

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

July 2021



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-442/20 <i>Isaline Grangé and Alizée Van Strydonck v EUIPO; Nema Srl</i></p> <p>5 May 2021 Reg 2017/1001</p> <p>Reported by: <i>Amy Cole</i></p>	<p>ÂME</p> <ul style="list-style-type: none"> leather and imitation leather; handbags, sport bags, bags for campers, travelling handbags, beach bags, school cases and bags; purses; wallets; backpacks; pouch bags; business card cases; credit card cases (pocket wallets); key cases; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walkingsticks (18) clothing, footwear, headgear; belts, suspenders, neckties (25) <p>.A.MEN.</p> <ul style="list-style-type: none"> purses; handbags; travelling sets [leatherware]; game bags [hunting accessories]; school satchels; business card cases; card cases [notecases]; pocket wallets; suitcases; attaché cases; rucksacks; umbrella sticks; travelling bags (18) clothing of imitations of leather; clothing of leather; dresses; suits; underwear; footwear; boots for sports; bathing trunks; shirts; hats; coats; belts [clothing]; neckties; pocket squares; stocking suspenders; sock suspenders; shoes (25) 	<p>The GC annulled the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b) on the basis that it had not correctly examined their conceptual similarity.</p> <p>The BoA had been correct to find an average degree of visual and phonetic similarity between the marks. In particular, the circumflex accent on the 'a' of the mark applied for would not have altered the pronunciation by the relevant public. The small rhombuses in the earlier mark acted as mere punctuation marks.</p> <p>However, the BoA had erred in stating that AMEN did not convey any concept or meaning unless it was placed in conjunction with other text, such as a prayer and therefore the conceptual comparison was neutral. The GC held that whilst ÂME had no meaning, AMEN had a clear and specific meaning understood by the relevant public, even when it was not integrated into a religious context. As such, the marks were not conceptually similar, and the BoA had not properly considered the counteraction of the visual and phonetic similarities through the conceptual differences.</p>
<p>Ref no.</p> <p>GC T-637/19 <i>Sun Stars & Sons Pte Ltd v EUIPO; Carpathian Springs SA</i></p> <p>T-638/19 <i>Sun Stars & Sons Pte Ltd v EUIPO; Valvis Holding</i></p> <p>12 May 2021 Reg 207/2009</p>	<p>Application (and where applicable, earlier mark)</p>  <p>(3D sign)</p> <ul style="list-style-type: none"> various goods relating to mineral and aerated waters (32) various services relating to advertising, business 	<p>Comment</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 earlier mark had weak distinctive character overall. The word element VODAVODA was more distinctive than the shape of the bottle at issue.</p> <p>The BoA was correct to find that there was a low degree of visual similarity and no phonetic similarity between the word element of the marks.</p> <p>The signs at issue had, at most, an average degree of conceptual similarity in that they referred to the same</p>

Reported by:
Rebekah Sellars

administration, wholesaling and retailing of mineral and aerated water (35)

- various services relating to the transport, distribution, delivery, packaging and storage of mineral and aerated waters (39)




- mineral waters for medicinal purposes (5)
- aerated waters, mineral waters (beverages), table waters, spring waters (32)

concept, that of 'water' ('aqua' and 'voda'). Both words, although requiring translation, were purely descriptive. In the light of the weak distinctive character of the common concept of 'water', the GC held that, contrary to the BoA's findings, a conceptual comparison, requiring prior translation, was possible.

Nevertheless, following a global assessment, the BoA was right to conclude that there was no likelihood of confusion, within the meaning of article 8(1)(b), despite the error made in finding that the conceptual comparison was neutral.

(EUTM and Slovenian 3D mark and Croatian figurative mark)

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-167/20	 <ul style="list-style-type: none"> - boats and vessels (12) 	<p>In an application for a declaration of invalidity under article 52(1)(b), the GC upheld the BoA's decision that the mark TORNADO was invalid for boats and vessels on the basis of bad faith.</p> <p>Tornado Boats was fully aware that it did not own the mark, since Haygreen had not transferred the mark to it, but it nevertheless decided to apply to register the mark in order to put up obstacles to Haygreen's activities by preventing him from using that mark which, over time, he had made popular in the inflatable boats sector.</p> <p>The BoA was correct to find that Tornado Boats' explanations were insufficient to justify the application for registration of the contested mark. Consequently, its conduct departed from accepted principles of ethical behaviour or honest commercial and business practices with the intention of undermining the interests of third parties.</p>
<p><i>Tornado Boats International ApS v EUIPO; David Haygreen</i></p> <p>12 May 2021 Reg 207/2009</p> <p>Reported by: <i>Milena Velikova</i></p>		
Ref no.	Application (and where applicable, earlier mark)	Comment

GC T-854/19 T-855/19 T-856/19	<p>MONTANA</p>  <ul style="list-style-type: none"> - bathroom furniture (11) - furniture (20) 	<p>In invalidity proceedings, the GC upheld the BoA's decision that the contested marks were not descriptive pursuant to article 7(1)(c).</p> <p>The BoA was correct to find that the relevant EU public would likely not have perceived the contested marks as</p>
<p><i>Franz Schröder GmbH & Co. KG v</i></p>		

EUIPO; RDS
Design ApS

- retail services connected with the sale of furniture (35)

references to Montana, US – which was where lumber and furniture was manufactured. Although Montana was the fourth largest US state, it ranked only 44th out of 50 in terms of population size and was little known to the relevant public.

2 June 2021

Reg 2017/1001

Reported by:
Robert Milligan

Further, it was not evident that the relevant public would associate the term ‘montana’ with the US state since the term also referred to “mountain” in some EU languages.

The GC held that, although furniture was manufactured in Montana and there was a “made in Montana” certification system in the US, the evidence had not proved that the relevant public would recognise the state of Montana as a well-known furniture production site.

As such the BoA was correct to find that the contested marks were not descriptive indications of the geographical origin of the goods at issue.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-177/20 <i>Erwin Leo Himmel, v EUIPO; Gonzalo Andres Ramirez Monfort</i>	Hispano Suiza <ul style="list-style-type: none">– cars (12) HISPANO SUIZA <ul style="list-style-type: none">– horological and chronometric instruments (14)– clothing, footwear, headgear (25)	<p>The GC annulled the BoA's decision that there was no likelihood of confusion under article 8(1)(b).</p> <p>The BoA erred when finding there was no similarity between the goods as it failed to consider a relevant criterion, that of market practices, in addition to those criteria already established by case law. Citing <i>Canon</i>, the GC held that in the global assessment to determine the similarity of goods and services, all relevant factors should be taken into account. The list of factors in <i>Canon</i> was purely indicative and there could be others in addition to or instead of them, as was the case here.</p> <p>The existence of a market practice involving car manufacturers across the EU offering for sale not only cars, car parts and fittings, but also a wide range of clothing and accessories, a practice of which consumers were aware, constituted a relevant criterion in this case and accordingly, the BoA was wrong to rule it out.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment

GC

T-266/20



In invalidity proceedings, the GC annulled the BoA's decision that the opposition under article 8(1)(b) should succeed in relation to certain of the services (the ones noted here). The GC

Global Chartered
Controller
Institute SL v
EUIPO; CFA
Institute

- advertising; business management; business administration (35)
- education; providing of training (41)

held that the BoA had erred in its determination of the relevant public's degree of attention.

The GC held that the relevant public would have displayed a high level of attention; rather than, as the BoA had held, an average level of attention. Although the GC agreed the services in the field of education in class 41 were aimed at both a specialised professional public and the general public, contrary to the BoA's decision, the GC held that those consumers would have displayed a high level of attentiveness for all the services in question. In contrast, the relevant public for the class 35 services was only comprised of professionals, defined by the narrower specification in the earlier mark. Such professionals would have displayed a high level of attentiveness.

9 June 2021
Reg 2017/1001

CFA

Reported by:
Alexander Grigg

- printed publications in the field of financial analysis (16)
- educational services, namely arranging, conducting and providing courses of instruction, workshops, seminars, and conferences in the field of financial analysis and distributing course materials in connection therewith (41)
- association services, namely promoting the interests of financial analysts (42)



- association services, namely the promotion of education, professional responsibility, ethics and integrity of financial analysts (42)

Passing off

UK Gymnastics Ltd ("UKG") v British Amateur Gymnastics Association ("BAGA")* (Lewison, Bean & Arnold LJJ; [2021] EWCA Civ 425; 24 March 2021)

The CA allowed UK Gymnastics' appeal against the judge's finding that it had passed off by misrepresenting that it was a National Governing Body for the sport of gymnastics. However, this did not detract from the judge's finding of passing off on two other bases. UKG's appeal in relation to the judge's finding of trade mark infringement was also dismissed. Hilary Atherton reports.

BAGA was a not for profit private company limited by guarantee, and a National Governing Body (NGB) for the sport of gymnastics in the United Kingdom. It was recognised as an NGB by the Sports Council in the UK, the European Union of Gymnastics and the Federation of International Gymnastics. It was incorporated in 1982 but had a history which could be traced back to the very beginnings of the sport of gymnastics in the UK with the establishment in 1888 of the 'Amateur Gymnastics and Fencing Association'. Since around 1997 it has traded and operated under and by reference to the name 'British Gymnastics'. BAGA owned the following UK trade marks which were registered in classes 9, 16, 25, 25, 28 and 41 (the "Marks"):



Since 2011 BAGA had operated under and by reference to certain logos incorporating the words "British Gymnastics" and the following get-up: (i) the Marks; (ii) the colours red, white and blue; and (iii) a background image depicting gymnastics motion in the form of coloured swirls in the colours red, white and blue; the pre-2011 logo as shown below:



UKG was incorporated in 2000 and had, since at least 2015, provided membership services to individual gymnasts, gymnastics clubs and coaches; competitions; courses and/or badge/certificate programmes; and/or educational services to coaches and gymnasts ("the UKG Services"), under and by reference to the sign 'UK Gymnastics' in the following logo formats:



At first instance ([2020] EWHC 1678 (IPEC)), HHJ Melissa Clarke sitting in the IPEC held that UKG had infringed BAGA's trade marks and committed passing off. UKG appealed.

The CA (Arnold LJ giving the lead judgment):

- (i) rejected UKG's claim that the judge had been wrong to find that it was not an NGB for the sport of gymnastics, as this was a finding that was clearly open to the judge on the evidence;
- (ii) concluded that the judge was in error in so far as she found BAGA's third claim for passing off established. The judge found that UKG had passed off by misrepresenting that it was an NGB for the sport of gymnastics, whereas BAGA's claim was that UKG was guilty of a misrepresentation that the status had been conferred upon it by BAGA. Therefore the judge had decided the wrong issue and found UKG liable for passing off on the wrong basis in this respect. However, this did not detract from her finding of passing off by misrepresenting that UKG and/or the UKG Services were: (a) those of or connected with BAGA, and/or (b) connected with BAGA in such a way as to cause damage to its goodwill;
- (iii) set aside the part of the injunction restraining UKG from passing off by denoting some form of official or approved status or otherwise asserting to be an NGB on the basis that it extended beyond BAGA's pleaded case; and
- (iv) rejected UKG's claims that the judge, when considering the issue of trade mark infringement under sections 10(2) and/or 10(3): (a) had erred in her findings as to the degree of similarity of the relevant marks, (b) had erred by not considering the matter from the perspective of the average consumer, and (c) was wrong to accept BAGA's argument that a relevant factor was its effective monopoly as the sole NGB for gymnastics in the UK for many years, such that little attention would be paid when purchasing or using the relevant services. The CA agreed that this last was a legitimate argument.

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

Editorial team

Katharine Stephens

Partner

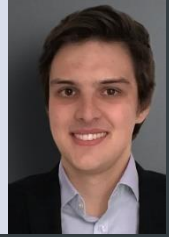
Tel: +442074156104
katharine.stephens@twobirds.com



Aaron Hetherington

Trademark Attorney

Tel: +442074156183
aaron.hetherington@twobirds.com



Bryony Gold

Associate

Tel: +442030176892
bryony.gold@twobirds.com



Reporters

Amy Cole; Rebekah Sellars; Milena Velikova; Robert Milligan; Maisie Briggs; Alexander Grigg; Hilary Atherton

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