



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


February 2021



Trade mark decisions

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

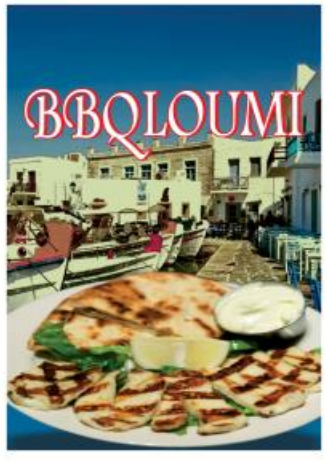
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-35/20 <i>Monster Energy Company ("Monster") v EUIPO; Nanjing aisiyou Clothing Co. Ltd</i></p> <p>2 December 2020 Reg 2017/1001</p> <p>Reported by: <i>Mark Day</i></p>	 <ul style="list-style-type: none"> – bags (18) – clothing (25) – advertising (35)  <ul style="list-style-type: none"> – bags (18) – clothing (25) – promotional services (35) 	<p>The GC annulled the BoA's decision insofar as it had rejected Monster's opposition based on articles 8(1)(b) and 8(5).</p> <p>The GC found that the BoA had erred in its assessment that there was low visual and conceptual similarity between the marks. The GC considered that the very similar stylisation of the vertical lines in all of the marks (which recalled claws or scratch marks) would have drawn the attention of the relevant public and outweighed the differences identified by the BoA, such that the degree of visual similarity was average. The GC found that the overall impression created was similar and the conceptual similarity, for the part of public that would regard the marks as claws/scratch marks, was also average.</p> <p>In light of this, and the assumed identity of the goods and services, the BoA had been wrong to rule out a likelihood of confusion. The BoA's error also vitiated its findings in respect of article 8(5).</p>
Ref no.	Application (and where applicable, earlier mark)	Comment

<p>GC T-190/20 <i>Almea Ltd v EUIPO; Sanacorp Pharmahandel GmbH</i></p> <p>9 December 2020 Reg 207/2009</p> <p>Reported by: <i>Charlotte Peacock</i></p>	 <ul style="list-style-type: none"> – cosmetics; preparations for the care and treatment of the body, face, skin and hair (3) – sanitary preparations for medical purposes; veterinary preparations; food for babies; plasters; disinfectants (5) <p>MEA</p> <ul style="list-style-type: none"> – cosmetics; soaps; hair lotions (3) – pharmaceutical and veterinary preparations; food for babies; plasters; disinfectants (5) <p>(German 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 held that the BoA had not erred in finding at least a low degree of phonetic and visual similarity between the respective marks.</p> <p>In particular, the GC agreed with the BoA's finding that, notwithstanding the fact that the first element of word marks were more likely to catch the consumer's attention than subsequent elements, the additional letters "AL" at the start of the opposed mark did not prevent consumers from perceiving the common element "MEA". The GC agreed with the BoA that "MEA" represented three fifths of the opposed mark and therefore contributed significantly to the overall impression.</p> <p>The GC confirmed that the figurative elements of the opposed mark would be perceived as secondary to the word elements.</p>
--	---	--

The identity and/or high degree of similarity of the respective goods was not in dispute.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-30/20 <i>Promed GmbH kosmetische Erzeugnisse v EUIPO; Centrumelektronik i sp.j.</i> 9 December 2020 Reg 40/94 Reported by: <i>Emma Ikpe</i>	Promed – test strips for medical purposes (5) – apparatus for measuring body temperature and functions (9) – surgical, medical, dental and veterinary instruments and apparatus, in particular pain therapy apparatus; orthopaedic stockings; insulin pens; foot massagers, massage apparatus; apparatus for radiotherapy, in particular heat and light therapy (10)	In the context of invalidity proceedings, the GC upheld the BoA's decision that the mark lacked distinctive character in relation to all goods under article 7(1)(b). The GC agreed that the Cancellation Division had not ruled outside the scope of the application for a declaration of invalidity, in declaring the registration invalid in respect of the class 5 goods, despite the fact that the form itself limited the application to the goods in classes 9 and 10. Further, the GC affirmed the BoA's finding that the combination of 'pro' and 'med' would be understood to refer to the concepts of 'professional' and 'medical' respectively. As such, the GC was satisfied that, viewed as a whole, the mark served a purely promotional function without indicating the commercial origin of the goods, and was therefore devoid of distinctive character.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-883/19 <i>Gustopharma Consumer Health, SL v EUIPO; Helixor Heilmittel GmbH</i> 16 December 2020 Reg 207/2009 Reported by: <i>Sophie Stoneham</i>	HELIX ELIXIR – health food supplements made principally of vitamins; nutritional supplements; food supplements; dietary supplements consisting of vitamins (5) HELIXOR – pharmaceutical preparations and medicines, in particular for the treatment for leukaemia and cancer; veterinary preparations (5)	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The attention of the relevant public was held to be higher than average because the respective goods affected the end consumer's state of health. Nevertheless, the BoA had not erred in finding that nutritional and dietary supplements were similar to the goods covered by the broad category of "pharmaceutical preparations," in particular because they were all composed of chemicals and used as health care products. The marks were held to be visually and phonetically similar to an average degree because both marks shared the same first five letters ("HELIX"). The marks could not be compared conceptually, partly because the relevant public included Slovak-speaking individuals and "HELIX" had no meaning in that language.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-328/17 RENV <i>Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO; M. J. Dairies EOOD</i></p> <p>20 January 2021 Reg 207/2009</p> <p>Reported by: <i>Stephen Allen</i></p>	 <ul style="list-style-type: none"> - dairy products and dairy substitutes; cheese products; meat extracts (29) - sandwiches; condiments; sauces (30) - restaurant services; fast food services; cafeterias; catering (43) <p>HALLOUMI</p> <ul style="list-style-type: none"> - cheese (29) <p>(EU collective mark)</p>	<p>After the CJEU referred the case back to the GC (C-766/18 P reported <i>May 2020 CIPA p.27</i>), the GC upheld the BoA's decision that there was no likelihood of confusion between the marks under article 8(1)(b).</p> <p>The GC originally held that (1) that the goods in classes 29 and 30, except for 'meat extracts', were identical or similar to the goods covered by the earlier mark; (2) that the earlier mark possessed only a low level of inherent distinctiveness and that enhanced distinctiveness had not been proven through use; and (3) that the marks were similar to a low degree. These findings were not called into question on appeal.</p> <p>In the global assessment, considering the low degree of similarity between the marks, the GC noted that the shared element 'loumi' was not dominant and had a weak degree of distinctiveness. The GC therefore concluded that even for those goods in class 29 which were identical, consumers would not establish a link between the marks: at most they would connect the mark with the goods designated by the earlier mark, namely halloumi cheese, and this was not sufficient to establish a likelihood of confusion.</p>

High Court upholds oppositions based on earlier use of unregistered mark

***Yellow Bulldog Ltd v AP & Co Ltd** (Morgan J; [2020] EWHC 3558 (Ch); 25 November 2020)**

The Judge held that the Hearing Officer had not erred in her assessment of the evidence of goodwill and misrepresentation in a decision to uphold oppositions based on earlier use of an unregistered mark. The Court clarified that the role of the appeal court is not to re-evaluate the evidence but to examine whether there was some identifiable flaw in the treatment of the question to be decided. Bryony Gold reports.

Facts

In 2018, Yellow Bulldog Ltd filed two applications for the device mark shown below incorporating the words 'Geek Store' for retail services in connection with a range of goods that included video games and equipment, various items of clothing, and low-value gift items in class 35.



AP & Co. Ltd opposed the applications on the grounds of passing off under section 5(4), based on (i) its earlier use throughout the UK of the unregistered word mark GEEKCORE in relation to similar goods, and (ii) bad faith due to Yellow Bulldog's alleged awareness of that use.

In respect of the first ground, the Hearing Officer found that the evidence filed by AP & Co established the three elements necessary to prove a passing off claim in the UK (namely goodwill, misrepresentation and a likelihood of damage). The opposition was therefore upheld. In reaching this conclusion, the Hearing Officer considered that the marks were visually dissimilar but shared a medium to high degree of conceptual and aural similarity. As the opposition succeeded on the basis of the passing off claim, bad faith was not addressed.

Appeal

Yellow Bulldog appealed the decision on grounds which mostly related to the Hearing Officer's evaluation of the evidence adduced by AP & Co. It challenged the finding that the evidence demonstrated goodwill, and of the aural and conceptual similarity of the marks at issue.

The High Court dismissed the appeal, finding that the Hearing Officer had not erred in law by reaching the conclusion she did based on the evidence. It was noted that Yellow Bulldog had not taken the opportunity to cross-examine the 'general and patchy' evidence of AP & Co's witness and that, in absence of that, the witness statement and the exhibits had to be taken for what they were. The Hearing Officer had commented on and accounted for the deficiencies in the evidence. Morgan J emphasised that the role of an appeal court was not to re-evaluate the evidence, but to ask whether the decision of the Hearing Officer was wrong by reason of some identifiable flaw in treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermined the cogency of the conclusion. The Hearing Officer was not wrong by any such reason and it was open to her to make the findings she did. Furthermore, the question of similarity between the marks was a clear case of evaluation by the Hearing Officer, with which there was no basis for the appeal court to interfere.

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

Tel: +442074156104
katharine.stephens@twobirds.com



Thomas Pugh

Associate

Tel: +442030176873
thomas.pugh@twobirds.com



Aaron Hetherington

Trademark Attorney

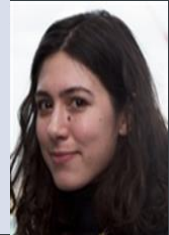
Tel: +442074156183
aaron.hetherington@twobirds.com



Ciara Hughes

Trademark Attorney

Tel: +442074156193
ciara.hughes@twobirds.com



Reporters

Mark Day; Charlotte Peacock; Emma Ikpe; Sophie Stoneham; Stephen Allen; Bryony Gold

This report was first published in the [CIPA Journal](#), February 2021