

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

August 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>CJ</p> <p>C-99/18 P</p> <p><i>FTI Touristik GmbH v EUIPO; Harald Prantner, Daniel Giersch</i></p> <p>4 July 2019</p> <p>Reg 207/2009</p> <p>Reported by: <i>Adeena Wells</i></p>	 <ul style="list-style-type: none"> - printed matter (16) - transport, travel information (39) - services for providing food and drink, temporary accommodation (43)  <ul style="list-style-type: none"> - printed matter (16) - transport, travel information (39) - education, training, arranging conferences and seminars (41) - services for providing food and drink, temporary accommodation (43) <p>(EUTM)</p>	<p>The CJ upheld the GC's decision that there was no likelihood of confusion between the marks under article 8(1)(b).</p> <p>The CJ held that the word element of a figurative mark in normal script is irrelevant when determining the relevant public's phonetic perception of the marks themselves as figurative marks.</p> <p>FTI Touristik submitted that the GC had erred in finding no phonetic similarity between the respective marks in light of the addition of '.de'. The CJ pointed to the actual wording of the GC's decision, which stated that the heart shape in the mark applied for would unlikely be viewed by the relevant public as a letter 'y' given its unusual nature, and even if the mark was pronounced 'fly', the phonetic similarity between the marks would be reduced by the addition of '.de'.</p> <p>Finally, the CJ dismissed FTI Touristik's claim that the heart symbol was used by Harald Prantner and Daniel Giersch in other instances on their website to replace the letter 'y', as this was not a point of law and was inadmissible.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>Joined cases</p> <p>T-910/16 and T-911/16</p> <p><i>Kurt Hesse v EUIPO - Wedl & Hofmann GmbH</i></p> <p>4 April 2019</p> <p>Reg 207/2009</p> <p>Reported by: <i>Ciara Hughes</i></p>	 <ul style="list-style-type: none"> - various goods and services in classes 7, 11, 20, 21, 25, 28, 30, 34 and 38 	<p>In revocation proceedings, the GC upheld the BoA's decision to partially revoke the mark pursuant to Art 51(1)(a) and to maintain the registration in respect of certain goods in classes 21 and 25.</p> <p>The GC affirmed the BoA's finding that Wedl & Hofmann's evidence of sales of goods bearing the mark to franchisees and licensees constituted evidence of public and outward use of the mark because these sales were acts intended to create or preserve an outlet for goods on the market. This was despite the fact that they were not directed at the end consumer.</p> <p>The GC further held that although Wedl & Hofmann's offering of goods in classes 21 and 25 may have been to promote the purchase of other goods such as 'coffee', the use of the mark established through the evidence of sales of such goods was</p>

not merely token or promotional.



However, the BoA correctly held that Wedl & Hofmann's evidence was insufficient to prove genuine use of the mark in relation to the other goods and services covered by the specification.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-37/18 <i>Stirlinx Arkadiusz Kamusiński v EUIPO; Heinrich Bauer Verlag</i>	Brave paper - paper, printed matter (16) - advertising, promotion and sale of goods including electronic versions of newspapers, paper, printed matter writing or drawing books (35)	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The BoA had been right to find that the marks were visually similar to an average degree as the presence of several letters in the same order at the start of the marks was significant and a consumer was more likely to pay attention to the beginning of a word mark. The later mark shared the same first four letters, differing only in the last. Moreover, 'paper' was descriptive and not capable of dominating the visual impression.
8 May 2019 Reg 2017/1001 207/2009	BRAVO - paper; cardboard (carton) and goods made from materials, printed matter (16) - advertising research; distribution of goods, especially of leaflets and printed matter (35)	Further, for a significant part of the relevant public (the part using the German pronunciation of 'brave') a certain degree of phonetic similarity existed between the marks as the pronunciation of the first part of 'brave' is identical to that of 'bravo'.
Reported by: <i>Mark Day</i>	(German mark)	The GC held that the BoA erred in its conclusion that the conceptual comparison was neutral finding instead that the signs were conceptually similar.



Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-354/18 <i>KID-Systeme GmbH v EUIPO and Sky Ltd formerly Sky plc</i>	SKYFi - apparatus for recording, transmission or reproduction of sound or images; compact discs, computer software; DVD discs; data carriers; computers; computer software (9) - repair of vehicles, scientific apparatus, apparatus for recording, transmission or reproduction of sound or images and computers; installation services (37)	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The initial opposition to the registration was based on two SKY marks. The GC found that the BoA ought to have rejected the opposition on the basis of one of the two marks, as the intervenor had not established that it was authorised by the proprietor of the mark to file a notice of opposition. The intervenor's opposition could only be based on the second mark where it was the registered proprietor.
16 May 2019 Reg 207/2009	SKY - apparatus for recording, transmission or reproduction of sound or images, data carriers, computers, computer software (9) - repair services, installation services (37)	Since neither of the marks, on which the opposition was based, had been registered for more than five years at the time of the publication of the SKYFi application, the BoA had rightly held that the applicant's request for proof of use was inadmissible.
Reported by: <i>Katie Tyndall</i>	(UK mark)	The GC agreed with the BoA's analysis; the marks were, to an average degree, visually, aurally and conceptually similar.


Since the goods and services were identical and the SKY mark had a normal level of inherent distinctiveness, there was a likelihood of confusion.

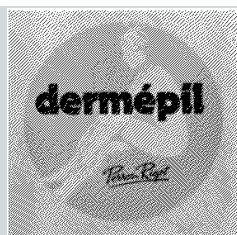
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-197/16 <i>Andrea Incontri Srl v EUIPO</i> 22 May 2019 Reg 207/2009 Reported by: <i>Katie Tyndall</i>	ANDREA INCONTRI - perfumery, cosmetics, aromatics, balms other than for medical purposes, make-up powder, flower perfumes, make-up, eyebrow cosmetics, nail polish, mascara, creams (cosmetic-), deodorants for human beings, oils for cosmetic purposes and other various goods and services in class (3) ANDREIA - beauty products, perfumery and cosmetics (3) (International registration designating the UK and France)	The GC annulled the decision of the BoA, finding that there was no likelihood of confusion under article 8(1)(b). When considering the distinctive character of the mark applied for, the BoA considered two situations, one where 'Andrea Incontri' was considered at a forename and a surname by the relevant public and one where this view was not taken. The BoA made no decision on the issue. The Court could not impose its own view on how the relevant public would envisage the mark. However, the BoA had fallen into error when considering the first hypothesis because it did not consider whether the names were common or rare. It had therefore not conducted an examination of all the relevant factors.
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-312/18 <i>Dentsply De Trey GmbH v EUIPO; IDS SpA</i> 23 May 2019 Reg 207/2009 Reported by: <i>Megan Curzon</i>	AQUAPRINT - laboratory alginates for dental technology purposes, silicones for dental implants (1) - chemical materials for dental impressions, laboratory silicones and alginates and liquids for use in dental technology (5) - impression holders of metal, for dental impressions, orthodontic appliances, machines, instruments, wire and elastomers (10) AQUACEM - chemical products for dentistry or dental technology, dental cement (5) - dental and dental apparatus and instruments, devices for dental and/or dental technology, artificial teeth, crowns, bridges, dentures (10) (German, Danish, UK and International marks) AQUASIL (Unregistered mark)	The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b). Overall, there was weak degree of visual, phonetic and conceptual similarity between the marks. The 'aqua' element of the marks was held to have weak distinctive character. The elements 'print' and 'cem' had an average distinctive character, but this was reduced in respect of dental impressions and dental cements (for the part of the relevant public who considered that 'cem' was an abbreviation of cement), respectively. Nevertheless, when taken together, the elements gave rise to a clear difference between the signs at issue and the BoA was correct in determining that there was no likelihood of confusion. The BoA was also correct to reject the opposition on the basis of article 8(4) as misrepresentation had not been established.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-837/17 <i>Alexandru Negru v EUIPO</i> 23 May 2019 Reg 207/2009 Reported by: <i>Katie Tyndall</i>	 <ul style="list-style-type: none"> - computer software, computer telephony software (9) - advertisement for others on the Internet, business administration services for processing sales made on the Internet (35) - bill payment services provided through a website, collection of payments for goods and services (36) - computer programming and software design (42) <p>SKY</p> <ul style="list-style-type: none"> - computer programs, computer software (9) - advertising and promotional services; business administration; (35) - insurance; (36) - design and development of computer hardware and software; (42) <p>(UK mark)</p>	<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 'Sky' element was the more distinctive word of the two in the application; the word 'Private' to an English speaking relevant public meant, amongst other things, 'confidential and/or secret'. The GC therefore found that the 'Private' element was, at most, weakly distinctive. Furthermore the GC held that with marks composed of word and figurative elements, the word element is the more distinctive. Additionally, the GC found that BoA had correctly held that the distinctive character of the figurative element was weak.</p> <p>The GC agreed that the relevant public might perceive the mark applied for as a new brand line under the earlier mark SKY, and that the BoA had been right in finding that there was a likelihood of confusion on the part of the relevant public.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-3/18 and T-4/18 <i>Holzer y Cia, SA de CV v EUIPO; Annco Inc.</i> 23 May 2019 Reg 2017/1001 Reported by: <i>Robert Milligan</i>	<p>ANN TAYLOR</p> <ul style="list-style-type: none"> - clocks; watches (14)  <p>ANN TAYLOR</p> <ul style="list-style-type: none"> - clocks; watches (14) (EUTMs) <p>ANN TAYLOR</p> <ul style="list-style-type: none"> - clothing (25) (US) 	<p>In an application for a declaration of invalidity under article 59(1)(b), the GC upheld the BoA's decision that Holzer had applied for their EUTMs in bad faith.</p> <p>The GC rejected Holzer's argument that the goods in question were clearly dissimilar and that the relevant consumer would not make a connection between the marks at issue. The GC confirmed that the BoA was correct to conclude that fashion designers' expand their goods offerings to market segments related to clothing, such as, shoes, jewellery, sunglasses, perfumes and watches, and the nexus between these goods should be considered alongside the identity and similarity of the marks as relevant factors in the bad faith assessment.</p> <p>The GC endorsed the BoA's assessment of the evidence relating to Holzer's knowledge of Annco's earlier rights; citing Holzer's approach to Annco for a licence as fatal.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
GC Joined cases T-113/18 and T-114/18 <i>Miles-Bramwell Executive Services Ltd v EUIPO</i> 12 June 2019 Reg 2017/1001 Reported by: <i>William Wortley</i>	FREE - apparatus and instruments for scientific research in laboratories(9) - paper and cardboard; (16) - meat, fish, poultry and game; meat extracts (29) - alcoholic beverages (except beer)(33) - advertising (35) - education (41) - personal and social services rendered by others to meet the needs of individuals (45)	The GC upheld the BoA's decision that the mark lacked distinctive character pursuant to article 7(1)(b). The GC held that the word 'free' is a generic term used in the food sector and that it would be perceived as a promotional or laudatory message promising that the goods and services covered were free from certain ingredients or constituents. Having found that the mark lacked distinctive character, there was no need for the GC to examine if the mark was also descriptive pursuant to article 7(1)(c).

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-583/17 <i>EOS Deutscher Inkasso-Dienst GmbH v EUIPO; IOS Finance EFC, SA</i> 12 June 2019 Reg 207/2009 Reported by: <i>Megan Curzon</i>	 - financial affairs, monetary affairs, real estate affairs, all the aforesaid relating to the management and transfer of credit claims (bills) (36)  - debt collection business, debt-collection services (36) (German mark)	The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b). The BoA was correct to take into account the figurative elements of the marks and the word element 'finance' when assessing similarity. The impact of these elements was not negligible and contributed to the overall impression of the signs. The GC confirmed that the signs at issue were phonetically similar to an average degree, and not conceptually similar. The GC held that the BoA was incorrect in finding that the marks were visually similar to a low degree. Despite the partial similarity of the dominant and distinctive 'eos' and 'ios' word elements, the marks were visually different. The visual differences were more important than phonetic similarities for the services in question, which were often provided via the internet. Consequently, there was no likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-398/18 <i>Radoslaw Pielczyk v EUIPO; Thalgo TCH</i> 13 June 2019 Reg 2017/1001 Reported by: <i>Henry Elliott</i>	 - cleaning preparations, perfumery, various essential oils, dentrifices, smoothing stones (3)	The GC upheld the BoA's decision that there had been genuine use of the earlier mark and that there was a likelihood of confusion under article 8(1)(b). The BoA was correct to conclude that the variants of the earlier mark could be regarded as evidence of use of that mark. None of the variants affected the distinctive character of the earlier mark as registered. The two marks had in common a distinctive and dominant word element




- perfumery products, cosmetics, including wax for hair removal (3)

(French mark)

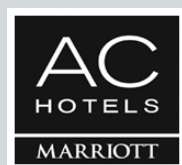
which was virtually identical. The addition of figurative and word elements resulted in an average degree of visual similarity.

The marks were phonetically identical and conceptually neutral, apart from for the French public, which perceived the word elements "dermépil" and "dermæpil" as conveying the same meaning.

There was therefore a likelihood of confusion between the marks, including with regard to goods products that were similar only to a low degree.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-307/17 <i>Adidas v EUIPO; Shoe Branding Europe BVBA</i>	 <ul style="list-style-type: none"> - Clothing, footwear, headgear (25) <p>Description: <i>The mark consists of three parallel equidistant stripes of identical width, applied on the product in any direction.</i></p>	<p>The GC upheld the BoA's decision that the mark was invalid pursuant to article 7(1)(b).</p> <p>Adidas submitted a large volume of evidence in an attempt to meet the threshold of acquired distinctiveness. However much of that evidence did not relate to the mark as registered, and instead showed the mark in reverse (i.e. in white on a dark background). Adidas did submit relevant evidence in the form of five market surveys completed in five member states, but this was found to be insufficient to prove acquired distinctiveness throughout the EU.</p> <p>The GC dismissed Adidas' argument that the BoA had incorrectly assumed that the registration was claimed in specific dimensions, and that they should have treated the registration as a pattern mark. The GC stated that they could only consider what was applied for. This was a figurative mark with no reference to a pattern.</p>
19 June 2019 Reg. 207/2009		
Reported by: <i>Tom Hooper</i>		

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-28/18 <i>Marriott Worldwide Corp. v EUIPO; Associazione Calcio Milan SpA (AC Milan)</i>	 <ul style="list-style-type: none"> - food and drink services, temporary accommodation, cafés, cafeterias, tourist homes, restaurants, hotels, bar services, food and drink catering, motels, snack-bars (43) 	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b).</p> <p>In relation to the mark applied for, the figurative element was visually dominant. The "Milan" element would be perceived as a reference to the city of Milan and due to its size it would not be disregarded by the relevant public. The "ac" element, despite its distinctive character, occupied a negligible position in the mark compared to the other elements. If the word element "ac" was perceived by the relevant public, then that element would not dominate the mark, despite its distinctive character.</p> <p>Visually, the mark applied for and the</p>
19 June 2019 Reg 2017/1001		
Reported by: <i>Henry Elliott</i>		
	AC	
	AC HOTELS BY MARRIOTT	



- all registered in respect of services in Classes 35, 41 and 43

EUTMs

earlier marks were at most similar to a very low degree. If the "ac" element in the mark applied for was negligible, the marks would be visually different.

Phonetically, even if "ac" in the mark applied for was pronounced by the relevant public, there was only a low degree of similarity between the marks.

Conceptually, the "ac" element of the mark applied for reinforced the concept that the mark referred to the well-known football club AC Milan. The Board of Appeal correctly found that, apart from the earlier "AC" mark, the earlier marks conveyed different concepts.

Given the low degree of visual and phonetic similarity between the marks at issue, and their conceptual dissimilarity, the BoA was right to find that there was no likelihood of confusion.

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC

T-397/18

Hugo's Hotel Ltd ("HHL") v EUIPO; H'ugo's GmbH



9 July 2019

Reg 2017/1001

Reported by:
Adeena Wells

- meat products; salads (29)
- burgers contained in bread rolls (30)

H'ugo's

- meat, meat extracts, preserved and cooked fruits and vegetables (29)
- coffee, tea, flour and preparations made from bread (30)
- services for providing food and drink (43)

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

The GC agreed with the BoA that the goods at issue were everyday consumer goods and the average consumer's level of attention was average; despite HHL's submission that consumers in the food and catering sectors were more attentive.

With regards to the assessment of similarity of the marks, the GC held that the BoA was correct to focus on the similarity between the words HUGO'S and H'UGO'S. This was because the dominant and distinctive element of marks in the food and catering sectors was the word element which carried greater impact, given that consumers would order such related goods orally in restaurants or shops.

The marks were held to be visually similar to an average degree and phonetically similar to a high degree, with the goods in class 29 held to be identical and those in class 30 to be similar due to the complementarity.

Ref no.	Application (and where applicable, earlier mark)	Comment
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GC

T-412/18

mobile.de GmbH v EUIPO; Droujestvo S Ogranichena Otgovornost 'Rezon'



- gathering of information (35)
- providing internet platforms for the buying and selling of vehicles, vehicle trailers and vehicle accessories (42)

The GC upheld the BoA's decision that the mark was invalid as there was a likelihood of confusion with the earlier marks under article 8(1)(b).

The BoA had not erred in law in finding that use of the following:
MOBILE.BG,

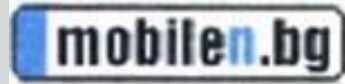
12 July 2019
Reg 2017/1001

Reported by:
William Wortley



- advertising; business management; business administration; office function (35)
- scientific and technological services and research and related design services; industrial analysis and research services; design and development of computer hardware and software; legal services (42)

(Bulgarian mark)



were use of signs differing in elements which did not alter the distinctive element of the earlier national mark. The elements ".BG", "N" and differences in colour were negligible such that the signs were broadly equivalent to the earlier mark. Further, the intervener had adduced proof of genuine use with regard to advertising services in connection with motor vehicles in class 35. The GC held that the use of the signs in connection with websites providing such services, as well as on the cover of specialist magazines, was consistent with use in the sector for the purpose of maintaining or creating market share.

The GC upheld the BoA decision that advertising services in connection with motor vehicles were similar to the 'gathering of information' as this is a preliminary step necessary for advertising goods and also to 'providing internet platforms' as these may be the means by which that advertising is carried out.

Ref no.

Application (and where applicable, earlier mark)

Comment

GC

T-54/18

*Fashion Energy Srl
v EUIPO; Retail
Royalty Co.*



- spectacles (9)
- household textiles and linen (24)
- clothing, footwear, headgear (25)

12 July 2019

Reg 2017/1001

Reported by:
Robert Milligan



- blazers, robes, shoes, hats (25)
- retail store services, all for a wide range of sunglasses (35)

(EUTM)

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

Contrary to Fashion Energy's submission, 'spectacles' was held to be a broad term encompassing 'sunglasses', while 'robes' was found to have a similar purpose and nature to 'household textiles and linen'. The goods in class 25 were held to be identical. The BoA was therefore correct to identify a similarity of goods.

The GC agreed with the BoA's assessment that the pictorial elements of the marks were similar. However, the GC held that the BoA failed to consider the verbal elements of the applied for mark, 1st AMERICAN, when assessing the mark's distinctive character and comparing the overall impression of the marks on the average consumer.

A 2-dimensional figurative mark could not constitute a 'shape which gives substantial value to goods'

Textilis Ltd, Ozgur Keskin v Svenskt Tenn AB (CJ; C-21/18, 14 March 2019)

Following a request for a preliminary ruling from the Swedish appeal court, the CJEU ruled that a sign consisting of two-dimensional decorative motifs cannot be regarded as being a 'shape giving substantial value' where the sign takes the three-dimensional shape of the goods that it is affixed to. Mark Day reports.

Background

Svenskt Tenn is a Swedish company that markets and sells furniture, furnishing fabrics and other decorative accessories. It started working with the architect Joseph Frank in the 1930s, and he designed various patterns for furnishing fabrics for Svenskt Tenn. One of the most famous is a pattern called MANHATTAN, the copyright for which was claimed to be owned by Svenskt Tenn. On 04 January 2012, Svenskt Tenn filed an application for registration of an EUTM for the figurative mark MANHATTAN (shown below) in respect of the following goods and services: lampshades (11); table cloths, coasters of paper (16); furniture (20); glassware, earthenware (21); wall hangings (27); and retail services (35).



Textilis is an English company that began online trading in 2013 and has marketed goods for interior decoration bearing patterns similar to the figurative MANHATTAN mark. This prompted Svenskt to bring an action in the Swedish District Court for trade mark and copyright infringement. Textilis counterclaimed for a declaration that the MANHATTAN mark was invalid because it lacked distinctive character and was made up of a shape which gave substantial value to the goods.

The Stockholm District ruled that Textilis had infringed the MANHATTAN EUTM and the copyright in the pattern. Textilis' appeal was stayed pending a reference to the CJEU in relation to the interpretation of article 7(1)(e)(iii).

Article 7(1)(e)(iii) provides that signs consisting exclusively of 'the shape which gives substantial value to the goods' shall not be registered. From 23 March 2016, Regulation 2015/2424 amended article 7(1)(e)(iii) to provide that signs consisting exclusively of 'the shape, or another characteristic, which gives substantial value to the goods' shall not be registered. The first question raised related to whether the amended provision had retrospective effect.

It was common ground that there was nothing in Regulation 2015/2424 stating that it was applicable to EUTMs registered before it came into effect on 23 March 2016. Further, it was not clear from either the purpose or the scheme of 2015/2424 that it was intended to have retrospective effect. As a result, the Court held that article 7(1)(e)(iii), as amended, should not be interpreted as being applicable to EUTMs registered before its entry into force.

By the second question, the Court was asked whether a sign, such as MANHATTAN, consisting of 2-dimensional decorative motifs which are affixed to the products consist "exclusively of the shape".

It was common ground that the sign in issue was made up of two-dimensional decorative motifs that contained lines and contours. This mark was then affixed to goods such as fabric and paper. The Court noted that while the sign in issue represented shapes which are formed by the external outline of stylised

geographical drawings, decorative elements were contained both inside and outside of those outlines and the sign contained words, in particular 'MANHATTAN'. The Court went on to state a sign consisting exclusively of two-dimensional decorative motifs could not be held to be indissociable from the shape of goods where that sign was affixed to goods and where the form of those goods differed from those of the decorative motifs e.g. fabric or paper.

For these reasons, the Court ruled that MANHATTAN could not be regarded as consisting "exclusively of the shape within" the meaning of article 7(1)(e)(iii).

Benefit's BEAUTY & THE BAY sub-brand found not to infringe or pass off BEAUTYBAY or BEAUTY BAY

***Beauty Bay Ltd & Anr ("BBL") v Benefit Cosmetics Ltd** (Mr Roger Wyand QC; [2019] EWHC 1150 (Ch); 14 May 2019)**

Benefit's use of BEAUTY & THE BAY on the packaging of its Christmas cosmetics gift set did not infringe BBL's UK and EU trade marks for BEAUTY BAY and BEAUTYBAY registered in classes 3 and 35 and did not amount to passing off. Hilary Atherton reports.

Background

BBL is an online retailer of cosmetics, beauty products and accessories founded in Manchester in 2005. It operates worldwide selling (mainly third party but some own-brand) products through its website www.beautybay.com and a mobile phone app. BEAUTY BAY appeared prominently on its website, app, marketing materials, packaging, invoices and receipts.

Benefit is the UK subsidiary of a global manufacturer and retailer of cosmetics based in San Francisco, USA and owned by LVMH. In the UK, Benefit products are sold through its own stores, through Benefit concessions in department stores, Boots, and airports, airlines and ferries, and via its own and third-party websites. The Benefit product in issue was part of a range of products (called the "Holiday 2017" range) targeted specifically at the Christmas 2017 gift market. It was a gift set comprising four cosmetic items contained in a globe-shaped gift box which was intended to celebrate Benefit's San Francisco heritage and mark the 50th anniversary of the Summer of Love. The front and rear of the product are shown below:



BBL brought proceedings against Benefit for trade mark infringement under articles 9(2)(b) and 9(2)(c) and their equivalent provisions under the Trade Marks Act 1994.

Relevant use

Mr Roger Wyand QC (sitting as a Deputy High Court Judge) rejected Benefit's argument that its use of BEAUTY & THE BAY did not constitute trade mark use because it did not serve to indicate the origin of the goods. The Judge said that the fact that Benefit took measures to indicate to the public that the item was a Benefit product did not detract from the function of BEAUTY & THE BAY as a 'sub-brand'.

Infringement under article 9(2)(b)

Benefit accepted that its product was identical to cosmetics in BBL's class 3 registration and similar to retail services connected with the sale of cosmetics in BBL's class 35 registration. The Judge found that the relevant marks were similar to a medium degree, that the average consumer included both those purchasing cosmetics for themselves and those purchasing for others as gifts, and that there was no evidence of any actual confusion, he then went on to find that there was no likelihood of confusion taking into account all relevant circumstances in a global appreciation.

Infringement under article 9(2)(c)

The Judge found that BBL's marks enjoyed a reputation in respect of both its class 3 and class 35 registrations in the UK at the relevant date. However, he was not convinced that the degree of similarity of the mark and sign were such that the average consumer would make the requisite link. Further, the nature of the use made by Benefit in the context of the colours and style of the decoration, including BEAUTY & THE BAY, on the globe, made it even less likely that a link would be made.

In case he was wrong on the question of 'link', the Judge went on to consider the other criteria under article 9(2)(c). Although the BEAUTY & THE BAY product was the best-selling product in Benefit's Holiday 2017 range, the Judge said it could not be assumed that this was due to a change in economic behaviour resulting from the making of the relevant link by consumers. Therefore, there was no likelihood that the use of BEAUTY & THE BAY by Benefit resulted in detriment to the distinctive character or repute of BBL's marks. The Judge also found that this was not a case of Benefit seeking to ride on the coat-tails of BBL's marks. He accepted the evidence of Benefit's Senior Director of Copy and of a freelancer engaged by Benefit to assist with the development of the Holiday 2017 range that the choice of the name BEAUTY & THE BAY owed nothing to the BBL marks or reputation. Furthermore, he did not believe as a matter of fact that the Benefit product took any advantage of the distinctive character or repute of the BBL marks, let alone any unfair advantage.

Defence under article 14

The Judge said that, had Benefit infringed BBL's marks, its defence under article 14(1)(b) would have failed because there was no evidence that the average consumer would perceive BEAUTY & THE BAY as descriptive or merely decorative but, rather, as having an origin function.

Passing off

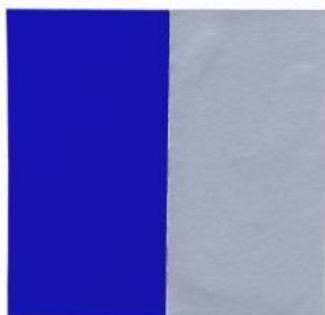
Having found there was no likelihood of confusion, the Judge did not believe there were any considerations that were relevant under the law of passing off that would lead him to find that the use resulted in a misrepresentation to the average consumer. Therefore, BBL's claim in passing off also failed.

Colour combinations

Red Bull GmbH (supported by Marques) v EUIPO, Optimum Mark sp. z o.o. (CJ; C-124/18; 29 July 2019)

The CJEU held that the combination of two colours was insufficiently clear and precise to be registered as a trade mark under article 4, despite the fact that the marks had been registered on the basis of acquired distinctiveness through use. Katharine Stephens reports.

Optimum applied to invalidate two of Red Bull's marks under article 52(1)(a) of Regulation 207/2009 in conjunction with articles 7(1)(a), (b) and (d) and article 52(1)(b). The marks, which had both been registered in Class 32 for energy drinks with an indication that they had acquired distinctive character through use, were comprised of the following representation:



The written descriptions were different. The first mark was accompanied by the following description: "Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio is approximately 50%-50%". In relation to the second mark, and following a request from the examiner, the mark was registered with the indication of the colours "blue (Pantone 2747C), silver (Pantone 877C)" and the following description "The two colours will be applied in equal proportion and juxtaposed to each other". The Cancellation Division found both marks invalid on the basis of articles 7(1)(a) and 4 of Regulation 207/2009. The BoA, the GC and the CJ dismissed Red Bull's appeal at each stage respectively.

The Court held that article 4 requires that a sign may only be registered if the applicant provides a graphic representation in which the subject matter and scope of protection sought is clearly and precisely determined. Further, where the application is accompanied by a verbal description of the sign, that description must clarify and not be inconsistent with the subject matter and scope of the protection sought. The Court in *Heidelberger Bauchemie* (C-49/02) also added that where a mark consists of a graphic representation of two or more colours designated in the abstract and without contours, the colours have to be arranged systematically so that they are associated in a predetermined and uniform way.

The GC applied these principles correctly when it found that the marks were invalid because they allowed for a plurality of reproductions that were neither determined in advance nor uniform. The GC had noted that the presence of the word "approximately" in the description of the first mark reinforced the imprecise nature of the graphic representation and, in relation to the second mark and by reference to the description, that "juxtaposition" could take different forms, giving rise to different images or layouts, while still being "in equal proportion". The Court specifically noted that, contrary to Red Bull's claims, requiring a mark to exhibit a systematic arrangement associating the colours in a predetermined and uniform way did not transform it into a figurative mark, since such a requirement did not mean that the colours had to be defined by contours.

From the evidence that was filed with the applications for registration (and on the basis of which the marks had been accepted as having acquired distinctiveness through use), it could be seen that the marks were used in a very different manner from the graphic representation. The GC had been entitled to consider this evidence and to take account of the various manifestations of the use made of the marks.

The principles of equal treatment and proportionality were not infringed by the GC when it referred to the CJ's case law when noting that particular attention had to be paid to not unduly restricting the availability of colour marks for other traders who offered goods and services of the same type.

Furthermore, Red Bull could not rely on the principle of protection of legitimate expectations. Red Bull contended that as the marks were considered valid by EUIPO before the CJ's judgment in *Heidelberger Bauchemie*, the requirements stemming from that judgment should apply only to trade marks registered after it had been delivered in June 2004. The Court held that this ground of appeal was only open to someone who had been given precise, unconditional and consistent assurances by a competent EU authority and Red Bull had not established that such assurances had been made. It could not rely upon combining a number of factors, namely the then current EUIPO guidelines, the additional clarification sought by the examiner and the fact that the marks were initially registered. The Court noted that, contrary to Red Bull's submissions, the examination of distinctive character by the EUIPO or by the EU judicature under article 7(1)(b) did not mean that the requirement for a trade mark to be clear and precise under article 4 had already been met.

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

Editorial team

Katharine Stephens

Partner, IP

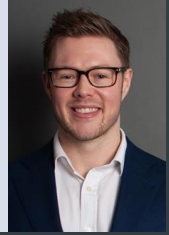
Tel: +44 020 7415 6104
katharine.stephens@twobirds.com



Thomas Pugh

Associate, IP

Tel: +44 020 3017 6873
thomas.pugh@twobirds.com



Reporters

Adeena Wells; Ciara Hughes; Mark Day; Katie Tyndall; Megan Curzon; Robert Milligan; William Wortley; Henry Elliott; Tom Hooper; Hilary Atherton

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