

1/2015 (17)

K&L GATES

TRADEMARKS AND UNFAIR COMPETITION

Quarterly Bulletin

K&L Gates Jamka sp.k., Plac Małachowskiego 2, 00-066 Warszawa, Poland
T: +48 22 653 4200 F: +48 22 653 4250

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INTRODUCTION

Welcome to another issue of our informative bulletin from the fields of trademark and competition law in Poland and the European Union. Of particular interest this time is a legislative initiative by the OHIM regarding an accelerated procedure for registering Community trademarks. This should lead to protection being obtained faster, within about five months from the application date.

As in past quarters, we present recent trademarks and unfair competition rulings, making important intellectual property law judgments available to you in an interesting format. In this issue, we focus on the automobile brands Aston Martin, Volvo and Land Rover, and how these distinctive marks are protected. We also look at problems arising over the registration of spatial trademarks, such as the well-known Żubrówka vodka bottle with its blade of fragrant grass, and the form of the Rubik's cube.

We have some new authors on board, this time from Great Britain: Arthur Artinian and Noirin McFadden. They have prepared an article in the final section of the bulletin concerning changes in intellectual property law in the UK which will affect the protection afforded to certain goods.

On behalf of all of our authors, I wish you a pleasant read and, as always, I invite you to share your comments and reflections.

Oskar Tułodziecki

LEGISLATION

FAST TRACK FOR REGISTERING A COMMUNITY TRADEMARK WITH THE OHIM

On 24 November 2014, the OHIM enabled users to publish announcements faster using a free “Fast Track.” The new procedure makes it possible to publish an application for registration of a Community trademark in half the time previously needed – now within eight to eleven weeks following the date on which payment for an announcement is made.

A form for the Fast Track procedure has been prepared that contains both required and default options so that an application for registration of a Community mark can be processed as quickly as possible. In order for the OHIM to approve an application for the Fast Track, the applicant must:

- choose a trademark from among the following types: (i) word mark, (ii) figurative mark, (iii) 3D mark, or (iv) sound mark. If the mark is a figurative or 3D mark and the application concerns a choice of colors, only those colors provided in the form can be used (a nonstandard color cannot be defined)
- choose goods and services from the OHIM uniform database containing previously approved and translated phrases
- attach all relevant attachments (e.g., document on priority) to the application for registration at the time it is submitted
- pay the application fee promptly after submission of the form.

Some applications that may meet the conditions for the Fast Track at the time they are submitted may later lose their status as applications qualifying for that procedure. This can result from the disclosure during the procedure that the registration requirements have not been met, such as when, for example, the trademark applied for is not distinctive. Other reasons for not qualifying for the Fast Track include (i) the submission of an application limiting the goods and services for which the mark is to be protected, (ii) the absence of attachments concerning priority, and (iii) the applicant stating that the trademark is to be a joint mark belonging to a number of entities.

Source: www.oami.europa.eu

*For further information please contact:
Michal.Ziolkowski@klgates.com*

APPLICATION FOR REGISTRATION OF A COMMUNITY TRADEMARK CONSIDERED ONLY AFTER PAYMENT

Another important OHIM practice introduced on 24 November 2014 is that applications for registration of a Community trademark will only be considered if the official fee has been paid. In this way the OHIM will avoid considering submissions that are never paid for, which in turn should reduce the waiting time for rights to be obtained.

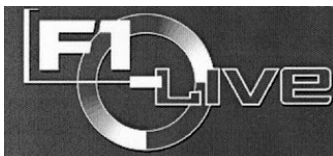
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*For further information please contact:
Michal.Ziolkowski@klgates.com*

EU COURTS AND THE OHIM CANNOT RULE ON THE ABSENCE OF DISTINCTIVENESS IN DOMESTIC MARKS – THE PRINCIPLE OF COEXISTENCE BETWEEN DOMESTIC AND EU MARKS – RULING OF THE EU COURT OF JUSTICE

On 11 December 2014, a ruling was handed down in the case of the marks “F1 – LIVE” and “F1 and Formula 1” (case file No. T-10/09), an interesting case with a long history about which we have reported in previous bulletins.

In 2004, Racing-Live SAS submitted an application to the OHIM for registration of the following figurative mark:



for goods and services belonging to Classes 16, 38 and 41:

- Class 16: “magazines, brochures, books; all of the goods specified concern Formula 1”
- Class 38: “transmission and dissemination of books, magazines and journals by computer terminals; all of the services specified concern Formula 1”
- Class 42: “publication of electronic books, reviews and periodicals; information on entertainment; organization of internet contests; reservation of places at events; online games; all of the services specified concern Formula 1”.

During the case, the initial applicant was eventually replaced by the company ESPN Sports Media Ltd. An objection against the application was raised by Formula One Licensing BV, which opposed the application with the following three registrations of word trademarks: “F1”: internationally in a number of European Union states, in Germany, and in the United Kingdom.

In addition, Formula One Licensing registered the following figurative Community trademark:



In 2007, the OHIM Objections Department dismissed the application, referring solely to the registration of the word mark “F1.” The applicant appealed against that ruling, and the First Board of Appeal overturned the decision of the Objections Department. Of importance in the case was the view expressed by the Board of Appeal that the mark “F1” would be perceived by the relevant target group as a designation of type. Similarly, the Board of Appeal held that there was no likelihood of consumers being misled in relation to the figurative marks being compared. The Board emphasized here, too, that the element “F1” is descriptive in nature.

In 2001, Formula One Licensing filed a complaint against that decision with the EU General Court, which, however, shared the Board of Appeal's view and dismissed the complaint. That ruling by the EU General Court was then challenged before the EU Court of Justice. In 2011, the Court of Justice overturned the ruling of the court of first instance and referred the case back to it for reconsideration. The Court pointed out that neither the OHIM nor EU courts have the right, independently and without regard for domestic procedures, to refute the distinctiveness of marks registered in a domestic legal system. Verification of how marks are perceived by the relevant consumers cannot lead to the conclusion that marks registered in a domestic system are not distinctive, since this would pose a threat to marks so registered, undermining the principle of the coexistence of Community and domestic trademarks. The absence of distinctiveness of domestic marks can be ascertained solely through an invalidation procedure conducted by the domestic authority.

In accordance with the guidelines provided by the EU Court of Justice, the EU General Court again conducted an analysis of the similarity of the marks being compared and of the possible risk of consumers being misled. Acting on the assumption that the word element “F1” is distinctive, and having analyzed the similarity



of the figurative marks, the Court came to the conclusion that there is a risk of consumers being misled, and invalidated the decision of the Board of Appeal, thereby finally preventing the registration of the mark applied for.

Source: www.curia.europa.eu

For further information please contact:
Oskar.Tulodziecki@klgates.com

THE COMMERCIAL USE OF A TRADEMARK SUBMITTED MUST BE EXAMINED – RULING OF THE EU GENERAL COURT

On 11 December 2014, in case T-480/12, the EU General Court ruled in favor of a complaint by The Coca-Cola Company (“Coca-Cola” or the “Plaintiff”) with its registered office in Atlanta, USA against a decision by the OHIM Second Board of Appeal. The course of the proceedings was as follows:

On 14 October 2010, Coca-Cola submitted an objection to the registration by Modern Industrial & Trading Investment Co. Ltd. with its registered office in Damascus, Syria (“Mitico”) of the following Community trademark:



Mitico had applied for the registration of the above mark in Classes 29, 30 and 32 of the Nice Classification, including for such products as nonalcoholic carbonated waters of all kinds and all flavors, and all kinds of drinks based on natural fruit juices. The Plaintiff based its objection on four earlier Community figurative marks and, secondly, on the earlier figurative trademark C registered in the United Kingdom.



The Objections Department of the OHIM dismissed the objection in its entirety. Coca-Cola appealed to the OHIM, but this too was dismissed by the OHIM Second Board of Appeal on 29 August 2012. In particular, the OHIM stated that the contested designations were not similar at all given that the word elements “coca-cola” and “master” are more distinctive than the graphic elements, and that therefore the marks have practically nothing in common other than the “tail” on the letters “c” and “m.” The OHIM also held that there was no likelihood of consumers being misled in respect of the trademarks. Though the goods concerned in the case are identical, and the earlier trademarks enjoy undisputed renown, it is difficult to see why a consumer would mistake the word “master” connected with an Arab word with the earlier trademarks containing the words “coca-cola,” since there is no coincidence on the textual level.

Coca-Cola filed a complaint with the EU General Court, claiming an infringement of Article 8 par. 5 of Regulation No. 207/2009 of 26 February 2009 on the Community trade mark. Pursuant to that provision, a trademark is not to be registered in the case of an objection by the owner of an earlier identical or similar mark for dissimilar goods or services if the earlier mark enjoys renown and if the unjustified use of that trademark would result in undue benefits being reaped or would be harmful to the distinctive nature or renown of the earlier trademark.

The EU General Court held that verification of the contested decision’s compliance with the law should involve, firstly, a visual comparison of the conflicting designations; secondly, an overall evaluation of their similarity, taking account of phonetic and conceptual differences between them; and thirdly, an assessment of the consequences of that evaluation for the application of, in this case, Article 8 par. 5 of Regulation No. 207/2009. The Court also found that the Board of Appeal had incorrectly isolated the Spencerian script used in both trademarks in the words “coca-cola” and “master,” when it should have made an overall assessment of the marks. In the view of the Court, the OHIM had rightly held that the earlier trademarks provided in the objection enjoy wide



renown. However, the Office had not addressed the likelihood that the unjustified use of the trademark submitted would cause undue benefits to be reaped from the distinctive nature or renown of the earlier trademarks, or would harm those trademarks. Because that issue had not been assessed by the OHIM, the Court could not rule on it for the first time as part of its verification of the contested decision's compliance with the law.

Referring to the second part of the only claim, the EU General Court found that the OHIM Board of Appeal had erred in ejecting evidence submitted by the Plaintiff concerning the commercial use of the trademark submitted, such as screenshots from Mitico's website:



After all, these are crucial to determining the likelihood of the existence of parasitism in the case. The EU General Court invalidated the decision of the OHIM Second Board of Appeal of 29 August 2012.

Source: www.eur-lex.europa.eu

For further information please contact:
Dorota.Kosela@klgates.com

REAPING UNDUE BENEFITS FROM THE REPUTATION OF AN EARLIER MARK? LOVOL VS. VOLVO – RULING OF THE EU GENERAL COURT

Now a dispute concerning the motor industry. In 2006, the Chinese company Hebei Aulion Heavy Industries Co. Ltd. applied for the registration of the figurative Community trademark “LOVOL.”

LOVOL

The application concerned goods belonging to Classes 7 and 12 of the Nice Classification, including reapers and farming machines, but also passenger cars, transport vehicles for farming purposes, motorcycles, bicycles and trucks.

An objection to the registration of that designation as a trademark for the above goods was submitted by the Swedish company Volvo Trademark Holding AB (“Volvo”), which referred to the following earlier trademarks: (1) a word Community trademark “VOLVO,” registered for goods belonging to Classes 7, 12 and others, (2) a figurative Community trademark registered for goods from Classes 7 and 12, (3) a domestic figurative trademark registered in Great Britain for goods from Class 12, and (4) a domestic figurative trademark registered in Great Britain for goods from Class 7.



Volvo's objection was dismissed by the OHIM, mainly because the conflicting marks were deemed insufficiently similar to each other. Moreover, the OHIM found that the level of attention paid by the relevant target consumer group is very high, mainly due to the high price of the goods concerned and their technical nature. The OHIM also stated that the conflicting designations differ from



each other to the extent that there was no likelihood of consumers being misled. In response to that ruling by the OHIM, Volvo filed a complaint with the EU General Court. After considering the case, the Court dismissed the complaint (T-524/11).

In its complaint, Volvo argued that “LOVOL” and “VOLVO” are similar. Each consists of five letters, with a similar combination of the letters “v,” “o” and “l”. The geometric structure of the capital letters “V” and “L” is also similar, as is the sequence of vowels “o” and “o”. The Court found, however, that the beginnings of the disputed designations are different. In light of established case law, consumers put more weight on the beginnings of words. Moreover, in the opinion of the Court, the plaintiff did not present evidence in support of its claim that the average consumer would tend to dissect a short word devoid of meaning and read its first syllable in reverse. The designations “VOLVO” and “LOVOL” do not consist of words having different meanings that are understandable to the relevant consumer group.

In the Court’s opinion, the average consumer would not make an association between the conflicting designations, because they differ in their first two letters, and the trademark submitted has two “l”s, while the Volvo trademark contains two “v”s. In the view of the Court, there is no question of a visual similarity between the marks.

Nor is there any phonetic similarity, mainly because the first sounds of the marks are different. Also, the Court found it impossible to make a conceptual comparison of the marks, since neither of them has any meaning in any language of the European Union.

In summary, the Court expressed the view that the circumstance that the conflicting designations are both comprised of the letters “v,” “l” and “o” and contain the letter set “vol” is not sufficient for holding that the relevant consumer group would associate the two designations with each other or perceive a connection between them. The Court thereby shared the view of the OHIM that the two designations are not similar.

Source: www.eur-lex.europa.eu

For further information please contact:
Ewelina.Madej@klgates.com

“...&CO.” IS NOT VERY DISTINCTIVE – THE ABSENCE OF CONFUSION BETWEEN M&CO. AND MAX&CO. – RULING OF THE EU GENERAL COURT

On 3 December 2014, the EU General Court ruled in the case of a complaint by MaxMara Fashion Group Srl against the OHIM, with the participation of Mackays Stores Ltd. (T-272/13). The complaint concerned the registration of the figurative Community trademark “M&Co.”

M&Co.

The British company Mackays Stores Ltd. applied to the OHIM on 25 May 2010 for registration of that mark for such goods as clothing, headwear and footwear. MaxMara contested the registration on the basis of the figurative designation “Max&Co”, registered previously as both Community and Italian domestic trademarks (CTM 1174333, CTM 838663, Italian trademark 793820).

MAX&Co.

MaxMara also referred to the Italian word mark “MAX&Co.” (No. 479779).

Despite the appeal procedure before the OHIM, MaxMara was not successful in opposing the registration of the “M&Co.” mark, and so brought the case to the EU General Court.



The parties to the proceedings did not question that the marks were registered for similar or identical goods. The dispute centered on whether the “M&Co.” mark created a risk of confusion with the earlier “Max&Co.” marks. The fundamental subject of the dispute was the nature of the suffix “&Co.,” that is, whether that suffix is distinctive in nature.

Referring to Article 8(1)(b) of Regulation 207/2009 on the Community trade mark, MaxMara argued that a likelihood of confusion existed between its marks and the “M&Co.” mark submitted for registration. The provision in question states that it is possible to object to the registration of a mark if *“it is identical or similar to an earlier trademark, or the goods or services concerned are identical or similar, such that there exists a likelihood of public opinion being misled in the territory in which the earlier mark enjoys protection; the likelihood of consumers being misled also includes the likelihood of an association being made with the earlier trademark arising.”*

The Court emphasized that, when evaluating whether there is a likelihood of consumers being misled by the marks under consideration, it is necessary to apply the criterion of an average, reasonable, well-informed consumer who is perceptive, where such consumer’s awareness will vary depending on the type of goods being purchased.

The Court also emphasized that such an analysis must be made based on the overall impression made by a mark, taking account of its distinctive and dominant elements. The average consumer does not analyze individual elements of a mark, but only perceives it as a whole. The principle is that analyses made by the OHIM and the Court cannot involve taking only one element of a complex sign into account and comparing that with another mark. On the contrary, the Court stated that such an assessment must be made by analyzing the whole of each of the marks concerned, where it may be the case that the overall impression made by a mark is the result of the dominance of one of its components. That element alone may be analyzed if all of the other elements of the mark are insignificant.

The Board of Appeal of the OHIM held that, in the “Max&Co.” mark, the element “max” is the dominant element. That cluster of letters placed at the beginning of the mark creates its own overall impression. In respect of the mark “M&Co.,” the OHIM found that it contains no dominant elements. As to the fragment “&Co.,” the authority stated that this is an abbreviation of the widely known

English-language term “and company,” which is used worldwide at the end of company names. “&Co.,” therefore, has only weak distinctiveness. The OHIM, therefore, ruled that the conflicting marks are not similar to each other. MaxMara claimed that the OHIM had not shown why it considered the element “&Co.” negligible in an overall evaluation of the marks, and had, therefore, incorrectly compared only the elements “max” and “m.”

Taking the above arguments concerning the risk of confusion and the method of evaluation into account, the Court analyzed the OHIM decision and found that the OHIM had not erred, as had been claimed. On the contrary, the OHIM had made an overall evaluation of the mark “M&Co.” submitted for registration, and had found that no element of that mark can be considered dominant. Noting that the element “&Co.” cannot be deemed dominant, the OHIM analyzed it, and at the same time evaluated the overall impression made by the mark, without omitting any element. The Court confirmed that a fragment of a designation that is often used in trade as a symbol is not very distinctive. Such an element cannot be deemed as an abstract concept possessing strong distinctiveness.

The Court further emphasized that, given that the marks in question are short, consumers will tend all the more to perceive differences between them. The Court also stated that, in view of the differences between the designations on the visual and phonetic levels, there was no risk of confusion. The Court, thereby, upheld the decision of the OHIM and ruled against the objection by MaxMara, stating that its complaint should be dismissed.

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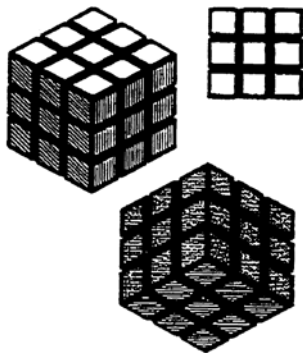
For further information please contact:
Marta.Wysokinska@klgates.com

RUBIK’S CUBE AS A TRADEMARK? – RULING OF THE EU GENERAL COURT

The designation below was registered in 1999 as a Community trademark by the British company Seven Towns Ltd. In 2006, that registration was extended for a further protection period. The goods that the registration concerned belong to Class 28 of the Nice Classification and constitute “three-dimensional puzzles.” The mark contains a graphic presentation of a cube, seen from three different angles, where each surface of the cube is a grid formed of edges



in the color black dividing the surface into nine equal squares arranged in three rows of three. Four thick black lines, of which two are horizontal and two vertical, divide each surface of the cube into such squares. Those elements give the contested trademark the appearance of a “black cage.”



In the same year—2006—in which the protection right to the above Community trademark was extended, a German producer of toys, Simba Toys GmbH & Co. KG (“Simba Toys”) moved for the invalidation of the trademark, primarily arguing that the mark contains a technical solution involving the capacity for rotation, whereas such a solution may only obtain patent protection, and cannot be protected as a trademark. The German company’s motion was dismissed by the OHIM. Simba Toys then took the case to the EU General Court, which also rejected the complaint (T-450/09).

The EU General Court held that the fundamental properties of the disputed trademark are, first of all, the cube itself, and secondly, the grid structure that appears on each of the six surfaces. The Court also shared the view of the OHIM Board of Appeal that the black lines and grid structure shown on each surface do not fulfill any technical function, nor even suggest such a function.

The registration of the trademark does not afford protection to the capacity for rotation, as Simba Toys claimed, but only to the form of the cube on whose surfaces the grid structure is placed. The Court ruled that the trademark does not entitle the owner of the mark to prohibit third parties from marketing any type of three-dimensional toy that is capable of rotation. Exclusivity is limited only to three-dimensional puzzles in the form of a cube on whose surfaces a grid structure is present.

The Court also held that the contested trademark has features that are distinctive. The grid structure on each surface of the cube, considered as a whole, lend the cube the appearance of a “black cage.” Those features are distinctive enough for the trademark to be deemed original in appearance, since it can easily be retained by an average consumer and can enable such a consumer to distinguish goods bearing the trademark from goods of other producers.

Source: www.curia.europa.eu

For further information please contact:
Ewelina.Madej@klgates.com

OBJECTION PROCEEDINGS – EVIDENCE SUBMITTED AFTER THE DEADLINE SET BY THE OHIM – RULING OF THE EU GENERAL COURT

The subject of this case (ruling of the European Union General Court of 11 December 2014 in case T-235/12) was a procedural problem concerning registration of the following three-dimensional trademark submitted by Underberg AG:



The mark is described as follows: “a greenish-brown blade of grass in a bottle, where the length of the blade is approximately three quarters of the height of the bottle.” The mark was submitted for Class 33, spirits.

An objection was filed by CEDC, the Polish producer of “Żubrówka” bison grass traditional vodka, which has for decades features a blade of grass placed in each bottle of the product. Although



the issue of adorning a bottle of spirits with a blade of bison grass is an extremely interesting one in terms of trademarks and potential acts of unfair competition, the Court considered an important procedural issue. In particular, it ruled on the limits of freedom of the OHIM in admitting evidence of the use of a competing mark where this was submitted after the deadline set by the authority.

Pursuant to Article 42 of Regulation 207/2009, in response to an application, the owner of an earlier trademark that has submitted an objection can present evidence that, within five years preceding the publication of the announcement, it has in fact used the earlier trademark. CEDC presented such evidence within the time period set by the Objections Department, but the Department held that the evidence was insufficient. In the opinion of the Department, the labels affixed to bottles as shown in the photographs provided by CEDC obscured the objects placed inside the bottles to such an extent that it was difficult to ascertain whether the bottles actually contained a blade of bison grass. For this reason, in its appeal to the OHIM Board of Appeal, CEDC presented additional photographs of products, including side views that left no doubt as to the type of object placed within the bottles.



This additional evidence, however, was submitted after the deadline set by the OHIM Objections Department, and the Board of Appeal, therefore, decided not to consider it. What is more, the Board of Appeal's justification to its ruling did not state why the Board chose not to admit that evidence. It was primarily on this issue that CEDC brought a complaint to the Court. The subject of the dispute thus became the procedural issue of the OHIM's scope of freedom in evaluating evidence and in admitting or refusing to consider it.

The Court noted first of all that the above Article 42 concerns material law, and the provision itself does not contain a time limit within which evidence of the use of an earlier mark can

be submitted. On the one hand, this does not mean that a plaintiff, therefore, has total freedom and can present evidence at any time. On the other hand, account must be taken of Article 76 of Regulation 207/2009, pursuant to which the OHIM may not consider facts or evidence that an interested party did not provide within the proper time period. In the opinion of the Court, it results from this provision that, in principle, it is possible to submit evidence after a deadline, and there is no prohibition on considering evidence presented later, even if it is presented to the Board of Appeal for the first time. The party presenting evidence, however, should not expect that the OHIM must consider late evidence. The OHIM should in each case justify its decision to admit or deny evidence that is submitted late. A lack of justification constitutes a serious infringement of procedure. The justification should indicate whether the OHIM correctly used its wide powers of discretion, or whether it has exceeded its authority, thereby infringing procedure. Such evidence should have real significance for the result of the proceeding pending, and its admission must be possible with respect to the stage of proceedings.

In analyzing the evidence submitted by CEDC in the context of the subject of the proceedings, the Court found that the Board of Appeal, in an objective and justified manner, should have used its discretion and admitted the evidence submitted late, since that evidence meets both of the criteria set forth in case law. For this reason, the Court invalidated the decision of the Board of Appeal, at the same time emphasizing that the Board of Appeal must finally consider the matter of the late evidence, taking particular account of the guidelines resulting from the Court's ruling.

Also worth noting is the Court's view on the issue of supplementing evidence submitted initially. The Court emphasized that case law does not require a tangible relationship between initial evidence and supplementary evidence. Supplementary evidence cannot be the first and only evidence of use, but must by nature be evidence that is "additional" or "supplementary."

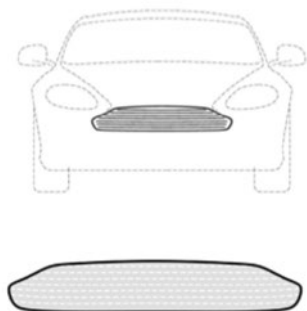
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*For further information please contact:
Oskar.Tulodziecki@klgates.com*



ASTON MARTIN RADIATOR GRILL AS A TRADEMARK – DECISION OF THE OHIM BOARD OF APPEAL

Aston Martin Lagonda Limited (“Aston Martin”) applied for Community trademarks in the form of a distinctive radiator grill used in the production of model cars. The application covered figurative marks and positional marks for such goods as cars, toys and computer games, as well as services relating to the construction and repair of cars.



While examining the application, the OHIM found that the marks are devoid of primary distinctiveness, and so Aston Martin was not granted the registration. In the opinion of the expert assessing the application, the form of the radiator grill presented does not have distinctive features that would distinguish it from other grills already existing in trade. A consumer looking at a car of that brand perceives the radiator grill solely in terms of its function, as a technical part of the car or as a decorative element, but not as a distinctive designation. In the OHIM’s opinion, what is important for a consumer is the logo or name of the producer, which is most often found on the radiator grill or which forms a part thereof. Aston Martin did not agree with this reasoning, and presented a lot of evidence attesting to the stylistic uniqueness of the radiator grill of its cars in an attempt to prove secondary distinctiveness. That evidence was deemed insufficient by the OHIM, which issued a refusal to register the mark.

Aston Martin appealed against that decision, arguing that the marks in the form of a unique radiator grill constitute a distinctive and sufficiently recognizable element of all cars of that brand, disseminated through many years of commercial

use. In cases R 1795/2014-2, R 1796/2014-2, R 1797/2014-2 and R 1798/2014-2 the OHIM Second Board of Appeal acknowledged that a radiator grill can constitute a trademark, though each application for such a trademark should be considered separately because of variations in depicting the designation graphically and the detailed characteristics attesting to a mark’s distinctiveness. The Aston Martin radiator grill is only recognizable to car enthusiasts and professionals. In the opinion of the Board of Appeal, the average consumer does not distinguish cars just by their radiator grills, unless such a grill possesses secondary distinctiveness. In the view of the Board, the expert who analyzed the submission correctly found that the marks presenting the radiator grill do not have primary distinctiveness, but did not make a detailed analysis of the issue of secondary distinctiveness. In view of the large amount of evidence provided by the applicant, the case will be referred back to the expert.

Source: www.curia.europa.eu

For further information please contact: Michal.Ziolkowski@klgates.com

NOT EVERY CAT JUMPS LIKE THE PUMA CAT – ABSENCE OF SIMILARITY OF MARKS – DECISION OF THE OHIM BOARD OF APPEAL

On 19 December 2014, the OHIM Fifth Board of Appeal issued a decision (R-1207/2014-5) in the case of a mark submitted by Gemma group S.r.l., which consists of a graphic design of a jumping cat, in the color blue, facing right.



The mark was submitted for goods in Class 7 of the Nice Classification, machines for treating wood and aluminum. The registration was objected to by Puma SE on the basis of a series of marks showing a jumping cat (a puma) registered as international trademarks.



None of those marks were submitted for goods in Class 7 of the Nice Classification. In general, the marks forming the basis of the objection were registered for clothing and toys, and so Puma presented evidence of the renown of the marks, arguing that that renown could suffer harm through the use of the mark submitted for registration.

At the first stage of the proceedings, the OHIM Objections Department ruled that the marks are similar to a certain extent, for each consists of a figure of a jumping cat. It was pointed out that the image of the animals face in opposite directions, and also that the styles of the competing images differ. The Department emphasized that the difference between the products concerned (machines vs. clothes and toys) is so great that it is unlikely that the mark submitted by Gemma Group would lead to any association with Puma. From the point of view of the relevant group of consumers, the markets on which the designations are to function are not related.

The complaint was based on the following arguments: the similarity of the marks is obvious, the Puma marks are universally known, the use of the mark submitted is not sought for important reasons, and the analysis of the lack of any association between the marks should be more thorough – for it was incorrectly limited to a comparison of the marks.

The Board of Appeal rejected the complaint, justifying its decision as follows. Pursuant to Article 8 par. 5 of the Regulation on the Community trade mark, in order to refuse to register a mark submitted, the competing marks (the mark submitted and earlier marks) must be identical or similar, the earlier mark that is to constitute the cause of the refusal to register must be renowned, and further, the risk must exist that the use, without proper justification, of the new trademark will result in undue benefits or will be harmful to the distinctiveness or renown of the earlier trademark. All of those conditions must be met. The Board of Appeal agreed with the evaluation of the marks made

by the Objections Department that there is a lack of similarity between the marks. In respect of renown of the earlier marks, it pointed to a number of absences in the material evidence aimed at demonstrating that renown. Translations were missing, and the evidence submitted concerned a period of time many years before the submission of the mark and a geographic territory irrelevant to the case. The Board of Appeal did not consider evidence in the form of favorable decisions concerning renown issued by the Polish Patent Office. In summary, the Board of Appeal held that there was a lack of evidence as to the renown of the marks in the relevant time periods and territories.

In reference to the last prerequisite set forth in Article 8.5 – undue benefits or harm to the distinctiveness or renown of an earlier mark caused by the use of a new mark – the Board of Appeal emphasized that the plaintiff failed to show for what reasons customers from a completely different community (the mark submitted was designated for specialized professionals, while the Puma marks are addressed to a wide group of end users) would make an association between the marks. In light of the above, it was necessary to dismiss the objection.

Source: www.oami.europa.eu

*For further information please contact:
Marta.Wysokinska@klgates.com*

DECISION OF THE OHIM ON THE MARK “LAND GLIDER” – ANALYSIS OF THE SIMILARITY OF MARKS HAVING AN IDENTICAL DESCRIPTIVE ELEMENT

In a decision of 9 December 2014, No. R 1415/2013-4, the Fourth Board of Appeal of the OHIM ruled in favor of a complaint by the Japanese company Nissan Jidosha Kabushiki Kaisha (the “Applicant” or “Nissan”) against a decision of the OHIM Objections Department. The complaint concerned a refusal to register the Community trademark “LAND GLIDER,” for which Nissan applied on 27 May 2009. The company Jaguar Land Rover Limited with its registered office in Whitley, Great Britain (“Jaguar Land Rover”) filed an objection to the registration based on earlier Community trademarks and marks registered in Germany and Great Britain. The OHIM Objections Department agreed with the objection, referring in particular to the similarity of the marks in respect



of their common element “LAND.” Further, the Department found that the trademark for which registration was sought could reap undue benefits from the reputation of the earlier mark due to consumers associating the marks because of the word “LAND” and the similarity of the goods bearing the marks. It could be assumed that Nissan could unfairly benefit from the reputation and permanent selling power of the earlier mark.

The Applicant appealed against that decision, referring to the low level of similarity of the marks resulting from the element “LAND.” In the Applicant’s view, that coincidence could not cause consumers to be misled. In addition, Jaguar Land Rover had not demonstrated the renown of the earlier marks. The OHIM Fourth Board of Appeal ruled in favor of the Applicant’s complaint, expressing the view that there was no risk of consumers being misled by the mark “LAND GLIDER.” This, the Board stated, was mainly because consumers throughout the European Union are able to understand the descriptive nature of the word “LAND” and would not associate different marks based on that element, in particular taking into consideration that “GLIDER” and “ROVER” are dissimilar visually, phonetically and conceptually.

In its objection to the registration of the mark “LAND GLIDER,” Jaguar Land Rover referred to Article 8(1)(b) of Regulation 207/2009. Pursuant to that provision, an application for registration of a Community trademark will be rejected if an earlier, similar trademark exists and there is a likelihood of consumers being misled within the territory in which the earlier mark enjoys protection. After comparing the marks “LAND GLIDER” and “LAND ROVER,” the OHIM Fourth Board of Appeal held that the element “LAND” refers to a characteristic of both vehicles – the fact that they are both land vehicles. Because of the differences resulting from the second element of the marks – the words “GLIDER” and “ROVER,” the marks are similar only to a negligible degree, and only because of the descriptive element “LAND.” Similarly, in comparing the “LAND GLIDER” mark and the following mark:



the Board of Appeal found that the visual similarity between the two is even smaller.

Analyzing the distinctiveness of each of the marks, the OHIM Board of Appeal decided that no risk of consumers being misled exists. Moreover, the risk of the marks being associated with each other by consumers cannot be based on an element that is not distinctive. Article 8(1)(b) of the Regulation, therefore, does not apply. Nissan’s complaint was successful, and Jaguar Land Rover’s objection dismissed.

Source: www.oami.europa.eu

For further information please contact:
Dorota.Kosela@klgates.com

REGISTRATION RIGHTS TO COMMUNITY DESIGNS DO NOT CONSTITUTE AUTOMATIC PROTECTION BEFORE A PRODUCT IS COPIED – RULING OF THE POLISH COURT FOR COMMUNITY TRADE MARKS AND INDUSTRIAL DESIGNS

In September 2014, the Regional Court in Warsaw Division XII Court for Community Trade Marks and Industrial Designs dismissed the claim filed under case No. XXII GWwp 23/13. The claimant had sought an order against the defendant against infringing the claimant’s rights to a series of Community designs registered with the OHIM.

That order was to ban offering, marketing, advertising and storing for commercial purposes products in the form of: marker stamps, artist’s markers, magic markers for blowing, extendable crayons, finger paints, and paints in tubes with brushes. The claims also included a demand that those goods be removed from trading and that all advertising materials containing images of them be destroyed. In addition, during the proceedings, the claim was extended to include a demand that the defendant refrain from committing acts of unfair competition against the claimant, by means of an order against the defendant producing, marketing, or advertising products imitating products of the claimant. The extension of the claim concerned the five plastic products shown below, with a detailed description of their appearance:



The claimant has been conducting business since 2007, including the wholesale and retail trading of school and educational products, and its offer includes the products specified in the claim. Since 2010, it has conducted activities aimed at promoting the Colorino brand that its products bear. In April 2010, it submitted to the OHIM the following figurative Community trademark, which appears on all of the products covered by the demands in the claim:



In July 2013, the OHIM registered the mark under No. 009029877. The current right holder to the mark is the claimant, which, on 14 June 2011, purchased that right from the company, which was the exclusive distributor of the products covered by the claim.

The defendant conducts activity, including retail sales. In 2012, it sold products specified in the claim, purchased from the exclusive distributor, in its sales network under the trade name ELEFUN. At the end of 2012, the defendant began negotiations with the distributor concerning sales of Colorino products in those same stores in 2013. Those talks did not lead to the conclusion of an agreement.

Competition law acknowledges the principle of priority, which is a condition for obtaining protection. The Court found that imitation itself is not a prohibited act – it must create a risk of consumers being misled as to the identity of a producer or the origin of a product. On the issue of confusion, the Supreme Court

has stated: *“the comprehensive and clear marking of a producer on packaging and the permanent fixture of a trademark directly on a product admitted to trading rules out the possibility of error arising in respect of the identity of both the producer and the product.”*

In the Court’s opinion, the material evidence submitted did not permit the finding that the claimant enjoys priority in the manufacture of products of a certain appearance that are copied and marketed by the defendant, creating a risk of consumers being misled. Holding rights from the registration of Community designs does not guarantee the right holder automatic protection against the copying of the product in which those rights are contained or to which they apply. The Court found that the packing in which the two parties offer their products for sale differ from each other sufficiently to preclude the view that the defendant’s products originate from the claimant.

Even if priority on the market were established, the claimant could not effectively demand protection against acts of unfair competition on the basis of Article 13 par. 1 of the Act on Combating Unfair Competition. Nor could it demand an order against acts of the defendant bearing the hallmarks of parasitism on the achievements of a third party, for the effort of building up the market position of the products in question and the outlays made in that regard as demonstrated in the proceeding refer to two other companies (including the exclusive distributor), and not only to the claimant itself. The claimant therefore had no active legitimacy by which it could identify itself with those companies and present their activities as its own.

Source: www.warszawa.so.gov.pl

For further information please contact:
Emilia.Pisarek@klgates.com



OTHER ISSUES

“FIRE IN THE BROTHEL” IS A NAME THAT DISRUPTS PUBLIC ORDER – DECISION OF THE POLISH PATENT OFFICE

In mid-February of this year, reports appeared in the press in connection with a refusal by the Polish Patent Office to register the trademark “Fire in the Brothel” (Polish: *“Pożar w burdelu”*), the name of a well-known theatre and cabaret troupe. As at the time of writing, the full content of that decision has not yet been published by the PPO. However, Adam Taukert, PPO spokesperson, has spoken on the issue in a radio interview. He confirmed that, in the opinion of the Office, the name “Fire in the Brothel” disrupts public order. The PPO’s decision was based on the view that the trademark submitted is contrary to good custom because the word “brothel” is vulgar in the Polish language.

Maciej Łubieński, cofounder of “Fire in the Brothel,” did not agree with the stance taken by the PPO and stated his intention of appealing against the decision. He stated that the authority “is not there to defend public morality” and emphasized that his theatre and cabaret troupe has existed for more than two years, is widely known, is partially subsidized by state institutions, and that its performances are frequently attended by Polish politicians and dignitaries, for which reasons he is all the more surprised by the way in which the PPO interpreted his company’s name.

Source: www.gazeta.pl

*For further information please contact:
Emilia.Pisarek@klgates.com*





REPEAL OF SECTION 52 OF THE UK COPYRIGHT, DESIGNS AND PATENTS ACT 1988

The arco lamp (Castiglioni brothers) and the butterfly chair (Lucian Ercolani, founder of Ercol) are two examples of iconic products which until a recently announced change in the law would not have been able to receive the full duration of copyright protection in the UK.

In the UK, as in many other countries, copyright protects an article for the creator's life plus 70 years. However, there are exceptions, including Section 52 of the UK Copyright Designs and Patents Act ("CDPA") 1988 which limits protection to 25 years for industrially manufactured copies. An article is regarded as industrially manufactured where more than fifty copies are made, or it consists of goods manufactured in lengths/pieces and the goods are not hand-made. The effect is that plaques, most sculptures, and printed literary or artistic matter (e.g. calendars, greeting cards, stamps) have full copyright protection, whereas mass produced designs (e.g. furniture, vases, lamps and other decorative items) are limited to 25 years. Few other EU countries limit the copyright of industrially manufactured artistic works.

On 25 April 2013, the UK Parliament passed the Enterprise and Regulatory Reform Act ("ERRA") 2013. Section 74 ERRA allowed the repeal of Section 52 CDPA at a date to be decided later. The government opened a consultation lasting from 15 September 2014 until 27 October 2014 to decide on a date of repeal.

On 18 February 2015, the Government published its response to the consultation which confirms that Section 52 CDPA will be repealed from 6 April 2020 in order to ensure 'fair treatment of all types of artistic works', 'rewards for British designers', and to 'encourage a new generation to innovate and grow'. There will be express provisions so that copies of industrially manufactured artistic works that already existed/were imported before 6 April 2020 can continue to be distributed, hired and sold indefinitely after repeal, but any unlicensed copies may not be imported or made after the repeal. The government will issue non-statutory guidance on what items may attract copyright protection and factors to consider closer to the date of repeal.

The change in law will be of particular interest to manufacturers of replica furniture and decorative items who will need

to re-evaluate the licensing requirements of their business model as they had previously relied on the shorter term of copyright protection.

Source: www.legislation.gov.uk; www.ercol.com/about/awards; www.flos.com/en/flosophy/prehistory;

*For further information please contact:
Noirin.McFadden@klgates.com
Arthur.Artinian@klgates.com*



For further information please contact:



Oskar Tułodziecki

Oskar.Tulodziecki@klgates.com



Marta Wysokińska

Marta.Wysokinska@klgates.com



Agata Lewartowska-Błaszczyk

Agata.Lewartowska-Blaszczyk@klgates.com



Michał Ziółkowski

Michal.Ziolkowski@klgates.com



Dorota Kosela

Dorota.Kosela@klgates.com



Arthur R. Artinian

Arthur.Artinian@klgates.com



Ewelina Madej

Ewelina.Madej@klgates.com



Noirin M. McFadden

Noirin.McFadden@klgates.com



Ewa Rusak

Ewa.Rusak@klgates.com

If you are interested in obtaining an electronic version of the bulletin, please send your request to: Emilia.Pisarek@klgates.com with the subject line: "TM Bulletin".

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