

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

December 2020




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-76/19 <i>Pontinova AG v EUIPO; Ponti & Partners, SLP</i></p> <p>13 May 2020 Reg 2017/1001</p> <p>Reported by: <i>Emma Ikpe</i></p>	 <p>– legal services (45)</p> <p>PONTI</p> <p>– industrial and intellectual property consultancy services (42)</p> <p>(Spanish registration)</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 confirmed that the services were identical as 'industrial and intellectual property consultancy services' were encompassed by 'legal services' insofar as the former necessarily included the provision of advice on intellectual property rights.</p> <p>Finding that the marks were visually and aurally similar to an average degree, the GC emphasised the importance of the common element 'ponti' as it was the only element of the earlier mark and the initial part of the mark applied for. As neither mark had a meaning, the conceptual comparison was neutral.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-564/19 <i>Lozano Arana ("LA") & Ors v EUIPO; Coltejer SA</i></p> <p>28 May 2020 Reg 2017/1001</p> <p>Reported by: <i>Charlotte Addley</i></p>	<p>LIBERTADOR</p> <p>– bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations; soaps; perfumery, essential oils, cosmetics (3)</p> <p>– jewellery, precious stones; horological and chronometric instruments (14)</p> <p>– leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks; wallets; handbags (18)</p> <p>– building materials (non-metallic) (19)</p> <p>– clothing; shoes; headgear (25)</p>	<p>The GC upheld the BoA's decision and dismissed the appeal against the Cancellation Division's order for revocation of the registration.</p> <p>LA claimed that he had not been informed of the application for revocation by his former legal representative, so was not in a position to lodge evidence of genuine use of the mark within the time limit prescribed.</p> <p>However, the GC held that LA's right to be heard had not been infringed: the Cancellation Division had duly notified LA's former representative of the application for revocation and could not be held responsible for the former representative's lack of diligence. Further, the GC noted that when LA became aware of the application for revocation it was still possible to lodge an application for <i>restitutio in integrum</i>, but LA failed to do so.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-601/19 <i>Osório & Gonçalves, SA</i></p>	 <p>– beer and brewery products (32)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion under article 8(1)(b) between the marks.</p> <p>In accordance with article 47(2) and (3), the evidence as a whole was brief but</p>

<p><i>("O&G") v EUIPO; Miguel Torres, SA</i></p>	<ul style="list-style-type: none"> – cider; preparations for making alcoholic beverages; wine; and other alcoholic goods and beverages (33) 	<p>sufficient to show genuine use of the earlier mark in relation to wines. The evidence that demonstrated the mark had been affixed to wines in Spain solely for their export to third countries was acceptable.</p>
<p>23 September 2020</p>	<p>INFINITE</p> <ul style="list-style-type: none"> – wines (33) <p>(Spanish registration)</p>	<p>Despite being split into groups of letters, the mark applied for strongly resembled the Spanish word 'infinitud', meaning 'infinitude'. As a result, the marks were conceptually similar to a high degree, and phonetically similar to a higher than average degree. They were visually similar to a low degree.</p>
<p>Reg 2017/1001</p>		<p>The BoA had erred in having found an average, rather than low degree, of similarity between beer and wines, since they differed significantly in their composition and method of production. Notwithstanding this, the GC held there was a likelihood of confusion for all goods. It was noted that the higher than average phonetic similarity was of particular importance in the assessment because consumers often purchased alcoholic goods orally.</p>
<p>Reported by: <i>Stephen Allen</i></p>		
Ref no.	Application (and where applicable, earlier mark)	Comment

<p>GC T-677/19</p>	<p>SYRENA</p> <ul style="list-style-type: none"> – computer and video game programs and software, none of the aforesaid goods relating to the aeronautical field, and in particular helicopters and rotorcrafts (9) – motor vehicles for locomotion by land and parts therefor (12) – games and playthings, model vehicles; scale model vehicles made of all materials, in particular paper model vehicles and die-cast model vehicles or plastic model vehicles (28) 	<p>In proceedings for revocation on the basis of non-use, the GC annulled the decision of the BoA to the extent that it upheld the registration of the mark in respect of 'cars' pursuant to article 58(1)(a).</p> <p>The GC upheld the BoA's finding that the intervener had demonstrated genuine use for 'racing cars'. The GC noted that racing cars were a specialised market notable for the sale of limited numbers of vehicles. In light of the features of the specific market, sales figures were not necessary for establishing genuine use. The GC was satisfied that there had been an effort to secure a market share by way of the preparatory tasks and advertising efforts made, and the cars had been marketed and was available to order.</p> <p>The GC held that racing cars were a subcategory of 'cars' generally, since their purposes were different. For example, racing cars were not driven on public roads. Since the evidence submitted only demonstrated use for racing cars, the BoA had been wrong to find that genuine use in respect of cars generally.</p>
<p><i>Polfarmex S.A. v EUIPO; Arkadiusz Kaminski</i></p>		
<p>23 September 2020 Reg 207/2009</p>		
<p>Reported by: <i>Laura Goold</i></p>		

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-788/19</p>		<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>T-851/19 <i>Body Attack</i> <i>Sports Nutrition</i> <i>GmbH & Co. KG v</i> <i>EUIPO; Maria</i> <i>Sakkari</i></p> <p>15 October 2020 Reg 2017/1001</p> <p>Reported by: <i>Katie Tyndall</i></p>		<ul style="list-style-type: none"> – woven fabrics, textile goods, substitutes for textile goods, towels of textile, bath towels, knitted elastic fabrics for sportswear (24) <p>ATTACK</p> <ul style="list-style-type: none"> – clothing, footwear, headgear, aforementioned goods also for use in sports (25) – articles for gymnastics and sports (28) <p>Body Attack</p> <ul style="list-style-type: none"> – garment covers [storage] (20) – towels (24) – t-shirts, jackets, fitnesswear, sportswear of any kind (25) 	<p>The GC upheld the BoA's finding that the goods applied for in class 24 were dissimilar to those covered by the earlier marks in class 25, on account of their different natures, methods of use and purposes, even if, in some cases, they had a degree of complementarity due to the fact that fabrics might be used for the production of clothing. The BoA was therefore correct to find that there was no likelihood of confusion in relation to the earlier mark ATTACK.</p> <p>Noting that the 'SAKK' element was more dominant for the part of the relevant public which understood the word 'attack' and that the figurative elements of the marks applied for had an average degree of distinctiveness, the GC found that the signs were visually and aurally similar to a low degree to the Body Attack mark. The degree of conceptual similarity was low at most for the English-speaking public.</p> <p>As a result, the GC upheld the BoA's finding that there was no likelihood of confusion in relation to the earlier Body Attack mark, despite some of the goods being identical.</p>
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Rewording specification following change in Nice Classification

Edison SpA ("Edison") v EUIPO (CJ (Ninth Chamber); C-121/19P; 16 September 2020)

The CJEU upheld the GC's decision to reject the rewording of a trade mark's list of goods following a change in the Nice Classification between application and registration of the mark. Theo Cooper reports.

Background

Edison filed an EUTM application for the figurative mark shown below in August 2003, for all of the goods falling within class 4 of the Nice Classification. At the time of the application, the eighth edition of the Nice Classification was in force, which made no reference to electrical energy within class 4.



Edison's mark was registered in August 2013, by which time the ninth edition of the Nice Classification was in force, which added 'electrical energy' to the alphabetical list of goods in class order under class 4 ('the alphabetical list'). In June 2015, Edison entered a request for surrender and rewording of a portion of the goods registered in class 4, to expressly include electrical energy.

The examiner refused this rewording on the basis that it would extend the list of goods claimed at the time of registration. Edison appealed this decision before the BoA, which dismissed the appeal on the basis that the eighth edition of the Nice Classification did not refer to electrical energy in the general indications under Class 4 or the alphabetical list, and therefore Edison could not have intended to claim protection for those goods at

the time of filing. Edison sought annulment of the BoA's decision before the GC, on the basis that the decision unlawfully excluded electrical energy under the terms 'fuels (including motor spirit)' and 'illuminants' in the heading of class 4, and 'carburants'/'motor fuel' in the alphabetical list of the eighth edition of the Nice Classification. This plea was rejected and the action dismissed. Edison appealed on the ground that the GC's interpretation of 'illuminants', 'fuels (including motor spirit)' and 'carburants'/'motor fuel' was incorrect.

Decision

The CJEU held that Edison had failed to make out certain of its arguments with sufficient precision, for example by alleging that the GC had failed to adopt a 'functional approach' without specifying where in the judgment that was the case. The CJEU endorsed the GC's finding that goods must be identified in the application with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of protection on that basis alone.

The CJEU also held that the validity of the GC's decision was unaffected by the fact that the EUIPO had drafted a list of goods (including electrical energy) for the ninth edition of the Nice Classification before the application was made. The GC had considered this evidence before reaching its decision, along with other evidence adduced such as the positions of environmental bodies and the fact that certain electric vehicles had already been put on the market. The GC made clear in its judgment that this evidence had been examined but was not considered sufficient to prove Edison's argument.

The CJEU further held that complaints against incidental grounds expressed by the GC for completeness were ineffective, and that the main reason for the GC's decision was its finding that electrical energy was not within the customary and ordinary meaning of the terms disputed. The CJEU also rejected Edison's argument that the GC had failed to consider a statement on the WIPO website stating that electrical energy is considered analogous to tangible fuels within class 4, as the GC explicitly conceded this analogy in its judgment, but held that electrical energy is not covered by the literal meaning of the goods within that class.

Bait and switch selling

***Pliteq Inc & Anr v iKoustic Ltd & Anr** (Miss Recorder Amanda Michaels; [2020] EWHC 2564 (IPEC); 2 October 2020)**

Save for a single webpage on iKoustic's website, Pliteq's claim against iKoustic for trade mark infringement and passing off failed. The recorder found that Pliteq's rights in its marks had been exhausted and that they did not have legitimate reasons to oppose iKoustic's use of them. Hilary Atherton reports.

Pliteq designed, made and sold a range of acoustic damping and sound control products under the trade marks GENIECLIP and GENIEMAT. In 2011, iKoustic became a non-exclusive distributor of Genieclip and Geniemat products. There was no written agreement between the parties and no restriction on iKoustic from offering competing products. The commercial relationship between the two companies later broke down and in 2019 iKoustic sourced and launched competing 'MuteMat' and 'MuteClip' products on its website.

For a period of some months, iKoustic sold both parties' products without Pliteq's consent. Pliteq claimed that iKoustic used the GENIECLIP and GENIEMAT marks for the purpose of selling its own, rather than Pliteq's, products. It claimed iKoustic had used those marks directly to customers as well as on its website and also in keyword and sponsored adverts on Google to attract custom which was diverted to iKoustic's own MuteMat and MuteClip products. It brought a claim against iKoustic for trade mark infringement and passing off. Pliteq did not claim that the parties' respective marks were confusing, but that iKoustic had used Pliteq's marks to sell their own goods under their own distinct trade marks, and that this amounted to trade mark infringement by "bait and switch" selling.

The recorder observed that the alleged infringements were not "classic" bait and switch selling - they could be distinguished from the facts of cases such as *Cosmetic Warriors Limited v Amazon.co.uk Ltd* [2014] EWHC 1316 (Ch) where Amazon had no Lush goods at all to sell and had never stocked them. Here, iKoustic did have a stock of genuine goods bearing Pliteq's marks and relied on the exhaustion defence under section 12/article 15. Further, the recorder was satisfied that the average consumer would have understood from the various communications from iKoustic that it was offering an alternative product to Pliteq's goods.

The recorder found that the rights in all of Pliteq's goods held by iKoustic had been exhausted. The only exception was use of GENIECLIP on a single webpage to announce that the product was out of stock and to advertise the availability of iKoustic's alternative product. As this did not amount to use in relation to goods to which Pliteq's rights had been exhausted, it did not amount to use of the mark by iKoustic in order to recommercialise Pliteq's goods. As such, the exhaustion defence did not apply to that webpage. In relation to all other uses, the recorder found that there were no legitimate reasons to oppose the further commercialisation of Pliteq's goods by iKoustic – there was no likelihood of damage to the marks' reputation, no false implication of a trade connection or any evidence of confusion of as to origin, and merely selling competing goods did not amount to taking an unfair advantage of the marks' reputation. Even when iKoustic had only limited stock of the marked goods, the exhaustion defence still applied. The recorder said that to find otherwise would be to add a significant limitation to the exhaustion defence which could not be found under the relevant provisions. The sole question was whether the use of the mark related to goods which had already been placed on the market by the proprietor or with his consent and would be seen by the average consumer as relating to the claimant's goods. Otherwise, all resellers of marked goods would run the risk that at some indeterminate point the defence would become unavailable to them, simply because they had sold some but not all of their stock of the products.

Therefore, Pliteq's trade mark infringement claim failed. Its claim for passing off was also rejected.

High Court guidance on Geographical Collective Trade Mark

Foundation for the Protection of the Traditional Cheese of Cyprus Named Halloumi (the "Foundation ") v Babel Sajt Kft. ("Babel") (Smith J; [2020] EWHC 2858 (Ch); 30 October 2020)

Summary

The Judge held that the Hearing Officer failed to properly account for the collective nature of the opposing mark when determining whether the registration of a new mark would give rise to a likelihood of confusion. The Judge provided guidance as to how the particular nature of a collective mark should be taken into account in determining (i) the identity of the average consumer and (ii) the likelihood of confusion. Louise O'Hara reports.

Facts

A Hungary based company, Babel filed a UKTM application to register a figurative mark containing the word element "Halloumi" (as depicted below) for 'milk and milk products; dairy and dairy products; cheese and cheese products' in class 29.



The Foundation sought to oppose this application, but the procedure to obtain a Protected Designation of Origin for Cyprus' 'halloumi' cheese had not been completed; and it presently remains unresolved. As a result, when the Foundation filed a notice of opposition against this application it had to rely on its EU collective mark registration for HALLOUMI for 'cheese' goods in class 29 instead.

The Foundation's opposition was brought on the grounds of sections 5(2)(b) and 5(3). In respect of the first ground the Hearing Officer found that there was no likelihood of confusion because there was only a low degree of visual similarity between the marks and the distinctive character of the EUTM registration for HALLOUMI was low. The officer referred primarily to a previous opposition brought by the Foundation, concluding that

she saw no reason to disagree with the CJEU's analysis (*Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO*, Case C-766/18P, reported in *The CIPA Journal* December 2019).

The Appeal

The Foundation appealed this decision on a number of grounds, including that the Hearing Officer had "failed to accord the Foundation's mark an appropriate minimum degree of distinctiveness". Smith J disputed the Foundation's reference to the Article 7's requirements as "minimum distinctive requirements", on the basis that the absolute grounds need not be expressed in terms of a minimum level of distinctive character; the nature of distinctive character incorporates its own threshold – a mark either has distinctive character or has no distinctive character.

Smith J considered that, whilst a collective mark should be considered like any other EUTM, the nature of a collective mark (as a mark of association rather than a single undertaking) requires particular consideration when determining how similar an EU collective mark is with another EUTM. The Hearing Officer failed to consider the significance that an average consumer would attach to the use of the Foundation's mark within Babel's trade mark. The Hearing Officer also failed to take any account of the collective nature of the Foundation's mark when determining the identity of the average consumer. A trade consumer would be aware of the difference between an EU collective mark and a EUTM designating a single undertaking as the origin of the product.

The Hearing Officer's decision on the distinctiveness of the Foundation's mark was also criticised on the basis that she relied entirely on the CJEU's reasoning from a previous case. While the CJEU's decisions on the application of law are binding, the question of similarity of the marks is a question of fact that needs to be considered in the context of each case.

The Judge set aside the Hearing Officer's decision and opted to deal with the opposition rather than remitting it.

The Opposition

The Judge endorsed the conclusion of the Hearing Officer that there was a high degree of similarity between the goods at issue. Contrary to the Hearing Officer, he held that the average consumer would comprise both ultimate consumers and trade purchasers. Ultimate consumers would not be alive to the significance of HALLOUMI as a collective mark and would not be confused into considering that Babel's mark indicated that Babel was a member of the Foundation. For the trade purchasers, however, they would appreciate that the use of the HALLOUMI mark indicated that the product stemmed from being a member of the Foundation. The incorporation of the word HALLOUMI into to a larger mark featuring the word "HAJDU" would indicate to trade purchasers that the cheese was produced by Hajdu, a member of the Foundation.

As a result, Smith J found a very strong likelihood of confusion and rejected Babel's application to register the mark.

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

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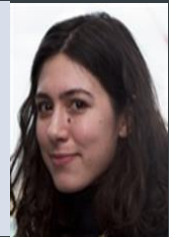
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