

Bird & Bird

Reports of Trade Mark Cases

For the CIPA Journal

March 2022



Trade mark decisions

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

Ref no.	Application (and where applicable, earlier mark)	Comment
GC	GRILLOUMI BURGER	In opposition proceedings, the GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b).
T-593/19	<ul style="list-style-type: none">meat, fish, poultry and game; fruits and vegetables; jellies, jams, compotes; eggs; milk products; edible oils and fats (29)	The BoA erred in finding that the goods and services were dissimilar. The GC held that, as foodstuffs of animal origin (such as meat) and cheese were commonly stocked in close proximity on supermarket shelves and commonly consumed together, they had a low degree of similarity. It also held that, as cheese and restaurant-type services were complementary, they had a weak degree of similarity.
Republic of Cyprus v EUIPO; Fontana Food	<ul style="list-style-type: none">coffee, tea, cocoa; preparations made from cereals; bread, pastry and confectionery; condiments; spices; ice (30)	
T-595/19	<ul style="list-style-type: none">services for providing food and drink; coffee-shop services; restaurants (43)	Nonetheless the GC found that there was no likelihood that people would establish a link as to commercial origin between the Grilloumi Burger-branded goods (even in relation to milk products) and the Halloumi marks on the basis that, even if they perceived a connection between Grilloumi and Halloumi in relation to cheese, when considered overall, the respective marks had a low degree of similarity.
Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO; Fontana Food	XALLOYMI HALLOUMI	
	<ul style="list-style-type: none">dairy product and specifically folded cheese known as fresh and mature halloumi (29)	
8 December 2021		
Reg 207/2009		
Reported by: Chloe Birkett		

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-76/21</p> <p>Masterbuilders, Heiermann, Schmidtman GbR v EUIPO; Francesco Cirillo</p> <p>19 January 2022 Reg 2017/1001</p> <p>Reported by: Adeena Wells</p>	<p>POMODORO</p> <ul style="list-style-type: none"> – scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for controlling electricity; apparatus for recording, transmission or reproduction of sound or images; digital recording media; cash registers, computers; computer software; fire-extinguishing apparatus (9) 	<p>In proceedings for revocation on the grounds of non-use, the GC upheld the decision of the BoA pursuant to article 58(1)(a) that sufficient evidence was submitted to prove genuine use of the mark in relation to "countdown timers" and "downloadable application software".</p> <p>The GC held that the proprietor had submitted valid evidence of use of the mark POMODORO in the form of sales reports demonstrating the number of units of the "countdown timers" sold, a report from an e-commerce platform demonstrating further sales of the items, and sample invoices all dated within the relevant five-year period. While sales volumes were relatively insignificant, this was offset by taking into account that the relevant goods were not everyday consumer goods, the sales were made regularly during the relevant time period and covered a broad territorial scope.</p> <p>The GC also held that the proprietor demonstrated sufficient use of the "downloadable application software" through a list of the number of application downloads from an email service and sample application download requests. These pieces of evidence adequately showed a relatively high proportion of downloads from customers mainly within the EU during the relevant period, taking into account that the application was only available for download for less than six months within the relevant period.</p>

Relevant date in counterclaim for revocation on the basis of non-use

Husqvarna AB v Lidl Digital International GmbH & Co. KG (CJ; C-607/19; 17 December 2020)

On a request for a preliminary ruling from the Bundesgerichtshof (Federal Court of Justice, Germany), in counterclaims to infringement actions, the CJEU held that the relevant date for the purposes of determining whether the continuous five-year period for non-use had ended was that on which the counterclaim was filed. Milena Velikova reports.

Background

Lidl sold a spiral hose set consisting of a spiral hose, a sprinkler nozzle and a coupling sleeve from July 2014 until January 2015. Husqvarna filed an action in the German court against Lidl alleging infringement of its EUTM registration for a three-dimensional mark (shown below) covering 'sprinklers for irrigation' in class 21. In September 2015, Lidl counterclaimed by requesting the revocation of Husqvarna's registration on the basis of non-use.



At first-instance, the court upheld Husqvarna's claims and dismissed Lidl's counterclaim. Lidl brought an appeal before the Higher Regional Court of Düsseldorf, which set aside that judgment and declared that Husqvarna's EUTM registration should be revoked for non-use as of 31 May 2017.

German law vs the EU Regulation

The point referred to the CJEU concerned how the relevant end date for the five-year non-use period was to be determined. According to German law, the relevant date was not the date on which Lidl had filed its counterclaim (September 2015) but was the date of the last hearing before that German court, i.e. 24 October 2017. By contrast, Article 51(1)(a) of Regulation 207/2009 did not specifically indicate the relevant date, although Article 55(1) stated that an EUTM registration is not to have existed from the date of a successful revocation counterclaim. At the date of the counterclaim in September 2015, goods had been marketed under the earlier mark within the last five years, whereas that was not the case within the five years preceding the date of the last hearing.

CJEU's decision

The CJEU considered that relying on the date of the last hearing would not be consistent with the consequences of revocation as per Article 55(1), i.e. that an EUTM registration would be deemed not to have existed from the date of a counterclaim. The approach of the German court would have led to situations where an EUTM registration was revoked from the date of a counterclaim, even where it was not technically vulnerable to such a non-use action at the date of the counterclaim.

The CJEU also pointed out that the unitary character of the EUTM would be undermined if proprietors' scope of protection varied in the context of revocation counterclaims depending on the procedural rules of Member States in which the counterclaims were filed. The merits of a counterclaim for non-use revocation of an EUTM registration could not be dependent on the length of national proceedings.

As such, the relevant date for the purposes of determining whether the continuous five-year period had ended was the date on which that counterclaim was filed.

Trade mark infringement and passing off

*easyGroup Ltd v Easylife Ltd & Anr** (Judge Briggs (sitting as a High Court Judge); [2021] EWHC 2150 (Ch); 29 July 2021)

The Defendants were successful in an action brought against them for trade mark infringement and passing off even though the weight of their evidence was not prepared in accordance with PD57AC. Although they did not disclose details of the process by which the consumer evidence they relied on was collected, the Court gave weight to the fact that their witnesses were cross-examined by experienced counsel at trial. Mark Day reports.

Facts

easyGroup owned a family of 'easy' brands. Easylife's primary business was the catalogue retailing of household goods, which it had developed into online services under the signs Easylife Group and Easylife.

easyGroup alleged that Easylife's use of the signs 'easylife group', 'easylifegroup.com', 'easyclean', 'easy green' and 'easycare' in relation to its core services amounted to trade mark infringement of easyGroup's UK trade marks EASYJET, EASYGROUP, EASYLAND and EASY4MEN, and that such use amounted to passing off. Easylife denied the allegations and counterclaimed that the trade marks relied on should be revoked under section 46.

Revocation of easyGroup's marks

Judge Briggs held that EASYLAND and EASY4MEN should be revoked as there had been no genuine use in the relevant period. In relation to EASYLAND, the Judge commented that easyGroup's main evidence should be treated with some caution - no attempt was made to provide evidence of a commercial enterprise, turnover of overhead costs, or that tax was paid in the relevant period. Evidence was given that the EASYLAND 'shop' depended on the goodwill of customers to use an "honesty box" and there was no evidence of connection between the mark and the marketing of the goods in question. In relation to EASY4MEN, the Judge commented that no evidence of real commercial exploitation of the mark had been provided and a product produced 14 years ago could not be relied upon for genuine use.

The specifications of 'EASYJET' and 'EASYGROUP' were each partially revoked to produce fair descriptions based on the use of the marks.

Weight given to consumer witness evidence

easyGroup's pre-trial application to have consumer evidence relied on by Easylife struck out was dismissed, leaving the issue of how much weight should be given to that evidence to the trial Judge (see The CIPA Journal , October 2021).

Documents concerning the collection of the evidence had not been disclosed, meaning that easyGroup and the Court were not fully able to scrutinise the evidence. The Judge agreed with easyGroup's criticisms of this but, although this lack of transparency would lean in favour of the evidence having no weight, experienced counsel had tested all elements of the evidence in cross-examination at trial. The Judge ruled that the evidence must therefore carry some weight and that it was right to include the evidence within the "global assessment".

Trade Mark Infringement

The assessment of the infringement claim was made on the basis of 'EASYJET' in relation to class 39 ("transportation of passengers...by air...") and 'EASYGROUP' in relation to class 35 ("the commercial administration and management of licensing of goods or services...").

The Judge noted that inter alia the case related to dissimilar services, and that the average consumer would not be confused by the signs complained of because inter alia 'easy' was a descriptive, non-distinctive word. The claim under section 10(2) was therefore dismissed.

In relation to section 10(3), the Judge ruled that the average consumer would not make the relevant link. Further, there was insufficient evidence of detriment to either distinctive character or repute of easyGroup's marks.

Passing off

The Judge noted that there was no convincing evidence to support a finding that a substantial number of the public would be deceived. easyGroup failed to discharge the heavy burden to show false representation and so the claim for passing off was dismissed.

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/>.

Editorial Contacts



Katharine Stephens

Partner

+442074156104
katharine.stephens@twobirds.com



Aaron Hetherington

Trademark Attorney

+442074156183
aaron.hetherington@twobirds.com



Bryony Gold

Associate

+442030176892
bryony.gold@twobirds.com

Reporters

Chloe Birkett; Adeena Wells; Milena Velikova; Mark Day

This report was first published in the CIPA Journal, March 2022

twobirds.com

- Abu Dhabi ● Amsterdam ● Beijing ● Bratislava ● Brussels ● Budapest ● Casablanca ● Copenhagen ● Dubai ● Dusseldorf ● Frankfurt ● The Hague ● Hamburg ● Helsinki ● Hong Kong ● London ● Luxembourg ● Lyon ● Madrid ● Milan ● Munich ● Paris ● Prague ● Rome ● San Francisco ● Shanghai ● Singapore ● Stockholm ● Sydney ● Warsaw

The information given in this document concerning technical legal or professional subject matter is for guidance only and does not constitute legal or professional advice. Always consult a suitably qualified lawyer on any specific legal problem or matter. Bird & Bird assumes no responsibility for such information contained in this document and disclaims all liability in respect of such information.

This document is confidential. Bird & Bird is, unless otherwise stated, the owner of copyright of this document and its contents. No part of this document may be published, distributed, extracted, re-utilised, or reproduced in any material form.

Bird & Bird is an international legal practice comprising Bird & Bird LLP and its affiliated and associated businesses.

Bird & Bird LLP is a limited liability partnership, registered in England and Wales with registered number OC340318 and is authorised and regulated by the Solicitors Regulation Authority (SRA) with SRA ID497264. Its registered office and principal place of business is at 12 New Fetter Lane, London EC4A 1JP. A list of members of Bird & Bird LLP and of any non-members who are designated as partners, and of their respective professional qualifications, is open to inspection at that address.