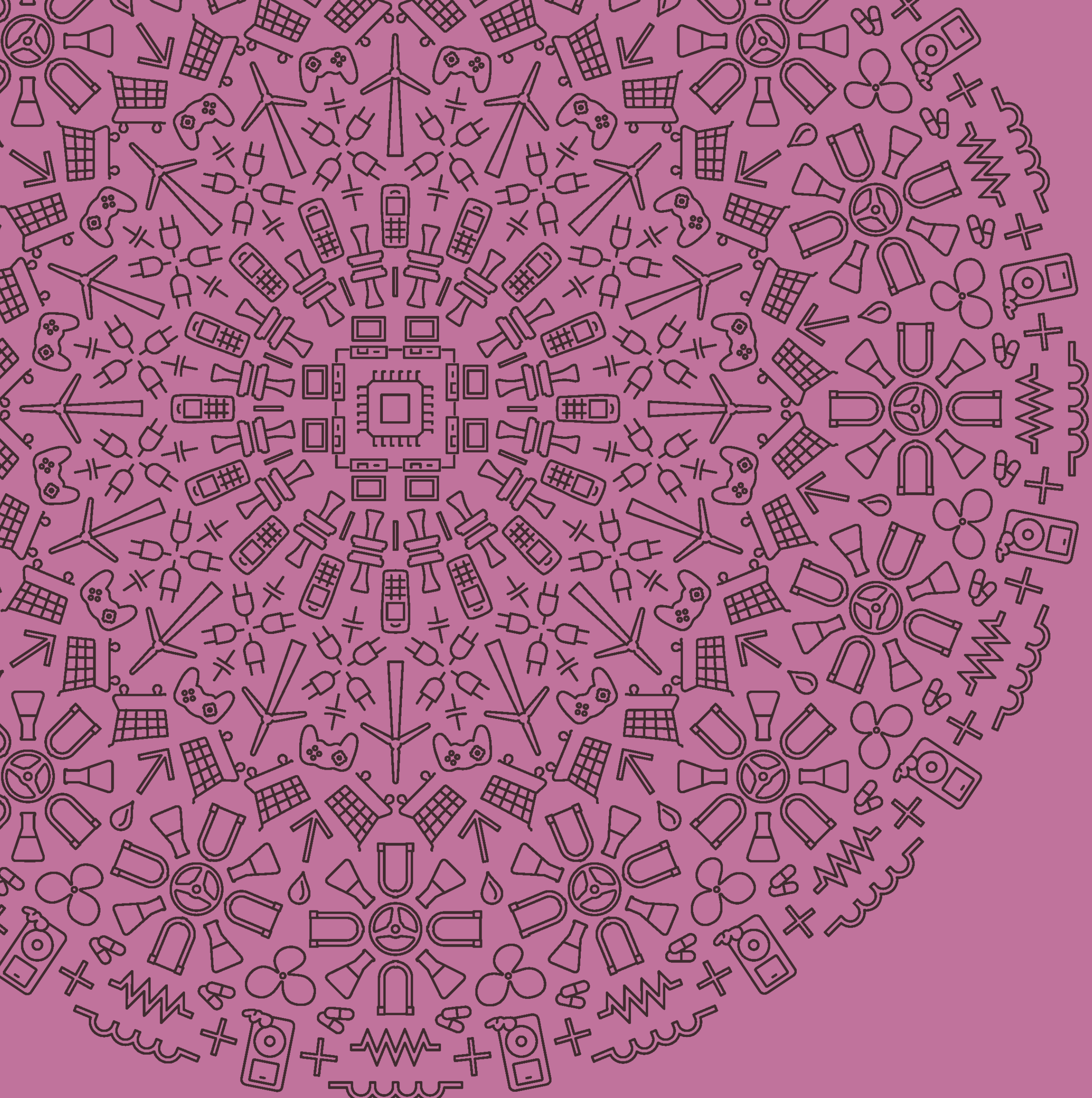

Review of UK and European Trade Mark Cases 2015

by Paul Walsh, Daniel Byrne, Saaira Gill, Tim Heaps, Remya Jayakkar, David Kemp, Jade MacIntyre and Abigail Smith

BRISTOWS

Quotation of the year:

"There is nothing inherently unpleasant or degrading about cava wine."

Per Mrs Justice Rose in *Champagne Louis Roederer v J Garcia Carrion S.A. and Others*[1]

The information contained in this document is intended for general guidance only. If you would like further information on any subject covered by this bulletin, please e-mail Paul Walsh (paul.walsh@bristows.com), or the Bristows lawyer with whom you normally deal. Alternatively, telephone on + 44 (0)20 7400 8000.

[1] [2015] EWHC 2760 (Ch)

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Introduction

This review of UK and European trade mark cases looks back over some of the cases of interest in 2015. It does not purport to be a comprehensive review of all cases and we have not considered cases which are not available in English. Following the format of previous reviews (of which there have been three), we address the cases predominantly thematically and seek to draw out points of interest. Due to the important upcoming legislative changes we also deal with trade mark law reform.

Distinctiveness - shapes

In our 2013 and 2014 reviews, we reported on *Société des Produits Nestlé SA v Cadbury UK Ltd*[2] which focused on the registrability of Nestlé's four-finger KitKat shape mark. In his High Court judgment in January 2014, Arnold J referred to the Court of Justice of the European Union ("CJEU") a number of questions relating to the registrability of shape marks. The questions covered what needs to be proved to establish acquired distinctiveness as well as the shape-specific exclusions to registrability under Article 3(1)(e). The answers to these questions have now been answered by the CJEU[3] and are summarised below.

Acquired distinctiveness – recognition or reliance?

The first question referred to the CJEU by Arnold J concerned the required threshold for establishing acquired distinctiveness in shape marks.

"In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3(3) of Directive 2008/95 ..., is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods?"

In short, in order to establish acquired distinctiveness, is it sufficient for a shape mark to be merely recognised as/associated with a particular product; or is it necessary for the shape mark to be relied upon by customers to identify the origin of the product? Arnold J, consistent with the approach traditionally taken by the UK courts in this regard, expressed a preference for the stricter requirement of reliance.

In its response, it is notable that the CJEU reformulated the reference and did not use the term "reliance", instead confirming that the shape mark alone (as opposed to any other trade mark which may be present) must be "perceived" as an indicator of origin. The judgment added that it is a "fundamental condition" that, as a consequence of use, the sign alone must serve to identify in the minds of the relevant persons the goods to which it relates as originating from a particular company.

As this publication was going to press, application of the law as explained by the CJEU had been considered in the High Court by Arnold J. He had to interpret what the CJEU meant by its use of the word "perceives" in its answer. Although, strictly, this falls to be dealt with in our 2016 review, it is worth mentioning that Arnold J[4] had some doubts about whether the CJEU was answering the precise question he had asked. Nevertheless, he thought that re-referring the question would not yield a materially different response and obtained support for interpreting the answer from its similarity with the AG's opinion, from what the CJEU had previously said in *Nestlé v Mars* and its similarity to his own preferred position which he stated in the reference. Accordingly, the level of perception required must be such that consumers would rely upon the sign as denoting the origin of the goods if it were used on its own. On the facts Nestlé's appeal was dismissed.

[2] [2014] EWHC 16 (Ch)
[3] Case C-215/14 [2015] E.T.M.R 50
[4] [2016] EWHC 50 (Ch)

Technical grounds for refusal

The other questions referred to the CJEU by Arnold J concerned the scope of the exclusions for shape mark registrations under Article 3(1)(e) of the Trade Marks Directive.

<u>Essential features</u>

"Where a shape consists of three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded under Article 3(1)(e)(i) and/or (ii) of [the Directive]?"

In other words, where a shape consists of two or more essential features, can different exclusions under Article 3(1)(e) apply to the different essential features respectively to preclude the shape mark from registration? Arnold J's preliminary view was that they should.

However, in line with its earlier decision in the *<u>Hauck</u>* ("TRIPP TRAPP chair") case (reported in our 2014 review) the CJEU confirmed that the answer is no. The Court found that the exclusions under Article 3(1)(e) operate independently of each other and, whilst it is possible for essential features of a shape mark to be covered by more than one exclusion, registration should only be refused where at least one of the exclusions is "fully applicable" to all of the essential features of the shape. The implication of this may be that the definition of "essential features" will come under additional strain and be subject to additional references.

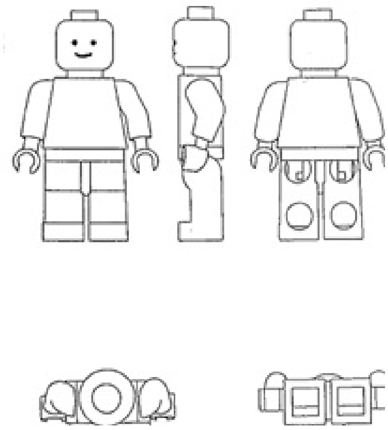
<u>Technical effect</u>

The final question related specifically to the exclusion under Article 3(1)(e)(ii), namely that a mark shall not be registered if it consists exclusively of the shape of goods necessary to obtain a technical result.

The question for the CJEU was whether this exclusion should be interpreted having regard to the manner in which the goods are *manufactured* as opposed to the manner in which the goods *function*. It was confirmed by the CJEU that it is only the manner in which the goods function that should be considered, not the manner of manufacture.

When justifying its answer, the CJEU recalled that the rationale for the grounds of refusal under Article 3(1)(e) was to prevent a monopoly from being granted on technical solutions which a user is likely to seek in the goods of competitors, observing that *"from the customer's perspective, the manner in which the goods function is decisive and their method of manufacture is not important".*

Another case which focused on the shape specific exclusion, this time under Article 7(1)(e) of the Community Trade Marks Regulation ("CTMR"), was *<u>Best-Lock (Europe) Ltd v OHIM, Lego Juris A/S</u>*[5].



This was a General Court judgment, upholding OHIM's Board of Appeal's ("BoA's") decision to reject the invalidity application of Best Lock (a UK company manufacturing bricks compatible with Lego) against Lego's figurative shape mark (pictured above).

Best Lock's arguments had centred around the shape specific exclusions of Article 7(1)(e)(i) and 7(1)(e)(ii) CTMR.

The BoA had rejected Best-Lock's argument under Article 7(1)(e)(i) that the shape of the goods was determined by the nature of the goods themselves as it considered that the toy could be made in any shape and not necessarily to the shape claimed. The General Court found no cogent evidence to reverse that judgment and therefore considered the ground of appeal inadmissible.

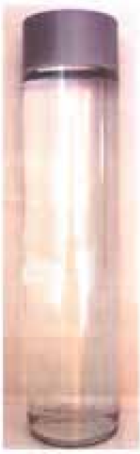
[5] Case T-395/14

Regarding the technical effect argument under Article 7(1)(e)(ii), the BoA had determined that the graphical representation of the hands, the holes in the legs and feet and the head protrusion did not indicate technical function in themselves. Further, it had found that, even if it was assumed that they were intended to connect the figures to building blocks, they were not the primary essential characteristics of the marks. The essential characteristics, of the shape of a person, were not technical (for instance, the limbs and torso do not connect to other blocks) but were included to represent human traits, and the use of the shape by a child in play was not a technical result.

Again, the General Court found that the pleas by Best-Lock amounted to little more than an overly general contention that the characteristics of the shape were necessary to combine it with other building blocks and found the ground of appeal inadmissible.

Inherent distinctiveness

The CJEU has dismissed an appeal against a declaration of invalidity made by the General Court in *Voss of Norway ASA v OHIM*[6] (reported in our 2013 review).



By way of reminder, Voss' 3D mark representing a transparent cylindrical bottle with an opaque cap, had earlier been viewed by the BoA as lacking distinctive character under Article 7(1)(b) of the CTMR on two distinct grounds, both of which were affirmed by the General Court.

First, it was found that it is well known that beverages are almost always sold in bottles, cans or other forms of packaging bearing a label and it is this indication which allows consumers to differentiate between the different products on the market. Voss had not adduced any evidence to the contrary.

Second, the BoA conducted an independent analysis of the distinctive character of the trade mark and concluded that the bottle was not significantly different from shapes of other bottles on the market for beverages and was a mere variant. It therefore did not depart significantly from the norms and customs of the sector.

Voss put forward six grounds of appeal to the CJEU following the General Court's decision which, as an interesting side-note, was supported by the intervening International Trade Marks Association ("INTA").

All grounds of appeal were rejected by the CJEU on reasoning which can be summarised as follows:

First, Voss argued that the General Court had erred in unduly imposing a burden on it to prove the distinctive character of the mark, despite the mark enjoying a presumption of validity through registration. The CJEU rejected this ground as unfounded on the basis that the BoA had carried out its own independent analysis of the distinctive character of the mark and had not imposed any such burden on Voss.

On the same theme, Voss' second ground of appeal opposed the alleged shift of the burden of proof away from the applicant for cancellation, who had not provided any evidence of non-distinctiveness. It was emphasised by INTA that a registered Community Trade Mark ("CTM") enjoys a presumption of validity.

The CJEU again rejected the suggestion that the burden of proof had been incorrectly shifted. The General Court had carried out its own independent analysis of the mark's distinctive character which confirmed that each component of the shape (i.e. the transparent cylindrical body and opaque cap) lacked distinctiveness and there was nothing in the combination of components which meant the mark, when taken as a whole, was greater than the sum of its parts.

[6] C-445/13 P

The third ground of appeal concerned the General Court holding that the shape of the bottle was devoid of distinctive character, without defining the norms and customs of the relevant sector (i.e. beverages). The CJEU denied that this had not been defined, determining that the General Court had relied on "well known facts", namely that the vast majority of bottles have a cylindrical section, closed with a cap which has a different colour/material from that of the bottle.

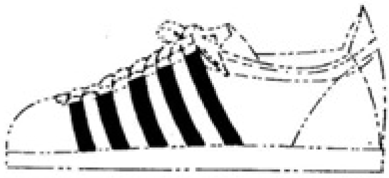
The fourth ground alleged that the General Court had assessed the distinctiveness of each component of the 3D mark separately, without assessing the sign as a whole as required by case law. This was rejected by the CJEU as unfounded on the basis that both the component parts and the shape as a whole had been considered in the analysis of distinctiveness.

The fifth ground of appeal alleged that the General Court distorted the evidence by comparing the perfect cylinder of the 3D sign at issue to a 2D circular section. As the latter is a feature of part of the majority of bottles, it was alleged that the assessment relating to the norms and customs of the relevant sector was erroneous. The CJEU denied that the analysis had been carried out in this way and stated that Voss' appeal was based on a misreading of the judgment.

Finally, Voss appealed against the General Court's ruling that the disputed trade mark was made of individually non-distinctive components and therefore lacked distinctiveness as a whole. It was alleged by Voss that such reasoning has the effect of making it impossible for the packaging of a product to be accorded distinctive character, which is contrary to the purpose the CTMR. Once again, the CJEU rejected this ground on the basis that the mark as a whole had in fact been considered; it had not been analysed solely on its component parts.

In our 2014 review we reported on the *K-Swiss Inc v OHIM*[7] case where the General Court rejected the validity of a CTM (filed on 8 December 2005) where the sign was indistinguishable from the appearance of the goods themselves and could only be justified as distinctive if it departed significantly from the norms or customs of the sector.

In 2015 the General Court was again faced with stripes on shoes in *K-Swiss Inc. v OHIM*[8]. An international application designating the EU for athletic shoes in class 25 was made (filed on 23 May 2013):



The General Court confirmed the BoA's decision that the mark applied for was devoid of any distinctive character, was inherently banal and, as the variation in stripe size appeared to be determined by the shoe shape, it did not depart sufficiently from the practices of the sector. There was insufficient evidence to allow the General Court to conclude that the mark had any distinctive character and the General Court rejected the submission that the practice of putting geometric shapes on the side of sports shoes meant that the average consumer would pay particular attention to them and consider them to be reflective of origin.

Distinctiveness – word marks

Acquired distinctiveness

In *The Ukulele Orchestra of Great Britain v Clausen & Another*[9], the Intellectual Property Enterprise Court ("IPEC") confirmed that a mark will acquire distinctive character only through use as a consequence of which the mark indicates to the relevant class of persons the exclusive origin of the goods or services concerned. This confirms that mere recognition of the mark and association of the goods with the applicant is insufficient to establish acquired distinctiveness. Although this case was decided before the CJEU's answer to Arnold J's question in *Société des Produits Nestlé SA v Cadbury UK Ltd* (discussed above), HHJ Hacon applied the law as stated by Arnold J and confirmed by the Advocate General's Opinion.

[7] Case T-85/13, 13 June 2014

[8] Case T-3/15, 4 December 2015

[9] [2015] EWHC 1772 (IPEC)

The case also confirmed that the territory across which acquired distinctiveness must be established depends on the language of the mark. Where it is English, acquired distinctiveness must be proven in 1) the EU Member States in which English is the official language or is the mother tongue (the UK, Ireland and Malta), 2) EU Member states in which English is sufficiently well spoken by the average consumer for the descriptive character of the word mark to be perceived (the Netherlands, Sweden, Denmark, Finland and Cyprus), and 3) Member states in which the words of the CTM are sufficiently similar to their equivalents in the local language (in this case: Germany, Austria, Luxembourg and Belgium).

Inherent distinctiveness

Yves Fostier v Disney Enterprises, Inc.[10] saw the BoA partially invalidate Disney's registration for PINOCCHIO. The BoA confirmed that a finding of non-distinctiveness is more likely where a title is famous enough to be truly well-known to the relevant public, where, in the context of the goods and services, it will be perceived as primarily signifying a famous story or book title, and there has been considerable exploitation of the title to a wide audience. On this basis the BoA invalidated Disney's application for goods and services that refer to the story of Pinocchio, i.e. films, printed matter, toys and entertainment services.

In *Canary Wharf Group Plc v The Comptroller General of Patents, Designs and Trade Marks*[11] the applicant's attempts to register the mark CANARY WHARF were rejected in an appeal to the High Court. The applicant had sought to argue before the Hearing Officer that Canary Wharf was not, in fact, a geographical location, but this argument was not pursued on appeal. The applicant argued that because a large number of services within the Nice Classification are of a kind that one would expect to be available in most towns and cities throughout the UK, trade marks under section 3(1)(c) of the Trade Marks Act ("TMA") (signs which designate geographical origin) would be excluded from registration. The Court confirmed that the mere fact that certain services are expected to be provided locally does not mean (to the extent that the Hearing Officer could be understood to mean this) there is a blanket ban on the registration of all places names in respect of such services. In this case the applicant failed because the services sought to be registered were precisely the kind of services one would expect to be provided in, from or to the geographical area of Canary Wharf as well as being those to which the name would be capable of indicating geographic origin.

See also the *Sofa Workshop Ltd v Sofaworks Ltd* case referred to in the Genuine Use section below.

Bad faith

In *Urb Rulmenti Suceava SA v OHIM*[12], the General Court upheld a decision of the BoA that there had not been bad faith in applying for a CTM in the knowledge that earlier conflicting marks existed.

The application for a declaration of invalidity was made against the below figurative mark, based on the grounds that there were earlier conflicting rights (Romanian collective marks) and the application was made in bad faith.

The invalidity applicant believed it was entitled to bring the proceedings as it was authorised to use the earlier marks. The Court rejected this claim as only proprietors or licensees of earlier marks are entitled to cite the same in invalidity applications. No evidence was submitted that demonstrated the invalidity applicant was a licensee of the earlier marks or that consent had been duly obtained from the proprietor to bring the proceedings. The contention that there were conflicting rights was therefore doomed to fail.

With regards to the bad faith ground (although anyone can bring such claims), it was again relevant that the invalidity applicant had provided no evidence that it was entitled to use the earlier marks at the time the trade mark application was filed or that the trade mark

[10] 25 February 2015. Case R 1856/2013-2
[11] [2015] EWHC 1588 (Ch)
[12] T-635/1417

applicant had intended to stop others from lawful use of the marks. The Court found that the trade mark applicant had a legitimate commercial interest in obtaining registration of the mark and the invalidity applicant had not established that it had done so merely to preclude others from the market. The fact that an applicant knows or should know that a third party has long been using an identical or similar sign in one member state for identical or similar goods, capable of being confused with the mark applied for is not, in itself, sufficient to assume that the applicant was acting in bad faith.

This was somewhat a re-run of Urb's unsuccessful bad faith allegation made in respect of the word mark URB applied for by the same trade mark applicant as in this case (which was covered in our 2014 review). There, it was held that there can have been no bad faith in respect of the invalidity applicant as it had no proven rights in respect of the alleged earlier marks.

Genuine use

In *Naazneen Investments Ltd v OHIM*[13], the General Court confirmed the BoA's decision that minimal test sales were not enough to establish genuine use of the CTM registration for SMARTWATER.

A revocation application for non use in relation to all goods for which the SMARTWATER mark was registered was initially successful and was appealed by the proprietor. The BoA however dismissed the appeal as the evidence which was filed did not establish genuine use of the mark and there were no proper reasons for non use.

The proprietor appealed this decision to the General Court which also dismissed the appeal. The goods (mineral water) were for mass consumption with a significant market size and the sales figures provided were too modest to demonstrate genuine use. Furthermore, advertising and promotional activities were not proof of imminent marketing; these activities were at the beginning of the 5 year period for assessing genuine use.

The General Court also rejected the proprietor's argument that the BoA had been wrong to find that defective manufacture of the bottles and the fact that revocation proceedings were brought by a third party did not constitute proper reasons for non use. "Proper reasons" refer to circumstances unconnected with the proprietor rather than circumstances associated with its commercial difficulties. Further, it was down to the proprietor to conduct an assessment of its chances of prevailing in the revocation proceedings and to draw the appropriate conclusion as to whether to continue to use its mark.

Affidavits filed were held to have limited evidential value due to the existence of a link between the authors of the affidavits and the proprietor, underlining the fact that credible evidence should be filed by independent third parties where possible.

It is worth bearing in mind that, although a de minimis rule applied in both *La Mer* and *Ansul*, it appears that minimal use may qualify as genuine use if it is appropriate for the market concerned. Here, a low volume of test sales in what was, essentially, a mass market was held not to be sufficient to demonstrate genuine use.

In the *Sofa Workshop Ltd v Sofaworks Ltd*[14] case, the claimant, Sofa Workshop, was a retailer of sofas and other furniture. Two CTM word mark registrations existed for the word SOFA WORKSHOP, in respect of furniture, textiles and homeware accessories as well as retail services in relation to stores selling such goods.

Extensive use had been made of the marks in the UK but use in other member states was limited to advertisements in UK magazines which had pan-European distribution. The customer base was almost exclusively in the UK with just a few sales outside the UK. The defendant, Sofaworks, had changed its trading name from CSL to Sofaworks in late December 2013 and was in the same business as the claimant.

An allegation of infringement was made by the claimant in relation to its CTM registrations as well as passing off. These claims were denied by the defendant and counterclaims for revocation of the marks for non-use and a declaration of invalidity were filed, the latter on the basis that the marks were descriptive of the goods and services registered under the marks.

[13] T-250/13

[14] [2015] EWHC 1773 (IPEC)

The Court found, amongst other things, that the marks were liable to be revoked for non use. The Court held that genuine use of a CTM requires evidence of use to create or maintain a market share beyond one member state. The advertisements in UK magazines with pan-European distribution were not deemed sufficient to demonstrate an intention to trade outside of the UK (the content of the advertisements encouraging consumers to telephone or visit a store indicated that the advertisements were targeting UK consumers). The default position when considering genuine use of CTMs is that use in one member state will not suffice (unless the market for the relevant goods or services is restricted to the territory of a single member state).

Although the Court accepted the defendant's arguments that the registrations were descriptive, the claimant satisfied the court that, due to their extensive use, the marks had acquired distinctiveness insofar as the UK was concerned. However, to support acquired distinctiveness through use post-registration, the use/distinctiveness must be present in all member states (i.e. if it is descriptive in just one member state it will fail). Descriptive English word marks are particularly liable to be considered descriptive elsewhere due to the widespread use of English. In light of there being no evidence of use outside of the UK, Sofa Workshop failed to establish acquired distinctiveness in Ireland or Malta (let alone Scandinavia, the Netherlands or Cyprus). Consequently, it was found that the CTMs had not acquired distinctive character.

This decision serves as a reminder that there are risks in obtaining a CTM registration where the use may not extend across the boundaries of at least one member state. Where such doubts exist, national applications should be filed (or conversion to a national mark should be considered). It should not be assumed that a trader in one member state will necessarily wish (or be able) to extend use across the whole of the EU although this will also require consideration of whether the relevant market is territorially limited.

Nevertheless, ultimately the claimant succeeded in showing that use of the name Sofaworks amounted to a misrepresentation that the goods and services of Sofaworks came from a source which was the same as, or associated with, Sofa Workshop and thus was passing off. Claimants may often be tempted to pursue a more straightforward case in trade mark infringement and avoid the potentially heavier burden of proof required in passing off. However, this case demonstrates that an additional claim in passing off should not be lightly discarded.

Conflict of rights

Confusion

The CJEU and the General Court were busy in 2015 scrutinising aspects of 'likelihood of confusion' in a number of different appeals relating to CTM and national trade mark oppositions. As a result of their efforts, several interesting decisions were issued adding to the already considerable jurisprudence on confusion generally, but, in particular, involving families of marks, acronyms and descriptive word combinations, figurative polo player and cola marks and confusing similarity between services: 'spa services' and goods: 'cosmetics' and 'bath products'.

In the UK, confusion based grounds are provided for in Sections 5(2) and 10(2) of the Trade Marks Act 1994 and also Articles 8(1)(b) and 9(1)(b) of the CTMR. A likelihood of confusion is determined according to a global assessment of various factors, all of which are interdependent with each other, and so, whether there is confusion between marks and signs and/or goods and services is very fact specific and depends on the circumstances of each case. The test for relative objections to registration is the same as for infringement and so such cases can be instructive in considerations of enforcement.

By way of reminder, factors that are considered in determining whether there is a likelihood of confusion include similarity of signs (including analysis of visual, phonetic, and conceptual similarities), similarity of goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

The following cases that are worthy of mention considered these factors in 2015. There are also two other decisions (*Champagne Louis Roderer v J Garcia Carrion SA and others*[15] and *Enterprise Holdings, Inc*

[15] [2015] EWHC 2760 (Ch)

v Europcar Group UK Ltd and another[16]) where the UK High Court looked at a likelihood of confusion but these decisions are dealt with in the section of this review which deals with unfair advantage.

Family of marks

A family of marks is one which comprises a number of trade marks with shared, distinctive characteristics, enabling them to be regarded as the same family or series. Assertion of rights in such a family can often be used to prevent registration of later filed marks or use where a mark contains a characteristic of the earlier family or series. Confusion could arise if consumers erroneously believed that the later mark was an extension of or associated with the earlier family.

In October, in the case of *Debonair Trading Internacional Ltda v OHIM*[17], the CJEU considered whether the mark "SÔ: UNIC" was confusingly similar to an earlier family of UK and CTM marks: "SO……..?", "SO…….? ONE", "SO……….? CHIC" in relation to class 3 goods (cleaning preparations, soaps, perfumery, cosmetics and other such goods).

The Appellant, Debonair Trading Internacional Ltda ("Debonair"), opposed the CTM on the grounds of confusing similarity with its prior registrations. The opposition and a subsequent appeal to the BoA by Debonair were rejected with a finding that the respective marks were not confusingly similar because conceptually they differed and "SÔ: UNIC" could not therefore be seen to be part of the same family of "SO……..?" marks. The appeal to the General Court was dismissed on the same basis.

Debonair claimed in the appeal to the CJEU that the General Court had erred and had not taken into account the correct criteria regarding likelihood of confusion and families of marks. It said it had wrongly equated the test for existence of a family of marks with that of a likelihood of confusion between the mark applied for and an existing family of marks and, also, that the General Court failed to carry out a global assessment of the likelihood of confusion.

In answer the CJEU held that, in respect of a family of marks, there will be a likelihood of confusion if the consumer is mistaken as to the provenance of the goods or services covered by the later mark and, that because of this, the consumer mistakenly believes that the later mark is part of the earlier family of marks. There will be a likelihood of confusion where there are a number of marks in a family and where the later mark presents within it shared, distinctive characteristics enabling it to be regarded as the same family or series.

Moreover, the CJEU stated that the likelihood of confusion must be assessed globally and it is necessary to take into account all the circumstances of the case. As a result of its analysis, the CJEU found that the General Court had correctly applied this test and dismissed the appeal. It said the General Court had not erred in finding that the SÔ element of the later mark did not coincide with the common element "SO…..?".

Acronyms

In a reference for a preliminary ruling to the CJEU from the German Federal Patent Court following trade mark opposition proceedings (*BGW v Bodo Scholz*[18]), the CJEU issued its decision on whether there would be a likelihood of confusion between marks bearing letter sequences in descriptive composite marks.

A German national mark for "BGW Bundersverband der deutschen Gesundheitswirtschaft" ("Federal Association for Undertakings in the German Healthcare Sector") was opposed on the basis of confusing similarity with an earlier figurative mark in classes 16, 35 and 41:

The opposition was partially upheld on the grounds that there existed a likelihood of confusion between the marks as a result of the independent role BGW played

[16] [2015] EWHC 17 (Ch)
[17] 15 October 2015, CJEU, Case C-270/14-P

[18] *BGW Beratungs-Gesellschaft Wirtschaft mbH BGW Marketing & Management Service GmbH v Bodo Scholz* 22 October 2015, CJEU, Case C-20/14

in the later BGW composite mark. The owner of the later mark appealed the decision and had it set aside.

The owner of the earlier BGW mark then appealed to the German Federal Patent Court where it was found that there was a likelihood of confusion in relation to identical goods and in relation to both identical and similar services insofar as they were provided to businesses operating in the health sector. However, the proceedings were then stayed pending a preliminary ruling on the comparison of the marks at hand from the CJEU. This was because the German court felt that there was some conflict between cases that had been decided on similar issues in relation to both inherent registrability and prior rights conflicts; essentially the CJEU had previously held[19] that a mark would be unregistrable if it *'consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination … and the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character…'.* On the other hand, and following *Medion*[20], BGW would play an independent and distinctive role in the later mark.

In October, the opinion of the Advocate General was published. It essentially said that, yes, there may be a likelihood of confusion where there were marks consisting of a distinctive and dominant letter sequence/acronym and also a later mark which reproduced the letter sequence but with an added, descriptive combination of words showing the initial letter sequence to be an acronym.

In reaching his conclusion, the Advocate General stated that the assessment of a likelihood of confusion should be global and involve an examination of the marks as a whole. Accordingly, the national court should therefore conduct a comparison of the overall impression made by the later mark and, taking this into consideration in an overall assessment of the circumstances of the case, consider whether or not a likelihood of confusion exists. The court would have to conduct an analysis of the possible links consumers may make between the acronym and the descriptive word combination and a determination of whether the acronym or letter sequence would be remembered independently of the composite word in the later mark. As part of this assessment the court would need to establish whether the letter sequence may, indeed, be perceived as an acronym of the words in the later mark.

On the apparent contradiction of the level of distinctiveness BGW played and the *Strigl and Securvita* and *Medion* cases, the Advocate General decided that consumers have only one overall perception of a mark but the reasons for refusing registration under either inherent registrability or prior rights grounds differed. The CJEU found that the ruling in *Strigl and Securvita* is not *'a general rule for assessing the ancillary nature of a sequence of letters which reproduces the first letter of each of the words in the word combination with which it is juxtaposed'.* On this basis, the court preferred to follow the *Medion* case and therefore distinguished *Strigl and Securvita*.

Overall, this case shows that while there may be a likelihood of confusion with marks using letter sequences or acronyms and descriptive wording, national courts must take into account the specific factual circumstances of a case. Therefore, it is not necessarily the case that a likelihood of confusion *will* arise. The law and principles of application, therefore, remain the same well accepted rules.

Some practitioners believe that the request made by the German court for a CJEU preliminary ruling was pointless as it seemed fairly clear how the Court would answer. Guidance for national courts has, however, been given on how to distinguish sequences of letters and acronyms and their descriptive wording involving inherent registrability issues on the one hand, and in relation to prior rights conflicts on the other - letter sequences in the latter are more likely to have an independent and distinctive origin identifying role.

The nature of the goods

In March the General Court ruled on yet another case involving figurative polo players in *Royal County of Berkshire Polo Club v OHIM*[21]. The case involved two figurative marks of polo players on horses, with

[19] *Strigl and Securvita* CJEU, Cases C-90/11 and C-91/11
[20] CJEU, Case C-120/04
[21] 26 March 2015, General Court, Case T-581/13

descriptive wording to denote the names of the respective polo clubs, in a dispute which originated from CTM opposition proceedings in 2011.

Royal County of Berkshire Polo Club ("Berkshire") filed its CTM application in classes 9, 14, 18, 25[22] for:

Beverly Hills Polo Club ("Beverly Hills") opposed all of the classes applied for based on a likelihood of confusion with its prior CTMs for the following mark because it was sufficiently similar to Berkshire's mark and covered identical goods:

The opposition was rejected but an appeal to the BoA by Beverly Hills was entirely successful and resulted in a decision to reject Berkshire's application in its entirety. In the appeal the BoA considered the factors involved in assessment of a likelihood of confusion; the goods at issue were everyday consumer goods and were directed at the general public who had a normal level of attention; the image of the polo player and the words POLO CLUB had an inherent, enhanced distinctiveness in relation to all of the goods and classes at issue; that the signs at issue had some visual similarity, a degree of aural similarity and significant conceptual similarity. Taking all of this into account, the BoA found there was a likelihood of confusion between the marks at issue in respect of all of the goods challenged.

Berkshire appealed to the General Court, which annulled the BoA's decision in respect of 'whips, harnesses and saddlery' in class 18, but maintained the rejection for all other goods. The reasoning behind the General Court's decision was that in relation to these goods the respective marks were considered inherently weak given that 'whips, harnesses and saddlery' were closely connected to the equestrian sport. Moreover, the specialist nature of these goods meant that consumers would more likely engage in a face to face consultation and purchase with a specialist seller, but, that in relation to all of the other goods that were allowed, the visual comparison was more important given the everyday nature of the goods. As such, the verbal elements of the marks in the proceedings, BEVERLY HILLS POLO CLUB and ROYAL BERKSHIRE COUNTY POLO CLUB, would play a more important role for these goods and, therefore, there was less of a likelihood of confusion given the two distinct clubs. In this regard, the General Court stated in relation to the goods that were to be rejected, that, even if consumers were to associate the two marks with different polo clubs, the degree of similarity would only be marginally reduced given that, overall, the marks denoted the sport of polo.

The General Court's ruling highlights the importance of how a likelihood of confusion can sometimes only impact certain goods or services. In reaching its decision, the Court considered a number of issues, namely the dominant and distinctive components of the marks, the relevant public, aural, visual and conceptual elements of the marks in the dispute and also it dissected the goods in the dispute and carved out 'whips, harnesses, saddlery'. The case has been appealed to the CJEU.

Another interesting General Court case in which a likelihood of confusion was considered was a CTM opposition by Coca Cola (*Intermark Srl v OHIM*[23]). The marks in dispute were Coca Cola's prior COCA COLA stylised, figurative CTM registration (as well as a word mark CTM registration for COCA-COLA in class 35) against the following figurative COLA (with the word "RIENERGY" and device) mark, applied for in classes 32 and 35:

[22] For the following goods "spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefore" (Class 9); "watches, jewellery, precious stones, precious metals, goods coated in precious metals" (Class 14); "leather goods; imitation leather goods; trunks, travel bags, umbrellas, parasols, whips, harnesses, saddlery, walking sticks" (Class 18) and "articles of clothing, footwear and headgear" (Class 25).

[23] 18 March 2015, General Court, Case T-384/13

Coca Cola opposed on the grounds that there was a likelihood of confusion with its prior marks, in addition to a claim that there would be unfair advantage and detriment to the distinctive character or repute of its earlier registered marks with a reputation. The Opposition Division did not, however, need to consider the latter ground because it ruled the later applied for mark was confusingly similar to Coca Cola's earlier CTMs.

The opposition decision was appealed by the Applicant, Intermark, to the BoA and then to the General Court when the BoA affirmed the Opposition Division's decision. The General Court had no hesitation in dismissing the appeal and affirming the lower tribunal decisions.

The decisions consistently invoked a global assessment of factors that could point to a likelihood of confusion. The General Court stated that the BoA was right to hold that the marks were visually, phonetically and conceptually similar because of the shared term COLA, in white, cursive script on a red background. Phonetically, the inclusion of COLA in both marks assumed a high degree of similarity and, in relation to COLA being generic, the court said it took the view that COLA referred to an idea of *'a brown carbonated drink for a section of the relevant public and is neutral for the remaining members of that public'* suggesting, for example, that COLA may be less of a generic and descriptive term in some parts of the EU than others. It stated that although COLA may be weakly descriptive in some countries it could not be disregarded in the global comparison of the marks, particularly as, in relation to some goods in class 32 and services in 35, COLA would be considered as distinctive.

Coca Cola also filed evidence of extensive use and reputation showing that it was also a mark with enhanced distinctive character and should therefore enjoy a wider scope of protection than marks of low or average distinctiveness; another factor which formed part of the overall, global assessment of confusion. This was pertinent, because the dominant element in the later mark was the word COLA and was the only shared word element, which was arguably descriptive in some parts of the EU for non-alcoholic beverages in class 32.

In addition, given that Coca Cola's prior marks were protected for goods identical to those of the later mark, this would also be a factor to be considered because the greater degree of similarity between the goods can offset the lesser degree of similarity between the marks (and vice versa). Therefore, based on the interdependence between these and other factors, the General Court confirmed that Intermark's later mark was indeed confusingly similar. Coca Cola's word mark registration in class 35 was considered confusingly similar to Intermark's class 35 application, particularly because COLA in relation to business services was very distinctive.

Whilst Intermarks' application also included a distinctive device and word "RIENERGY", albeit not particularly prominently, it was COLA that dominated and so these additional elements could not be considered sufficient to prevent a likelihood of confusion.

This dispute shows how extensive prior use and reputation can influence a finding of likelihood of confusion. Had it not been for Coca Cola's reputation, the decision could arguably have gone the other way because of the descriptive nature of the COLA element in relation to non-alcoholic drinks in class 32. The decision also shows, again, how a number of different factors need to be considered when determining a likelihood of confusion.

Similarity of goods

In addition to marks being confusingly similar, it is also a condition of a likelihood of confusion that the respective goods and services are also confusingly similar, if not identical. In yet another General Court decision (*Costa Crociere Spa v OHIM*[24]) the Court held that the BoA was correct to find that 'spa' and 'sauna' services in class 44 were confusingly similar to 'soaps', 'perfumes' and 'cosmetics' goods in class 3. As such, its decision to allow a CTM opposition based on a likelihood of confusion, against the identical mark SAMSARA, and the class 44 services was correct.

Similarity of goods and services must be considered through an assessment of various factors, including the nature, intended purpose, method of use of the

[24] 26 February 2015, General Court, Case T-388/13

goods/services, whether they are in competition or are complementary. The General Court said that, in considering these factors, the fact that there are goods being compared with services cannot preclude the existence of any similarity. In this case the goods and services shared the same overall purpose: beauty and health care.

Further, spas, Turkish baths and sauna services and health spa services often include cosmetics treatments requiring use of soaps, fragrances, oils or other beauty products. Accordingly, distribution channels could overlap and the target public was identical. Additionally, it was also held that there was some complementarity between the soaps, perfumes and cosmetics products and the spa and sauna services as use of the latter is always followed by use of the former. Therefore, the Applicant's argument that its services were dissimilar to the goods covered by the earlier registration was rejected by the Court.

This case is a useful reminder of how the examination of confusing similarity is determined as between goods and services. It is also highlights the accepted practice that businesses involved in the product sectors can come up against trade mark issues with companies operating in the service sectors if their goods share similar characteristics or are complementary. Therefore, when launching new brands it is important to clear a mark, as part of pre-launch due diligence, in not only core classes and goods/services, but also the broader set of those that could potentially be held confusingly similar.

Unfair advantage/detriment

In January, Arnold J delivered his judgment in *Enterprise Holdings, Inc v Europcar Group UK Limited and another*[25]. The case involved two big players in the car rental market: Enterprise and Europcar, regarding the 'e' logos as shown below (the first being the claimant's and the second being the defendant's):

Enterprise was the proprietor of several UK and Community trade mark registrations for the above (left) 'e' logo, both in colour and in black and white. Enterprise had rights in this logo dating back to 1993. Europcar re-branded in 2012 and launched the above (right) logo as part of this exercise (referred to as the "e-moving logo"). Enterprise commenced court proceedings against Europcar for trade mark infringement and passing off in June 2013. Enterprise's claim for trade mark infringement related to three different types of use by Europcar: (i) use of the 'e-moving logo' mark alone; (ii) use of the 'e-moving logo' alongside descriptive words which denote Europcar's sub-brands such as "Prestige" and "Privilege"; and (iii) use of the 'e-moving logo' in combination with the word "EUROPCAR" and sometimes alongside the strapline "MOVING YOUR WAY".

The claimant was successful insofar as its claims under Article 9(1)(b) CTMR and passing off were concerned. This finding of infringement related to all three types of uses noted above. In respect of infringement under Article 9(1)(c), Arnold J assessed this on the assumption that there would be no likelihood of confusion. In so doing, he was not convinced that there were strong reasons to accept the argument for detriment to distinctive character or unfair advantage. Thus he concluded that if Enterprise's claim under Article 9(1)(b) failed, so too would its claim under Article 9(1)(c).

Some noteworthy points arose from this case. First, the discussion as to whether the relevant public in a trade mark infringement case can include residents of a foreign country, such as the USA. Arnold J noted in this particular case that whilst the service of vehicle rental was physically being provided in the UK, the vehicle rental market has a strong transnational character. As such, he believed it would be *"artificial and wrong"* to exclude consumers who are resident abroad. Having said this, he warned that the foreign part of the relevant public should be treated with some caution as it would be harder for the Court to put itself into the position of such consumers.

Another issue which came to light was the importance of evidence of actual confusion. The evidence of

[25] [2015] EWHC 17 (Ch)

actual confusion was extensive and included, inter alia, evidence that between January 2013 and October 2014, Europcar customers mistakenly got on the Enterprise shuttle bus at Heathrow on at least 529 occasions ("wrong way round" confusion) and several occasions whereby customers with Enterprise reservations mistakenly visited Europcar desks or branches to obtain their cars ("right way round" confusion).

The context of the defendant's use was also key. While, on the face of it, Arnold J believed the context of use should have gone in favour of Europcar's case as the defendant, he, in fact, found that each of the three different types of use was objectionable as the 'e-moving logo' logo within each retained an independent distinctive role. The judge also found that *"Europcar uses the e-moving logo as a unifying visual element between its main brand and its various sub-brands. This in itself conveys the message to consumers that the logo links different brands"* (para 206).

All of the above considerations led Arnold J to make the following conclusions on Article 9(1)(b) infringement:

"Taking all the factors into account, my assessment is as follows. The inherent distinctive character of [the Enterprise trade mark], its enhanced distinctive character acquired through use in green and white and the identity of the respective services are factors which support the existence of a likelihood of confusion. The average consumer's level of attention is a neutral factor. The relatively low degree of similarity between the e-moving logo and [the Enterprise trade mark] is a factor which points away from a likelihood of confusion, but this factor does not compel the conclusion that there is no likelihood of confusion because it remains possible that the average consumer who does not have the opportunity to compare the sign and the trade mark side by side would mistake the former for the latter as a result of imperfect recollection. The context of Europcar's use is another factor which points away from a likelihood of confusion, but as explained above, the strength of this factor varies between the three categories of use. It is strongest in relation to the third category (use of the e-moving logo together with the Europcar logo and the strapline "moving your way"), weaker in relation to the second category (use with the descriptive sub-brands) and weakest in relation to the first category (solus use).

Even in the absence of the evidence of actual confusion, I would probably have concluded that there was a likelihood of confusion on the part of the average consumer as a result of the first category of use of the e-moving logo as at the relevant date, but I would have hesitated as to whether to reach the same conclusion in relation to the second category of use and, even more so, the third category. Given the evidence of actual confusion, however, I conclude that there is a likelihood of confusion on the part of the average consumer as a result of the second and third categories of use" (per Arnold J, paras 216 – 217).

Finally, it is also interesting to note that the claimant was granted permission to adduce survey evidence in these proceedings, having satisfied the "real value" and "cost-benefit" test laid down by the Court of Appeal in *Interflora 1*, *Interflora 2* and *Zeebox*. It can be understood from Arnold J's judgment that he is not particularly pleased about this new test (or perhaps its application), which in his words: *"put the parties in the present case to the cost (amounting to some £215,000) of a two-day hearing in advance of trial which has not saved any costs at trial and to require the court to consider Europcar's criticisms of the surveys twice"* (at para 102).

The next case of interest was *J.W. Spear & Sons Ltd and others v Zynga Inc*[26]. This case was part of a long-running dispute between the parties, a part of which (concerning the scrabble tile trade mark) we reported on in our 2013 review. The first instance decision[27] was surprising as the trial judge found that Mattel's CTM for SCRAMBLE was invalid on the grounds that it was descriptive and was also customary in the trade. Further, he found that Mattel's rights in SCRABBLE were not infringed by Zynga's use of SCRAMBLE and SCRAMBLE WITH FRIENDS in respect of an online game.

On appeal, the Court of Appeal disagreed as to the invalidity of the SCRAMBLE trade mark and also upheld Mattel's claim for trade mark infringement on

[26] [2015] EWCA Civ 290
[27] [2013] EWHC 3348 (Ch)

the basis of this registration. Interestingly though, the Court of Appeal did not find there was a likelihood of confusion between SCRABBLE and SCRAMBLE and so there was no infringement of the SCRABBLE mark. It would seem that the appeal judges were influenced by the lack of evidence of actual confusion in reaching this conclusion, given that the games had coexisted in the marketplace for a number of years.

The Court of Appeal addressed some interesting points in its judgment, the first of which related to the extent to which the trade mark proprietor can rely on contextual matters extraneous to the mark as registered. Whilst the context of the defendant's use of the allegedly infringing sign is considered in infringement proceedings as a matter of course, this is not necessarily the case in relation to the context in which the proprietor's mark is used.

However, following guidance laid down by the CJEU in *Specsavers*[28] counsel for the appellants argued that additional matter Mattel routinely and uniformly used in immediate association with their registered trade marks (such as tiles, numbers and premium word scores as well as a "woodland green" background colour) should also be taken into account. Whilst Floyd LJ accepted that *Specsavers* allowed for the Court to consider the colour or colour combination in which the proprietor had used their mark, it did not allow the Court to go as far as considering other matter used in association with the mark. He therefore confirmed the correct comparison is one between the marks as they appear on the register and the allegedly infringing signs as they would appear in use to the average consumer.

The second point related to the question regarding whether there is a minimal threshold for the finding that two marks are similar. Floyd LJ answered this in the negative and confirmed that he did not believe there was authority to support the suggestion that there is a minimum threshold for similarity. He confirmed that the Court has to assess whether there is any phonetic, visual or conceptual similarity between the mark and the sign and decide whether, overall, the average consumer would consider there to be any similarity. If there is no similarity at all between the marks (which would perhaps seem unlikely in contested litigation), the Court would be justified in declining to go on to consider the likelihood of confusion. Where the average consumer would perceive some overall similarity, however faint, the Court must go on to conduct the global appreciation test for the likelihood of confusion.

In *Supreme Petfoods Ltd v Henry Bell & Co (Grantham) Ltd*[29] Mr Justice Arnold addressed an interesting procedural point. In respect of infringement under Article 5(1)(a) of the Directive (Article 9(1)(a) CTMR), it is settled case law that the alleged infringing use must affect, or be liable to affect, one of the functions of the trade mark. However Arnold J considered, after an extensive review of the case law, that it was unclear as to whom the burden of proof was on. For the purposes of this particular case, the judge proceeded on the basis that, once the trade mark proprietor had shown the other conditions necessary to prove infringement, the defendant would then bear the burden of proving that its use did not affect, nor was liable to affect, any of the functions of the trade mark. A reference to the CJEU is likely to be required to clarify this issue in the future.

In the IPEC, in *The Comptroller-General of Patents, Designs and Trade Marks & Another v Intellectual Property Agency Ltd & Another*[30] the claimants were successful in arguing both passing off and trade mark infringement of the "INTELLECTUAL PROPERTY OFFICE" trade mark by use of "INTELLECTUAL PROPERTY AGENCY" by the defendant in relation to alleged scam patent and trade mark renewal notices. The account of profits showed that the defendants had made a gross profit of £1.1 million through their activities, thus Hacon HHJ did not hesitate in awarding the maximum level of damages permitted under the IPEC cap, namely £500,000.

In one of the more colourful judgments of this year, Rose J considered the alleged infringement of the mark CRISTAL by use of the mark CRISTALINO[31]. The case concerned the claimant (Roederer's) flagship luxury Champagne brand CRISTAL, which was created in 1876 at the request of Tsar Nicolas II of Russia and was first made commercially available in the UK in 1924. Since then, it has built up a considerable reputation not only in the UK, but worldwide. The defendant was the manufacturer and seller of a cava

[28] *Specsavers International Healthcare Ltd and others v Asda Stores Ltd*, Case C-252/12, 18 July 2013

[29] [2015] EWHC 256 (Ch)

[30] [2015] EWHC 3256 (IPEC)

[31] *Champagne Louis Roederer v J Garcia Carrion S.A. and others* [2015] EWHC 2760 (Ch)

(sparkling wine from Spain) called CRISTALINO. The claimant alleged infringement of its UK and Community trade mark registrations in the word CRISTAL under Sections 10(2) and 10(3) of the UK Trade Marks Act and Articles 9(1)(b) and 9(1)(c) Community Trade Mark Regulation.

The claimants were successful under both “confusion infringement” under Section 10(2) and Article 9(1)(b) and “reputation infringement” grounds under Section 10(3) and Article 9(1)(c), as the learned judge labelled them in her judgment.

Insofar as confusion infringement was concerned, the judge found that that there was similarity in the marks. Further, there was similarity in the goods (Champagne v cava) as both are alcoholic drinks served at parties or other celebrations, designed to create a convivial atmosphere. Whilst Roederer’s CRISTAL product was at the top-end of the market, retailing at £175 and above, their trade mark registrations covered Champagne, for which there were other brands which were available for a much lower price. For this reason, the judge considered Champagne and cava to be loosely in competition with each other. She also found there was a risk of direct confusion but a greater likelihood for indirect confusion in the context of so-called “second-wine” practice, whereby the producer of a premium wine produces a wine of a slightly lower quality with a more affordable price-point, often using as the name a diminutive of the premier wine. Consumers may be led to believe CRISTALINO cava was a cheaper sparkling wine product put onto the market by Roederer in order to capitalise on the brand value of its CRISTAL Champagne.

In respect of reputation infringement, Roederer had to establish the requisite level of reputation in the UK. They were able to do so through their factual evidence regarding level of sales (the UK being their fourth biggest market), third party statements in the press media and social media and finally through survey evidence. All of the evidence presented was persuasive in finding that the CRISTAL brand has a strong reputation amongst a significant proportion of those who have previously bought Champagne or sparkling wine. Rose J commented that she had no doubt that CRISTAL was recognised by wine connoisseurs and in popular culture as *“a high quality, prestigious and aspirational brand”.*

Roederer also had to show one of the three types of injury referred to in the wording of the Act or the Regulation: “dilution” being detriment to the distinctive character of the mark; “tarnishment”, namely detriment to the repute of the mark; or lastly “free-riding”/“parasitism”, being the taking of unfair advantage of the mark’s distinctive character or repute. Roederer alleged all three types of injury were being caused by the defendants’ use of the CRISTALINO sign.

The claim was successful under the dilution and free riding heads where the claimant was able to show the likely effect the use of the CRISTALINO mark used in relation to cava would have on the economic behaviour of both the claimant’s consumers (the judge was satisfied that their consumers would buy less CRISTAL if the name ceased to be linked with luxury and prestige) and the economic behaviour of the defendant’s consumers (again the judge was satisfied the evidence amply supported the finding that there was a change in the behaviour of cava buyers in choosing CRISTALINO because of its quasi-association with the CRISTAL brand).

The judge’s comments on the issue of tarnishment were particularly interesting. She noted that tarnishment happens when the reputed mark ceases to convey desirable messages to the public. In this case, there was no criticism being made regarding the quality of the defendant’s cava. She also noted that there is nothing inherently unpleasant or degrading about cava wine. As such, she thought it would be a step forward in the law to find that tarnishment could be made out simply by using a sign on a product which is cheaper and more ordinary than the product of the claimant. As it was not necessary for her to take this step in order to decide the case, she refrained from making a finding in relation to tarnishment.

Own name defence

The Court of Appeal also handed down judgment in 2015 in the *ASSOS v ASOS*[32] case. The Supreme Court recently refused permission to appeal this decision and

[32] *Maier and another v ASOS plc and another [2015] EWCA Civ 220*

so the Court of Appeal decision is the final word on this long-running dispute.

Whilst there was a finding of infringement of the ASSOS trade mark under Articles 9(1)(b) and 9(1)(c) of the Community Trade Mark Regulation, ASOS's plea for a defence under Article 12(a) CTMR (the "own name defence") was successful by a 2-1 majority amongst the Lord Justices.

At first instance, the judge did not find that there had been infringement and so did not go on to consider the merits of the own name defence. On appeal, the defence became the crucial deciding factor as all three appeal judges found that there had been infringement.

As it is settled law (until the new Trade Mark Directive comes into force, see further below) that the own name defence applies to legal persons as well as to natural persons (and thus was a defence available for ASOS to plead), the key question was whether ASOS's actions had been "in accordance with honest practices in industrial or commercial matters". The majority (Kitchin LJ and Underhill LJ) found in favour of ASOS on this point.

They were particularly influenced by the fact that ASOS had adopted the name innocently as an acronym for their name "As Seen On Screen" and in their opinion it was never their intention to confuse the public or to trade off the goodwill associated with Asoss' business. Furthermore, there was no significant evidence of confusion in the marketplace. They were also convinced that ASOS' actions after becoming aware of ASSOS were sufficient to reduce any possibility of confusion. Taking into account all relevant factors, the judges believed ASOS had fulfilled its duty to act fairly in relation to Assos' legitimate interests and had not conducted its business so as to unfairly compete with Assos. Having acted in accordance with honest practices, ASOS was, on the particular facts of this unusual case, able to benefit from the own name defence.

In an interesting dissenting judgment, Sales LJ was particularly critical of ASOS' failure to conduct comprehensive clearance searches prior to adopting the name ASOS:

"This was not a case of an under-resourced one-man company making an unwitting and perhaps excusable blunder in choosing a confusing name. I consider that "honest business" practices for a person in Asos's position would have involved conducting reasonable checks whether "ASOS" or any similar sign was already being used to market goods of the same type which Asos intended to market, to make sure it would not trespass upon the legitimate interests of other undertakings using the same or similar names... A crude check by Googling the name "ASOS" to see if anything came up (the procedure used by Asos, as described at [152] of the main judgment) did not represent a fair attempt to have regard to the potential legitimate interests of others. In my opinion, "honest practices" within the meaning of Article 12 should have included a check for similar name trade marks. Had such a check been carried out in competent fashion, there is no reason to doubt that the registered "ASSOS" international trade mark of Assos would have been discovered." (per Sales LJ, para 245).

Overall, he noted that greater weight should be given to the rights of the proprietor of the CTM and the protection of the interests of the relevant public (in not being confused) when considering the applicability of factors such as defences to infringement under Article 12. Taking account of all of the relevant facts of the case and the policy considerations underpinning the Regulation, Sales LJ did not believe the own name defence should have been available to ASOS.

Another interesting point to arise from the case, and one on which the appeal judges were unanimous, was confirmation of the need to consider likelihood of confusion based on notional and fair use of the registered mark across the entire trade mark specification (even after a partial revocation), not just the actual use made by the claimant.

Whilst ASOS were successful on this occasion in pleading the own name defence, this case is a stark reminder of the need to conduct full clearance searches prior to adopting a new brand name. The own name defence has traditionally been a difficult one to substantiate and judges are unlikely to look favourably on defendants seeking to rely on this defence, who who have failed to conduct the proper due diligence.

Another interesting judgment was provided by the CJEU in *Loutfi Management Propriété intellectuelle SARL v AMJ Meatproducts NV and Halalsupply NV*[33] in response to questions raised by the Hof van beroep te Brussel (Court of Appeal in Brussels). The case involved trade mark infringement proceedings in Belgium whereby both parties were in the business of selling halal food products. The claimant owned two figurative CTMs for goods in Classes 29 and 30 including the words EL BENNA and EL BNINA (alongside the Arabic versions of the same words). The defendant applied to register, and also used, a logo mark containing the words EL BAINA in both Latin and Arabic script. The words appearing in the claimant's marks and the defendant's marks had some visual similarity but their pronunciation and meaning in Arabic were substantially different.

The Brussels Court decided to stay the proceedings and refer a question to the CJEU regarding whether the national court need take account of the words' meanings and pronunciations in Arabic for the purposes of assessing a likelihood of confusion, even though Arabic is not an official language of the EU. The CJEU answered this in the affirmative. The issue of a likelihood of confusion must be assessed by reference to the perception of the relevant public. As the national court found that the relevant public were *"composed of Muslim consumers of Arab origin who consume 'halal' food products in the European Union and who have at least a basic knowledge of written Arabic",* the meaning and pronunciation of the words in Arabic must be taken into account.

Whilst this case was quite specific to its facts, it may have relevance to brand owners who market goods to particular ethnic, religious or linguistic groups within the EU.

Parallel trade

The conflict between the free movement of goods and trade mark rights appeared before the courts in both the UK and the CJEU in 2015.

In *Flynn Pharma Limited v (1) Drugsrus Limited and (2) Tenolol Limited*[34] the High Court was asked to restrain the defendants from rebranding parallel imports of an epilepsy drug known as "EPANUTIN" in other EU member states with the name "Phenytoin Sodium Flynn".

Pfizer had for many years manufactured and sold Phenytoin Sodium under the brand "EPANUTIN" in the UK. The claimant had bought the rights from Pfizer to distribute the drug within the UK only and had intended to genericise as "Phenytoin Sodium" the product so as to avoid the price capping of branded drugs by the UK Government for provision via the NHS (and the price rose from roughly £3 per bottle to £54 per bottle). However, due to the very narrow therapeutic index required for Phenytoin Sodium to be effective the Medical Health Care Products Regulatory Agency ("MRHA") required that the renamed drug be called "Phenytoin Sodium Flynn" to identify the manufacturer so as to ensure that patients, doctors and pharmacists could ensure continuity of supply. The claimant (whose name included the word Flynn in any event) subsequently obtained a number of UK and CTM trade mark registrations for the mark FLYNN.

The defendants were established parallel importers and wished to exploit the price differential between EPANUTIN manufactured by Pfizer and sold in other EU member states and the Phenytoin Sodium which was manufactured by Pfizer but sold by the claimant in the UK as "Phenytoin Sodium Flynn".

The defendants wanted to obtain access to the generic Phenytoin Sodium market which was represented by using the name "Phenytoin Sodium Flynn" and therefore wished to re-brand the EPANUTIN as "Phenytoin Sodium Flynn".

The defendants were subject to trade mark infringement proceedings for their use of FLYNN. They sought to rely on the grounds that: their use of the mark FLYNN was not trade mark use (it was descriptive) and any such use fell within the defence of s.11(2)(b) of the UK Trade Mark Act (use of a mark to describe the kind, quality, intended purpose, etc). In the alternative, the rebranding of the imported goods was permissible under the long established BMS conditions[35], summarised by Jacob LJ as being: *"(1) Necessary to repackage to market the product; (2) No effect on original condition and proper instructions; (3)*

[33] Case C-147/14, 25 June 2015
[34] [2015] EWHC 2759 (Ch)
[35] *Bristol-Myers Squibb v Paranova* [1996] ECR I-3457

Clear identification of manufacturer and importer; (4) Non-damaging presentation; and (5) Notice."[36]

The Court held that use of the word FLYNN on rebranded imported EPANUTIN was trade mark use and such use did not fall within the s.11(2)(b) defence. Further, for a party to avail itself of the BMS exception, the goods in question must have been put on the market by the same entity that seeks to restrain the rebranding. As it was Pfizer who put the EPANUTIN on the mark in the EU and the claimant who was objecting to the rebranding, then BMS did not apply. However, the judge found that if BMS could apply, then the rebranding would have been necessary for the defendants to establish a market for their goods in the UK.

It might seem somewhat unfair on the defendants that, despite the Court finding that they needed to re-brand the drug in order to have access to the relevant market, they could not rely on the BMS criteria because Pfizer had adequately divested itself of responsibility for the product in the UK. It might also seem unfair that the defendant was put in this situation by a regulatory requirement (or quirk) of the MHRA. However, this decision is a strong one for trade mark rights and other mechanisms will have to be developed to balance the various public policy considerations.

A Court of Appeal case that was considered by Mrs Justice Rose in the Flynn case concerned a different rebranding issue: *Speciality European Pharma Ltd v Doncaster Pharmaceuticals Group Ltd & Madaus GmbH*[37]. Here the Court was asked to consider circumstances when a pharmaceutical manufacturer markets the identical product in EU member state A under trade mark X and in EU member state B under trade mark Y. In what circumstances can a parallel importer take the goods (marked X) from state A to state B and re-brand them with mark Y?

In this case the First defendant was a well known parallel importer and had sought to import trospium chloride for the treatment of over-active bladder symptoms into the UK from France and Germany. Tropsium chloride was manufactured and marketed by Madus (the Second defendant) in France as CÉRIS, in Germany as URIVESC and in the UK as REGURIN.

For many years Doncaster (the First defendant) had imported trospium chloride from France and simply over-stickered using the generic name, but not the UK brand name. Sometime later, Doncaster started over-stickering the French boxes with the mark REGURIN and subsequently commenced importation from Germany, which it also over-stickered with the mark REGURIN. It should be noted that the claimant is Madus's exclusive licensee and Madus took no part in these proceedings, but was joined as a defendant as required by UK law. The first instance judge held that Doncaster had infringed the REGURIN mark. Doncaster was subsequently given permission to appeal.

At appeal, the Court found that, on the evidence there were a significant proportion of prescribing doctors and pharmacists who were resistant to the prescribing of generic prescriptions for trospium chloride. Further, the Court found that Doncaster's parallel imports could not compete on price with the generic products already on the market. As such, the Court held that the re-branding went no further than was necessary to overcome artificial barriers to effective market access by Doncaster and allowed the appeal. In other words the First defendant could avail itself of the exception provided by the BMS conditions (due, in part, to the nexus between the exclusive licensee claimant and the licensor).

Finally, in *Logistics BV, Van Caem International BV v Bacardi & Company Ltd, Bacardi International Ltd; Bacardi & Company Ltd, Bacardi International Ltd v TOP Logistics BV, Van Caem International BV*[38] the CJEU held that Article 5 of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark registered in one or more Member States may oppose a third party placing goods bearing that trade mark under the duty suspension arrangement (for goods not intended to be marketed within the EEA) after they have been introduced into the EEA and released for free circulation without the consent of that proprietor.

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[36] *Boehringer Ingelheim v Swingward* [2004] EWCA Civ 129; [2004 ETMR 65 at [28]

[37] [2015] EWCA Civ 54

[38] C 379/14

Protected geographical indications

The General Court considered two appeal cases[39] brought by *Federación Nacional de Cafeteros de Colombia* ("FNCC"). The first case related to an opposition filed against the stylised mark COLOMBIANO HOUSE for the provision of food and drink services in class 43. The second case concerned an application for a declaration of invalidity against COLOMBIANO COFFEE HOUSE registered for food products in class 30 (but not coffee) and services for providing food and drink in class 43.

FNCC relied upon Article 8(4) CTMR for both the opposition and the invalidity application on the basis of its PGI for "Cafe de Colombia" which is registered in the EC for coffee. The opposition and invalidity application were rejected on the grounds that the application services and/or goods do not belong in the same class of product as coffee within the meaning of Article 14(1) of the EC regulation for the protection of PGI's (EC Regulation No 510/2006). The Court confirmed that Article 13 relates to proceedings based on relative grounds whereas Article 14 relates to proceedings based on absolute grounds. The BoA had committed an error in applying only Article 14 as various situations described under Article 13 had also been invoked by FNCC.

In *Instituto dos Vinhos do Douro e do Porto, IP and Bruichladdich Distillery Co. Ltd v OHIM*[40] the General Court considered a case concerning an invalidity application filed against a CTM for PORT CHARLOTTE registered for 'whisky' in class 33. Instituto dos Vinhos had relied upon its appellations of origin in "porto" and "port" which are protected under Community law and national Portuguese law. OHIM had rejected the invalidity application on the basis that it could not consider Portuguese law as the protection of designations of origin for wines is governed exclusively by Regulation No 491/2009 (specific provisions for certain agricultural products) and therefore fell within the exclusive competence of the EU.

The Court considered that OHIM was wrong to disregard Portuguese law and confirmed that the protection for geographical indications granted under Regulation no 491/2009 can be supplemented by the relevant national law, which may grant additional protection. The decision is a departure from established practice and means that national laws for the protection of geographical indications – which can often be very broad – must now be taken into account.

A recent opposition case highlights the importance of submitting sufficient evidence of reputation. The *Consorzio Di Tutela Della Denominazione Di Origine Controllata Prosecco*[41] filed an opposition against a CTM application for "T-SECCO" covering food products in class 30, preparations for making alcoholic beverages in class 33 and provision of food and drink in class 43, on the basis of their Collective CTM for "PROSECCO PDO PROSECCO DOC" under Article 8(1)(b) (likelihood of confusion) and a Protected Designation of Origin for "Prosecco" under Article 8(4) (an earlier sign of more than mere local significance). The Opposition Division rejected the opposition under Article 8(4) as they considered that the opponent had not filed sufficient evidence to prove that "Prosecco" had been used in the course of trade, nor had the opponent met the threshold for proving a reputation.

The case serves as a reminder that even the owners of well known signs must submit sufficient evidence of use.

Passing off

The Supreme Court resisted an attempt to broaden the scope of passing off to a business with reputation but no customers within the UK, *Starbucks (HK) Limited and another (Appellants) v British Sky Broadcasting Group PLC and others (Respondents)*[42]. The Court considered that the protection afforded to "well known marks" under Article 6bis of the Paris Convention by section 56 of the UK TMA provided sufficient protection for owners of unregistered but "well known marks" in the UK and that there was no need to extend that protection to marks with mere reputation via an expansion of the tort of passing off.

The Court of Appeal was asked to consider whether the sale of a t-shirt bearing an image of a famous pop star, without her consent, constituted passing off in *Robyn Rihanna Fenty, Roraj Trade LLC and*

[39] T-387/13 and T-359/14
[40] 18 November 2015, Case T-659/14
[41] Opposition no. B002406885
[42] [2015] UKSC 31

Combermere Entertainment Properties, LLC v Arcadia Group Brands Limited and Topshop/Topman Limited[43]. The first instance Court considered the defendants' production and sale of the t-shirt bearing the image of Rihanna constituted a misrepresentation which was likely to mislead potential customers. The claimants relied upon the particular image, the way it was presented and the nature of the t-shirt itself, together with the role of the defendant as a major and reputable high street retailer. The Court held that all of these circumstances created a real likelihood that a substantial number of persons would be deceived into thinking that the t-shirt was an authorised product and would, as a result, buy it.

The Court of Appeal dismissed the defendants' appeal, commenting that, whilst this was a borderline case: *"[t]he judge's conclusion that some members of the relevant public would think that the t-shirt was endorsed by Rihanna is based essentially on two things - her past public association with Topshop ... and the particular features of the image itself, which is apparently posed and shows her with the very distinctive hairstyle adopted in the publicity for Talk That Talk. I do not believe that either by itself would suffice."*

The Appeal Court made it clear that this was a very specific case of misrepresentation and that there were differences between endorsement and merchandising cases and the judge was entitled to find that this was an endorsement case. It fell within the scope of passing off and no new tort of image rights had been developed.

Reputation

2015 saw the handing down of a noteworthy judgment on the threshold for finding that an earlier CTM enjoys a reputation in the EU and guidance on applying this finding in national opposition proceedings.

In *Iron & Smith kft v Unilever NV*[44], the CJEU considered a series of questions referred to them by the Budapest Municipal Court in Hungary. The background of the case is this: Iron & Smith applied to register the figurative colour sign 'BE IMPULSIVE' as a Hungarian national trade mark and Unilever opposed on the basis of its earlier Community and International trade marks for 'IMPULSE' (being a well-known brand of body spray, at least insofar as the UK is concerned). Unilever failed to show reputation in IMPULSE in Hungary and thus the International marks could not be relied upon in the opposition. The more interesting question was whether they could rely upon their Community trade marks, in which they could show a reputation in some member states of the EU (namely the UK and Italy), but crucially not the member state in which the national opposition proceedings were taking place (Hungary).

The Hungarian IPO found that reputation of the earlier CTM had been proved in relation to a substantial part of the EU and they consequently found in favour of Unilever, refusing the application under the national equivalent of Article 4(3) Directive 2008/95 and citing that there could be a risk of unfair advantage or detriment. Iron & Smith appealed to the Municipal Court, who referred a number of questions to the CJEU.

The first question related to whether reputation in one member state would be sufficient to establish reputation of a CTM in the EU, even if that member state was not the state in which the opposition proceedings were taking place. In answering this question, the CJEU reaffirmed the principles laid down in *PAGO*[45] by stating that reputation must be proven in relation to a substantial part of the territory of the Community and in some circumstances, this may correspond to the territory of a single member state, regardless of whether that one territory coincides with the territory of the national proceedings.

The second question asked whether the principles surrounding genuine use can be applied in the context of the territorial criteria used when examining reputation. The Court answered this question in the negative. The criteria in the law of genuine use are not relevant for the purposes of establishing a reputation under Article 4(3) of the Directive.

In answering the third question, the Court confirmed that, where the proprietor of the earlier CTM has shown a reputation in a substantial part of the territory which does not include the territory in which the later mark

[43] [2015] EWCA Civ 3
[44] Case C-125/14, 3 September 2015
[45] *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH* C-301/07, 6 October 2009

has been filed, there is no additional requirement for it to also prove a reputation in the member state of the national proceedingsnational proceedings.

The final and crucial question, building upon the third question, asked how a trade mark proprietor who had a reputation in member states other than the country in which the national opposition proceedings were taking place might meet the other conditions under Article 4(3), namely showing that there would be a risk of detriment or unfair advantage in that country, as the mark may be unknown to the relevant national consumer.

Here, the Court reiterated the principles laid down in *Intel*[46] that the public concerned must make the necessary 'link' between the earlier CTM and the later national mark and the proprietor must show one of the specific injuries referred to, namely unfair advantage or detriment to the distinctive character or repute of the earlier trade mark. The Court commented that it is conceivable that a "commercially significant part" of the relevant public in the member state would be familiar with the earlier mark, which has a reputation in other member states of the EU and thus would make the necessary connection between the earlier CTM and the later national mark. It is stated that this would be an issue for the national court to determine. Thus if a CTM proprietor wants to rely upon the national equivalent of Article 4(3) in national opposition proceedings, if it does not have a reputation in that particular member state, it must show that a commercially significant part of that public is familiar with the mark, makes a connection between it and the later mark and there is actual or real risk of the specific types of injury referred to in that provision.

This decision clarifies and effectively limits the protection afforded under Article 4(3) of the Directive; simply showing a reputation in member states outside of the territory in which the proceedings take place may no longer be sufficient.

Proprietors trying to enforce their earlier Community trade marks in national opposition proceedings under the equivalent of Article 4(3) will have to either (i) show a reputation in that particular member state, or (ii) show that a commercially significant part of that public is familiar with that mark, makes a connection between that mark and the later mark and that there is actual or real injury.

The Court did not go on to define exactly what they would consider to be a "commercially significant part of the public" and so this is likely to result in further references in the future.

Trade mark law reform

In 2015 the European Parliament adopted a package of reform proposals for EU laws on trade marks. The implications of these reforms will be realised in 2016 (and later), but they are of sufficient importance to warrant setting out here.

In particular, there will be a new EU Trade Marks Directive and a new EU Trade Mark Regulation.

Trade marks directive

The new Trade Marks Directive (2015/2436) dated 16 December 2015 was published in the Official Journal on 23 December 2015 and repeals Directive 2008/95/EC as of 15 January 2019. The provisions of the Directive must be transposed into UK law before that and a consultation by the IPO is expected.

The major changes include:

- Removal of the requirement that signs be capable of graphical representation;
- An updating amendment to bring the legislation into line with case law so as to remove the requirement that marks with a reputation can only be infringed in relation to dissimilar goods;
- Express provisions relating to trade mark infringement in the absence of compliance with comparative advertising Directive;
- Ability for trade mark owners to prevent the importation of counterfeit goods even where the goods are not to be released into the EU (unless it can be shown they would not infringe in the destination country);
- Expressly limiting the own name defence to natural persons (not companies).

[46] *Intel Corporation Inc. v CPM United Kingdom Ltd* Case C-252/07, 27 November 2008

EU trade mark regulation

The new regulation results from amendments to the existing Regulation 207/2009 (by means of Regulation 2015/2424) and will be referred to as the European Union Trade Mark Regulation (EUTMR) and incorporate the provisions of the Fees Regulation. OHIM will be referred to as the EU Intellectual Property Office (EUIPO).

Key changes include:

- EUTMs cannot be filed with national trade mark offices;
- Removal of the possibility of adding disclaimers;
- The opposition period for international applications is now to open one month after the date of publication;
- A long-stop date (of 24 September 2016) for filing a declaration for marks which were applied for before 22 June 2012 that specifications consisting of class headings were intended to cover goods/services beyond the goods/services listed in the heading;
- EU Trade Mark Courts may not proceed with the examination of counterclaims until the EUIPO has been informed of the date on which the counterclaim was filed and the EUIPO has reported on any previous applications made for revocation or invalidity;
- Fee structure is to be changed so as not to include 3 classes of goods/services within the fee and to reduce renewal fees.

Looking ahead

It is always difficult to accurately predict decisions to watch out for in the following year as cases have a habit of settling or being decided significantly later than expected due to the court timetable. While some of the ones to watch have been reviewed here, a number of cases we identified in our 2014 review as being of interest in their further stages have not proceeded (for example *Thomas Pink*, *Interflora* and *Lush*). Another (the Glee appeal) has been decided in 2016 and will be dealt with in that year's review publication.

At the beginning of this review we reported on the latest chapter of the dispute between Cadbury and Nestlé regarding Nestlé's attempt to register a trade mark resembling its four-fingered Kit Kat chocolate wafer product. At the time of printing Nestlé had stated its intention to apply to the Court of Appeal for permission to appeal. Whether or not permission will be granted remains to be seen. However, during the course of 2016 it is likely that there will be a hearing in a related matter, namely registrability of the same shape as a CTM by the General Court. Further reports will follow.

In last year's review we reported on Cartier's success in obtaining website blocking injunctions against ISPs. This judgment is listed for appeal in 2016. Whilst it seems unlikely that the substance of the first instance decision will be overturned, there may be further guidance on pre-action conduct from claimants seeking injunctions which is worth reviewing.

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Paul is an industry-acknowledged leader in all aspects of “brands” law. He is head of the brands practice and specialises in the entirety of the work - from brand and design creation to brand enforcement and exploitation. In terms of exploitation and use of brands, he advises not only on IP rights but day-to-day use of brands in market. This includes advertising, specific product regulatory regimes and relevant consumer law.

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Tim trained with Bristows and qualified into the Intellectual Property Litigation department in 2014. His experience covers both contentious and non-contentious matters, with a focus on trade mark and copyright disputes, patents, confidential information and advertising advisory work. Since joining Bristows, he has spent time on secondment in the in-house legal department of a multi-national company, advising on brand protection and marketing.

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