

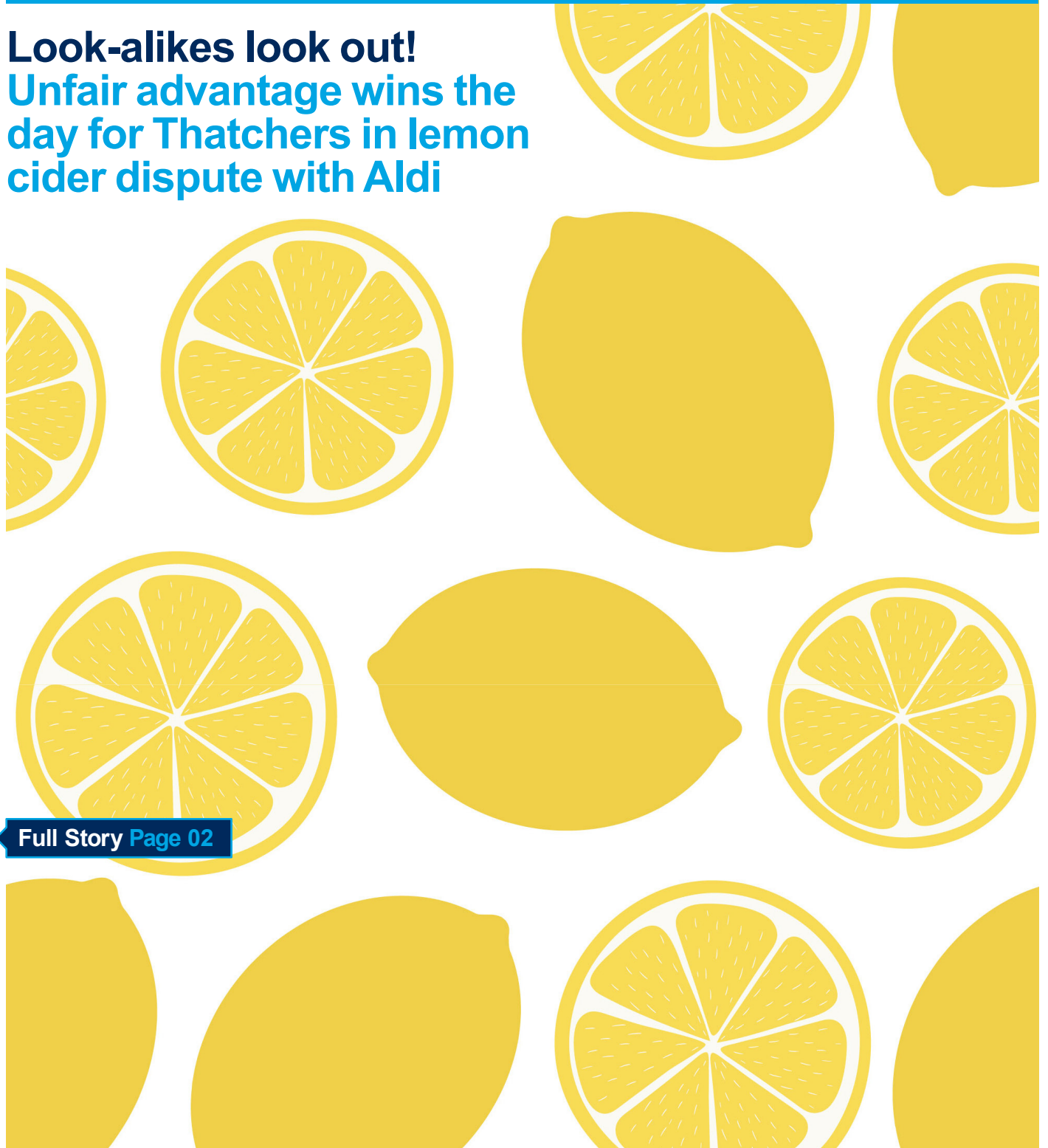
# D YOUNG & CO TRADE MARK NEWSLETTER *no.139*

March 2025

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## Look-alikes look out! Unfair advantage wins the day for Thatchers in lemon cider dispute with Aldi



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This edition brings a number of interesting cases in the world of trade marks. Towards the end of 2024, the UK High Court delivered its first substantial ruling relating to the registrability and infringement of position marks. Meanwhile, the EU General Court has issued its first decision on distinctiveness for virtual goods, offering fresh insights into trade mark protection in the digital space. As trade mark law continues to evolve, both in the real and digital world, these cases set fascinating new precedents.

We also cover more guidance from the General Court on the assessment of visual similarity between logo-only marks, as well as a reminder that the threshold for acquiescence remains high. Finally, in the UK the UKIPO sheds light on historical settlement agreements in *TfL v GAP*, and the Court of Appeal hands Thatchers a win over Aldi in a dispute concerning look-alikes (a refreshing result for brand owners). With so many key developments we hope you enjoy reading our full analysis!

Matthew Dick, Partner Solicitor

Events



**MARQUES Spring Meeting**

Barcelona, Spain, 13-14 March 2025

Jana Bogatz and Gabriele Engels will be attending the 22nd MARQUES Spring Meeting.

**PTMG Spring Conference**

Edinburgh, UK, 24-25 March 2025

Tamsin Holman will be attending the Pharmaceutical Trade Marks Group Spring Conference, which incorporates the Annual General Meeting

**INTA Annual Meeting**

San Diego, USA, 17-21 May 2025

Jana Bogatz, Richard Burton, Matthew Dick, Gemma Kirkland, Anna Reid and Yvonne Stone will join brand professionals from around the world at INTA2025. They look forward to catching up with clients and colleagues during the meeting.

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Look-alike branding

# Look-alikes look out! Unfair advantage wins the day for Thatchers in lemon cider dispute with Aldi

A family company has won its trade mark battle with a discount supermarket concerning look-alike branding.

**Apples to lemons to look-alike**

Thatchers is a well-known British cider maker. It has been making cider of over 100 years, but for the last few years it has been fighting a look-alike branding battle with the discount supermarket, Aldi.

It all started with Thatchers' first foray into fruit-flavoured cider. Seeing an emerging trend for lemon-flavoured alcoholic drinks, it launched its Thatchers Cloudy Lemon Cider in February 2020. £3 million pounds of marketing spend, a registered trade mark for the graphics used on the Thatchers Cloudy Lemon Cider product and its packaging and £20 million in sales later, the move from apples to lemons looked justified.

Big bets on big trends don't go unnoticed in the market. Discount supermarkets, in particular, have enjoyed plenty of success imitating these successful trends with look-alike products. It was Aldi that jumped on the cloudy lemon cider cart and launched its Taurus Cloudy Lemon Cider, the Aldi Cider, in May 2022.

**IPEC leaves a sour taste**

Thatchers sued Aldi in September 2022 in the Intellectual Property and Enterprise Court (IPEC), a specialist UK court for

intellectual property disputes of a certain scale. Thatchers made claims against Aldi for trade mark infringement and passing off. This was, essentially, on the basis that the Aldi Cider copied the graphics for Thatchers Cloudy Lemon and its UK trade mark.

Thatchers lost. No likelihood of confusion, no unfair advantage, no deception or damage. A surprising, but not wholly unexpected, outcome given the difficulties brands have experienced with tackling look-alike products in the UK.

**If life gives you lemons, go to the Court of Appeal**

Thatchers appealed the IPEC decision to the Court of Appeal. The appeal focused on overturning the decision on unfair advantage (under s.10(3) of the Trade Marks Act 1994). It did not appeal the decision on likelihood of confusion (under 10(2) of the Trade Marks Act 1994) or passing off.

The Court of Appeal would not, ordinarily, challenge findings of fact made by the IPEC judge. This would rule out, for example, a reassessment of factual matters, such as whether there is similarity between the Thatchers Cloudy Lemon UKTM and the Aldi Cider. However, the Court of Appeal found that certain conclusions by the IPEC judge were "rationally insupportable" and wrong in law or principle, and so it looked again at the fundamental trade mark infringement analysis.



Thatchers Cloudy Cider UK trade mark (left) and Aldi Cider (right).  
Source: [2025] EWCA Civ 5, [dycip.com/thatchers-aldi-cider-appeal](https://dycip.com/thatchers-aldi-cider-appeal)

## Case details at a glance

Jurisdiction: England & Wales

Decision level: Court of Appeal

Parties: Thatchers Cider Company

Limited (claimant/appellant) and Aldi Stores Limited (defendant/respondent)

Citation: [2025] EWCA Civ 5

Date: 20 January 2025

Decision: [dycip.com/thatchers-aldi-cider-appeal](https://dycip.com/thatchers-aldi-cider-appeal)

## Comparing apples with apples

The Court of Appeal found that the IPEC judge had made the wrong comparison between the Thatchers Cloudy Lemon and the Aldi Cider.

At the IPEC, the judge compared the Thatchers Cloudy Lemon UK trade mark (a **2-dimensional** image) with a single can of the Aldi Cider (a **3-dimensional** product). It also failed to consider the use of the Thatchers Cloudy Lemon UKTM in real life, and so failed to make a comparison between the 2D packaging of the Thatchers Cloudy Lemon and the Aldi Cider. This led it to the conclusion of low similarity between the Thatchers Cloudy Lemon and the Aldi Cider. The Court of Appeal had a different view. The correct comparison was between the Thatchers Cloudy Lemon UK trade mark (as registered and as used in real life) and **the graphics on the cans and packaging** of the Aldi Cider.

Considering the similarity test from this perspective, the Court of Appeal found the level of similarity to be “somewhat greater” than the judge found in IPEC.

## It’s so unfair!

A finding of similarity gave Thatchers a route to re-argue unfair advantage. This argument had two main elements: that Aldi **intended** to take unfair advantage and that it did, in effect, take unfair advantage of the Thatchers Cloudy Lemon. As the Court of Appeal neatly summarised, Aldi was not competing on price, quality and promotional effort, but rather brazenly copying the features of the Thatchers Cloudy Lemon and communicating to consumers that the Aldi Cider was “like the Thatchers’ Product, only cheaper”. And so, the Aldi Cider did take unfair advantage of the distinctive character of the Thatchers Cloudy Lemon.

## Intention

Aldi had actively intended for the design of Aldi Cider to remind consumers of the Thatchers Cloudy Lemon. Aldi already had a range of apple and other fruit ciders under its Taurus house-brand when it launched the Aldi Cider. The Taurus brand had a simple, dark, no-frills design pallet. However (see image above), Aldi departed from its house



Source: [2025] EWCA Civ 5, [dycip.com/thatchers-aldi-cider-appeal](https://dycip.com/thatchers-aldi-cider-appeal)

style for the Aldi Cider in the following ways:

- It used images of fruit and foliage.
- It used a light colour palette.
- The TAURUS brand name used black lettering against a light-coloured background.

It was also found in evidence that Aldi Cider was not just inspired by the Thatchers Cloudy Lemon, the Thatchers Cloudy Lemon was seemingly the only inspiration. During the design process for the Aldi Cider the only product featured in a “Market Review” document produced by Aldi’s design agency was the Thatchers Cloudy Lemon, and Aldi asked its design agency to produce “a hybrid of Taurus and Thatcher’s [sic] – i.e. a bit more playful – add lemons as Thatcher’s etc”.

## Effect

Aldi had not just intended to take advantage of the Thatchers Cloudy Lemon, but it had succeeded in doing so. Despite spending a grand total of zero pounds on marketing the Aldi Cider, it had made almost £1 million in sales revenue.

Consumers had also commented extensively on the same-but-cheaper message with social media comments revealed in evidence including “a Thatchers Lemon cider rip-off”, “my kids would call this a knock-off brand”, “very good Thatchers cider rip-off”, and “not quite Thatchers Lemon but for half the price there’s not much to complain about”. The only plausible explanation for this outcome was that consumers saw and understood the message loud and clear, that the Aldi

Cider was “like the Thatchers’ Product, only cheaper”. It had achieved the transfer of image of the distinctive character of the Thatchers Cloudy Lemon to the Aldi Cider.

## Let’s be honest, it really was unfair

Despite the finding of unfair advantage, Aldi attempted to argue that it had defences to trade mark infringement. Both of these failed.

Most damaging for Aldi is that the Court of Appeal found that Aldi’s conduct did not fall within the realms of honest business practices. The intent and success in taking unfair advantage was manifestly not honest. Aldi also tried to argue that it had only copied elements of the Thatchers Cloudy Lemon that were descriptive or not tied to branding (for example, using images of lemons and the descriptive wording “cloudy lemon cider”). That analysis did not give the full picture and Aldi could not simply ignore the overall similarities with the Thatchers Cloudy Lemon.

## A final round?

Aldi intends to appeal this decision to the Supreme Court, although it is not yet clear on what grounds.

For brands, a useful lesson here is to obtain trade mark protection for the graphics used on their products and their packaging. Thatchers eventually succeeded because it owned a registered trade mark for the graphics used for the Thatchers Cloudy Lemon but it could have made its life easier if it had a wider portfolio of packaging marks to rely on against Aldi.

Author:

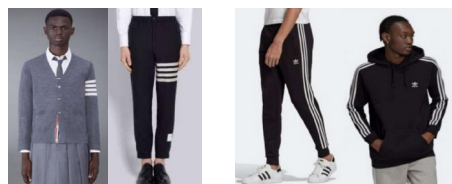
Phil Leonard



# Stripe strife

## First High Court exploration of position mark infringement and registrability

In November 2024 luxury fashion brand Thom Browne sought to invalidate 16 trade marks registered by adidas, all of which were position marks featuring variations of the iconic three-stripe design. Thom Browne argued these marks lacked clarity and precision, violating Section 1(1) of the Trade Marks Act 1994. Adidas counterclaimed for infringement and passing off in relation to Thom Browne's use of a four-stripe design.



Thom Browne's four-stripe design (left) and adidas's three-stripe design (right). Source [2024] EWHC 2990 (Ch): [dycip.com/2024-ewhc-2990-ch](https://dycip.com/2024-ewhc-2990-ch)

### Invalidity

The key issue on validity was whether adidas's trade marks were registered in a way that made them sufficiently identifiable. Given no authority was found regarding position marks, Justice Joanna Smith relied on *Nestlé v Cadbury*, a case involving colour marks. This ruling established that vague terms such as "predominantly" in trade mark descriptions allow for multiple interpretations, implying various signs that are neither represented nor described, resulting in registrations lacking clarity and precision. Consequently, Justice Smith concluded that graphical and verbal descriptions of position marks must together enable the mark to correspond to one single, objectively ascertainable sign.

The portfolio of marks that Thom Browne sought to invalidate covered garments and accessories including tracksuits, jackets, shoes and bags (see image above right). Among these was a mark registered for tracksuit tops, shorts, trousers, T-shirts and anoraks, with a description describing the stripes extending "substantially" along the entire outer surface of the sleeves, legs, or trunks. However, the attached illustration depicted a long-sleeved tracksuit top, leaving ambiguity regarding its application to the other garments. Additionally, the term "substantially" left room

Tracksuit Top Mark '588	Tracksuit Bottom Mark '661	Vest Mark '612	Shoe Mark '646
Slide Mark '951	Slide Mark '327	Cap Mark '072	Bag Mark '889

Source [2024] EWHC 2990 (Ch): [dycip.com/2024-ewhc-2990-ch](https://dycip.com/2024-ewhc-2990-ch)

for interpretation: did it mean 90% of the length or just 51%? This lack of clarity in the description and graphical elements rendered the mark incapable of registration.

Two more marks were registered for upper garments like polo shirts and tracksuit tops, their descriptions specifying that the three stripes extended along "one-third or more" of the sleeve. Yet the attached illustration only showed a tracksuit top with full-length stripes. Without a precise definition of "one-third or more" (considering variations in length, starting point, and finishing point) the marks lacked clarity and were deemed unregistrable. A similar vagueness or inconsistency in the descriptions and illustrations of two tracksuit bottom marks and the bag mark also prevented them from forming a single, objective, registrable sign.

However, certain registrations (including those on shoes, caps and one tracksuit bottom mark) were unobjectionable. The latter described three stripes running down the leg with two horizontal stripes going around the back of the knee, and was also registered only for trousers and tracksuit bottoms. Consequently, given these elements were all represented in the illustration, there was no scope for different interpretations, so the registration requirements were met. This was also the case with the shoe and cap marks.

### Infringement

Adidas's infringement claim largely failed because Justice Smith determined that the average consumer would be able to distinguish between three and four stripes, as well as differences in width and spacing. Since Thom Browne's design generally featured four stripes with greater spacing and a thicker appearance, there was no likelihood of confusion or

### Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Thom Browne Inc v Adidas AG

Date: 22 November 2024

Citation: [2024] EWHC 2990 (Ch)

Decision (PDF): [dycip.com/2024-ewhc-2990-ch](https://dycip.com/2024-ewhc-2990-ch)

### Related article

*It is all in the angles: Umbro wins its double diamond logo trade mark infringement appeal, (Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Ors, Court of Appeal, [2023] EWHC 706 (Ch)) 20 March 2024:* [dycip.com/umbro-diamond-logo-appeal](https://dycip.com/umbro-diamond-logo-appeal)

association with adidas's marks. Consequently, Thom Browne's designs did not violate Sections 10(2) or 10(3) of the Trade Marks Act 1994.

Adidas argued that consumer attention is lower in a post-sale context, where garments are often seen in motion, causing a "bunching" effect that obscures differences between the stripe designs. However, Justice Smith rejected this argument, emphasising that the hypothetical average consumer must be considered in the context of making a purchase, where they have a clear view of the sign. Thus, the level of attention is not diminished post-sale.

Adidas also failed in its passing off claim, given there was no substantial evidence of consumer confusion, let alone deception.

### Zooming out

This case marks the first substantive ruling on the registrability and infringement of position marks in the UK. Although adidas failed on all its infringement and passing off claims, even in relation to those registrations deemed to be valid, the case should not be interpreted to mean that position marks do not have value. Indeed, the judgment confirms that a mark characterised by the goods on which it is positioned might be deemed similar to a sign which is not located on any particular goods, or is located on different goods (although the position element of the mark is clearly a very important factor in that analysis). Care needs to be taken, as ever, when filing position marks, to ensure that verbal descriptions and graphic depictions are consistent and provide a clear and precise indication of the scope of protection claimed.

This case also confirms the increasing difficulty of proving a likelihood of confusion in a world where consumer commentary on social media should make any such confusion easily identifiable; and also the challenge of finding an actionable "link" for the purposes of reputation-based infringement. The court's assessment of post-sale confusion is likely to be informed further by the Supreme Court, which is due to hear the appeal in *Iconix Luxembourg Holdings v Dream Pairs Europe* in March 2025.

Author:  
Matthew Dick



# Public perceives virtual watches the same way as real watches

## First General Court ruling on distinctiveness for virtual goods

🔗 Case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: Glashütter Uhrenbetrieb GmbH v EUIPO

Date: 11 December 2024

Citation: T-1163/23

Link to decision: [dycip.com/t-116323](https://dycip.com/t-116323)

For the first time, the General Court has ruled on the distinctiveness of a trade mark for virtual goods. It confirmed that the figurative sign shown below, applied for various goods, including virtual watches, lacks inherent distinctiveness:



The image shows the 'Glashütte ORIGINAL' trade mark logo. The word 'Glashütte' is written in a large, elegant, cursive script, and 'ORIGINAL' is written in a smaller, bold, sans-serif font below it.

Glashütte ORIGINAL EU trade mark 018727034, source EUIPO eSearch: [dycip.com/tm-018727034](https://dycip.com/tm-018727034)

### Background

The sign was applied for *inter alia* downloadable virtual goods, namely watches, clocks, and their accessories, for use online or in online virtual worlds in class 9, as well as retail services and provision of these virtual goods in classes 35 and 41.

The European Union Intellectual Property Office (EUIPO) rejected the trade mark application for the virtual goods and services, ruling that the mark lacked distinctiveness.

This was upheld by the Board of Appeal, concluding that “Glashütte” would evoke the well-known reputation of the German town Glashütte (near Dresden) associated with luxury watchmaking, even in virtual settings. The applicant then appealed to the General Court.

### General Court’s decision

The General Court dismissed the appeal and upheld the Board of Appeal’s decision, confirming the mark’s lack of distinctive character based on the following key points:

#### 1) Recognition of Glashütte’s reputation

The General Court confirmed that a non-negligible part of the German public, especially those interested in watches, knows Glashütte (a town in Saxony near Dresden) renowned for its high-quality watchmaking.

#### 2) Public perception of virtual goods and services

The key question in the case was whether Glashütte’s reputation in traditional watchmaking could be extended to virtual goods and services. The court found this to be true if:

- the virtual goods merely represent real goods; or
- the virtual goods and services represent or emulate the functions of real goods and services.

The possibility of such a transfer must, however, be assessed on a case-by-case basis, considering the specific nature of the virtual products and services in question.

The General Court found that the virtual watches and accessories in this case were clearly related to their real-world equivalents. As a result, consumers would associate the mark with Glashütte’s established reputation rather than perceive it as a distinctive identifier. Therefore, the sign would merely be perceived as promotional information about the quality and authenticity of these goods and services, conveyed by the reference to Glashütte and its reputation in physical watchmaking products.

#### Implications of the judgment

This judgment marks an important decision, as the General Court confirms that many virtual goods might be, in principle, perceived in the same way as their real-world counterparts. This can be seen as a general rule, at least when assessing absolute

grounds for refusal. While each case will have to be assessed individually, this principle is likely to apply broadly to virtual goods.

However, this judgment leaves questions open that continue to be discussed: If consumers associate virtual goods with their real-world equivalents for distinctiveness assessments, should the same logic apply when assessing similarity? Could this lead to an assumption that virtual and physical goods come from the same company?

The answer to these questions and the impact of this decision on the assessment of similarity between virtual and real goods remains uncertain. In a recent EUIPO decision, virtual cosmetics and soaps were deemed dissimilar from their physical counterparts. The EUIPO reasoned that, despite virtual goods mimicking real-world items this would not be sufficient to establish similarity, as there is no established market practice for linking them to their physical equivalents (see our article “Virtual v real: EUIPO draws the line” of 06 November 2024: [dycip.com/virtual-real-vinivio-artessence](https://dycip.com/virtual-real-vinivio-artessence)).

This approach could be influenced by the General Court’s ruling. Although the criteria for assessing similarity of goods and services (such as nature, purpose and method of use) are different from those for assessing distinctiveness, the General Court’s reasoning suggests a closer link between the two, when the recognition of real goods/services can be transferred to virtual goods/services.

Author:

Julian Graf Wrangel



Glashütter Uhrenbetrieb’s mark applied for various goods, including virtual watches



# Mind the...gap? Transport for London v GAP

Case details at a glance  
Jurisdiction: England & Wales  
Decision level: UKIPO  
Parties: Transport for London and GAP  
Citation: O/1219/24  
Date: 24 December 2024  
Decision (PDF): [dycip.com/ukipo-tfl-gap-o121924](https://dycip.com/ukipo-tfl-gap-o121924)

Whilst many will be aware of the “MIND THE GAP” warning that has echoed around the London Underground for the past 50 years, you may not know about MIND THE GAP branded merchandise as sold by TfL.

The UKIPO recently issued a decision in a fraught opposition between Transport for London (TfL) and GAP (ITM) Inc (GAP). In September 2021, TfL filed a UK trade mark application seeking protection of the phrase “MIND THE GAP” covering a variety of goods in classes 9 and 18 including: eyewear, helmets, bags, umbrellas, wallets, and cardholders, provoking opposition by GAP.

GAP opposed the application on the basis of its prior “GAP” rights in classes 9, 18 and 25 asserting that the application contravened Sections 5(2)(b) (likelihood of confusion), 5(3) (unfair advantage/ detriment to reputation) and 5(4)(a) (passing off) of the Act. GAP further alleged section 3(6) (bad faith) and 5(4)(b) (other earlier rights) relying on a settlement agreement executed between the parties in 2004, which it alleged the application breached.

## Confusion

The hearing officer rejected GAP’s confusion claim, holding that the respective marks were visually and phonetically similar to a low-medium degree, with limited conceptual similarity. “MIND THE GAP” would be understood as a warning which would not be conveyed by the word GAP alone. GAP’s assertions that the dominant and distinctive part of the marks was the term GAP also failed, as the hearing officer considered that it was very unlikely that average consumers would dissect “MIND THE GAP” into “MIND THE” and “GAP”, and disregard or downgrade the distinctive significance of “MIND THE” element in the composite term. Additionally, the strong association of the phrase “MIND THE GAP” with the London Underground, combined with the dissimilarity or low similarity of the goods, would not result in direct nor indirect confusion. Section 5(2) was dismissed.

## Unfair advantage and reputation

GAP argued that use of the phrase “MIND

## GAP opposed TfL’s application for “MIND THE GAP” in classes 9 and 18



THE GAP” by TfL would exploit the reputation of GAP’s brand, which is well-known for clothing and accessories in the UK. The hearing officer found no evidence that consumers would make a link between the two marks, particularly given the distinctive meaning of “MIND THE GAP” as a public safety warning and its long-standing use by TfL. Section 5(3) was also dismissed.

## Passing off

GAP claimed goodwill in the “GAP” brand and alleged that TfL’s use of “MIND THE GAP” would mislead the public. The hearing officer rejected this claim and, referring to TfL’s historic use, found that misrepresentation nor confusion would likely arise on part of the average consumer. The section 5(4)(a) ground was rejected.

## Bad faith

GAP argued that TfL’s application breached a 2004 settlement agreement between the parties, precluding TfL from registering “MIND THE GAP” for “clothing accessories”. The hearing officer held that the agreement was binding and TfL had acted in bad faith by filing an application covering goods explicitly forbidden by the agreement (for example, wallets, purses and cardholders).

## Other earlier rights

GAP attempted to rely on the 2004 settlement agreement as “earlier rights”; however, the hearing officer held that private contractual agreements relating to trade marks do not constitute “earlier rights” under this provision, which applies to rights such as copyright or industrial property. GAP’s opposition under section 5(4)(b) failed.

## Outcome

GAP was partially successful. The hearing officer found that TfL had acted in bad faith

by applying to register “MIND THE GAP” for goods falling within the scope of the settlement agreement, resulting in the refusal of those goods. However, TfL was also partially successful in defending the application, since the opposition failed on all other grounds and the mark was allowed to progress in relation to the remaining class 9 and 18 goods listed. Off the scale costs have been requested by both parties and a supplementary decision addressing this will be issued in due course.

## In short

This decision highlights the intricacies of IP disputes where historical agreements are in place. In its arguments, TfL claimed that due to Brexit the 2004 settlement agreement no longer applied to the UK and thus it could not be found to have acted in bad faith. The hearing officer held that such an inference based on ambiguous wording was against the spirit of the agreement, thus TfL was still bound and had acted in bad faith. Since the only ground GAP succeeded on was bad faith, this decision clearly emphasises the importance of respecting existing agreements.

It also shines a light on disputes between renowned brands and the difficulty owners can have in establishing confusion, unfair advantage and passing off where the applicant and opponent’s marks are equally well-known.

The opposition may have been avoided if the parties had engaged in open discussions about the scope of the agreement, its current suitability, and TfL’s proposed use of “MIND THE GAP” moving forward. Businesses subject to settlement agreements should therefore ensure that their trade mark strategies align with prior commitments to forestall costly disputes.

Author:  
Rachel Pellatt



# Is it a bird? General court confirms subjective nature of visual similarity of logo only marks

👉 Case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: Giorgio Armani SpA v Shenzhen

City Chongzheng Technology Co Ltd

Date: 27 November 2024

Citation: T-509/23

Decision: [dycip.com/t-2024-870](https://dycip.com/t-2024-870)

The applicant, Shenzhen City Chongzheng Technology, sought to register the mark shown below in the EU, for goods in class 9. The application was opposed by Giorgio Armani based on its earlier mark, also depicted below, covering goods in classes 9 and 25 based on Article 8(1)(b) and Article 8(5) of Regulation 2017/1001.



Shenzhen City (left) Giorgio Armani (right).  
Source T-509/23: [dycip.com/t-2024-870](https://dycip.com/t-2024-870)

## Background

At first instance, the Opposition Division rejected the opposition entirely and the Board of Appeal rejected Armani's appeal based on the marks being dissimilar, irrespective of the level of attention of the relevant public, so there was no need to take into account reputation. In those circumstances, it considered that the applicant's arguments concerning the identity or similarity of the goods at issue and existence of a likelihood of confusion were ineffective. were.

According to the Board of Appeal, since the identity or similarity of the marks at issue was one of the cumulative conditions for the application of Article 8(1)(b) and Article 8(5), those provisions did not apply.

Armani appealed to the General Court which upheld the appeal and annulled the Board of Appeal decision.

## The General Court's decision

The Board of Appeal found, in essence, that the earlier mark was a purely figurative sign representing a stylised eagle with its wings spread and its head turned to the right, characterised by fairly thick horizontal bands, with a diagonal lateral cut. The mark applied for was also purely figurative, characterised by thinner horizontal lines, well-spaced from each other, with rounded ends, and representing the capital letter "V" or "Y", as suggested by the presence of a lower horizontal line longer than the previous ones.

Armani claimed that, visually, the marks at issue have at least an average level of similarity. Indeed, they would both form a V, which would evoke a stylised bird and would be designed to convey the same message of harmony, symmetry and elegance.

The European Union Intellectual Property Office (EUIPO) disputed Armani's claims and claimed that the marks at issue were comparable to short signs, in respect of which even slight differences could produce a different overall impression. It stated that the allusion to an eagle in flight in the earlier mark was absent from the mark applied for. On the other hand, it was undoubtedly reminiscent of the capital letter "Y". Lastly, Armani's assessment of the similarities between the marks was highly subjective, in particular when it referred to concepts that are difficult to define objectively, such as the "sober and minimalist" style, or when it interpreted the V-shape as constituting a reminder of the image of a bird.

It was noted that the marks at issue were both composed of the same number of horizontal black stripes on a white background and have a V-shape. While it was true that those characteristics were represented in a somewhat different manner in each of the two marks, those differences were considered to be minimal and unable to lead to a different overall visual impression, contrary to what the Board of Appeal found.

The marks would both be perceived and memorised as a V-shape, of comparable thickness, emerging from the horizontal black lines juxtaposed on a white background. The fact that consumers retained in their memory an image of the signs that is only imperfect, reinforced the finding of a rather low visual similarity between the signs.

In those circumstances where there is at least partial equality between the marks as regards one or more relevant aspects, namely the visual, phonetic and conceptual aspects, the General Court concluded that the Board of Appeal erred in failing to carry out a global assessment of the likelihood of confusion, as a result of its erroneous finding of an overall difference between the marks at issue and the "inapplicability" of Article 8(1)(b), a finding based, on the "very different" overall impression that consumers would have visually.

As the Board of Appeal had erred in its assessment of the likelihood of confusion of the marks (having found the marks to be dissimilar), thereby also ruling out an assessment under Article 8(5), the contested decision was annulled without analysing the other relevant conditions.

## In short

This case demonstrates how subjective an analysis of similarity can be and therefore to assess likelihood of success in opposition proceedings, particularly in relation to logo only marks. Caution should be paid when comparing two visual only marks and finding that they share no visual similarity at all.

Author:

Kate Cheney



Armani claimed that visually the marks both formed a V, evoking a stylised bird



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Acquiescence

# No proof of “actual awareness” Acquiescence argument fails in the EU

**G**eneral Court decision T-136/23 is a reminder that the threshold to establish acquiescence is high, and that earlier marks can invalidate EU trade mark (EUTM) registrations that have been in use for more than five years.

The figurative EUTM “vintae” was registered in 2008 for, *inter alia*, “alcoholic beverages (except beers)” in class 33 and related retail/wholesale services in class 35.

12 years post-registration, Grande Vitae brought an invalidation action on the basis of a likelihood of confusion with (in particular) its earlier German word mark VITAE, which covered identical/similar goods.

Vintae claimed that Grande Vitae had acquiesced in the use of “vintae” for a period of five successive years and should be prevented from bringing the invalidation action. However, neither the Cancellation Division nor the Board of Appeal considered Vintae’s evidence proved acquiescence. A likelihood of confusion was found, and Vintae appealed to the General Court.

The General Court focused on the conditions for acquiescence. Some key takeaways are:

- the purpose of limitation in consequence of acquiescence is to penalise proprietors of earlier marks who have acquiesced in the use of a later EUTM for a period of five successive years whilst being aware of the use.
- the five-year period will run from when the earlier mark owner becomes “actually aware” of the use of the later EUTM registration.
- mere presumptions or suppositions of use are insufficient to prove acquiescence, and general knowledge of the use in the sector concerned, which could be inferred from, for example, the duration of use, is not enough to prove acquiescence (although may be relevant to bad faith claims).

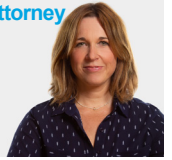
Therefore, even if it could be proved that both parties won awards in the same wine competitions and that this attracted significant media coverage and/or that both parties attended the same international trade fairs, this did not prove “actual awareness”. It could not be presumed that Grande Vitae had seen Vintae’s mark on wine bottles in media coverage, during competitions, or at trade fairs. Therefore, the conditions for acquiescence had not been proved, and the invalidation action was successful.

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