

# D YOUNG & CO TRADE MARK NEWSLETTER *no.82*

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One is a lonely country  
EU territorial borders not  
necessarily overlooked in  
assessment of genuine use



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In this edition, two obscurely linked objects (sofas and umbrellas) provide cautionary tales to brand owners who may not think or act sufficiently globally in terms of brand use and protection. We are reminded of the recent Jordan case where Michael Jordan's legal team failed to convince the Chinese court that 'Qiodan' (pronounced "chee-ow dahn") mis-used the famous basketball player's name: a good reminder of the importance of global registration, regardless of your reputation in any specific jurisdiction.

Thinking globally ourselves, you'll find us in Vienna, London and Chicago this September (see events below). If you would like to arrange a meeting do let us know.

## Editors:

Jackie Johnson &amp; Matthew Dick



## Events



15-18 September 2015

**MARQUES Conference, Vienna, Austria**

Matthew Dick and Anna Reid will be representing the D Young & Co trade mark and dispute resolution and legal teams at the MARQUES annual conference.

25 September 2015

**London Design Festival, UK**

Jonathan Jackson and guest speakers from top brand leaders will talk about how to protect and enforce designs. This free seminar at the V&A will be followed by an IP drop-in Q&A.

27-29 September 2015

**IPO Annual Meeting, Chicago, US**

Matthew Dick, Richard Willoughby, Garreth Duncan and Darren Lewis will be attending the Intellectual Property Owners Association's 43rd Annual Meeting.

[www.dyoung.com/events](http://www.dyoung.com/events)

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## Genuine use

# One is a lonely number

## EU territorial borders not necessarily overlooked in assessment of genuine use

**T**his recent Intellectual Property Enterprise Court (IPEC) decision found that genuine use was required in more than one European Union (EU) member state to maintain a Community trade mark (CTM) registration. This case involved an infringement action brought by The Sofa Workshop Limited (Sofa Workshop) against Sofaworks Limited (Sofaworks).

**Sofa Workshop v Sofaworks**

The two companies were in the business of selling sofas and household furniture.

Sofa Workshop claimed Sofaworks' use of SOFAWORKS infringed its CTM registration for SOFA WORKSHOP and amounted to passing off.

By way of a defence Sofaworks counter claimed that Sofa Workshop's CTM registrations were invalid as they were descriptive and lacked distinctiveness, or in the alternative, should be revoked on the ground of non-use.

Sofa Workshop's infringement case was unsuccessful. The judge ruled that both of Sofa Workshop's CTM registrations were invalidly registered as they consisted exclusively of signs which may serve in trade to designate a characteristic of some of the grounds for which those marks are registered. However, the judge noted that even if this had not been the case,

**the CTMs relied on had not been put to genuine use across the EU as the evidence of use filed was limited to the UK only.**

A thorough review of the relevant case law on genuine use claims was conducted in these proceedings, which gave the following guidance and reasoning to find that there had not been genuine use of the CTMs:

**What qualifies as actual use of a mark in a particular member state when it comes to marketing?**

- Use of a trade mark in online marketing would only be found where an offer for sale of goods or services bearing the mark is specifically targeted at consumers in that member state, as opposed to a website being merely accessible in that country.
- Genuine use of a trade mark in a published advertisement will qualify as use in a particular member state if, when viewed objectively, the advertisement can be seen to specifically target consumers in the member state in question, such as the provision of overseas phone numbers for consumers.

### Can use in only one EU member state suffice?

The judge relied heavily on the ONEL v OMEL case.

C-149/11 ONEL v OMEL case details can be viewed online at [www.dyoung.com/article-onelomel0313](http://www.dyoung.com/article-onelomel0313).

Key issues in ONEL v OMEL were:

- Territorial extent of use required to constitute 'genuine use' of a CTM in the Community - could use in just one country save a CTM?
- Leno owned a CTM for ONEL from 2002 but use was limited to the Netherlands. Leno opposed the Benelux application for OMEL. BOIP rejected the opposition claiming no genuine use.
- Questions put to the Court of Justice of the European Union (CJ) by a Dutch court as to whether genuine use of a Community trade mark in a single member state is sufficient to satisfy the requirement for genuine use in the Community or whether the territorial borders of the member states should be disregarded.

The judge referred to paragraphs 50 and 54 of the CJ decision in particular:

> **Case details at a glance**

**Jurisdiction:** Courts of England and Wales  
**Decision level:** The High Court of Justice  
Chancery Division Intellectual Property  
Enterprise Court (IPEC)  
**Parties:** The Sofa Workshop Ltd v  
Sofaworks Ltd  
**Citation:** [2015] EWHC 1773 (IPEC)  
**Date:** 29 June 2015  
**Full decision:** [dycip.com/sofactms](http://dycip.com/sofactms)

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**Sofa Workshop's evidence of genuine use was limited to the United Kingdom only**



**Paragraph 50**

"Whilst there is admittedly some justification for thinking that a CTM should...be used in a larger area than the territory of a single member state".

This was taken to imply that genuine use in one member state would not be sufficient to qualify as genuine use in the Community as a whole.

This was reinforced by the fact that this particular paragraph in the decision ended with an exception for businesses where the market for the particular goods or services is necessarily restricted to only one EU member state.

**Paragraph 54**

This part of the decision set out that whilst it is reasonable to expect that a CTM should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, as such a qualification would depend on the characteristics of the product or services in question.

This was found 'ambiguous' by the judge though he concluded that the implied notion

was that use beyond one member state is by default a necessary ingredient of genuine use in the Community as a whole.

In the judge's opinion, the logic of disregarding territorial borders (due to the size of markets for particular goods or services) may suggest that it would be necessary to have used the mark in more than two member states.

**As Sofa Workshop's use was limited to the UK, and the market for sofas and other furniture was obviously not restricted to the UK, the judge found there had not been use sufficient to constitute 'genuine use in the Community' of the CTMs relied on.**

**Comment**

This decision will raise concern amongst trade mark owners as it could indicate a shift, at least in the UK, to use being required more broadly in the EU to

maintain a CTM registration. However, applying territorial borders to assess the scope of use is not consistent with the notion of borderless trade in the EU, so we expect to see the decision appealed.

**Author:**

**Wendy Oliver**



**In short**

Marketing of a trade mark in the EU must be seen to specifically target consumers in the different countries.

Access to a website alone does not indicate goods or services have been 'offered for sale' to consumers in a particular country.

This case should also serve as a reminder to companies of the potential risk of losing their trade mark protection if relying solely on a CTM for a brand used in the UK only.



# US utility patent publication invalidates umbrella RCD

## Senz Technologies v OHIM - Impliva

➤ Case details at a glance  
**Jurisdiction:** European Union  
**Decision level:** General Court  
**Parties:** Senz Technologies BV v OHIM – Impliva BV  
**Citation:** Joined cases T-22/13 and T-23/13  
**Date:** 21 May 2015  
**Full decision:** [dycip.com/senzrcd](http://dycip.com/senzrcd)

**T**he recent General Court (GC) decision in *Senz Technologies BV v OHIM – Impliva BV* shows that arguably obscure, non-European prior art can be taken into account when assessing the validity of a registered Community design (RCD).

To be valid, an RCD must be novel and have individual character, relative to the prior art.

In the *Senz* case, concerning designs for asymmetric shaped umbrellas, the publication of just a single US utility patent, containing illustrations of a similar shaped umbrella, was enough to invalidate the RCDs for lack of individual character.

### Individual character

When assessing the individual character of a Community design, it must be compared with prior designs which have been “made available to the public”. Under the Community Designs Regulation:

“A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by **any design which has been made available to the public** ... [before the RCD filing/priority date].” [Emphasis added].

### What is meant by “made available to the public”?

The regulation contains the following, rather opaque, definition:

“...a design shall be deemed to have been made available to the public if it has been published..., exhibited, used in trade or otherwise disclosed [before the RCD filing/priority date], **except where these events could not reasonably have become known in the normal course of business to the circles specialised in**

### Impliva's US utility patent was enough to invalidate Senz's umbrella RCD



the sector concerned, operating within the Community.” [Emphasis added].

### Arguments before the GC

In attacking the validity of two RCDs, Impliva relied on a prior design disclosed by the publication of a US utility patent, which it said meant that the RCDs lacked novelty and “individual character”. The RCDs’ owner, Senz, argued that the US patent should not be taken into account, as it could not be known to circles specialised in the sector concerned, operating in the EU, since:

- designs are not the same as patented inventions;
- the average EU designer would not consult the US patent register;
- the patented umbrella had never been manufactured or marketed.

The GC dismissed Senz’s arguments, primarily due to lack of supporting evidence. In what some may consider a surprising decision, the court held that the mere presence of the US patent on the United States Patent and Trademark Office (USPTO) register was sufficient for the illustrations contained in it to be deemed relevant prior

art, even though there was no evidence that the patented product had ever reached the market. Accordingly, the GC held the RCDs invalid for lack of individual character (though the novelty attack failed).

One take-away from this case is that it is worth checking online patent registers (in the European Union and beyond) for prior art, when seeking to invalidate a Community design.

**Author:**  
Tamsin Holman



### In short

A single piece of prior art can deprive a Community design of individual character.

A published US utility patent can suffice for this purpose, even when the subject matter has never been marketed.

# PORTO v PORTOBELLO ROAD OHIM mixes gin and wine for surprise opposition decision

## > Case details at a glance

**Jurisdiction:** European Union

**Decision level:** OHIM Opposition Division

**Parties:** Instituto Dos Vinhos Do Douro e Do  
Porto v Gerard Feltham

**Citation:** Opposition No B 2 338 120

**Date:** 17 April 2015

**Full decision:** [dycip.com/portobellogin](http://dycip.com/portobellogin)

**T**rade mark decisions involving geographical indications (GIs) and protected designation of origins (PDOs) are relatively rare. In this case an application for a label design mark for PORTOBELLO ROAD No. 171 LONDON DRY GIN LONDON ENGLAND filed for gin was opposed, based on the PDO for PORTO, for wines from the well known region in Portugal.

To the surprise of many, including the writer, the opposition was upheld.

Whilst the Office for Harmonisation in the Internal Market (OHIM) were right to find that PORTO had been used and had extended to beyond mere local significance, it was somewhat vague when it came to comparing gin and wine merely holding that they are “comparable”.

### Protected designation of origins

In relation to the comparison of the mark and the PDO, the opposition division (OD) stated that the mark applied for contained the element PORTO and that, as this was common to both marks, they were conceptually similar. Nevertheless, they also noted that they differed with the elements:

- BELLO
- ROAD
- No. 171
- GIN
- LONDON
- ENGLAND.

The decision refers to the fact that some people might associate another meaning with the word PORTOBELLO, namely, flat cap mushrooms. Thus for these additional elements and the lion design the marks are conceptually dissimilar.

Only the briefest of mentions was made regarding the visual and phonetic comparison

but without any clear statement other than that both contain the element PORTO.

### Global assessment

The decision then turns to the global assessment and the fundamental question of whether the wine buying public seeking to purchase gin would be “misled”?

The OD generously suggested that these buyers will have an imperfect picture in their mind (possibly as a result of an alcohol-induced haze?) and then stated, without any reference or evidence, that marks for porto wine could be composed of two or three words.

The OD then extrapolated to reach a conclusion that there was a possibility that some of these relevant consumers will see the PORTOBELLO ROAD GIN mark as a sub-brand, for export reasons, for the PDO PORTO.

For good measure OHIM also held that BELLO was “rather weak for the goods at issue” and thus the consumer could be misled and the opposition succeeded.

We hope, and expect, the Board of Appeal, sipping on nothing stronger than some PDO-branded sparkling water, will keep their heads clear when considering the appeal that has been filed.

### Author:

Jeremy Pennant



### In short

This decision acts as a timely reminder to brand owners and practitioners alike that, in some parts of OHIM at least, the strength and scope of protection afforded to PDOs can extend a good deal further than one might expect.

OHIM's comparison between wine and gin was a somewhat blurred





# Die Wanderhure

## Wandering trade mark finds a home in the Community trade mark register

> Case details at a glance  
**Jurisdiction:** European Union  
**Decision level:** OHIM Board of Appeal  
**Parties:** Verlagsgruppe Droemer Knaur GmbH & Co KG, Iny Klocke and Elmar Wolrath v OHIM  
**Citation:** R 2889/2014-4  
**Date:** 28 May 2015  
**Full decision:** [dycip.com/wanderhure280515](http://dycip.com/wanderhure280515)

In the European Union (EU), the test under Article 7(1)(f) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark (CTMR) is whether the mark is “contrary to public policy or to accepted principles of morality”.

The concept of morality in Article 7(1)(f) CTMR is not concerned with bad taste or the protection of individuals’ feelings. In order to fall foul of the provision, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the basic moral norms of society.

There is no need to establish that the applicant **wants** to shock or insult the public concerned; the objective fact that the CTM applied for **might** be seen as such a shock or insult is sufficient.

### Rejection of the application for DIE WANDERHURE

In this case, the Office for Harmonisation in the Internal Market (OHIM) had to consider an application for the mark DIE WANDERHURE. In German the word ‘Hure’ is a term used to refer to a prostitute. OHIM rejected the application initially on the basis that the mark as a whole was considered to embody a vulgar and indecent expression and an offensive swearword.

### Evidence for die Wanderhure as a novel and film

The applicants appealed to the Board of Appeal, filing a substantial amount of evidence showing media coverage which reported on the success of a novel and film promoted under the title “Die Wanderhure”.

They argued that the mark was not contrary to public policy or to accepted principles of morality. Further they referred to the German Prostitution Law of 20 December 2001 and an Austrian court decision dating from 2012, according to which the term “prostitute”, including the activity related thereto, is no

longer considered immoral in the legal sense.

The Board of Appeal held that the examiner had confined itself to the assessment of the second word element, in particular HURE, without commenting on its first two components, namely the definite article DIE, equivalent to the English word ‘the’, and the term WANDER, describing the act of changing a location on foot (as in English, also to ‘wander’).

The Board of Appeal held that the success of the book and the film showed that the public took offense to neither the content of the book nor to its title; rather the sign described a social phenomenon that no longer exists.

The Board of Appeal found that the OHIM decision had confused the descriptive word of a phenomenon with the phenomenon itself.

If the OHIM examiner was correct, any thriller containing the word ‘murder’ in its title had to be banned because killings are a crime, and it was noted that there is nothing more immoral than those who commit it.

Accordingly, the Board of Appeal overturned the OHIM decision, allowing the registration of the mark.

### OHIM’s refusal of other offensive marks

OHIM has previously refused an application for CURVE which means ‘whores’ in Romanian and was therefore considered by OHIM to be offensive. It has also refused applications for marks such as BIN LADIN and SCREW YOU on the same basis.

Earlier in 2015, the intellectual property issues surrounding the registration of JE SUIS CHARLIE were considered to be of overriding public interest by OHIM such that it held that the mark would not be registrable.

Article 7(1)(f) CTMR concerns what is contrary to accepted principles of morality



# GC refuses to play ball Swatch unsuccessful in opposition to SWATCHBALL CTM application

➤ **Case details at a glance**  
**Jurisdiction:** European Union  
**Decision level:** General Court  
**Parties:** Swatch AG v OHIM, Panavision Europe Ltd  
**Citation:** T-71/14  
**Date:** 19 May 2015  
**Full decision:** [dycip.com/swatchball](http://dycip.com/swatchball)

**You-Q BV v OHIM case details:**  
[dycip.com/t36910dec](http://dycip.com/t36910dec)

**T**he General Court (GC) has rejected an opposition by Swatch AG to an application for the mark SWATCHBALL on the basis of its reputation in the mark SWATCH because there was no evidence that the relevant consumers would make a link between the marks SWATCH and SWATCHBALL.

## The SWATCHBALL application

The applicant, Panavision Europe Limited, applied for a Community trade mark (CTM) for the mark SWATCHBALL in classes 9, 35, 41 and 42. The goods and services covered by the application included: “electronic publications and computer software relating to the creation and selection of lighting, optical and other visual effects in cinematographic television, video and other visual performance arts; electronic publications for selection of lens hoods, bellows” along with retail and consultancy services relating to the same. The application restricted the goods and services to those which did not include timekeeping.

## The decisions of the Opposition Division and the Board of Appeal

Swatch opposed the application on the basis of various earlier trade marks for the word SWATCH which covered, among other things, watches in class 14.

The Opposition Division rejected the opposition in its entirety and the Board of Appeal dismissed the appeal.

In relation to the grounds of opposition under Article 8(5) CTMR, the Board of Appeal acknowledged that Swatch had established a reputation in the mark SWATCH in France, Germany and Spain in relation to goods in class 14, however, the Board of Appeal considered that the goods and services covered by the application were so different that SWATCHBALL was unlikely to bring to mind the mark SWATCH in the mind of the relevant public. The Board of Appeal also considered that Swatch had failed to prove that the application would cause dilution to, or take unfair advantage of, its earlier trade marks.

## The decision of the GC

The GC reiterated that the fact that two marks

The SWATCHBALL is a three dimensional way of viewing a range of light filters



are similar does not necessarily mean that the relevant public will make a link between them. Furthermore, the GC also pointed out that even if a link is present this does not mean that there will necessarily be injury to the earlier mark.

The GC accepted that the earlier SWATCH marks did enjoy a reputation, however, the GC weighed up all the factors relevant to the question of whether the public was likely to establish a link between the marks SWATCH and SWATCHBALL and concluded that the public was not likely to make such a link.

On the one hand, the GC considered the factors weighing in favour of finding a link between the marks as follows:

- the similarity of the marks at issue; and
- the strength of the reputation of the earlier mark which was considered to be high.

On the other hand, however, various factors weighed against the finding of a link in this instance, including:

- the different nature of the goods and service concerned, including the different distribution channels, the fact that the goods and services are not interchangeable nor in competition with each other and the fact that the goods and services serve very different purposes. This all resulted in a very limited degree of closeness between the goods and services; and
- the existence of two relevant publics.

## In summary

The GC agreed with the Board of Appeal that while it was possible that the specialist public for the goods and services covered by the application may also be aware of the earlier SWATCH marks, this public will not establish a link between the relevant marks because it is very unlikely that the public will encounter goods covered by the relevant marks in the same shops.

## Author:

Anna Reid



## In short

This case highlights the need for consumers to make a link between the marks at issue in cases where the opponent is relying on a mark with a reputation under Article 8(5) CTMR.

This case can be contrasted with earlier cases such as *You-Q BV v OHIM* where Apple Corps was successful in opposing an opposition for the mark BEATLE for mobility scooters and related goods on the basis of its reputation in the mark BEATLES.



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## D Young & Co event

### London Design Festival Are you protecting your designs?

First staged in 2003, the London Design Festival is one of the world's most important annual design events. The festival programme is made up of over 350 events and exhibitions staged by hundreds of partner organisations across the design spectrum and from around the world.

"During the 9-day period visitors will be able to see a series of exciting and beautiful installations interacting with our world-renowned collections and historic spaces; take part in innovative design workshops; and hear from the best international designers working today to motivate, provoke and discover new creative ideas." Dr. Martin Roth, Director of the V&A.

D Young & Co is pleased to be a festival partner and will present a free design seminar to take place at the V&A.

Our talk will take place at the V&A, and will be followed by an opportunity to speak with

patent, trade mark, design and copyright advisors, who will be on hand to answer IP questions. The V&A will be open until 10pm as an extended Friday opening during the festival.

#### IP design seminar and IP Q&A V&A seminar room 1, Friday 25 September

D Young & Co's IP law experts will be presenting this design focused seminar, perfect for those involved in all aspects of design and its commercialisation. Partner Jonathan Jackson, European Patent Attorney and European Design Attorney, will provide delegates with the IP information needed to protect and enforce designs (and for agencies, those of their clients).

The seminar will be of interest to companies and individuals involved in the creative design industry, particularly product and packaging design, design engineering, brand and corporate identity, 2D and 3D design, graphic and digital design and creative marketing solutions.

For further information please see [www.dyoung.com/event-ldwdesigns](http://www.dyoung.com/event-ldwdesigns).

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