

## Chapter 13: Infringement and loss of registration of trade marks

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### Likelihood of confusion and computer games

In *Kalypto Media Group GmbH v EUIPO*, Case T-700/18, ECLI:EU:T:2019:739, the ECJ (General Court) held that when assessing likelihood of confusion (Article 8(1)(b) EUTMR) relating to games and computer games the relevant public's attention is 'average at best'. This had the effect that DUNGEONS was found to be confusingly similar to DUNGEONS AND DRAGONS.

### Trade mark cancellation: the shape of the Rubik's cube

The trade mark consisting of the shape of the famous Rubik's Cube was cancelled in *Rubik's Brand Ltd v EUIPO*, T-601/17, ECLI:EU:T:2019:765. Following the judgment of the CJEU in the same proceedings (*Simba Toys GmbH & Co. KG v EUIPO*, C-30/15 P, ECLI:EU:C:2016:849), the General Court held that the rationale of the absolute ground for refusing the registration of shapes in Article 7(1)(e)(ii) EUTMR is twofold: to prevent trade mark law from the grant of monopolies on technical solutions or functional characteristics of a product and to supplement protection offered through other, expired intellectual property rights (e.g. patents). The General Court held that

'the fact that the rotating capability of the vertical and horizontal lattices of the "Rubik's Cube" resulted from a mechanism internal to the cube, that is, an element which was not visible in the graphic representation of the contested mark, did not prevent the Board of Appeal from being able to have regard to that rotating capability in its analysis of the functionality of the essential characteristics of that mark.'

The Court concluded that given that the characteristics of the contested mark (namely the overall cube shape, on the one hand, and the black lines and the little squares on each face of the cube, on the other, are necessary to obtain the intended technical result of the

actual goods concerned), the mark fell within the absolute ground referred to in Article 7(1)(e)(ii).

### **Invalidity and 3D marks**

In *Fromageries Bel SA v J Sainsbury Plc* [2019] EWHC 3454 (Ch), it was held that the 'Babybel cheese' 3D trade mark could not survive an application for a declaration of invalidity on the grounds of s.3(1)(a) or s.3(2) of the 1994 Act. It was held that the trade mark could be capable of distinguishing only if a particular hue of red used on the main body of the product was associated with the Babybel cheese, hence the trade mark had to be limited to a single hue of red.

### **Invalidity and bad faith applications**

The CJEU held in *Sky v SkyKick*, C-371/18, ECLI:EU:C:2020:45, that a trade mark cannot be declared wholly or partially invalid due to lack of clarity and precision of its specifications. Importantly, the Court held that a trade mark application made without any intention to use the trade mark constitutes bad faith, if the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark.

### **Invalidity and genuine use**

In *Aiwa Co. Ltd V Aiwa Corp* [2019] EWHC 3468 (Ch) the question was whether the sale of second-hand goods suffices as 'genuine use' to enable a registration and avoid revocation for non-use. The Court upheld the principles on 'genuine use' as developed by Arnold J (as he then was) in *London Taxi Corp v Frazer-Nash Research Ltd* [2016] EWHC 52 (Ch). Mr Justice Mann stressed that reaching a general conclusion as to whether all second-hand sales of branded goods amount to genuine use would not be possible and each case would depend on its own facts. In the present case, it was impossible to see how Arnold J's criteria were fulfilled on the facts of the advertisements and sales performed, hence there was no genuine use with the consent of the proprietor, and the appeal was dismissed.

In *adidas AG v EUIPO*, T-307/17, ECLI:EU:T:2019:427, the General Court was called to assess whether a three-stripe EU trade mark owned by adidas was invalid. The Court held that the trade mark at issue was an ordinary figurative mark and that the forms by which it was used should not be taken into account. In addition, the Court held that

‘in order to demonstrate that the mark at issue has acquired distinctive character, the applicant cannot rely on all of the evidence which shows a mark consisting of three parallel equidistant stripes. Indeed, ... the relevant evidence is only that which shows the mark at issue in its registered form or, failing that, in forms which are broadly equivalent, which excludes forms of use where the colour scheme is reversed or which fail to respect the other essential characteristics of the mark at issue.’

Because the evidence adidas produced included five market surveys completed in only five Member States it was not deemed sufficient to prove acquired distinctiveness throughout the EU.

### **Conceptual comparisons of names**

The General Court has clarified that conceptual comparisons between names are not usually possible. The case concerned an opposition against the sign LUCIANO SANDRONE on the basis of earlier word mark DON LUCIANO, both registered for 'Alcoholic beverages (except beer)'. As the Court noted, ordinary names such as those in question (i.e. names that do not convey a 'general and abstract idea') are devoid of semantic content and lack any 'concept' with the result that a conceptual comparison is not possible (*Luciano Sadrone v EUIPO*, T-268/18, ECLI:EU:T:2019:452).