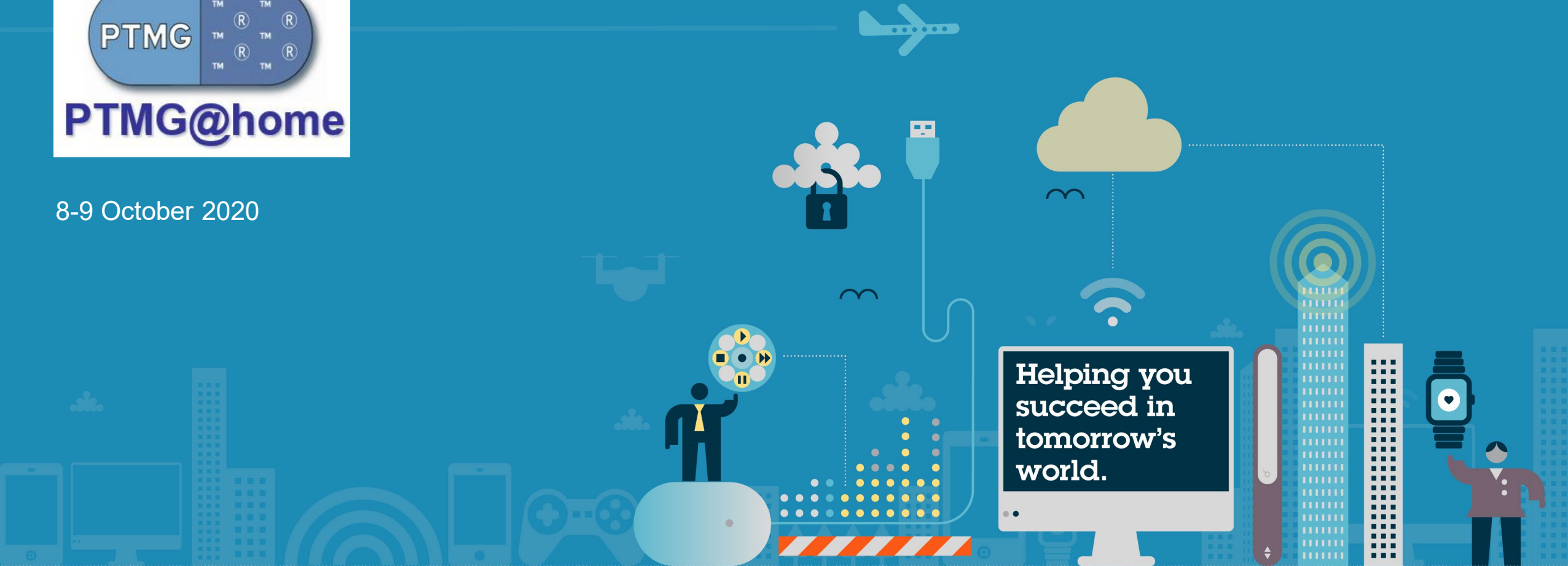


International Case Law Roundup

Richard May, Associate Director



8-9 October 2020



Agenda



Topic	Cases
Trade mark specifications/bad faith	Sky v Skykick (CJEU and UK); Alliance Pharmaceuticals v EUIPO (EU General Court)
Colour marks	Glaxo v Sandoz (UK); Unilever v Beiersdorf (Germany)
Intermediary liability	Easygroup v Akenes (Switzerland); Omega v 375 Canal (USA)
Counterfeits	Chanel v Ye Meng-Zong (China)
Fair use	Tiffany v Costo (USA)



TM specifications/bad faith



Sky v Skykick, CJEU, Case C-371/18, 29 January 2020 / UK High Court HC-2016-001587 29 April 2020

The CJEU ruled on two important areas of trade mark law:

(1) the validity of broad terms contained in registered marks; and

(2) the validity of registrations filed with no intention to use.

UK court partially invalidated Sky's registrations for bad faith



TM specifications/bad faith - *Sky v Skykick*



The ruling is significant because:

- The CJEU has confirmed that trade mark registrations containing broad terms such as 'computer software', 'financial services' or 'telecommunications services' *cannot* be invalidated in whole or in part due to an alleged lack of clarity and precision of such terms
- Despite the earlier AG opinion, the inclusion of broad terms in trade mark specifications *cannot* be regarded as contrary to public policy
- The CJEU also confirmed that applying for a trade mark with no intention to use *may* constitute bad faith, *but* only if the applicant intended to undermine the interest of third parties or to obtain a monopoly for purposes other than to fulfil the functions of a trade mark
- If bad faith is made out in such circumstances, only the goods and services that constitute bad faith will be invalidated, rather than the entire registration

Trade mark specifications

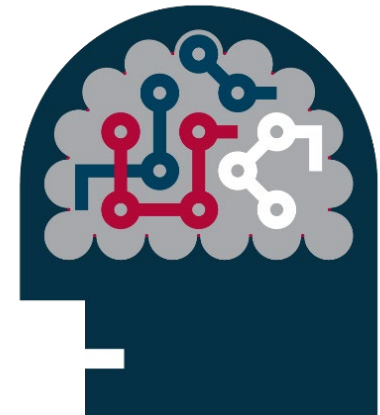


Alliance Pharmaceuticals v EUIPO, EU General Court, Case T-279/18, 17 October 2019

Alliance asserted a trade mark registration in class 5 for:

*“Pharmaceutical preparations **but not including** infants’ and invalids’ foods **and** chemical preparations for pharmaceutical purposes”*

What does this cover??

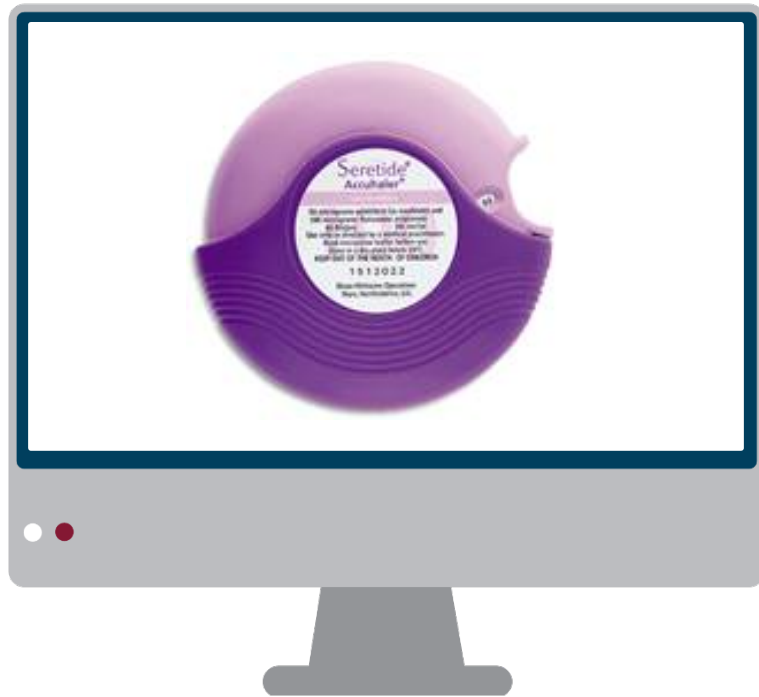


Trade mark specifications - *Alliance Pharmaceuticals v EUIPO*

- The General Court has confirmed two essential factors to consider when interpreting unclear specifications:
 - (1) the actual intention of the trade mark owner;
 - (2) the need to give an appropriate interpretation to the wording of the specification, one that precludes an absurd result for the trade mark owner
- Literal interpretation of specifications is to be preferred, but this is no use when two literal interpretations are equally possible
- Common sense interpretation should prevail

Colour marks

Glaxo v Sandoz, UK High Court, [2019] EWHC 2545 (Ch), 4 October 2019



VS



Colour marks - *Glaxo v Sandoz*



- The High Court dismissed Glaxo's claim that the colour purple is distinctive of its Seretide Accuhaler dry powder inhaler
- Survey evidence not sufficient (4 x surveys; 6 x survey experts)
- Court looked through the lenses of both patients and healthcare professionals (HCPs)
- HCPs – Purple recognised as a feature of the Seretide inhaler. Did not signify a particular medical authorisation
- Patients – No evidence. Knew Seretide (preventer) was purple, but did not know all purple inhalers would be Seretide. Purple used to differentiate therapeutic effect of Seretide inhaler from other coloured inhalers
- Misrepresentation as to origin and misrepresentation as to equivalence not made out

Colour marks



Unilever v Beiersdorf, German Federal Patent Court, 27 W (pat) 1/17, 18 October 2019

- German Reg no. 30571072 for the colour blue
- In class 3 for "Cosmetics, namely skin and body care products"
- Pantone 280 C



Colour marks – *Unilever v Beiersdorf*



- Nivea's colour blue can function as a trade mark due to acquired distinctiveness through use
- Survey evidence sufficient
- In Germany, acquired distinctiveness for colour marks per se requires a degree of consumer recognition of more than 50%

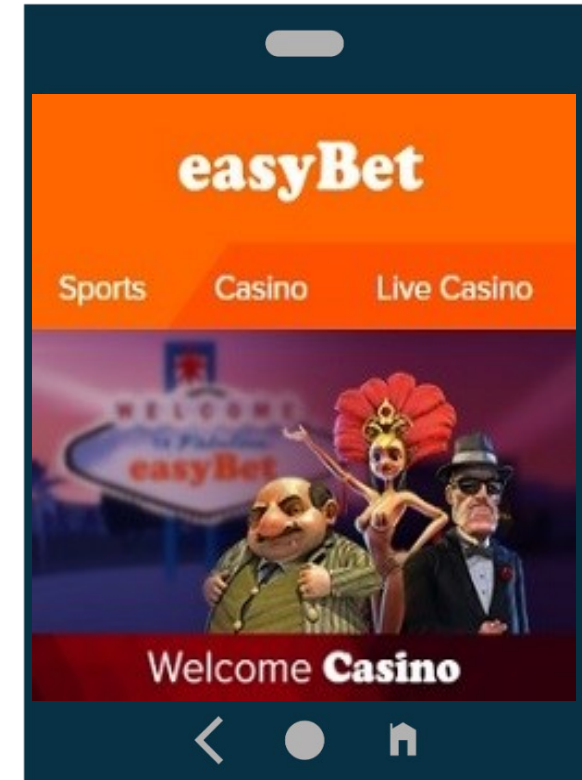


Intermediary liability



*Easygroup Ltd v Akenes SA, Swiss Commercial Court,
2 December 2019*

Easybet.com



Intermediary liability – *Easygroup Ltd v Akenes SA*



- First reported Swiss case in which a hosting provider has been ordered to take down a website for hosting trade mark infringing content
- The court concluded EASYJET is a famous trade mark under Swiss law
- Famous marks are protected against use of a third party sign for *any* goods and services, provided such use threatens its distinctiveness or exploits or damages its reputation



Intermediary liability



Omega SA v 375 Canal LLC, US District Court, New York, 12 Civ. 6979 (PAC), 4 March 2019

375 Canal Street, Lower Manhattan, NYC



Intermediary liability - *Omega SA v 375 Canal LLC*



- Jury finds large Manhattan landlord liable for contributory trade mark infringement
- Landlord continued to lease property to tenants knowing the premises were being used for counterfeiting activities
- Omega awarded \$1.1 million statutory damages (\$275,000 for each of Omega's four infringed marks)

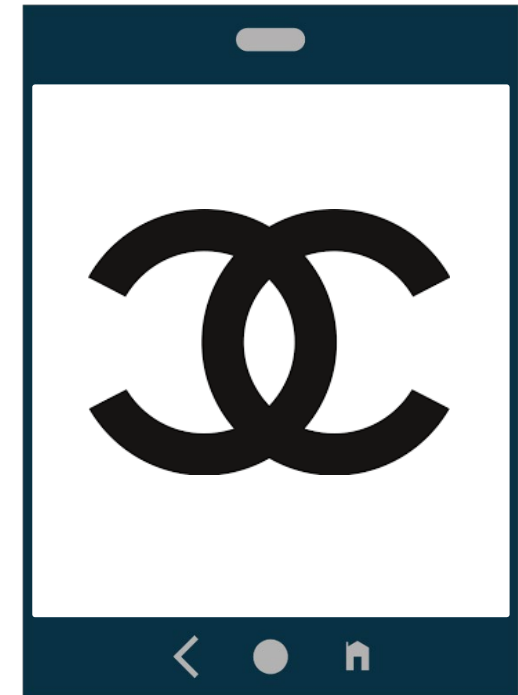


Counterfeits



Chanel v Ye Meng-Zong, Guangzhou IP Court, China, July 2019

The Chanel 'double C' logo



Counterfeits - *Chanel v Ye Meng-Zong*



- Selling goods under the trade mark 周百福 ("Zhoubaifu"), in the shape of Chanel's 'double C' logo did not amount to trade mark infringement or a counterfeit product
- Shape of the product was not performing a trade mark function nor was it "decoration"
- No post-sale confusion in China
- Case heard in one of China's three new courts recently created exclusively for IP cases
- Shape will continue to be assessed on a case-by-case basis



Fair use

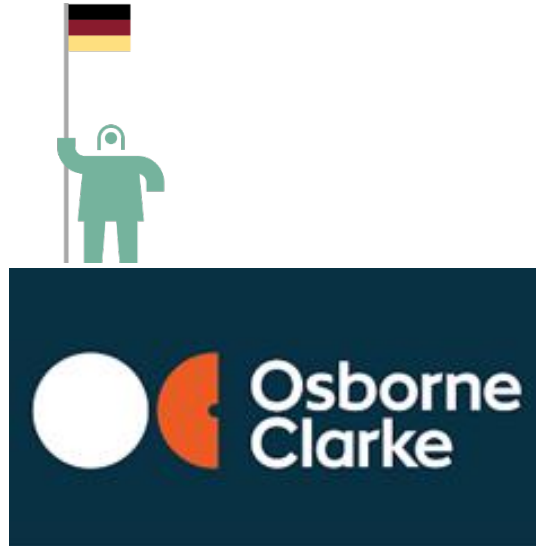


Tiffany & Co. v Costco Wholesale Corp., 2nd US Circuit Court of Appeals No. 17-2798, 17 August 2020

- Costco uses "Tiffany", "Tiffany setting" and Tiffany style" to describe its own unbranded six-prong diamond rings
- In 2015, Tiffany obtained summary judgment and \$21 million damages
- Appeal court overturned summary judgment and remanded case for trial
- Words can have descriptive meaning independent of their trade mark meaning



Special thanks to:



walderwyss

ROUSE



Thank you

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