



EU case law update

BMM Spring meeting

Laura Fresco

25 March 2021



TOPICS

- **Raising the bar?** Limitations CJEU appeals
- **Genuine use** Ferrari, Taiga, Husqvarna
- **Non-traditional marks** Östgötrafiken
- **Similarity and risk of confusion** Massi/Messi, Halloumi/BBQloui, Decathlon/Athlon
- **Bad faith** Target Ventures/Target Partners
- **Agency marks** John Mills
- **Designs** Tinnus, Dvectis

RAISING THE BAR?

Limitations CJEU appeals

- Since May 2019 only appeals to CJEU “significant to development of EU law” can be admitted
- So far, none of the applications for appeal were admitted (2 decisions of the CJEU in appeal cases which we will discuss today predate the stricted regime)
- Currently 21 applications for appeal pending
- More than 100 GC decisions in past 6 months: small selection today
- Slim pickings preliminary questions: 3 CJEU decisions in past 6 months on TM – nothing on designs
- But interesting preliminary questions pending, f.i. parallel import medicines and reboxing, acquiescence TM use and two design cases. Next time!



GENUINE USE

CJEU 22 October 2020, C-720/18 and C-721/18 (Ferrari/DU)

- How to maintain protection for (iconic) old trademarks
- Lack of genuine use 1987 German TESTAROSSA trademark for cars and car parts?



GENUINE USE

CJEU 22 October 2020, C-720/18 and C-721/18 (Ferrari/DU)

- Second-hand (car or spare part) sale by TM holder may constitute genuine use (even though rights have been exhausted); see also Ansul/Ajax, 2003
- Use of trademark for spare parts which are “integral” to the goods at issue (i.e. luxury sportscars) can also constitute genuine use for those goods



GENUINE USE

CJEU 16 July 2020, C-714/18 P (Tigha/Taiga):

- Discussion in Ferrari about subcategories: “luxury sportscars” are not a separate subcategory of “cars”.
- Similar findings in Tigha/Taiga: no artificial subdivision “clothing” in “jackets to protect against unfavorable weather conditions)
- Positive for trademark holder, no need to establish genuine use for each possible separate subcategory



GENUINE USE

CJEU 17 December 2020, C-607/19 (Husqvarna/Lidl)

- Relevance: clash EU and national law
- Husqvarna claims Lidl infringes its Sprinkler shape mark in Germany, Lidl requests revocation due to lack of genuine use
- Relevant date for calculating 5 yr non-use period?



GENUINE USE

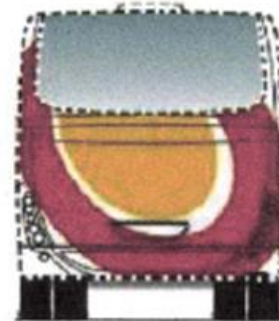
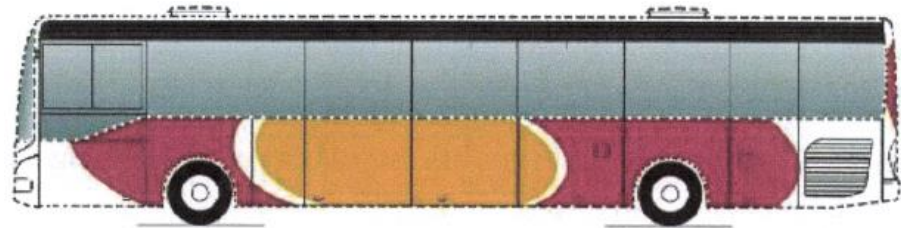
CJEU 17 December 2020, C-607/19 (Husqvarna/Lidl)

- German court applies German procedural law: not date of filing claim (Sep 2015) but date of last hearing (Oct 2017) → relevant because last genuine use in 2012...
- CJEU: indeed no express provision, but it follows from framework regulation 207/2009 that “the date with regard to which it must be determined whether the continuous period of five years has ended is the date on which the application or counterclaim in question was filed.”
- Quest CJEU to unify IP law, see also G-Star/Cofemel, criteria for copyright protection

NON-TRADITIONAL MARKS

CJEU 8 October 2020, C-456/19 (Pattern on a bus)

- Shape marks must depart significantly from the norm to be held distinctive (Henkel, 2004)
- What about 'position' marks?



NON-TRADITIONAL MARKS

CJEU 8 October 2020, C-456/19 (Pattern on a bus)

- Pattern intended to be used on a bus is not a shape (see also Louboutin, 2019)
- So “significant departure from the norm” requirement does not apply
- But: pattern is “not indissociable” from the shape (the bus) and thus its (inherent) distinctiveness cannot be assessed in abstracto, but in relation to the affixing to the shape (the bus)
- Potato, potato?

SIMILARITY AND RISK OF CONFUSION



11

CJEU 17 September 2020, C-449/18 P and C-474/18 P (Massi/Messi)

- Lionel Messi filed a TM application in 2011 for classes 9, 25 and 28; MASSI opposes (same classes)
- EUIPO: risk of confusion; GC: no risk of confusion, “well-known fact” that Messi is a very famous person, conceptual dissimilarity
- CJEU agrees:
 - ◆ Popularity Messi is relevant factor in assessment of risk of confusion
 - ◆ Affects perception relevant public
 - ◆ Conceptual dissimilarity counteracts visual and phonetical similarity



SIMILARITY AND RISK OF CONFUSION

12

CJEU 17 September 2020, C-449/18 P and C-474/18 P (Massi/Messi)

- Not very surprising in light of CJEU 12 January 2006 Picasso/Picaro:

“19 that global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (see, in particular, SABEL, paragraph 23).

20 By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

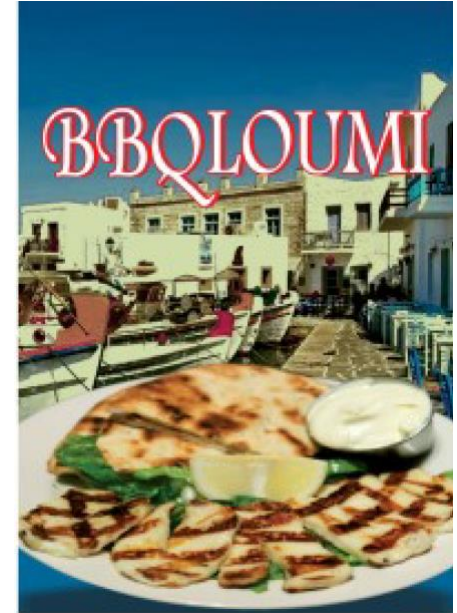
- But questions remain: personal fame gray area, especially without proof – remember Big Mac decision?

SIMILARITY AND RISK OF CONFUSION

13

General Court 20 January 20201, T-328/17 RENV (HALLOUMI/BBQLOUMI)

- EUTMa BBQLOUMI figurative mark 2014
- Cyprus Foundation for the Protection of Halloumi opposes based on HALLOUMI collective word mark
- EUIPO, BoA and General Court dismissed opposition due to longstanding use Halloumi as generic name, weak distinctiveness
- CJEU disagreed (5 March 2020, C-766/18 P) and sent case back to GCEU: wrong criteria for assessment risk of confusion collective mark



SIMILARITY AND RISK OF CONFUSION

General Court 20 January 2020¹, T-328/17 RENV (HALLOUMI/BBQLOUMI)

- Likelihood confusion with collective marks is risk that public might believe that goods originate from members of association (in this case the Cyprus Halloumi association)
- But... GC maintains its conclusion: inherent distinctiveness of Halloumi is weak, and given the low distinctiveness of the identical element “loumi” and the differences between the figurative BBQLLLOUMI mark and HALLOUMI, there is no risk of confusion, not even for cheese

SIMILARITY AND RISK OF CONFUSION



General Court 15 October 2020, T-349/19 (Decathlon/Athlon)

- Athlon files EUTMa for clothing in 2016:
- Decathlon opposes based on DECATHLON word mark for clothing
- GC: figurative elements not insignificant, impact on visual assessment
- Decathlon and Athlon are quite descriptive for part of public, weak inherent distinctive character
- GC: no evidence enhanced distinctiveness Decathlon for clothing (only for retail services)
- Visual differences counteract phonetic/conceptual similarity: no risk of confusion



BAD FAITH

General Court 20 October 2020, T 237/19 (Target Ventures/Target Partners)

- Target Partners registers EUTM TARGET VENTURES in 2015 for inter alia financial affairs
- Target Ventures, a venture capital fund from the BVI, applies for invalidity based on bad faith application
- GC confirms: applicable law is law in force on date of TM application (no retroactive effect, see also CJEU Textilis)
- References to CJEU Lindt, Koton and Skykick decisions: must be an aim of undermining interests third parties
- GC: BoA's approach that bad faith requires "conduct which departs from accepted principles of ethical behaviour" too restrictive; no proof of actual or presumed knowledge of prior use needed

BAD FAITH

17

General Court 20 October 2020, T 237/19 (Target Ventures/Target Partners)

- GC considers is established that Target Partner's intention was not to use it (see CJEU Skykick)
- Very factual, but interesting that court emphasizes that applying for a TM (Target Ventures) to prevent a likelihood of confusion with applicant's earlier trade mark (Target Partners) is not a legitimate aim
- GC: it is "extraneous to the functions of a trade mark, in particular the essential function of indicating origin"



TARGET PARTNERS

CAPITAL MEETS IDEAS.

AGENCY MARKS

CJEU 11 November 2020, C-809/18 P (John Mills)

- John Mills, former EU distributor for Jerome Alexander Magic Minerals, applies for EUTMa MINERAL MAGIC
- Jerome Alexander owns US TM “MAGIC MINERALS BY JEROME ALEXANDER” and invokes art. 8(3) EUTMR:



18



“Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.”

AGENCY MARKS

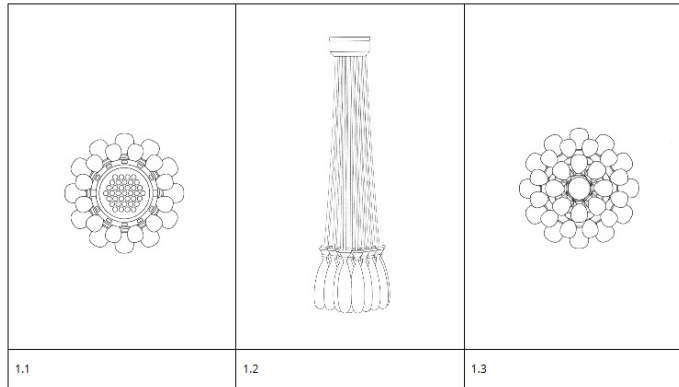
CJEU 11 November 2020, C-809/18 P (John Mills)

- GC: article 8(3) EUTMR only applies if TMs are identical
- CJEU: no, also applies in case of similarity
 - ◆ Unclear from the wording
 - ◆ Explicitly left open, but clearly inspired by Paris Treaty
 - ◆ Paris Treaty intends to also cover similarity; also in line with TRIPS Agreement
 - ◆ Objective is to prevent misuse
- CJEU agrees with GC that agency should be interpreted broadly

DESIGNS: TECHNICAL FUNCTION

General Court 18 November 2020, T-574/19 (Tinnus/Mystic Products and Koopman)

- Tinnus registered Community design in 2015 for “fluid distribution equipment”



- Mystic Products starts invalidity proceedings claiming that all features of design are solely dictated by their technical function (art. 8(1) CDR); Koopman joins with similar claims

DESIGNS: TECHNICAL FUNCTION

21

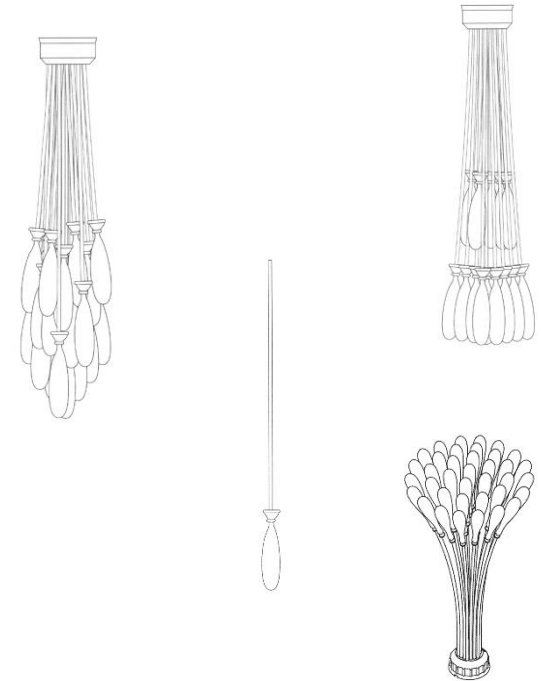
General Court 18 November 2020, T-574/19 (Tinnus/Mystic Products and Koopman)

- EUIPO, BoA: design is invalid
- GC agrees and applies Doceram (C-395/16) test:
 1. Determine the technical function of the product;
 2. Analyze the features of appearance of that product;
 3. Examine, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned, i.e. the sole factor that determined the choice by the designer of those features (so visual/aesthetic considerations played no role)
 4. Do remaining features meet novelty & individual character requirements?
- In this case:
 1. Fill number of inflatable balloons with water at the same time
 2. Housing, hollow tubes, inflatable balloons, fasteners
 3. All dictated by technical function to simultaneously fill & release the water balloons
 4. N/a

DESIGNS: TECHNICAL FUNCTION

General Court 18 November 2020, T-574/19 (Tinnus/Mystic Products and Koopman)

- Existence of alternative designs are not decisive, but a relevant objective circumstance;
- BoA did not err when including in the assessment that alternative designs were part of the multiple application;
- BoA were right to use the CDR holder's patent application, but did not solely rely on it
- Witness statement by designer ("*simple, clean and elegant*") of limited evidential value



DESIGNS: INDIVIDUAL CHARACTER

23

General Court 15 October 2020, T-818/19 (support pillow)

- In 2016 Dvectis filed shape mark application for support pillow
- Yado claims invalidity based on earlier support pillow



- GC agrees with BoA: no individual character, freedom of designer is not significantly limited, same overall impression on informed user



Laura Fresco

+31 20 592 4417

Laura.fresco@hoyngrokh.com

www.hoyngrokh.com

Questions?

THANK YOU!



HOYNG
ROKH
MONEGIER



www.hoyngrokhmonegier.com

AMSTERDAM

Rembrandt Tower, 30th floor
Amstelplein 1
1096 HA Amsterdam
The Netherlands
T +31 20 592 4411
E amsterdam@hoyngrokh.com

BRUSSELS

Avenue des Nerviens 9-31, 4th Floor
1040 Brussels
Belgium
T +32 2 740 00 00
E brussels@hoyngrokh.com

DÜSSELDORF

Steinstraße 20
40212 Düsseldorf
Germany
T +49 211 550 220
E duesseldorf@hoyngrokh.com

LYON

52, rue de la République
69002 Lyon
France
T +33 1 40 69 01 69
E lyon@hoyngrokh.com

MADRID

C/ Príncipe de Vergara, 36,
5.º dcha.
28001 Madrid
Spain
T +34 91 521 85 86
E madrid@hoyngrokh.com

MANNHEIM

O 7, 16
68161 Mannheim
Germany
T +49 211 550 220
E duesseldorf@hoyngrokh.com

MUNICH

Theatinerstraße 7
Entrance Maffeistraße
80333 Munich
Germany
T +49 89 904 11 710
E munich@hoyngrokh.com

PARIS

33, rue Vivienne
75002 Paris
France
T +33 1 40 69 01 69
E paris@hoyngrokh.com

