

Bird & Bird

Report of Trade Mark Cases



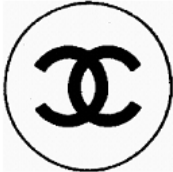

For the CIPA Journal

April 2022



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-44/20 <i>Chanel v EUIPO; Huawei Technologies Co. Ltd</i></p> <p>21 April 2021 Reg 2017/1001</p> <p>Reported by: <i>Maisie Briggs</i></p>	 <ul style="list-style-type: none"> computer hardware and computer software programs; mobile phones; earphones and headphones; smartwatches; wearable activity trackers; etc (9)  <ul style="list-style-type: none"> cameras, sunglasses, glasses; earphones and headphones; computer hardware (9)  <ul style="list-style-type: none"> perfumes, cosmetics (3) costume jewellery (14) leather goods (18) clothes (25) <p>(earlier French registrations)</p>	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b), and that the conditions of article 8(5) had not been met.</p> <p>The GC held that the marks shared a common characteristic of the interlaced curves - however, there were visual differences in the shape and stylisation of the curves, their arrangement (vertical v horizontal) and the thickness of the lines of the curves.</p> <p>The GC confirmed that it was necessary to compare the marks in the form they were registered/applied for - the actual or hypothetical use of the marks in another form, such as being rotated, was irrelevant for that comparison in this case. Therefore, the GC held that the BoA had been correct in finding the marks to be visually dissimilar.</p> <p>The GC also upheld the BoA's decision that the marks were conceptually different because each was made up of an image referring to different stylised letters.</p> <p>Since the marks were not similar, the GC agreed with the BoA that an essential condition of both articles 8(1)(b) nor 8(5) had not been satisfied.</p>
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-531/20 <i>Wolf Oil Corporation NV v EUIPO; Rolf Lubricants GmbH</i></p> <p>30 June 2021</p>	 <ul style="list-style-type: none"> antifreeze; oil dispersants; detergent additives to petrol (1) 	<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 held that there was a low degree of visual and phonetic similarity between the signs at issue: since the marks were only</p>


<p>Reg 2017/1001</p> <p>Reported by: <i>Milena Velikova</i></p>	<ul style="list-style-type: none"> - cutting fluids; industrial oil; lubricants; lubricating grease; lubricating oil; motor oil (4) <p>WOLF</p> <ul style="list-style-type: none"> - antifreeze and antifreeze compounds included in this class (1) - cleaning, polishing, scouring and abrasive products; soap, oils for cleaning purposes; stain removers; polishing paper; windshield washers (3) - industrial oils and greases; lubricants; dust collecting products; fuels, including motor spirit, and illuminants (4) 	<p>four letters long, the difference between the first letters 'W' and 'R' was readily visually perceptible, particularly since those letters were visually very different and the public's impression of the marks depended considerably on the beginning of the signs. Further, there was a lack of conceptual similarity. As such, the mere fact that the two signs shared the letter sequence 'olf' was not sufficient to establish similarity, and the marks were considered sufficiently different.</p> <p>Therefore, despite the assumed identical nature of the goods at issue, there was no likelihood of confusion.</p>
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Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-501/20</p> <p><i>Stefan Makk v EUIPO; Ubati Luxury Cosmetics, SL.</i></p> <p>30 June 2021</p> <p>Reg 2017/1001</p> <p>Reported by: <i>Charlotte Colthurst</i></p>	<p>PANTA RHEI</p> <ul style="list-style-type: none"> - pharmaceuticals, dietetic food supplements for medicinal purposes, nutritional supplements; non-alcoholic beverages adapted for medical purposes for the prevention and curative treatment of eye diseases (5) <p>PANTA RHEI</p> <ul style="list-style-type: none"> - perfumery; essential oils; cosmetics; hair lotion; soap (3) 	<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 agreed with the BoA that the goods were similar to a low degree. It was held that whilst goods in those classes were not always similar, certain pharmaceuticals and certain cosmetics shared the same intended purpose and common benefits (such as skin and hair care and improving physical appearance) meaning they were complementary, and shared the same distribution channels (namely, products sold in pharmacies). Where the intended purpose was not considered the same (e.g. non-alcoholic beverages for the prevention of eye diseases vs cosmetics), a shared distribution channel was enough to establish similarity.</p> <p>Therefore, since the marks were identical, and considering the principle of interdependence, there was scope for a likelihood of confusion to arise.</p> <p>The applicant argued that the earlier mark was of weak distinctiveness, although that argument was dismissed - the GC noted that, in any event, a finding of weak distinctiveness on its own</p>

		did not prevent a finding of a likelihood of confusion.
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-86/20 T-84/20 T-85/20 <i>Qx World Kft. v EUIPO; Mandelay Magyarország Kereskedelmi Kft</i></p> <p>8 September 2021 Reg 2017/1001</p> <p>Reported by: <i>Jon Edwards</i></p>	<p>T-86/20</p> <p>SCIO</p> <ul style="list-style-type: none"> – scientific, nautical, surveying and photographic apparatus; etc (9) – hygienic and beauty care of human beings or animals; agriculture, horticulture and forestry services (44) <p>SCIO</p> <ul style="list-style-type: none"> – scientific, nautical, surveying, photographic apparatus; etc (9) – medical services; veterinary services; etc (44) <p>(unregistered mark)</p> <p>T-84/20 and T-85/20</p> <p>EDUCTOR</p> <ul style="list-style-type: none"> – scientific, nautical, surveying, photographic apparatus; etc (9) – medical and veterinary instruments and devices; etc (10) – commercial services relating to medical instruments and devices; etc (35) – therapeutic and diagnostic medical services based on bioresonance; medical services; etc (44) <p>EDUCTOR</p> <ul style="list-style-type: none"> – scientific, nautical, surveying, photographic apparatus; etc (9) – medical services; veterinary services; etc (44) <p>(unregistered mark)</p>	<p>In invalidity proceedings based on article 60(1)(b) read in conjunction with article 8(3), the GC annulled the BoA's decision on the basis that it had erred in law by dismissing the applicant's contention that the earlier mark was well-known.</p> <p>During a later stage of the proceedings, Qx World had asserted that its earlier mark was also a well-known mark, although it had not mentioned this in its application for invalidity. The BoA found that by doing so Qx World were attempting to rely on a new ground for invalidity under a different article, which meant that that argument could not be introduced at that later stage.</p> <p>However, the GC held that well-known marks within the meaning of article 6<i>bis</i> of the Paris Convention fell within the definition of 'trade marks' for the purposes of article 8(3). As such, the applicant's contention that the earlier mark was well-known did not constitute a new ground for invalidity, and the GC annulled the BoA's decision.</p>
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-331/20 <i>Laboratorios Ern, SA, v EUIPO; Le-Vel Brands, LLC</i></p> <p>15 September 2021 Reg 2017/1001</p>	<p>Le-Vel</p> <ul style="list-style-type: none"> – polishing, scouring and abrasive preparations; perfumery; flavourings for beverages [essential oils]; food flavourings prepared from essential oils; fragrances for personal use; perfume oils for the manufacture of cosmetic preparations (3) – retail and online retail store services connected with the sale of bleaching preparations and other substances for 	<p>The GC upheld the BoA's decision that there was no similarity between the goods and services for the purposes of article 8(1)(b) and dismissed the applicants' appeal entirely.</p> <p>The GC held that the BoA had been correct in deciding that 'perfumery', 'fragrances for personal use' and 'perfume oils for the manufacture of cosmetic</p>


<p>Reported by: <i>Alexander Grigg</i></p>	<p>laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, etc (35)</p> <p>LEVEL</p> <ul style="list-style-type: none"> – pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; preparations for destroying vermin; fungicides, herbicides (5) <p>(earlier Spanish registration)</p>	<p>preparations' in class 3 were not similar to the pharmaceutical and sanitary preparations in class 5 of the earlier registration. The GC agreed that the class 3 goods were for beauty and personal care purposes, whereas those in class 5 were intended for medical treatment or healthcare. As such, they were not in competition or complementary. Further, the distribution channels differed: the goods in class 3 would have been sold in drugstores or supermarkets, whereas those in class 5 would have been sold in pharmacies. As such, the class 3 retail services relating to the class 3 goods was also not similar to the class 5 goods.</p> <p>The 'polishing, scouring and abrasive preparations' and 'preparations for destroying vermin; fungicides, herbicides' also differed in their purpose, distribution channels, and were not usually manufactured by the same companies.</p> <p>As the goods and services were not similar, one of the essential components of article 8(1)(b) had not been satisfied.</p>
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Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-700/20 <i>Gabriele Schmid v EUIPO; Landeskammer für Land- und Forstwirtschaft in Steiermark</i></p> <p>1 December 2021 Reg 2017/1001</p> <p>Reported by: <i>Adeena Wells</i></p>	 <ul style="list-style-type: none"> – pumpkin seed oil, corresponding to the protected geographical indication Styrian pumpkin seed oil (29)  <p>(the above sign is the German version of the EU symbol for 'Protected Geographical Indications' ('PGI') on quality schemes for agricultural products and foodstuffs)</p>	<p>In an application for a declaration of invalidity under article 59(1)(a) read in conjunction with article 7(1)(i), the GC annulled the BoA's invalidity decision.</p> <p>Under article 7(1)(i), the registration of trade marks that include badges, emblems or escutcheons cannot be registered where i) the badge is of particular public interest, and ii) the competent authority has not consented to the registration. These two conditions were held to apply to the contested mark, and so the BoA found that registration to be invalid.</p> <p>However, the GC held that a third cumulative condition had not been considered by the BoA: whether the contested mark as a whole was likely to mislead public that there was a connection between the proprietor/user and the competent authority (in this case,</p>

		<p>the EU). In other words, the BoA had not evaluated how the public would have perceived the PGI as a component of the contested mark overall, and whether that perception would lead the public to believe that the goods covered under the applied for mark were authorised by or connected to the relevant authority.</p> <p>Therefore, the BoA had erred by failing to consider the three cumulative conditions – the fact that the first two conditions had been met did not automatically lead to the conclusion that the third condition had been satisfied.</p>
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-483/20 <i>Tecnica Group SpA v EUIPO; Zeitneu GmbH</i></p> <p>19 January 2022 Reg 2017/1001</p> <p>Reported by: <i>Charlotte Colthurst</i></p>	 <ul style="list-style-type: none"> – trunks and travelling bags; umbrellas; casual bags, handbags, travel baggage, bags for climbers, schoolbags (18) – furniture, mirrors, picture frames; armchairs and divans (20) – clothing; footwear; footwear soles; insoles; heelpieces for footwear; footwear uppers (25) 	<p>In invalidity proceedings, the GC upheld the BoA's decision that the contested 3D mark was invalid for the footwear goods in class 25 on the basis that it lacked distinctive character pursuant to article 7(1)(b).</p> <p>The GC endorsed the BoA's assessment that the shape and thickness of the soles and the position of the laces and stripes on the shaft of the boot did not indicate origin and were attributes not uncommon to other after-ski boots in the sector.</p> <p>The GC confirmed that because the shape of the boots corresponded with the common shape of after-ski boots, which generally consisted of a high shaft, often in a light synthetic material, with soles and laces, the 3D mark did not depart significantly from the norms and customs of the sector, such that the relevant public were unlikely to have relied on the mark to make assumptions about the commercial origin of the goods. As such, it was therefore devoid of distinctive character for the footwear goods in class 25, and the registration was invalid.</p>

Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-694/20 <i>Maria Alexandra Canisius v EUIPO; Beiersdorf AG</i></p> <p>2 February 2022 Reg 2017/1001</p> <p>Reported by: <i>Ayah Elomrani</i></p>	 <ul style="list-style-type: none"> – toiletries; cleaning and fragrancng preparations; nail varnish; cosmetics; make-up (3) – paper tissues for cosmetic use (16) – clothing (25) <p>LABELLO</p> <ul style="list-style-type: none"> – cosmetic preparations (3) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion within the meaning of article 8(1)(b) in relation to the goods applied for in classes 3 and 16, but not in relation to clothing in class 25.</p> <p>The GC confirmed that the goods applied for in classes 3 and 16 were identical or highly similar to cosmetic preparations; and that the goods in classes 3 and 16 were also identical or highly similar to lip care products specifically (for which Beiersdorf had proven the earlier mark had a reputation) as they shared the same nature, distribution channels and intended purposes i.e. personal grooming or to improve the impression a person made.</p> <p>The GC acknowledged that the word element of the sign could be perceived as 'cclabelle' or 'labelle', and held that this, alongside the figurative element, dominated the overall impression created by the sign and had an average degree of distinctiveness. The GC found that the marks shared a high degree of phonetic similarity, at least for part of the relevant public. This was sufficient to establish a likelihood of confusion, despite the low degree of visual similarity and conceptual dissimilarity.</p>
Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-202/21 <i>Vita Zahnfabrik H. Rauter GmbH & Co. KG v EUIPO; VIPI Indústria, Comércio, Exportação E Importação De Produtos Odontológicos LTDA</i></p> <p>2 February 2022 Reg 2017/1001</p>	<p>VITABLOCS TriLuxe forte</p> <ul style="list-style-type: none"> – ceramic dental materials; adhesives for affixing prostheses, namely dental cement and dental adhesives for bonding toothstumps or implants for use in dental restoration (5) – goods related to dental medicine, namely artificial teeth made of dental ceramics; dental apparatus and instruments, especially color rings for dental use (10) <p>TRILUX</p> <ul style="list-style-type: none"> – dental abrasives; adhesives for dentures; dental cements; adhesives for dentures; 	<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 distinctive elements of the sign were 'VITABLOCS' and 'TriLuxe', given that 'forte' would be interpreted as meaning strong or durable in relation to the goods at issue for the Italian-speaking public.</p> <p>Visually the marks were similar to an average degree based on the near identity of the distinctive 'TriLuxe' element and the earlier mark. The capitalisation of the</p>

<p>Reported by: <i>Adeena Wells</i></p>	<p>moulding wax for dental use; material for stopping teeth; resin for dental purposes (5)</p> <ul style="list-style-type: none"> – dentures; artificial teeth; of artificial teeth (prostheses); dental burs; pins for artificial teeth (10) 	<p>word 'VITABLOCS' in the sign did not increase its impact for the visual assessment. The GC also confirmed that generally the first element of a mark caught the attention of a consumer more than other elements, but this did not apply in all cases: here, the three words in the sign were all visible, so had to be equally considered for the purposes of the visual comparison.</p> <p>The marks were held to be phonetically identical in the 'TriLuxe' element and the conceptual comparison was neutral as neither mark had meaning. The identity and similarity between the goods was not in dispute.</p>
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Ref No.	Application (and where applicable, earlier mark)	Comment
<p>GC T-171/21 <i>Ubisoft Entertainment v EUIPO; Huawei Technologies Co. Ltd</i></p> <p>2 March 2022 Reg 2017/1001</p> <p>Reported by: <i>Ayah Elomrani</i></p>	<div style="text-align: center;">  </div> <ul style="list-style-type: none"> – apparatus for recording, transmission, reception, reproduction and processing of sound and images; computers; telephone and telecommunications apparatus (9) – apparatus for electronic games; toy action figures (28) – education; entertainment; sporting and cultural activities (41) <p>HONOR</p> <ul style="list-style-type: none"> – communication equipment; telecommunications devices; computers; apparatus for transmission of sound; portable power packs; batteries (9) – retail services in relation to communication equipment, telecommunication devices, computers, portable power packs (35) – communication services (38) 	<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 held that the goods and services were identical or similar to varying degrees.</p> <p>The GC confirmed the BoA's finding that the word HONOR was the distinctive and dominant element of the mark applied for, due to its larger size and central position.</p> <p>Further, the marks shared a high degree of visual similarity, as they coincided in the word element HONOR. The GC confirmed that the addition of the word FOR in the mark applied for was not enough to dispel the high degree of phonetic similarity resulting from the identical element HONOR'. Conceptually the marks were also highly similar.</p>

St Barts travel company website targeted the UK

easyGroup Ltd & Ors v Easyway SBH & Mr Stephane-Michael Roche (Mr Douglas Campbell QC; [2021] EWHC 2007 (IPEC); 22 July 2021)

After establishing that Easyway's website targeted UK consumers and assessing possible defences, Mr Douglas Campbell found that easyGroup's family of EASY trade marks were infringed under sections 10(2) and 10(3). The Judge also partially upheld easyGroup's claim for passing off. Ciara Hughes reports.

Background

easyGroup owned a number of UK trade mark registrations for EASYJET, EASYCAR and EASYBUS, covering various transportation services in class 39, and for EASYHOTEL covering 'providing hotel accommodation; reservation services for hotel accommodation' in class 42. These registrations dated back to between 1995 and 2002.

Easyway was established in 2007 in St Barthelemy ("St Barts") in the Caribbean. Mr Roche was the co-founder and owner of Easyway. The company's main activity was providing an airport "meet and greet" service for tourists visiting St Barts, but it also provided flight and hotel booking services as well as car or boat travel services in St Barts, via their website at www.easyway-sbh.com. Easyway used the signs "easyway", "easyway SBH" and the stylised mark shown below:



easyGroup brought trade mark infringement and passing off proceedings against Easyway in the High Court, but the proceedings were subsequently transferred to the IPEC following an application by Easyway and Mr Roche.

easyGroup's rights

The Judge found that easyGroup's EASYJET mark had an enhanced distinctive character as at the relevant date i.e. 19 June 2013, in relation to 'transportation of passengers and travellers by air' and 'airline services'; and that the EASYCAR mark possessed enhanced distinctiveness in relation to 'rental and hire of vehicles'. easyGroup also provided extensive evidence of use in relation to the EASYBUS and EASYHOTEL marks. Based on the evidence provided, the Judge held that easyGroup was entitled to rely on a 'family of marks'.

Direct acts

Although it was difficult to determine the proportion of Easyway's business which came from the UK, the Judge held that the fact that Easyway responded to queries from UK customers via their website was sufficient to establish that Easyway were offering services directly to UK customers in these instances. It was irrelevant that Easyway did not engage in mass mailing to UK customers: Easyway's communications with UK customers still constituted direct marketing and it was not necessary to consider targeting in respect of these acts.

Targeting

However, easyGroup's case against Easyway also included the use of the signs on Easyway's website. With reference to Nugee J's judgment in *easyGroup v Empresa* [2020] EWHC 40 (Ch) (reported in CIPA Journal March 2020), the Judge observed that the fact that Easyway's services were supplied abroad was no defence to infringement in the UK. After weighing up the parties' arguments, the Judge held that Easyway's website did target the UK. In particular, the services themselves were of an international nature; the website generated sales enquiries from UK customers and Easyway actively engaged with these sales enquiries to profit from them; and there was virtually no difference between Easyway's marketing approach for US and UK customers, so the English language version of the website could just as easily be targeting either.

Trade mark infringement

The Judge found that there was at least a medium degree of similarity between easyGroup's marks and the signs, and that there was a high or medium degree of similarity between the relevant services. Although little weight was attributed to the evidence of two alleged instances of actual confusion, the Judge concluded that there was a likelihood of confusion in relation to each mark and each type of use by Easyway.

Further, the Judge held that there was trade mark infringement under section 10(3) as easyGroup had a reputation in relation to the EASYJET mark and Easyway's use of the signs was likely to dilute the distinctive character of the EASYJET mark.

Defences

Easyway had tried to claim that their signs consisted of a descriptive term and that their use was in accordance with honest commercial practices, within the meaning of section 11(2). The Judge swiftly rejected this contention on the basis that Easyway was not using the words 'easy' and 'way' in a descriptive sense.

Likewise, Easyway's attempt to establish a defence of honest concurrent use failed because as at the relevant date, the parties had only co-existed for a few years and Easyway's use had been small in extent whereas easyGroup's use had been extensive.

Passing off

Dealing briefly with this point, the Judge held that Easyway's use of both 'easyway' and 'easyway SBH' would constitute passing off, irrespective of the differences between the parties' businesses. However, the use of the stylised 'easyway' sign did not constitute passing off because of the use of the green and blue colours, in contrast to easyGroup's standard orange and white colouring.

Joint tortfeasance

Noting that Mr Roche was both a director and 60% shareholder of Easyway, and that Mr Roche was an active participant in the company's key decisions, the Judge held that Mr Roche was jointly liable for trade mark infringement and passing off.

Acquisition of an earlier registration to use as a sword and shield in infringement proceedings

ABP Technology Ltd v Voyetra Turtle Beach, Inc. & Turtle Beach Europe Ltd (Miles J; [2021] EWHC 3096 (Ch); 19 November 2021)*

In a case where ABP alleged that use of STEALTH infringed its STEALTH marks, Turtle Beach acquired an earlier registration for STEALTH to use as a sword and a shield: to defend the infringement claim and to counterclaim for infringement and invalidity of ABP's rights. Miles J dismissed ABP's summary judgment application and permitted Turtle Beach to amend its defence in part. The decision has been appealed. Robert Milligan reports.

Facts

ABP alleged that Turtle Beach had infringed two of its UK trade marks for STEALTH and STEALTH VR, both registered in relation to 'audio headsets for playing video games', by use of the sign STEALTH in relation to video game headsets. Turtle Beach did not deny such use but sought to rely on the defence of honest concurrent use. ABP applied for summary judgment.

In the meantime, Turtle Beach acquired, via a third-party agent, a registered UK trade mark for STEALTH covering 'Hi-fi apparatus, instruments and loudspeakers; parts and fittings for all the aforesaid goods' (the "Registration") that pre-dated ABP's rights.

Turtle Beach sought to amend its defence to rely on the Registration as a defence to infringement and to counterclaim that ABP's rights were invalid and that ABP had infringed the Registration. ABP objected to the amendment on the grounds that (i) use made by Turtle Beach of STEALTH for gaming headsets fell outside the scope of the Registration; and (ii) should the Court allow the amendment, ABP would suffer irreparable prejudice because ABP was deprived of the chance to revoke the Registration on grounds of non-use partly due to Turtle Beach's covert plan to acquire the Registration and its late application to amend the defence.

Summary judgment relating to the existing defence of honest concurrent use

The Judge was not satisfied that Turtle Beach lacked a real prospect of successfully defending the claim on the basis of honest concurrent use. Although the case law concerned much longer periods of concurrent use than the 7 or so years in question, the cases did not stipulate a minimum period of use. The Judge also found that the assessment had to be made on a multi-factorial basis that considered, amongst others, consumers' understanding of the use of the mark by the two different businesses.

Application to amend the defence

The Judge found that Turtle Beach's amendment had not been made late as the proceedings were at a very early stage, pleadings were not yet closed, and no work already done or costs incurred had been wasted. Turtle Beach was only required to propose the amendments to its defence upon the transfer of the Registration's legal title to it.

Miles J said that ABP's real grievance was that Turtle Beach had acquired the Registration and then used it under licence for a few months without disclosing those facts to ABP until the transfer of the legal title. However, the non-disclosure of the acquisition of the Registration did not contravene any procedural requirements or abuse the court's processes. ABP had also the opportunity to acquire the Registration or apply for it to be revoked.

The Judge held that, although ABP would have been prejudiced by allowing the application, the prejudice had not arisen from any unjustified delay by Turtle Beach, the proceedings would not be disrupted, and any earlier work undertaken would not be wasted. Therefore, the application to amend the defence was granted.

ABP's argument that permission to amend should not be granted for use of the mark during the three month period of the licence was rejected on the basis that such a restriction would circumscribe the statutory defences and claims Turtle Beach sought to rely on and was entitled to rely on under the law.

The Judge dismissed ABP's claim that the goods covered by the Registration were dissimilar to audio headsets by finding that there was an arguable case to the contrary.

In relation to Turtle Beach's counterclaim for invalidity of ABP's registrations, Miles J found that the law required the genuine use of the mark to be by the proprietor or with its consent and, in the present case, this was not the case. Turtle Beach was neither the proprietor of the Registration nor acting with the proprietor's consent when using the STEALTH mark prior to the relevant date in March 2020. It had also not requested permission to rely on use of the mark by the previous owner. Therefore, it had no realistic prospect of proving genuine use of the mark and permission to amend the pleadings to include a counterclaim for invalidity of ABP's registrations was refused.

With regards to Turtle Beach's counterclaim for infringement, the Judge found there to be an arguable case based on the Registration and that any defences relied on by ABP, such as, honest concurrent use would need to be pleaded in full and decided at trial.

Permission for Turtle Beach to rely on the Registration as part of its honest concurrent use argument was refused on the basis that it had been acquired after the proceedings had commenced and would not assist with establishing use prior to the relevant date.

The CJ and GC decisions can be found at https://curia.europa.eu/jcms/jcms/j_6/en/. Cases marked with a * can be found at <http://www.bailii.org/>.



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