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Coreix v Coretx [2017] EWHC 1695 (IPEC) Douglas Campbell QC

Followed *Marussia v Manor* - defence of estoppel not available in TM case (UK registration not EU in this case). Adverse conclusions can be drawn from absence of witness. Defence of acquiescence failed on the facts as there was no reliance.

Black & Decker Corporation v DVICE BV [2017] EWHC 3387 (Ch) Arnold J

Decision on jurisdiction of Community Trade Mark Courts under the Regulation. Must be a good arguable case that the act of infringement has been committed in the jurisdiction of the Court. It is not enough if the damage occurs or will occur within the jurisdiction if the act of infringement did not occur there.

Mermeren v Fox [2017] EWHC 1408 (IPEC) HHJ Hacon

Inherent character of a mark in relation to designation of geographical origin is to be assessed at the date the trade mark is applied for **and any use is to be disregarded**. Distinctive character must be assessed in relation to the goods or services covered and the presumed expectations of an average consumer of the category of goods or services in question. Significant proportion more than *de minimis* but not necessarily over half.

Where average consumer has never heard of the place that name cannot inherently designate a geographical origin in the mind of the average consumer. The use of the mark up to 2011 made it designate a geographical origin but the use between 2011 and August 2013, the date of the TM application, made it distinctive.

Nestle v Cadbury [2017] EWCA Civ 358 The Chancellor, Kitchin and Floyd LJ

A shape mark. The fact that a significant proportion of average consumers had come to **recognise** the shape in question and associated it with Kit Kat was not enough. However it was not necessary to show that the public had actually come to **rely** on the shape for the mark to be registered. It was necessary to establish that consumers **perceived** the shape as a badge of origin.

Flynn Pharma v DrugsRus [2017] EWCA Civ 226 The Chancellor, Kitchin and Floyd LJ

Flynn obtained the product that it sold under the trade mark in the UK from Pfizer and had control over the quality of the product. DrugsRus obtained product made by Pfizer and put on the market by Pfizer in other Member States. and repackaged it, using Flynn's trade mark. Flynn had no control over the quality of the product sold by Pfizer. Importation of that product into the UK under Flynn's trade mark was an infringement of Flynn's rights and enforcing those rights did not constitute a disguised restriction on trade between Member States.

Burgerista v Burgista [2018] EWHC 35 (IPEC) HHJ Hacon

Consideration of descriptiveness and of the required reputation for the extended protection of marks with a reputation.

Jadebay Limited v Clarke-Coles [2017] EWHC 1400 (IPEC) HHJ Melissa Clarke

Defendant listing their product on Amazon under the Claimants' listing for "Aluminium Flagpole 20ft with Union Jack Flag by DesignElements". The Claimants have the trade mark "Design Elements" in a cursive script. By undercutting the Claimant the Defendant's product obtains a higher listing and is the product purchased by clicking in the Buy Box. Held to be similar but not identical. Infringement under 10(2) and 10(3) and passing off. The fact that there was no evidence of actual confusion in 4 years of selling could be explained by people failing to report confusion and no evidence that the Defendant's products were inferior.

Apple v Arcadia [2017] EWHC 440 (Ch) Arnold J

Appeal from UKIPO on opposition to IWATCH. Apple attempted to rely on acquired distinctiveness by reason of the use, not of IWATCH, but of a family of other marks including IPHONE and IPAD. Whilst Arnold J observed that this did not appear to qualify under the act, not being acquired "as a result of the use made of it", he didn't express a concluded view on the point as the hearing officer had found that, in any event, the mark had not acquired distinctiveness on the facts.

R v M [2017] UKSC 58 Lords Neuberger, Mance, Sumption, Hughes and Hodge

Upheld CA. TMA 1994 s92 criminal offence committed where the mark has been applied with the consent of the proprietor but there has been no consent to the sale of the goods.

Glaxo v Sandoz [2017] EWCA (Civ) 335 The Chancellor, Kitchin and Floyd LJ

Application for Summary Judgment on the counterclaim for invalidity of the registered colour mark: "...the colour dark purple applied to a significant proportion of an inhaler and the colour light purple applied to the remainder of the inhaler" (Pantone colours identifying both) with a pictorial representation of an inhaler.

Appropriate for summary judgment as neither side suggested their case would be improved by further evidence and no issues that required reference to the CJEU.

The mark lacks the clarity, intelligibility, precision, specificity and accessibility that the law requires.

AMS Neve v Heritage [2018] EWCA (Civ) 86 Lewison and Kitchin LJ

Infringement of an EUTM by online advertisement held by HHJ Hacon to be actionable only in the country where the advertisement was activated (Spain) and not where it was targeted (UK), based on CJEU case law. This is because jurisdiction is conferred by the Regulation and is a derogation from Brussels and is given in the country where the act of infringement took place. CA doubted this conclusion, differing from the Bundesgerichtshof, and referred questions to the CJEU.

BMW v Technosport [2017] EWCA (Civ) 779 Patten and Floyd LJ

The Judge below (HHJ Hacon) was wrong in suggesting that BMW had needed more evidence to succeed in an infringement action on the basis of the use of the word mark BMW when used in

conjunction with TECHNOSPORT. The Judge had to decide whether the use was informative use or misleading use. The court has to make its own assessment, taking into account all relevant circumstances. "Where what is in issue is an ordinary consumer product the court is not normally assisted by the evidence of individual consumers to establish what impression is conveyed by a sign."

The London Taxi Company v Frazer-Nash [2017] EWCA (Civ) 1729 Kitchin and Floyd LJ

Registered trade mark consisting of the shape of a London taxi. The alleged infringement was designed to be "recognisable as a licensed London cab at a generic level" and was stated in a press release to be "instantly recognisable as an iconic London Hackney Cab". Issue as to identity of 'average consumer' and whether that included a hirer of a taxi not decided but indication that it did.

Shape of a London taxi did not differ sufficiently from the norms and customs of the car sector to have inherent distinctive character. No acquired distinctiveness in the shape. Indications that the court disagreed with the judge over his assessment of some of the evidence it was not sufficient to interfere with his judgment. The court agreed with the judge on his assessment of the overall comparison required for infringement under Ar 9(1)(b) but would have found infringement under Ar 9(1)(c) if the registrations had been valid.

Sky v Skykick [2017] EWHC 1769 (Ch) Birss J

Application for a reference before trial as to the validity of the abolition of the own name defence for companies as being contrary to Ar 16 of the EU Charter (Freedom to Conduct Business), Ar 17 of the EU Charter (A Right to Property), Ar 20 of the EU Charter (Equality Before the Law and Ar 21 of the EU Charter (Non-Discrimination). Held that there was an arguable case but it was premature to make a reference at this stage.

Both parties agreed that there should not be a stay of the proceedings although the validity of the EU trade marks was being challenged in the EUIPO. The judge held that although the case for special grounds existing was not "the strongest" he was satisfied that there were special grounds and did not stay the proceedings.

Sky v Skykick [2018] EWHC 155 (Ch) Arnold J

Registration of a trade mark for 'computer software' is too broad and is unjustified and contrary to the public interest. Questions referred to the CJEU as to whether this can be a ground of invalidity of a trade mark after registration.

Attack on validity of registrations based on bad faith where the applicant had no intention to use is arguable particularly where the applicant has no reasonable commercial rationale for seeking such protection. Judge referred questions to the CJEU, including whether an application can be partly in good faith and partly in bad faith,

Student Union Lettings v Essex Student Lets [2018] EWHC 419 (IPEC) Amand Michaels

Detailed consideration of s.11(3) effect of earlier right in a particular locality.

National Guild of Removers v Luckes [2017] EWHC 3176 (IPEC) HHJ Hacon

The individual defendants could not be liable as joint tortfeasors in respect of an act about which they knew nothing.

Pablo Star Media v Richard Bowen [2017] EWHC 2541 (IPEC) HHJ Hacon

Appeal from the IPEC small claims track. Not successful either in substance or on the issue of costs.

Glaxo v Sandoz [2017] EWHC 1524 (Ch) Chief Master Marsh

Refusal to grant permission for three experts covering three interrelated subject areas. Passing off. Following Birss J in *Fenty v Arcadia*, the evidence sought to be introduced was likely to be fact evidence and not properly characterised as expert evidence but permission to re-apply.

Merck v MSD [2017] EWCA Civ 1834 Patten, Kitchin, Floyd LJ

Breach of contract (governed by German law), trade mark infringement, company names, use on the internet. Appeal partially successful and case remitted to the High Court.

The court applied the principles of German law on the construction of contracts as summarised by the trial judge. The German approach to construction of contracts is very different and is reminiscent of the German approach to the construction of patent claims pre the EPC. They take into account many more factors than the English courts do. The court upheld the judge on his interpretation of the agreement between the parties extending not just to trade mark use, but also to use as a trade or business name. The court also upheld the judge's decision that the 1970 agreement covered service marks although, at that date, there was no registration system for protecting service marks in Germany (and many other countries).

The court summarised the principles of trade mark infringement over the internet: (1) it must be targeted at UK consumers; (2) accessibility is not enough; (3) targeting is assessed objectively from the perspective of average consumers in the UK although evidence that the trader intended to target UK consumers can be relevant; (4) all relevant circumstances, even going beyond the website itself, must be considered.

Principles for partial revocation for non-use expressed more clearly than in the *Assos* case: (1) identify goods/services mark used for; (2) consider whether specification for the registration is sufficiently broad that independent subcategories can be identified; (3) not possible to use for all possible variations so care to be taken not to exclude goods/services not the same as those for which use proved but which are not in essence different and cannot be distinguished other than in an arbitrary way; (4) to be considered with the perception of the average consumer and having regard to the purpose and intended use to arrive at a fair specification having regard to the use made.

Honest concurrent use and own name defence both failed because it was a breach of contract, albeit not a conscious breach.

Judge failed to give reasons for the relief he granted.

W3 v easyGroup [2018] EWHC 7 (Ch) Arnold J

Trade Mark EASY is devoid of distinctive character and had not acquired distinctive character through use.

EasyRoommate and easyroommate do not infringe the various 'easy-' prefixed marks belonging to easyGroup.

No unjustifiable threats as the reasonable person with knowledge of all the relevant circumstances would not have seen as a threat of proceedings to trade mark infringement other than by the supply of services under the sign. Interesting alternative argument that no person aggrieved since the recipient was not affected by the threats extending beyond what was permissible.

Lifestyle Equities v Santa Monica Polo Club [2017] EWHC 3313 (Ch) Douglas Campbell QC

Various one and two horse signs held to infringe under s.10(2). Three horse sign held not to be sufficiently similar to establish a likelihood of confusion. Infringement by all signs under s.10(3) held. Judge held that the necessary reputation need not be in relation to the goods or services for which the trade mark is actually registered and that the reputation could be established by sales outside the territory as only reputation was necessary and not goodwill.

Lifestyle Equities v Santa Monica Polo Club [2017] EWHC 3578 (Ch) Douglas Campbell QC

Relief hearing after judgment on trade mark and passing off case. Considering form of injunction, Island Records Disclosure, Costs, Interim payment, Interim payment on account of financial remedy, publicity order, permission to appeal and stay of injunctions.

Soul Cycle v Matalan [2017] EWHC 496 (Ch) Mann J

Appeal from UKIPO. Decision on basis of more than one class of average consumers justified on authority.

Glaxo v Sandoz [2017] EWHC (Ch) Birss J

Admissibility of survey evidence in passing off action based on colour. Survey produced for purpose of UKIPO proceedings.

Zuma's Choice v Azumi [2017] EWCA Civ 2133 Patten, Floyd LJ

Deputy Judge not required to recuse himself when counsel from his chambers appeared before him

Azumi v Zuma's Choice [2017] EWHC 609 (IPEC)

Registration of ZUMA for restaurant services infringed under s.10(3) by the use of ZUMA and Dine in With ZUMA for dog food. Own name defence in respect of the dog ZUMA failed. Finding of unjustified threats but no damage caused thereby.

Abanka v Abanca [2017] EWHC 2428 (Ch) Daniel Alexander QC

Appeal from UKIPO where the Appellant's marks were revoked for non-use with the result that its opposition to registration of the Respondent's mark failed. Consideration of the proper approach to an appeal from the UKIPO and consideration of what is required to prove use. Appeal succeeded on a limited range of usage. Further hearing to determine what happens to the opposition.

Abanka v Abanca [2017] EWHC 3242 (Ch) Daniel Alexander QC

Further hearing where the Deputy Judge applied the test formulated by Kitchin LJ in Merck v MSD to determine the scope of the specification where use has been established in respect of a limited range of goods. The Opposition was remitted to the UKIPO to determine.

Apple v Swatch [2017] 713 (Ch) John Baldwin QC

Appeal from UKIPO where Swatch successfully opposed, in part, the registration of IWATCH in respect of certain goods in class 9. Hearing Officer erred in holding a high degree of similarity between watches in class 14 and computers, computer hardware and wireless communication devices in class 9.