

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

June 2021



Trade mark decisions


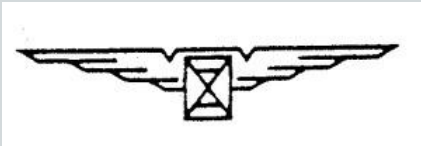
Decisions of the General Court (GC) and Court of Justice (CJ)

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-535/19 <i>H.R. Participations SA v EUIPO; Hottinger Investment Management Ltd</i>	JCE HOTTINGUER <ul style="list-style-type: none"> – advertising; business administration; market research services (35) – banking business; insurance; financial affairs; real estate affairs (36) 	In an application for a declaration of invalidity under article 53(1)(c), read in conjunction with article 8(4), the GC upheld the BoA's decision that the mark was invalid for all but a portion of the contested services. The GC held that the BoA had correctly carried out an overall assessment of the evidence to establish goodwill. While the BoA had given importance to the witness evidence, the assertions had been confirmed by exhibits from reliable sources, such as the website of the financial regulation body.
16 December 2020 Reg 207/2009 Reported by: <i>Louise O'Hara</i>	HOTTINGER <ul style="list-style-type: none"> – financial services; financial advice; wealth management; investment management and wealth advisory services (earlier unregistered UK mark)	While the BoA wrongly considered that misrepresentation must be considered with regards the customers of the proprietor of the contested mark (rather than the common customers of the parties), the BoA was correct to find that misrepresentation arose in any event. In circumstances where the signs at issue were visually and phonetically highly similar and the services in question were partly identical or partly similar, the absence of evidence of instances of confusion was not determinative of the issue of whether damage to goodwill was likely.
Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-168/20 <i>Creaton South-East Europe Kft. v EUIPO; Henkel AG & Co. KGaA</i>	CREATHERM <ul style="list-style-type: none"> – building and construction materials and elements, not of metal, in particular for roofing and cladding; roofing materials, not of metal; roofing underlayment; cladding materials, not of metal; tiles; slates; corrugated sheets; sidings; building panels; refractory construction materials (19) 	The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The GC endorsed the BoA's reasoning that the level of attention of the relevant public was above average; this was because the goods in question were not purchased on a daily basis, and other considerations including the functional aspects relating to compliance with safety standards, quality and sustainability.
24 March 2021 Reg 2017/1001 Reported by: <i>Maisie Briggs</i>	CERETHERM <ul style="list-style-type: none"> – stopping and insulating materials (17) – building materials (not of metal); coatings (building materials) (19) 	The identity of the goods was not in dispute. There was an average degree of visual similarity, and a low degree of phonetic similarity in the territories concerned. The GC concluded that the BoA had erred in considering that there was no conceptual similarity between the marks; the element 'therm' referred

(IR designating Bulgaria, the Czech Republic, Hungary, Poland, Romania and Slovakia)

to 'thermal insulation' and despite the fact that it had a low degree of distinctiveness they were conceptually similar.

Despite this error, the BoA had been correct to conclude that there was a likelihood of confusion, and in giving greater weight to the visual similarity, because the goods would have typically been purchased in self-service DIY shops where the signs would be displayed. The degree of attention did not call this finding into question.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-615/19	 <ul style="list-style-type: none"> – watches and chronometric instruments (14) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The marks were found to share a degree of visual similarity because of their similar central elements and stylised wings, and the fact the public would have perceived the earlier mark as a single sign rather than multiple independent devices. The more detailed differences were less likely to have been noticed on account of the imperfect recollection of the consumers, and their average to high degree of attention. The GC also agreed with the BoA that the marks were conceptually similar to an average degree, and that the goods were identical.</p>
<p><i>Point Tec Products Electronic GmbH v EUIPO; Compagnie des montres Longines, Francillon S.A.</i></p> <p>28 April 2021 Reg 207/2009</p> <p>Reported by: <i>Milena Velikova</i></p>	 <ul style="list-style-type: none"> – precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments (14) 	
Ref no.	Application (and where applicable, earlier mark)	Comment

GC T-644/19	<p>VERTILIGHT</p> <ul style="list-style-type: none"> – lighting and lighting reflectors, vehicle headlamps (11) 	<p>The GC annulled the decision of the BoA and found there was no risk of unfair advantage pursuant to article 8(5). The GC held that the goods were not similar and had no points of contact: they were not complementary, in competition with each other, or sold through the same distribution channels. Even if 'vehicle headlamps' were intended for use on cars, it was not established that the public would believe they could receive benefits in their car insurance policies by purchasing the headlamps.</p> <p>The GC also found the BoA had erred by stating the public's degree of attention was average. Due to the nature of the goods, the degree of attention was high. It had also erred in finding the marks were similar to a high degree, and the GC held they were in fact similar to an average degree at most.</p> <p>Although the earlier mark enjoyed a certain level of reputation, the evidence had not established that reputation</p>
<p><i>Linde Material Handling GmbH v EUIPO; Verti Aseguradora, Compañía de seguros y reaseguros, SA</i></p> <p>28 April 2021 Reg 207/2009</p> <p>Reported by: <i>Jon Edwards</i></p>	<p>VERTI</p> <ul style="list-style-type: none"> – insurance, financial affairs, monetary affairs, real estate affairs (36) – building construction, repair, installation, expressly excluding those related with the motorway sector, car parks, airports and logistics platforms (37) <p>(earlier Spanish registration)</p>	

extended beyond the public of the services for which it was registered. Since the goods were dissimilar, there was no possibility of the public making a link between the marks.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-191/20 <i>FCA Italy SpA v EUIPO; Christoph Bettag</i>	PANDEM – windshiled wipers [vehicle parts]; parts and fittings for land vehicles; wheels, tyres and continuous tracks (12)	The GC upheld the BoA's decision that there was no likelihood of confusion between the marks pursuant to article 8(1)(b). The BoA had been correct in finding that, due to the difference in their endings, and keeping in mind that the marks were relatively short in length, the signs were visually similar to an average degree and phonetically similar to a below average degree.
28 April 2021 Reg 2017/2001	PANDA – motor vehicles and parts thereof, namely bodies for vehicles and their parts, motors and their parts, clutch mechanisms, brakes and braking equipment, safety belts for passengers of motor-driven vehicles (12)	It had also been correct in concluding that the marks were conceptually different; in that regard, the earlier mark would have been understood as referring to a black and white bear native to south east China, whereas the mark applied for was devoid of meaning in all the relevant languages.
Reported by: <i>Robert Rose</i>		Whilst keeping in mind the high level of attention paid by the public for the relevant goods, the visual and phonetic similarities between the signs at issue were offset by the conceptual differences, as the earlier mark had a clear, specific meaning which could have been grasped immediately.

Ref no.	Application (and where applicable, earlier mark)	Comment
GC T-300/20 <i>Nosio SpA v EUIPO; Tros del Beto, SLU</i>	ACCUSÌ – beers; mineral, natural and aerated waters; fruit beverages and fruit juices; aperitifs, non-alcoholic; cocktails, non-alcoholic (32)	The GC upheld the BoA's decision to remit the case to the Opposition Division for an assessment of proof of genuine use, which it was required to carry out before the global assessment of whether there was a likelihood of confusion under article 8(1)(b).
28 April 2021 Reg 207/2009	– alcoholic beverages, especially wines and sparkling wines (33)	The GC found that there was a low degree of visual and phonetic similarity between the marks, not an average degree as the BoA had held. The marks were conceptually dissimilar for the part of the public that would have understood a meaning, and not similar for those for which it had no meaning.
Reported by: <i>Theo Cooper</i>	ACÚSTIC – beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverage (32) – alcoholic beverages (except beers) (33) – various goods in classes 29 and 30	Despite the BoA's errors in the analysis of the comparison of the marks, as both the BoA and GC had found the marks were not different, meaning a likelihood of confusion could not be entirely ruled out at that stage, the preliminary matter of proof of genuine use had to be carried out as a preliminary obligation. The BoA had consequently been correct in

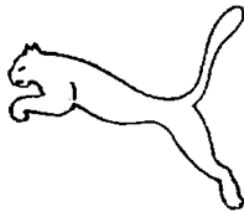
remitting the case to the Opposition Division for consideration.

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-324/20 <i>Yongkang Kugoo Technology Co. Ltd v EUIPO; Ford Motor Company</i></p> <p>19 May 2021 Reg 207/2009</p> <p>Reported by: <i>Amy Cole</i></p>	 <p>– electric vehicles; driverless cars [autonomous cars]; motorcycles; golf carts [vehicles]; yachts; air cushion vehicles; push scooters [vehicles]; camping cars; roof racks for automobiles; electric cars; bicycles; mobility scooters; electric bicycles; mopeds; self-balancing unicycles; trolleys; pushchairs; air vehicles; sailing vessels; airships (12)</p> <p>KUGA KUGA ENERGI</p> <p>– motor land vehicles and parts and accessories therefor (12)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks for the identical and similar goods under article 8(1)(b).</p> <p>The GC agreed with the BoA that the relevant public would have displayed a high level of attention for the goods in question, as they were bought infrequently and were relatively expensive.</p> <p>The GC held that the BoA had correctly found that the marks were visually and phonetically similar to an average degree, because they shared the first three letters 'KUG' which would have drawn the attention of the consumer. The conceptual comparison assessment was regarded as neutral. Despite the high level of attention displayed by the public, they would not have made a direct comparison between marks.</p> <p>The goods were either identical or similar, other than 'yachts; air vehicles; sailing vessels; airships' and 'trolleys; pushchairs'; those goods were different because they were not land vehicles, and the mere coincidence in their purpose was not enough to make them similar; the BoA had erred in finding them similar to a very low degree.</p> <p>The goods that did not use motors, i.e. bicycles and push scooters, still had the same nature, intended purpose and distribution channels as vehicles with motors, and so were similar to them, though not identical as the BoA had held.</p>
Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-510/19 <i>Puma SE v EUIPO; Gemma Group Srl</i></p> <p>19 May 2021 Reg 207/2009</p> <p>Reported by: <i>Alexander Grigg</i></p>	 <p>– machines for processing of wood; machines for processing aluminium; machines for treatment of PVC (7)</p>	<p>In the context of invalidity proceedings, the GC upheld the BoA's decision that the mark applied for would not take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks under article 8(5).</p> <p>The BoA was correct to find that the relevant sections of the public for the goods covered by each of the marks at issue were different. The goods covered by the mark applied for were aimed at industry specialists, whereas the goods covered by the earlier marks were aimed at the general public. The BoA was also entitled to find that there was only a certain degree of similarity between the marks.</p>



- bags; especially for apparatus and sportswear (18)
- clothing; boots, shoes and slippers (25)
- games; toys; equipment for physical exercise (28)

(IR designating Benelux, Croatia, France, Hungary, Italy, Portugal, the Czech Republic, Romania, Slovakia and Slovenia)



- leather goods or imitation leather goods included in this class; handbags; rucksacks; trunks and suitcases; umbrellas (18)
- clothing; footwear; headgear; raincoats; jackets (25)
- games; toys; apparatus for physical training and sport (28)

(IR designating Austria, Benelux, Bulgaria, Cyprus, Croatia, Spain, Estonia, Finland, France, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, the United Kingdom, the Czech Republic, Romania, Slovenia and Slovakia)

The BoA had not erred in its consideration of the evidence. It was not necessary to carry out a full assessment of the filed evidence as to the earlier marks' reputation where some evidence was either irrelevant or did not follow the requisite procedural formalities. The BoA had accepted that the earlier marks had the same degree of reputation as found in previous EUIPO decisions.

The applicant had not shown that the relevant sections of the public targeted by the goods covered by the marks at issue would establish a link between the non-identical marks, given the differences between the goods and the sections of the public targeted by those goods.

Scope of an oral licence

Cormeton Fire Protection Ltd ("CFP") v Cormeton Electronics Ltd ("CE") & John Aitchison* (David Stone; [2021] EWHC 11 (IPEC); 18.01.21)

In a case involving two companies who had historically operated under the shared umbrella brand CORMETON, David Stone (sitting as a Deputy High Court Judge) upheld claims for trade mark infringement and passing off in relation to use falling outside the scope of an oral licence. Lauren Kourie reports.

CFP had been in the business of mechanical fire protection solutions (such as fire extinguishers) since 1967. To expand its business into electronic fire protection solutions (such as fire alarms), it teamed up with John Aitchison and together they registered the corporate entity, CE. The parties worked together from 1989 until 2003 when the businesses split on good terms. At the time, a licence was agreed covering use of the CORMETON name. The parties continued to co-exist, trading in similar fields (i.e. mechanical versus electronic fire protection) and under similar names, until the relationship deteriorated in 2015.

In 2016, CFP registered CORMETON as a trade mark for various goods and services in classes 6, 9, 37, 40, 41, 42 and 45. It was at this time that CE also increasingly started to use the CORMETON name on its own, and in respect of mechanical as well as electronic fire protection. As a result, CFP brought proceedings for trade mark infringement, copyright infringement in the artistic work incorporating the word CORMERTON (shown below) and passing off. CE counter-claimed for invalidity and/or revocation of the registered mark.



Scope of the licence

The terms of the licence agreed between the parties was heavily disputed. As no written agreement was produced by the parties, the Deputy Judge ultimately concluded that it was most likely that an oral agreement had been reached, whereby CFP (as the original owner of the CORMETON name) permitted CE to continue to trade under CORMETON ELECTRONICS, but only in relation to electrical safety equipment (not mechanical fire safety goods and services). The Deputy Judge considered that these terms accorded with both common business practice and with the conduct of the parties at the time.

Most of CE's use of the CORMETON name was within the scope of the licence. However, the unlicensed uses by CE were for signs and goods and services that were identical/ similar to the registered mark. The unlicensed uses were therefore infringements of the registered mark under sections 10(1), 10(2) and 10(3) and constituted passing off.

Defences

CE unsuccessfully put forward a number of defences, including that it had made honest concurrent use of the CORMETON name. The Deputy Judge rejected this argument, as the unlicensed use had not been for a long enough period and furthermore, by trading in identical services to CFP, CE did not meet its duty to act fairly with regard to the trade mark owner. The use was therefore not considered honest.

Copyright

CFP's allegation of copyright infringement in the artistic work failed. During cross-examination, the director of the company admitted he did not create the work in question and believed it had been created by CE shortly before 2013.

Counterclaim for invalidity and revocation

CE made an application for invalidity under section 3(3)(b) on the basis that given the CORMETON mark had been used by both parties, it was now perceived by the public as relating to separate businesses and was therefore misleading as to the origin of the goods and services. The Deputy Judge rejected this argument at

law and on the facts. Firstly, he held that this sort of deception was remediable under the relative grounds for refusal (not the absolute grounds) and secondly, that this argument failed on the facts as the bulk of CE's use was licensed by CFP, which indicated CFP held the relevant goodwill. For the same reasons, the Deputy Judge found that the application for revocation under section 46(1)(d) also failed.

Passing off

Philip Warren & Son Ltd v Lidl Great Britain Ltd & Ors (Daniel Alexander QC; [2021] EWHC 1097 (Ch); 30.04.21)

In a passing off case where up to £47 million was sought in damages by a butcher, as a result of Lidl's use of the mark WARREN & SONS, Daniel Alexander QC sitting as a Deputy High Court Judge found that there was no such passing off. In reaching his decision, the Deputy Judge relied on the lack of evidence of deception on the part of Lidl, giving guidance on the approach to damages or accounts of profits in such a case. Tristan Sherliker and William Wortley report.

Facts

Philip Warren & Son, a high-end family run butcher, had traded for a number of years in the local retail and wholesale markets under the signs PHILIP WARREN and PHILIP WARREN & SON, as well as the stylised logo shown below.



Following a decision to rebrand its in-house fresh meat produce, Lidl registered the mark WARREN & SONS. In June 2015, Lidl began trading nationwide using the mark and the stylised logo shown below, continuing until September 2020. By the time the case was brought, Lidl's WARREN & SONS brand was already being retired.



Philip Warren alleged that Lidl's use of the WARREN & SONS mark amounted to passing off and launched proceedings in 2019. Lidl argued that there was no misrepresentation and (in any event) no damage caused. There was also a conditional counterclaim that, if there had been misrepresentation on the Claimant's case, then the same facts would lead to misrepresentation in the opposite direction in respect of at least some sales, however this was not pursued at trial.

Approach to the Evidence

The Deputy Judge noted that the case was unusual in that, whereas typically such claims are brought relatively quickly upon discovering the activities complained of, this case came after five years of side-by-side trading. Therefore, instead of the court making findings as to the potential future effects of such trade, in this instance it was possible to make findings by reference to the actual effects. This was made easier, particularly as both Philip Warren and Lidl had retail locations within a short distance of one another in Launceston.

This was an important illustration in the difference between retrospective actions and those brought in respect of ongoing or future activities. The court noted that: *"given the sheer magnitude of sales and the "optimum" conditions for confusion to arise in that context, the absence of evidence of this kind is more important than it may be in other cases."*

The nature of the claimed relief, and in particular the fact that the claim was advanced for a very large monetary award, also made detailed examination of the evidence important.

Goodwill

Lidl accepted from the outset that Philip Warren had goodwill in respect of its wholesale business, as well as in the locality of its retail locations but disputed Philip Warren's contention that its goodwill was national. The Deputy Judge noted that there was a lack of evidence of any overlap of customers who would shop at both Philip Warren and Lidl. He also noted that, while there were some customers of the claimant who travelled to Philip Warren from outside its immediate retail area, as well as some online customers at the relevant time, these were not very substantial in volume.

No misrepresentation

Philip Warren relied on evidence of confusion in the form of a number of emails received from customers, as well as witness evidence, which it argued showed confusion caused by Lidl's use of the WARREN & SONS mark. There were, however, no direct reports of confusion from Philip Warren customers in their shops. Further, there were no reports of instances of material confusion in Lidl's shop, despite such extensive side-by-side trading and a large volume of WARREN & SONS products sold. Where there was evidence of confusion before the Court, it was limited and did not remain unaffected by cross-examination. The Deputy Judge held that in those instances those who had contacted Philip Warren had been confused in the sense of merely wondering whether there could be a connection between the parties; and that once a query was raised it was dealt with quickly. Importantly, the evidence did not show that any of those customers were actually deceived, which is the threshold for a claim passing off, and therefore there was no operative confusion.

No Damage

As a separate finding in addition to the lack of misrepresentation, the Deputy Judge held that there was no evidence of any damage to Philip Warren resulting from Lidl's use of the mark WARREN & SONS. There was no evidence of any lost retail customers or wholesale customers put off from trading with Philip Warren. In fact, the Deputy Judge noted that the presence of Lidl's produce did not materially affect Philip Warren's ability to expand its wholesale trade, and that its business had expanded significantly during the relevant period.

Availability of damages on the user principle

The claim was put on the basis that damages would be available on the user principle, even if an account of profits was deemed to be unavailable. The basis of damages did not arise after the finding on liability; however the Deputy Judge went on to hold *obiter* that damages on a "user principle" would not have been available as of right, and that they may be disproportionate in cases where damage to any goodwill was minor. The question of delay was a relevant factor but the effects of that delay were not fully argued in this case.

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

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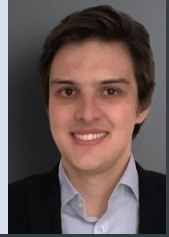
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