or EU consumer to believe that Easy Fly's Website or Facebook page was aimed at them.

Good arguable case and forum

Arnold J said that, had there been a real prospect of success, easyGroup would have had a good arguable case. In addition, England would have been the appropriate forum for the trial of the claim.

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

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