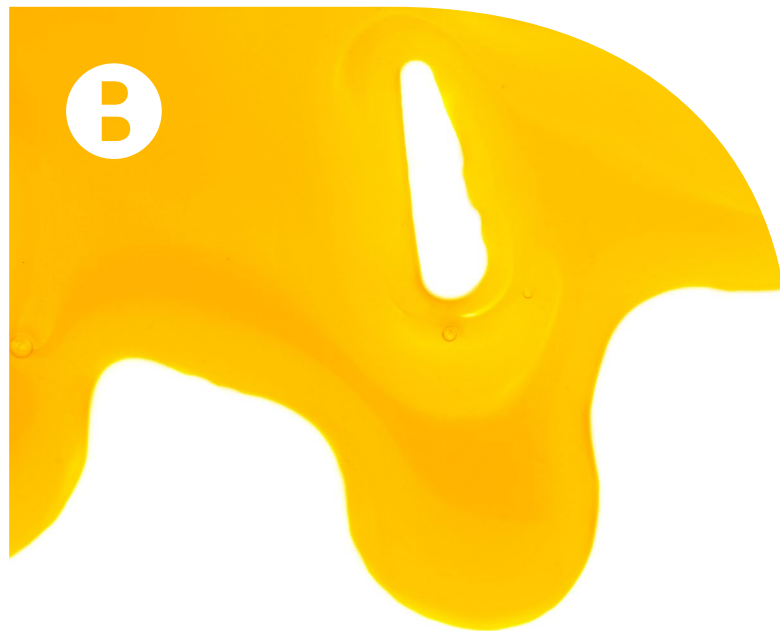


Review of UK and European

Trade Mark Cases 2019



Bristows

Quotation of the Year:

“The applicant’s pleading of its case, which I consider the proprietor is justified in labelling as ‘shambolic’, and the delay and additional cost it had already caused the proprietor, was a further aggravating factor. However, my decision did not depend on this.”

J. Sainsbury Plc v Fromageries Bel S.A., O/086/19, 13 February 2019

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The information contained in this document is intended for general guidance only.

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Introduction

This edition of a Review of UK and European Trade Mark Cases 2019 includes a number of interesting cases in relation to invalidity, passing off and infringement. The recent decision handed down in *Sky v Skykick* provides comfort to trade mark owners, but at the same time will remain a frustration in respect of invalidation Applicants.

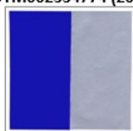
Distinctiveness - colour

In the *Red Bull* case¹, the CJEU ruled that the General Court had correctly interpreted the rules on colour combination trade marks.

We first reported on this case back in 2017. By way of background, Red Bull GmbH filed EU trade mark applications for the following two colour combinations for “energy drinks” in class 32 in 2002 and 2010 respectively:

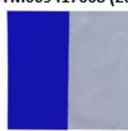
The marks were registered in 2005 and 2011 respectively,

EUTM002534774 (2002)



Description: Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%.

EUTM009417668 (2010)



Description: The two colours will be applied in equal proportion and juxtaposed to each other.

both on the basis of acquired distinctiveness.

A Polish company, Optimum Mark, then filed invalidity applications against both registrations. Optimum Mark argued that both applications were invalid as they did not meet the requirements for registration under Article 4 and Article 7(1)(a) of Regulation No. 207/2009.

Specifically, it argued that the first mark did not meet the requirements “since its graphic representation did not systematically arrange the colours by associating them in a predetermined and uniform way and, secondly, that the description of the trade mark, according to which the ratio of the two colours of which the mark was composed was “approximately 50%-50%”, allowed for numerous combinations, with the result that consumers would not be able to make further purchases with certainty.”

As regards the second mark, it argued, “first, that it did not meet the requirements of Article 7(1)(a) of Regulation No 207/2009 and, secondly, that, on account of the fact that the term “juxtaposed” might have several meanings, the description of the trade mark did not indicate the type of arrangement in which the two colours would be applied to the goods and was therefore not self-contained, clear and precise.”

In October 2013, the Cancellation Division of the EUIPO declared the two marks to be invalid, on the grounds that they were not sufficiently precise. The Cancellation Division relied on the fact that they allowed numerous different combinations which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to make further purchases with certainty.

Red Bull appealed these decisions to the Board of Appeal. The Board of Appeal dismissed both appeals stating that the graphical representation of the marks evaluated in conjunction with the accompanying description did not satisfy the requirements of precision and durability laid down in the 2004 Court of Justice decision in *Heidelberger Bauchemie*². This case laid down the following test – “marks consisting of a combination of colours must be systematically arranged in such a way that the colours concerned are associated in a predetermined and uniform way.”

In *Heidelberger Bauchemie*, it was also noted that the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours “in every conceivable form”, will not exhibit the qualities of precision and uniformity required by Article 4. Importantly, such representations would allow numerous different combinations which would not permit the consumer to perceive and recall any particular combination, thereby failing to enable them to make further purchases with certainty. Similarly, the competent authorities and economic operators would not know the scope of the protection afforded to the proprietor of the trade mark in question.

Red Bull appealed the Board of Appeal decisions to the General Court, which dismissed the actions in their entirety. Red Bull then appealed the decisions to the Court of Justice of the European Union (CJEU).

CJEU decision

Red Bull put forward five grounds of appeal, however it is the second ground of appeal – namely infringement of Article 4 and Article 7(1)(a) of Regulation 207/2009, which is of particular interest.

Red Bull argued that the General Court had misinterpreted the judgment in *Heidelberger Bauchemie* in holding that marks consisting of a combination of colours must systematically specify the spatial arrangement of the colours in question and, consequently, concluding that the graphic representation of the marks at issue was insufficiently precise without such an arrangement. The second ground of appeal was split into three parts:

¹ *Red Bull GmbH v EUIPO*, Case C-124/18 P

² Case C-49/02, 24 June 2004

- i. First, Red Bull contended that by considering that the mere juxtaposition of colours was not sufficient to constitute a precise and uniform graphic representation, the General Court had failed to consider that a trade mark must be viewed as filed, as per the CJEU decision in *Apple*³. As such, it had failed to consider the specific feature of marks consisting of a combination of colours, which is not to have contours.

The CJEU held that Red Bull could not rely on the *Apple* case in support of its claim that the General Court had erred in holding that the graphic representation of the marks at issue was insufficiently precise. That case merely concerned graphic representation of “a collection of lines, curves and shapes”, which was not the case here. Furthermore, requiring a mark consisting of a combination of colours to display a systematic arrangement associating the colours in a predetermined and uniform way cannot, contrary to Red Bull’s arguments, transform that type of mark into a figurative mark, since that requirement does not mean that the colours must be defined by contours.

- ii. Red Bull also took issue with the General Court’s statement that marks consisting of a combination of colours *must* include a description of the graphic representation, whereas such a description has always been left to the discretion of the parties. In any event, the marks at issue each included a description, which was not inconsistent with the graphic representation and which did not therefore justify the marks being declared invalid.

The CJEU did not give much time to this argument. As both of the marks in question included a description, this argument was deemed to be ineffective on the facts.

- iii. Red Bull also criticised the General Court for taking into account actual use that was made of the marks to establish that their graphic representation allowed a multitude of arrangements, thereby conflating the analysis of the graphic representation with that of the distinctive character of the sign in question. Red Bull argued that under Article 7(3) and Article 15(1) of Regulation No 207/2009, the proprietor of a mark is entitled to use such a mark in different variations and, accordingly, marks consisting of a combination of colours should not be reduced to a single figurative arrangement reflecting the way in which they are actually used.

The CJEU rejected this ground and noted that as the marks were registered on the basis of acquired distinctiveness, the General Court was entitled to examine whether the marks at issue met the requirements of Article 4 of Regulation No 207/2009 and as part

of that examination, to take into account the various manifestations of that use, in particular the actual use of those marks.

Overall, the CJEU concluded that the General Court had not erred in its assessment of Article 4 and 7(1)(a) of the Regulation. The General Court was right to consider that the description of the marks could result in numerous combinations with respect to the arrangement of the two colours. Therefore, marks that allow for a plurality of reproductions that are neither determined in advance nor uniform are considered incompatible with the Regulation.

All of the other grounds of appeal were dismissed or found to be inadmissible. Consequently, the whole appeal was dismissed and Red Bull was ordered to pay costs.

This case confirms that for a colour combination mark to be registrable, it must be systematically arranged in such a way that the colours concerned are associated in a predetermined and uniform way. The mere juxtaposition of two colours with a certain ratio is unlikely to be deemed a valid trade mark. If the graphic representation alongside the description is in any way unclear or ambiguous, this is likely to result in the application being refused or the registration being declared invalid.

Applicants for colour combination marks should also consider their prior use of the mark which they seek to register, as colour marks are likely to require evidence of acquired distinctiveness to be submitted in order to support an application for registration. If there have been many forms of prior use (as was the case in *Red Bull*), then this may be damaging to the Applicant’s case. Care should be taken to ensure that the use evidence submitted shows the colour combination mark in the form in which registration is sought, and that the graphic representation alongside a precise verbal description closely mirrors this.

The CJEU did not itself provide any further practical guidance on how an Applicant for a colour combination mark may overcome the *Heidelberger* hurdle, however this may well be clarified in future judgments from the Court.

³ *Apple Inc v Deutsches Patent- und Markenamt*, Case C-421/13, 10 July 2014

Distinctiveness – word/slogan marks

The General Court discussed the distinctiveness of a mark which may also be used as an advertising slogan in *Medrobotics*⁴.

The Applicant, Medrobotics, filed EU application for the mark SEE MORE. REACH MORE. TREAT MORE. in relation to “*medical devices, namely, surgical devices for diagnostic and surgical use; articulated arms for medical diagnostic and surgical use; probes used concurrently therewith for medical purposes with one or more positional tools coupled thereto*” in class 10.

The Examiner rejected the application on the basis of Article 7(1)(b) of the Regulation⁵ which was appealed by the Applicant. The Board of Appeal dismissed the appeal affirming that the structure of the mark complied with the rules of English grammar and syntax and that it would be easily understood by the relevant public. Nothing about the mark would, based on obvious generalisation,

Accordingly, the Court confirmed the Board of Appeal’s decision that the mark was an ordinary advertising message which was not likely to trigger a cognitive process in the minds of the relevant public, therefore being devoid of any distinctive character.

In April 2019, the Board of Appeal explained why an EU application for PROTECT LIFE was refused for a range of goods and services in classes 9, 13, 41 and 45⁶.

The Applicant, Axon Enterprise Inc, sought to register the trade mark for PROTECT LIFE in relation to “*life-saving apparatus; motion picture films that include recorded video, picture, etc.*” in class 9, “*weapons*” in class 13, “*advertising services*” in class 35, “*education services*” in class 41 and “*security services for the protection of property and individuals*” in class 45. The Examiner refused the application on the grounds that the mark was descriptive and devoid of distinctive character for those goods and services.

This is an excerpt of Review of UK and European Trade Mark Cases 2019.

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