


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

December 2019







Trade mark decisions

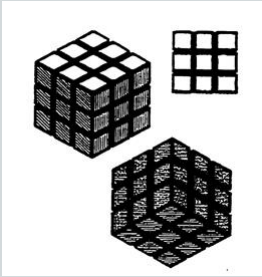
Decisions of the General Court (GC) and Court of Justice (CJ)


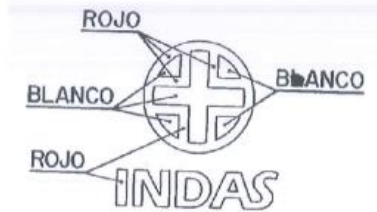
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-536/18 <i>Nestlé SA v EUIPO; European Food SA</i>	FITNESS - dairy products, jellies, fruit, vegetables, protein preparations (29) - cereals; foodstuffs based on rice or flour (30) - non-alcoholic drinks (32)	Following the EUIPO's dismissal of an application for a declaration of invalidity under article 59(1)(a), European Food filed an appeal in which they submitted new evidence before the BoA. The matter was referred to the GC on the admissibility of this evidence before returning to the BoA. The BoA had held that the new evidence had to be taken into account and, therefore, found the registration to be invalid on the basis that the mark was descriptive of the goods. However, the GC found that the BoA was not required to take into account the new evidence but instead it should have exercised its discretion as to whether the evidence should be admissible and provide reasons explaining their decision. Therefore, the GC annulled the BoA's decision.
10 October 2019 Reg 2017/1001		
Reported by: <i>Robert Milligan</i>		
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-10/19 <i>United States Seafoods LLC v EUIPO</i>	 - fish; fish fillets (29)	The GC upheld the BoA's decision that the mark was descriptive pursuant to article 7(1)(c). The word and figurative elements of the mark in combination were descriptive of the nature and geographical origin of the goods concerned. The relevant English-speaking general public would have perceived the sign as referring to seafood originating from the US, since part of the US flag was reproduced in the mark. The differences between the sign and the US flag were minor. As a result of the conclusion on article 7(1)(c), it was unnecessary for the GC to consider arguments based on article 7(1)(b).
17 October 2019 Reg 207/2009		
Reported by: <i>Nicholas Puschman</i>		
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-279/18 <i>Alliance Pharmaceuticals Ltd v EUIPO; AxiCorp GmbH</i>	AXICORP ALLIANCE - pharmaceutical and veterinary preparations; dietetic substances adapted for medical use (5) ALLIANCE	The GC annulled the BoA's decision in so far as the BoA dismissed the opposition under articles 8(1)(b) and (5), because the BoA had infringed article 47(2) by interpreting the specification of the earlier rights strictly on the basis of a

<p>17 October 2019 Reg 2017/1001</p> <p>Reported by: <i>Bryony Gold</i></p>	 <p>- pharmaceutical preparations but not including infants' and invalids' foods and chemical preparations for pharmaceutical purposes (5)</p>	<p>literal meaning only.</p> <p>The BoA had interpreted the specification of Alliance's rights as excluding 'chemical preparations for pharmaceutical purposes'. Since Alliance had only proved genuine use of its marks for those excluded goods, its opposition was rejected insofar as it was based on articles 8(1)(b) and (5).</p> <p>The GC held that , if correct, this would lead to the absurd result that Alliance had intended to register a category of goods which it then restricted by a broadly equivalent category of goods. The GC held that, where two literal interpretations of a specification are equally possible, other factors should be taken into account when interpreting specifications, in particular the intention of the proprietor concerned. To avoid absurd results for proprietors, specifications should be given their most plausible and predictable interpretations in light of such factors.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-41/19</p> <p><i>MSI Svetovanje, marketing, d.o.o. ("MSI") v EUIPO; Industrial Farmaceutica Cantabria, SA</i></p>		<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b) in relation to the goods that had been found to be identical or similar.</p> <p>In relation to the goods in class 5, the fact that the food supplements covered by the earlier mark were sold in pharmacies and specialist shops, whilst the pharmaceutical preparations covered by the mark applied for were only sold in pharmacies, was not sufficient to prevent them being similar. Nor was the fact that they were produced according to different standards.</p> <p>The marks were held to be visually similar, and phonetically similar to an average degree. The common identical element 'nume' was placed at the beginning of the earlier mark where it was most eye-catching. The figurative elements of the later mark – placing 'nu' on top of 'me' in thick, stylised lettering – were not sufficient to distract the relevant public from the common element. The GC did not accept MSI's submission that the separation of the elements meant that consumers would pronounce the mark 'new me'.</p>
<p>24 October 2019 Reg 2017/1001</p> <p>Reported by: <i>Elizabeth Greene</i></p>	<p>- pharmaceutical, veterinary and sanitary preparations for medical purposes; dietetic foods adapted for medical purposes; nutritional supplements (5)</p> <p>- meat, fish, poultry and game; milk and milk products (29)</p> <p>- ice cream; beverages based on cocoa, coffee, chocolate or tea (30)</p> <p>NUMEDERM</p> <p>- food supplements for human beings for medical purposes, for supplementing a normal diet and for improving health (5)</p> <p>- meat, fish, poultry and game; milk and milk products (29)</p> <p>- coffee, tea, cocoa and artificial coffee; ices and ice creams (30)</p>	

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-498/18 T-708/18 <i>ZPC Flis sp.j</i> <i>("Flis") v EUIPO;</i> <i>Aldi Einkauf</i> <i>("Aldi")</i>	  <p>- confectionary, sweetmeats [candy], wafer biscuits, waer rolls, pastries (30)</p> <p>- retailing or wholesaling of confectionary, cookie molds, edible wafers and rolled wafers; the aforementioned but via the internet (35)</p>	<p>The GC upheld the BoA's decision to allow the opposition under article 8(1)(b) in respect of all goods and services in the application, with the exception of services for the retailing or wholesaling of cookie molds.</p> <p>The BoA failed to take into account the effect of a limitation relating to the earlier German marks when it made the contested decision. The GC therefore annulled the decision of the BoA insofar that it applied to goods other than those for which the earlier marks were actually registered. However, this did not affect the outcome of the assessment on whether there was likelihood of confusion.</p>
24 October 2019 Reg 207/209 (replaced by 2017/1001)	  <p>- coffee, coffee-based products and beverages with a proportion of coffee; cocoa-based beverage powder (30) (the "amended list of goods")</p> <p>(Earlier German marks)</p>	<p>The marks were held to be similar on account of the fact that the later marks reproduced the earlier marks in their entirety. The distinctive element of the marks was the word 'moreno' and the figurative elements were laudatory, negligible and secondary to the overall impression. Similarly, the decorative differences could not offset the visual similarity and the overall impression was that the marks were phonetically very similar.</p>
Reported by: <i>Mark Day</i>		
Ref no.	Application (and where applicable, earlier mark)	Comment

GC T-58/18 <i>Ramona Mahr v EUIPO;</i> <i>Especialidades Vira, SL</i>	<p>XOCOLAT</p> <p>- chocolate, chocolate goods; cocoa products; chocolates and confectionery (30)</p> <p>LUXOCOLAT</p> <p>- pastry and confectionary goods; chocolates, nougat, marzipan, cocoa (30)</p> <p>- wholesaling and retailing or sale via global computer networks of pastry and confectionery, chocolates, nougat, marzipan (35)</p> <p>- transport, storage and distribution of pastry and confectionery, chocolates, nougat, marzipan (39)</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 there was visual similarity between the marks, as the mark applied for was wholly contained within the earlier mark. The fact that earlier mark had two additional letters 'LU' at the start was not sufficient to neutralise the visual similarity produced by the common element 'XOCOLAT'.</p> <p>Further, the BoA's finding that the earlier mark had a weak distinctive character did not preclude a finding of a likelihood of confusion: the distinctive character of an earlier mark was only one factor to be taken into account when assessing likelihood of confusion.</p>
24 October 2019 Reg 2017/1001		
Reported by: <i>Robert Rose</i>		

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-601/17 <i>Rubik's Brand Ltd v EUIPO; Simba Toys GmbH & Co. KG</i></p> <p>24 October 2019 Reg 2017/1001</p> <p>Reported by: <i>Rebecca Slater</i></p>	 <p>- three-dimensional puzzles (28)</p>	<p>In an application for a declaration of invalidity, the GC upheld the BoA's decision that the three-dimensional mark should be cancelled on the basis that it consisted solely of the shape of the goods which was necessary to obtain a technical result under article 7(1)(e)(ii).</p> <p>Contrary to the BoA, the GC held that the essential characteristics of the mark were limited to the overall cube shape, the black lines and little squares on each face of the cube and did not include the differences in the colours on the six faces of the cube.</p> <p>However, the BoA had correctly defined the intended technical result as 'axially rotating, vertically and horizontally, rows of smaller cubes of different colours until the nine squares of each face of the cube show the same colour'. The cube shape and physical separation between the small cubes, represented by the black lines, were necessary to achieve that technical result so the BoA's decision was upheld.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-380/18 <i>Intas Pharmaceuticals Ltd v EUIPO; Laboratorios Indas, SA ("Laboratorios")</i></p> <p>07 November 2019 Reg 2017/1001</p> <p>Reported by: <i>Dean Rae</i></p>	<p>INTAS</p> <p>- prescription-only human or veterinary medicines (5)</p> <p>- medical or veterinary injection apparatus (10)</p>  <p>- disposable products for use during medical procedures (10)</p>  <p>- pharmaceutical, veterinary and sanitary preparations; plasters, materials for dressings (5)</p> <p>(EUTM and Spanish marks)</p>	<p>The GC upheld the BoA's decision that the earlier marks had been put to genuine use by the Laboratorios and that there was a likelihood of confusion between the marks under article 8(1)(b).</p> <p>The BoA correctly found that the earlier marks had been put to genuine use in connection with the goods in class 10 as well as 'gauzes' and 'cottons' which constituted genuine use in relation to 'materials for dressings' in class 5, as this was a sufficiently specific and narrowly defined category of goods.</p> <p>The GC held that the BoA was correct to find a high degree of phonetic similarity and an average degree of visual similarity between the marks as they shared the same length, rhythm and intonation. The goods at issue were also similar to an average degree as they were complementary and shared the same intended purpose and distribution channels.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>CJ C-528/18 P <i>Outsource Professional Services Ltd ("Outsource") v Flatworld Solutions Pvt Ltd ("Flatworld"); EUIPO</i></p> <p>13 November 2019 Reg 207/2009</p> <p>Reported by: <i>Nicholas Puschman</i></p>	 <ul style="list-style-type: none"> - business administration; office functions (35) - receiving, processing and handling of orders (36) - temporary employment agencies (41) 	<p>The CJ dismissed Outsource's appeal against the GC's decision which had found that Outsource had acted in bad faith under article 52(1)(b).</p> <p>The GC had held that Outsource had acted in bad faith when it applied to register a mark which was similar to an unregistered mark being used by Flatworld after it became clear that pre-contractual commercial discussions between the parties would not lead to an agreement.</p> <p>Although, the CJ found that the GC had distorted certain facts and evidence as part of its assessment, it held that Outsource had acted in bad faith in applying for the mark which was in use by Flatworld and which Outsource had previously used in connection with its proposed collaboration with Flatworld.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-149/19 <i>Société des produits Nestlé SA ("Nestlé") v EUIPO; Jumbo Africa, SL</i></p> <p>14 November 2019 Reg 2017/1001</p> <p>Reported by: <i>Elizabeth Greene</i></p>	 <ul style="list-style-type: none"> - soups, soup concentrates, stock in the form of cubes, of tablets or granulates (29) - bread, yeast, pastry, rice, pasta, noodles, pizza, sandwiches, sauces, condiments (30)  <ul style="list-style-type: none"> - meat, fish, poultry and game, jellies, jams, eggs, milk and milk products (29) - coffee, tea, cocoa, sugar, bread, pastry and confectionary, yeast, sauces (condiments), spices (30) 	<p>The GC annulled the BoA's decision and held that there was no likelihood of confusion under article 8(1)(b).</p> <p>The GC noted that the human figures depicted in the marks were the dominant elements of each but had a weak distinctive character as they were likely to indicate to the relevant public that the foodstuffs would make people strong or healthy rather than denoting origin. Taking account of the other figurative elements, the GC concluded that the earlier mark had a weak distinctive character.</p> <p>The GC held that the marks were not visually similar although they were conceptually similar to an average degree as both suggested that the goods were beneficial to health.</p> <p>In view of the weak distinctive character of the earlier mark and the lack of visual similarity, no likelihood of confusion could be established, even if the goods in question were regarded as identical.</p>

Lack of clarity and precision in specification of goods/services and registration in bad faith

***Sky plc, Sky International AG, Sky UK Ltd ('Sky') v SkyKick UK Ltd, SkyKick Inc ('SkyKick')* (AG Tachev for the CJEU; C-371/18; 16 October 2019)**

In the opinion of the AG, a trade mark registration should not be invalidated for a lack of clarity and precision in the goods and/or services specified. However, there may be grounds to invalidate the registration, in whole or part, either where the goods and/or services are unjustified and contrary to public policy, or, on the grounds of bad faith - where the applicant has applied for a trade mark without any intention to use it for the specified goods and/or services. Robert Milligan reports.

Background

Sky, a satellite and digital broadcaster, owned four EUTM registrations, and one UK trade mark registration, consisting of the word element SKY for various goods and services, including "computer software". Sky sued SkyKick in the UK for infringement of the SKY marks by virtue of SkyKick's use of SKYKICK in relation to downloadable software and cloud migration information technology goods and services.

SkyKick denied infringement and counterclaimed for a declaration that the SKY marks were invalidly registered, in whole or in part, on the grounds that (i) the specifications of goods and services lacked clarity and precision, and (ii) the applications were made in bad faith. The High Court referred five questions to the CJEU.

Can a trade mark be declared wholly or partially invalid on the grounds that it was registered for goods and services that are not specified with sufficient clarity and precision?

AG Tachev opined that there was no provision in any of the relevant EU legislation for the invalidity of a registered trade mark on the ground that some or all of the terms in the specification of goods or services lacked sufficient clarity and precision as article 51 of Regulation 40/94 was exhaustive. However, the fact remains that a lack of clarity and precision in the specification of goods and services will have an effect on the scope of protection afforded to the registration.

Is a term such as 'computer software' too general and does it cover goods which are too variable to be compatible with the trade mark's function as an indication of origin?

AG Tachev was decisive in stating that the registration of a trade mark for 'computer software' was unjustified and contrary to the public interest because it conferred on the proprietor of the trade mark a monopoly of immense breadth which could not be justified by any legitimate commercial interest of the proprietor.

As a result, AG Tachev opined that the requirement for clarity and precision could be covered by article 3(1)(f) of the Trade Marks Directive and article 7(1)(f) of the EUTMR, which provide for the refusal or invalidity of trade marks which are contrary to public policy. A term such as 'computer software' was too general, and covered goods and services which were too variable, to be compatible with the trade mark's function as an indication of origin.

Can it constitute bad faith simply to apply to register a trade mark without any intention to use it in relation to the specified goods or services?

AG Tachev was of the opinion that applying for a trade mark without any intention of using it for the specified goods or services may constitute an element of bad faith under article 51(1)(b) of Regulation 40/94. He stated that this type of registration is an abuse of the trade mark system inasmuch as the applicant is improperly seeking a monopoly to exclude potential competitors from using a sign which the applicant has no intention of using.

Does bad faith apply only to the specific goods and services for which there is no intention to use the trade mark for?

Pursuant to article 51(3) of Regulation 40/94 and article 13 of the Trade Marks Directive 89/104, AG Tachev opined that where the ground for invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark is to be declared invalid as regards those goods or services only.

Is section 32(3) of the Trade Marks Act 1994 compatible with the EU trade mark regime?

AG Tanchev was of the view that section 32(2) of the Trade Marks Act 1994, which requires an applicant of a UK trade mark application to make a statement upon filing that they intend to use the mark, is compatible with the Trade Marks Directive 89/104; provided it is not the sole basis for a finding of bad faith.

Distinctive character of geographical collective trade marks

Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v European Union Intellectual Property Office (CJ, C-766/18 P; 17 October 2019)

The CJEU held that the distinctive character of geographical collective trade marks must be assessed according to the general trade mark criteria and consequently dismissed the opposition based on the registration of the mark HALLOUMI to the figurative mark containing the word BBQLOUMI. Olivia Bowden reports.

Background

The procedure to protect "halloumi" as a Protected Designation of Origin for cheese made by Cypriot producers has been ongoing since 2014 and remains unresolved. In the meantime the Foundation for the Protection of Traditional Cheese of Cyprus named Halloumi (the "Foundation") secured the designation "HALLOUMI" as an EU collective mark for goods in class 29 with the description "cheese." The Foundation has since sought to prevent certain undertakings from using the designation "HALLOUMI" as a trade mark.

On 9 July 2014, M.J. Dairies filed an application with EUIPO for the registration of a colour figurative mark containing the word "BBQLOUMI" (depicted below) for classes 29, 30 and 43.



The Foundation filed a notice of opposition, relying on article 8(1). The Opposition Division rejected the opposition, which was then followed by an unsuccessful appeal to the BoA and an unsuccessful appeal to the GC. The BoA and GC rejected the appeals on the grounds that the registered collective mark had low distinctive character because it merely described a well-known Cypriot cheese and therefore a likelihood of confusion could not be established.

The Decision

Article 66(2) provides that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, may constitute Community collective marks within the meaning of article 66(1). The Foundation argued that the distinctive character of geographical collective marks under article 66(2) cannot be assessed by reference to general criteria.

In response, the CJ confirmed that geographical collective marks are subject to the general trade mark criteria underlining that the essential function of a collective mark is to guarantee the collective commercial origin of goods and services. As such, the distinctive character of a geographical collective mark must therefore be assessed according to the extent to which it identifies such collective commercial origin of the goods or services concerned.

AG Kokott cited *Tea Board v EUIPO* (C-673/15 P) as the leading case on geographical collective marks, highlighting it was a good example of the application of article 66(2) because "DARJEELING" is both the name of a city in India and it stands for a well-known black tea grown there.

In contrast, AG Kokott explained that the "HALLOUMI" mark does not designate a specific place. According to AG Kokott the mark was merely associated with the country Cyprus, which was in itself doubtful as the cheese is also widespread across other countries in the region often under similar or identical designations. Accordingly, the CJ held that the "HALLOUMI" mark only gives rise to identification of the commercial origin at most to a low degree. On this basis, the CJ upheld the GC's finding that there was no likelihood of confusion under article 8(1).

Method for comparing signs

EUIPO v Equivalenza Manufactory SL ("Equivalenza") (Opinion of AG Saugmandsgaard Øe; C-328/18 P; 14 November 2019)

AG Saugmandsgaard Øe opined that the GC had misinterpreted article 8(1)(b) by carrying out a 'global assessment of similarity' at the stage of comparing the marks and not carrying out a global assessment of the likelihood of confusion. Ciara Hughes reports.

Equivalenza applied to register the figurative sign below at the EUIPO for 'perfumery' in class 3.



ITM Enterprises opposed Equivalenza's application on the grounds of a likelihood of confusion under article 8(1)(b), based, inter alia, on an international registration, designating various EU member states, for the earlier figurative mark below covering identical goods in class 3.



The EUIPO upheld the opposition in full based on a likelihood of confusion on the part of the relevant public in the Czech Republic, Hungary, Poland and Slovenia. The BoA rejected Equivalenza's appeal. Considering that the relevant public in those member states had an average level of attention, the BoA found that the goods were identical and that, despite being conceptually dissimilar, the signs were similar overall due to their average degree of visual and aural similarity. The BoA concluded that there was a likelihood of confusion.

The GC overturned the BoA's decision. Whilst agreeing that the signs had an average degree of aural similarity and were conceptually dissimilar, the GC held that the signs conveyed different overall visual impressions. In carrying out a global assessment of the similarity of the signs, the GC noted that perfumes were generally sold in self-service stores or perfume shops and so the visual aspect of the signs was more important for their overall impression than their aural and conceptual aspects. The GC therefore concluded that the signs were not similar, based on an overall impression, and that the BoA had erred in finding that there was a likelihood of confusion.

The EUIPO appealed to the CJEU.

The AG observed that there was no need to carry out the global assessment of the likelihood of confusion when signs were not similar. However, the AG noted that the case-law of the GC diverged into two methods for assessing the similarity of signs; a 'strict' method and a 'flexible' method.

According to the 'strict' line of case-law, at the stage of comparing the signs the GC should simply compare the visual, aural and conceptual similarities of the signs. If similarity was found, even if it is weak, in any one of those aspects, then the signs were similar, satisfying the first condition of article 8(1)(b). If the goods or services were also similar, then the GC had to carry out the global assessment of the likelihood of confusion. The circumstances in which the goods or services were marketed and any 'counteraction' of the similarities found on account of their conceptual difference had to be examined as part of the global assessment alongside all other relevant factors including the distinctive character of the earlier mark and the degree of attention of the relevant public.

In contrast, the 'flexible' line of case-law required the GC to not only compare the visual, aural and conceptual aspects of the signs but also to balance the degrees of similarity and differences found for each aspect, taking into account marketing conditions of the goods and services and any possible counteraction, as part of the 'global assessment of similarity'. If the GC held that the differences outweighed the similarities, then it had to conclude that the marks were dissimilar overall and not carry out the global assessment of the likelihood of confusion.

The AG considered that the 'flexible' approach conflated the objective comparison of the signs, which was simply to establish the existence of any similarity, with the global assessment, which was to determine whether those similarities, considered alongside all other relevant factors, were sufficient to give rise to a likelihood of confusion. Further, the AG stressed that the question of whether similarities between the signs were sufficient to give rise to a likelihood of confusion could not be assessed in isolation: the principle of interdependence and consideration of all relevant factors as part of the global assessment of the likelihood of confusion were crucial in ensuring that the assessment correlated as closely as possible with the actual perception of the relevant public of the signs. As a result, the 'flexible' method risked curtailing the analysis of the similarities between the signs without sufficient consideration of all other relevant factors in the global assessment of the likelihood of confusion.

The AG therefore recommended that the CJEU adopt a position in favour of the 'strict' method for assessing the similarity of signs and took the view that the GC had erred in law by finding that the signs at issue were dissimilar overall despite having an average degree of aural similarity.

Bentley Clothing prevails against Bentley Motors

Bentley 1962 Ltd and Anr ("Bentley Clothing") v Bentley Motors Ltd ("Bentley Motors")*
(Judge Hacon; [2019] EWHC 2925 (Ch); 1 November 2019)

Bentley Motors infringed Bentley Clothing's registered trade mark for BENTLEY. In reaching his conclusion, Judge Hacon considered: (i) whether a combination mark could be considered use of one mark or two; (ii) the extent of a defence available pursuant to the transitional provisions of the Trade Mark Act 1994 and (iii) whether honest concurrent use could provide a defence in a situation where there had been long term co-existence. Louise Vaziri reports.

Facts

Bentley Clothing was a seller of clothing that owned a number of registered rights for the trade mark BENTLEY for clothing and headgear. Bentley Motors was the famous luxury car manufacturer. Since 1987

Bentley Motors sold a limited range of clothing and headgear. In 1998 Bentley Clothing offered Bentley Motors an exclusive licence. Negotiations were unsuccessful. Bentley Clothing objected to Bentley Motors use of its wings device logo in combination with the word BENTLEY as shown in the below logo (the "Combination Sign") for clothing and headgear. Bentley Motors unsuccessfully attempted to invalidate Bentley Clothing's trade mark registrations and Bentley Clothing claimed infringement pursuant to sections 10(1) and (2).



Infringement

The Judge found that the average consumer would perceive the Combination Sign as two distinct signs used together. Use of the Combination Sign was therefore use of BENTLEY which, when used in respect of clothing, amounted to infringement of Bentley trade marks pursuant to section 10(1).

As regards the section 10(2) claim, there was a lack of evidence of actual confusion; however the Judge held that this could be explained due to the size and nature of Bentley Clothing's enterprise. The dominant component of the Combination Sign was the word BENTLEY; applying the factors set out in *Maier v ASOS plc* ([2015] EWCA Civ 220), the Judge held that there was a likelihood of confusion.

Transitional provisions of the Trade Marks Act

The 1994 Trade Marks Act contains transitional provisions that provide that use of a sign which was lawful under the 1938 Act but which was no longer lawful under the 1994 Act can continue. Bentley Motors sold a limited range of garments prior to November 1994. The Judge held that the transitional provisions only provided a defence for use of a sign in the same manner, and in relation to the same goods, that it had been used prior to the 1994 Act. Bentley Motor's use of the sign was different to, and for a wider selection of clothing than, its use prior to the implementation of the 1994 Act. Accordingly, its defence under the transitional provisions was not sufficient to cover the majority of activity complained of by Bentley Clothing.

Honest concurrent use

Although there was longstanding concurrent use of BENTLEY, from 2000 onwards, Bentley Motors had slowly increased and altered its use of BENTLEY on clothing and head gear during that time. The Judge was of the view that the incremental increase in both use and prominence of the sign constituted a "grandmother's footsteps" encroachment of Bentley Clothing's rights and accordingly was not honest concurrent use.

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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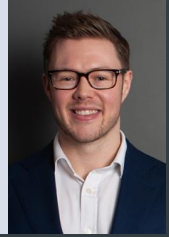
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