

PTMG – Fall 2023 International Case Round Up

October 6, 2023

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Agenda



1. EU

Glaxo v. Cipla Europe



2. UK

Lidl v. Tesco



3. USA

Spireon v. Flex
Apple v. Bertini



4. China

Shenzhen Zhonglian v. Sinopharm
Zhonglian



5. India

Mankind Pharma v. Novakind Bio Science
Glaxosmithkline v. Horizon



6. Canada

Energizer v. Duracell

EU: Glaxo v. Cipla Europe*



Background

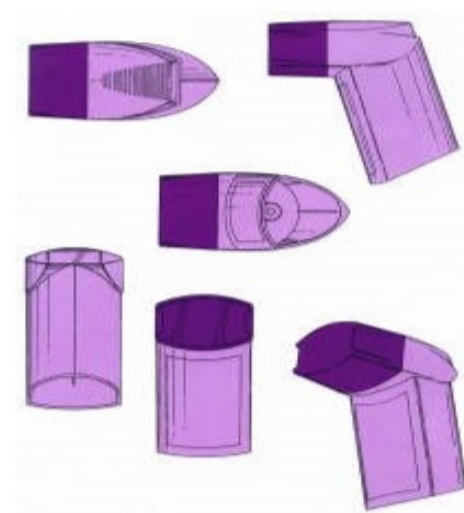
- Based on an application filed in 2001, Glaxo registered 3D mark claiming lilac and deep purple in connection with inhalers and preparations for respiratory ailments
- In 2014, Cipla filed an application for declaration of invalidity, claiming the mark was non-distinctive
- Cipla application granted, and Board of Appeal rejected Glaxo appeal
 - Among other things, Board found colors to be descriptive

General Court Judgment

- Board erred by:
 - Failing to consider mark as a whole
 - Providing contradictory reasoning as to alleged non-distinctiveness as of the relevant date (filing date), amounting to a failure to state any reasons at all
 - Evidence post-dating filing can be probative in certain circumstances
- Board decision annulled

Observations

- Decided on procedural grounds
- Contradictory reasoning sufficient for annulment
- Relevant date is filing date of contested mark





What is the most popular sport in the EU that is also featured in the summer Olympics?

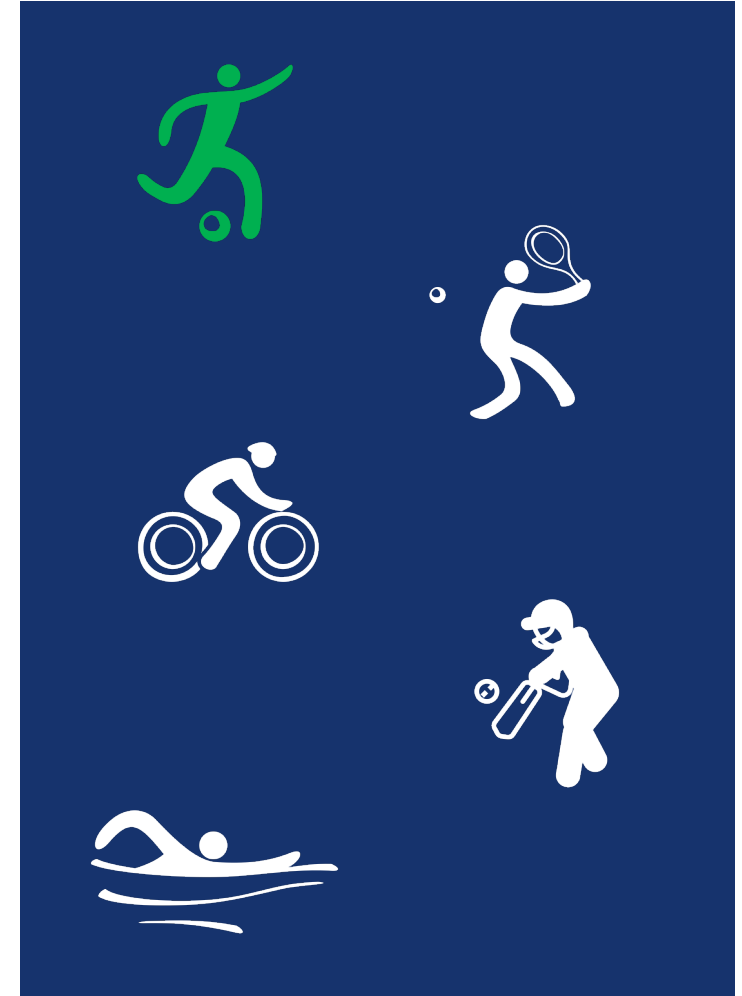
- a) Football/Soccer**
- b) Tennis**
- c) Cycling**
- d) Cricket**
- e) Swimming**





What is the most popular sport in the EU that is also featured in the summer Olympics?

- a) **Football/Soccer**
- b) Tennis
- c) Cycling
- d) Cricket
- e) Swimming





Background

- Lidl asserted claims based on rights in registered logos:
 - Logo with “Lidl” text:The Lidl logo, which consists of the word "LIDL" in blue capital letters with a red dot over the 'i', set against a yellow circular background with a red border, all within a blue square.
 - “Wordless Mark”:A wordless mark consisting of a yellow circle with a red border, set against a blue square background.
- Lidl alleged trademark infringement, passing off, and copyright infringement
- Tesco denied claims and asserted counterclaims against Lidl’s Wordless Mark based on alleged:
 - Non-use
 - Lack of distinctive character
 - Bad-faith registration



Lidl Marks



Tesco Marks





High Court Decision

- **For Lidl on infringement claims**
 - Tesco signs deemed similar to the mark with text
 - Rejected Tesco's argument that text "blocked out the sun"
 - Tesco signs also deemed similar to Wordless Mark
- **Mixed ruling on counterclaims against Wordless Mark**
 - Non-use claims largely dismissed
 - Lidl established genuine use of the design through use with text
 - But registration invalidated based on bad faith
 - Logo's use following registration not determinative
 - Lidl unable to rebut inference that registration was obtained for use "as a weapon to secure a wider legal monopoly than it was entitled to, with no genuine intention to use it"
 - Several subsequent registrations also found invalid – evergreening
- **For Lidl on claims of passing off and copyright infringement**
 - Passing off claims as to equivalence (consumers deceived into believing Tesco prices same or lower for equivalent goods)

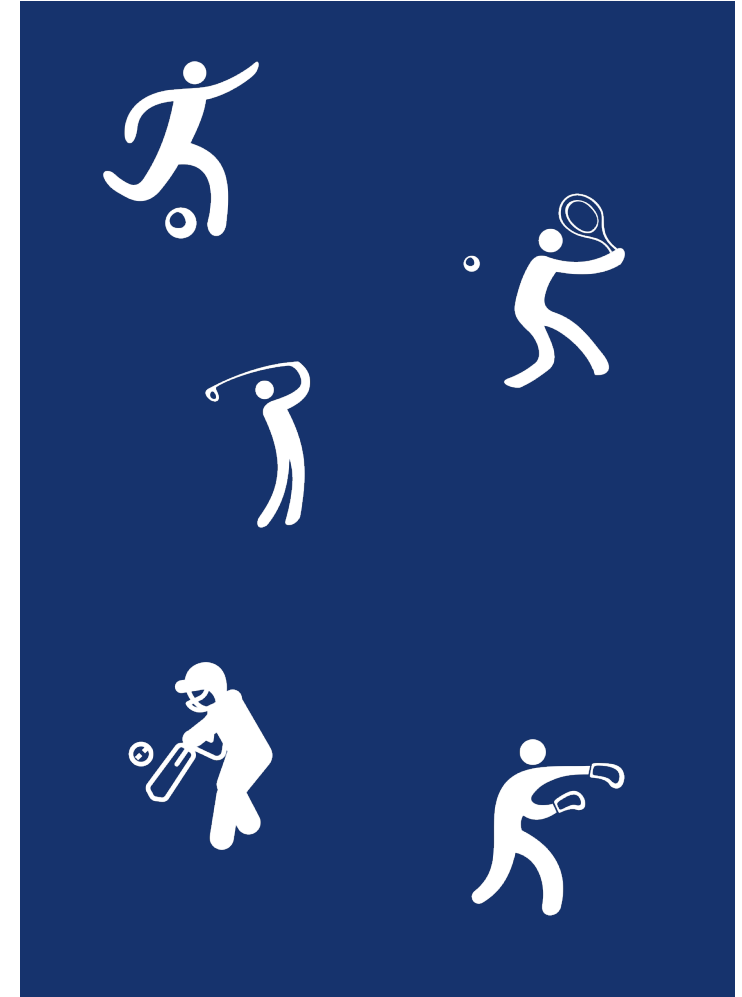
Observations

- Use of registered design may withstand non-use challenge even if only used with incorporated text
- But bad faith may still be found as of time of filing
- Retain records of intent to use as of filing date



What is the second most popular sport in the UK that is also featured in the summer Olympics?

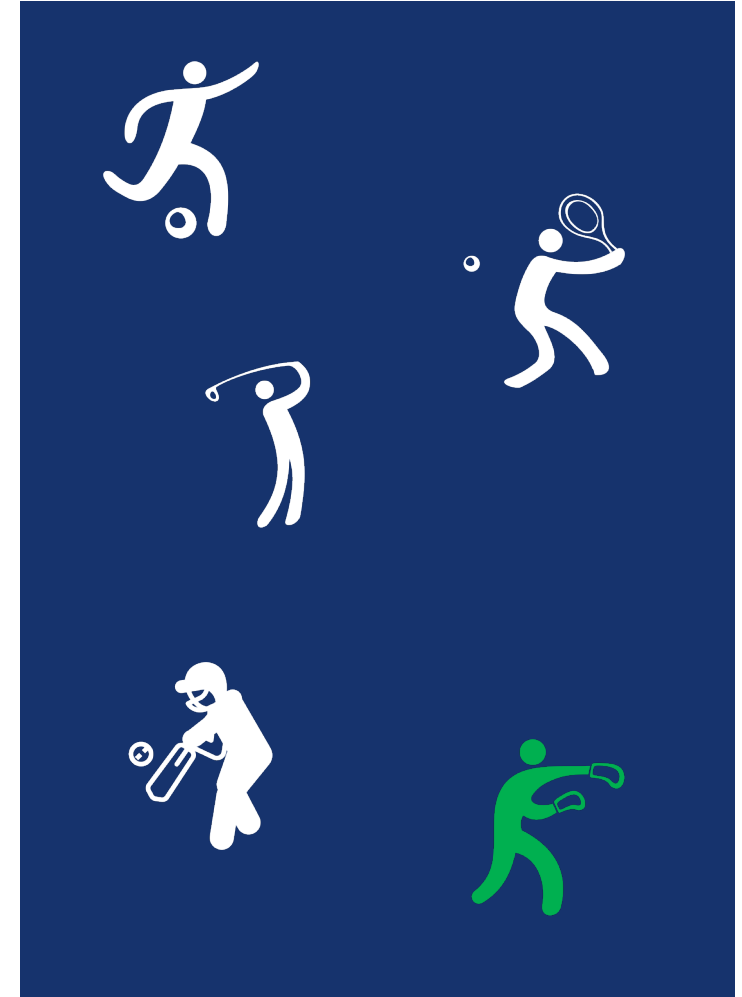
- a) Football/Soccer
- b) Tennis
- c) Golf
- d) Cricket
- e) Boxing





What is the second most popular sport in the UK that is also featured in the summer Olympics?

- a) Football/Soccer
- b) Tennis
- c) Golf
- d) Cricket
- e) **Boxing**





Background

- Spireon applied to register FL FLEX in connection with electronic tracking devices
- Flex opposed based on its previously registered marks FLEX, FLEX (stylized), and FLEX PULSE
- TTAB sustained opposition – application of traditional likelihood of confusion factors

Federal Circuit

- TTAB applied incorrect analysis regarding strength of prior FLEX marks
 - Erred by disregarding less similar third-party composite marks
- Also novel question on burden of proof
 - Court concluded that burden rests on opposer to show non-use of registered third-party marks cited by applicant (identical marks for identical goods)
- Case remanded to TTAB

Observations

- Absent proof of non-use of identical third-party marks for identical goods, use will be assumed.
- Don't discount the importance of less similar third-party marks.



Background

- Apple applied to register APPLE MUSIC in connection with numerous services, including sound recordings and live performances; first use 2015
- Bertini had previously used APPLE JAZZ for sound recordings and concerts
- Issue – priority
 - Apple itself did not begin using APPLE MUSIC until after Bertini's APPLE JAZZ but claimed prior rights through purchase of third-party APPLE registration covering gramophone records with a 1968 first-use date
- Board: Apple entitled to tack its 2015 use of APPLE MUSIC onto 1968 use of APPLE for gramophone records
- Bertini opposition dismissed



Federal Circuit

- Novel question – can an applicant establish priority for every good/service in its application when it can show priority through tacking in a single covered good or service?
- No – tacking must be established for all covered goods and services. And tacking only applies where goods/services are “substantially identical”
 - Ok if goods are within “normal evolution of the previous line of goods,” such as gramophones and sound recordings
- Apple cannot claim priority for all services in its application (including live performances) by tacking onto its assignor’s 1968 rights in APPLE for gramophone records
- Dismissal of opposition reversed

Observations

- Acquiring older marks and invoking tacking can be effective in acquiring priority
- But high standard requires legally equivalent marks and substantially identical goods/services
- Must establish tacking for each good/service



What is the most popular sport in the US that is also featured in the summer Olympics?

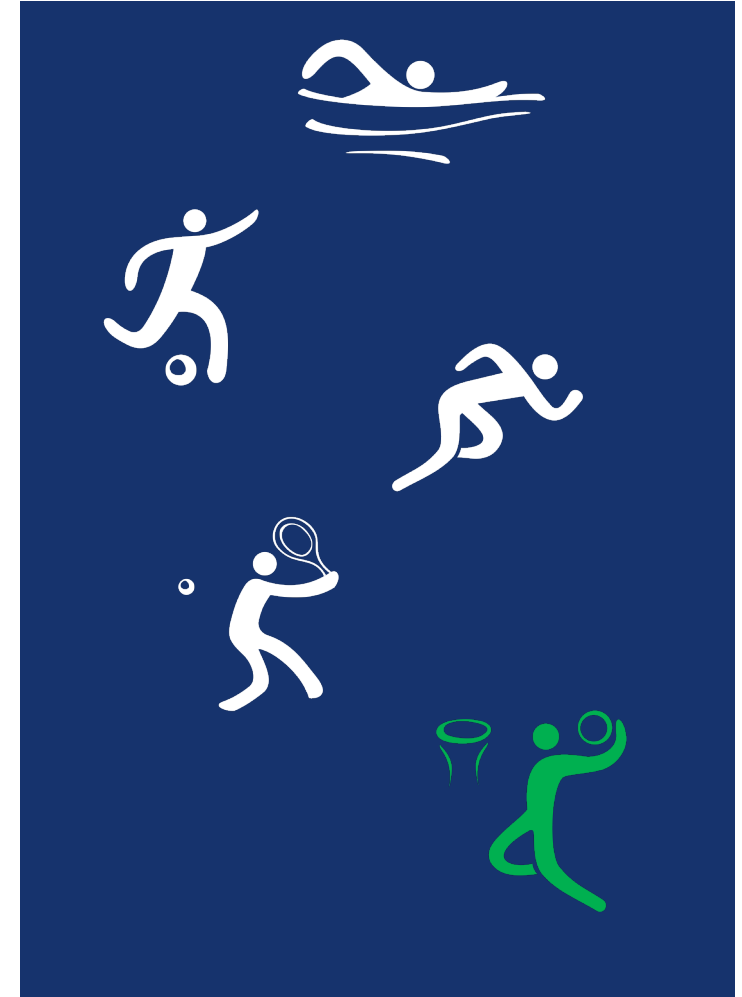
- a) **Swimming**
- b) **Football/Soccer**
- c) **Track and Field**
- d) **Tennis**
- e) **Basketball**





What is the most popular sport in the US that is also featured in the summer Olympics?

- a) Swimming
- b) Football/Soccer
- c) Track and Field
- d) Tennis
- e) Basketball**



China: Shenzhen Zhonglian v. Sinopharm Zhonglian*



Background

- Plaintiff Sinopharm Zhonglian filed invalidation action against the trademark 中联大药房 (Zhonglian Pharmacy) in class 35 covering retail trade of pharmaceuticals
- Plaintiff owned series of 中联 (Zhonglian) trademarks in class 5 covering traditional Chinese medicines
- CNIPA ruled for defendant based on finding of dissimilar services and goods
- Beijing Intellectual Property Court reversed – similarity between the marks, coupled with the plaintiff's reputation in the field and prior sales, meant that the challenged mark would cause confusion to the relevant public

Decision

- High People's Court of Beijing Municipality reversed again – most important characteristic of the Class 35 services was they were provided for others
- Thus, the goods and services of the challenged mark and the cited mark were not closely related in terms of function, use, consumer objects, sales channels, etc.

Sinopharm Zhonglian mark
(Class 5)

中联

Shenzhen Zhonglian mark
(Class 35)

中联大药房



What is the most popular sport in China that is also featured in the summer Olympics?

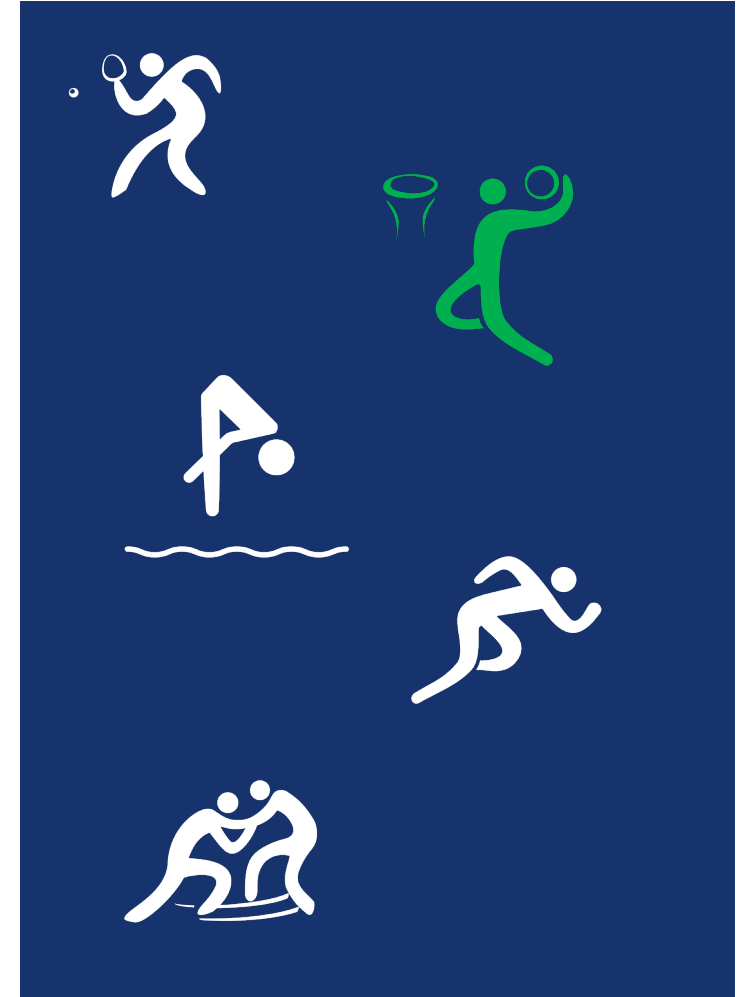
- a) Table Tennis
- b) Basketball
- c) Diving
- d) Track and Field
- e) Wrestling





What is the most popular sport in China that is also featured in the summer Olympics?

- a) Table Tennis
- b) Basketball**
- c) Diving
- d) Track and Field
- e) Wrestling





Background

- Plaintiff, fifth largest pharmaceutical company in India, trades under MANKIND mark and uses family of “-KIND” marks for various products
- Defendant used NOVAKIND BIO SCIENCES PRIVATE LIMITED and DEFZAKIND in connection with certain pharmaceutical products
- Plaintiff sought injunction covering all uses of “KIND” as a trade name or trademark in connection with any pharmaceutical products

Delhi High Court

- Court concluded that the parties’ marks were deceptively similar and granted injunction
- Although the parties’ respective products were prescribed by doctors and dispensed by chemists, the “[p]ublic interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal products.”
- Relied on both law and practical considerations



“The little apothecary, oftentimes not even able to flaunt a medical degree, occupying the little cubbyhole at the street corner, dispensing medicines, is an unfortunate reality in this country. The poor, and those who are unable to afford the services of the more upmarket physician, often people these ‘clinics’”.



Background

- Plaintiff registered COBADEX in connection with pharmaceutical goods and used mark for a prescription vitamin product
- Defendant used COMODEX PLUS in connection with an OTC vitamin product
- Defendant argued, among other things, that there was no possibility of confusion because Plaintiff's product had to be prescribed by a registered medical practitioner

Delhi High Court

- Ruled in Plaintiff's favor based on likelihood of confusion
- Again emphasized the need for increased degree of care given practical realities of marketplace



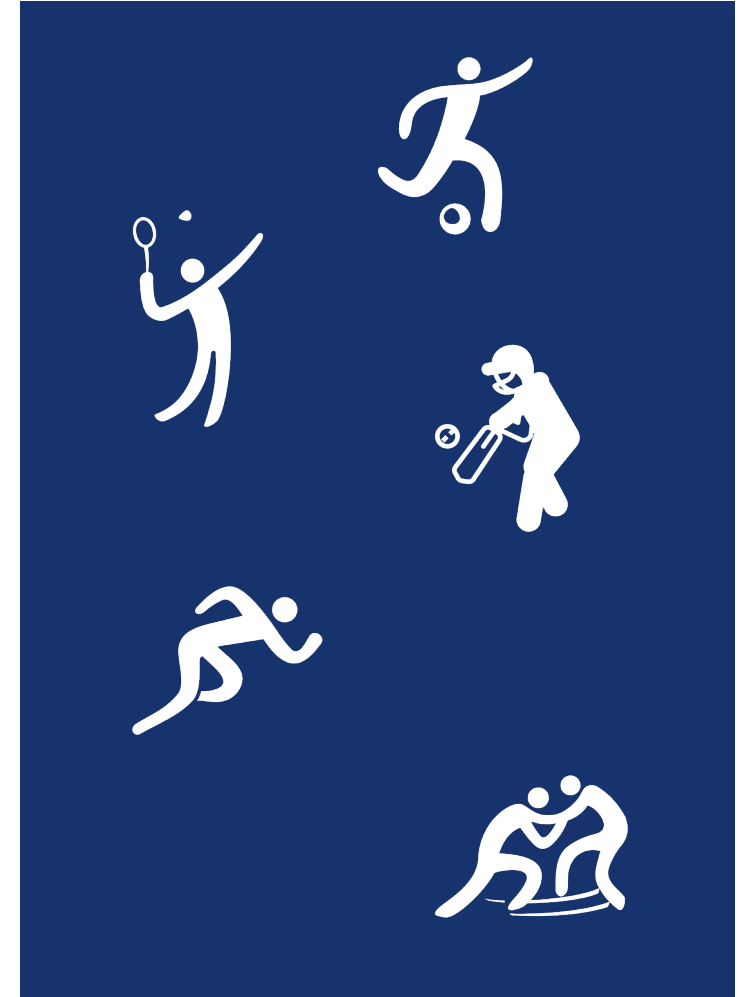
In view of the varying infrastructure for supervision of physicians and pharmacists . . . in our country due to linguistic, urban, semi-urban and rural divide across the country . . . , strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.

[I]t is an unfortunate matter of common practice that, at times, prescription drugs are also sold without prescription. Where public interest is involved, the Court cannot shut its eyes to this reality.



What is the most popular sport in India that is also featured in the summer Olympics?

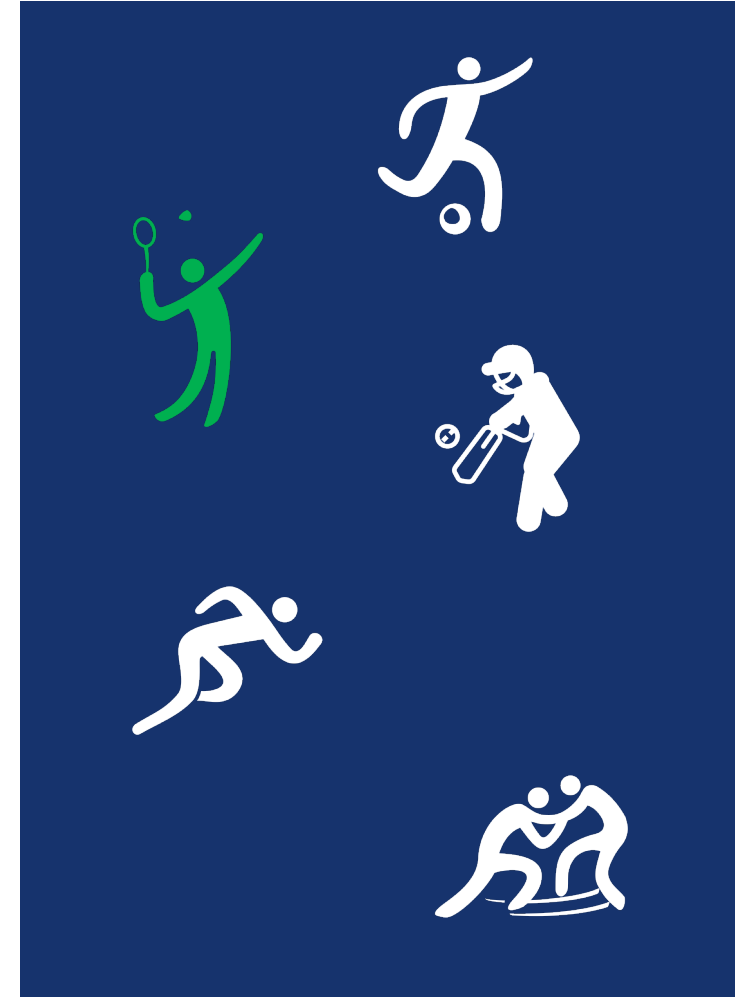
- a) Football
- b) Badminton
- c) Cricket
- d) Track and Field
- e) Wrestling





What is the most popular sport in India that is also featured in the summer Olympics?

- a) Football
- b) Badminton**
- c) Cricket
- d) Track and Field
- e) Wrestling





Background

- Duracell packaging compared longevity of its batteries to that of Energizer, referring to:
 - Energizer's registered marks ENERGIZER and ENERGIZER MAX
 - “the bunny brand”
 - “the next leading competitive brand”
- Energizer claimed that this use was likely to have the effect of depreciating the value of the goodwill attached to the marks

Canada: Energizer v. Duracell



Examples of
Duracell
packaging





Decision

- Applied 4-part test: (1) use in connection with goods/services, (2) sufficiently well-known mark, (3) linkage (use in a manner likely to have an effect on claimant's goodwill, and (4) damage
- Mixed ruling
 - Energizer prevailed on use of ENERGIZER marks: Energizer trademarks "bandied about resulting in lost control . . . and lesser distinctiveness"
 - Duracell prevailed on use of "the bunny brand": insufficient showing of requisite linkage
 - Context important, including size and placement
 - Additional mental steps required
 - Duracell prevailed on use of "the next leading competitive brand": insufficient showing of likelihood of depreciation of goodwill
- Energizer awarded permanent injunction and 179,000 CAD in damages (regarding use of "Energizer" word marks)

Observations

- Relatively rare comparative advertising case
- Importance of context, including placement and size



What is the most popular sport in Canada that is also featured in the summer Olympics?

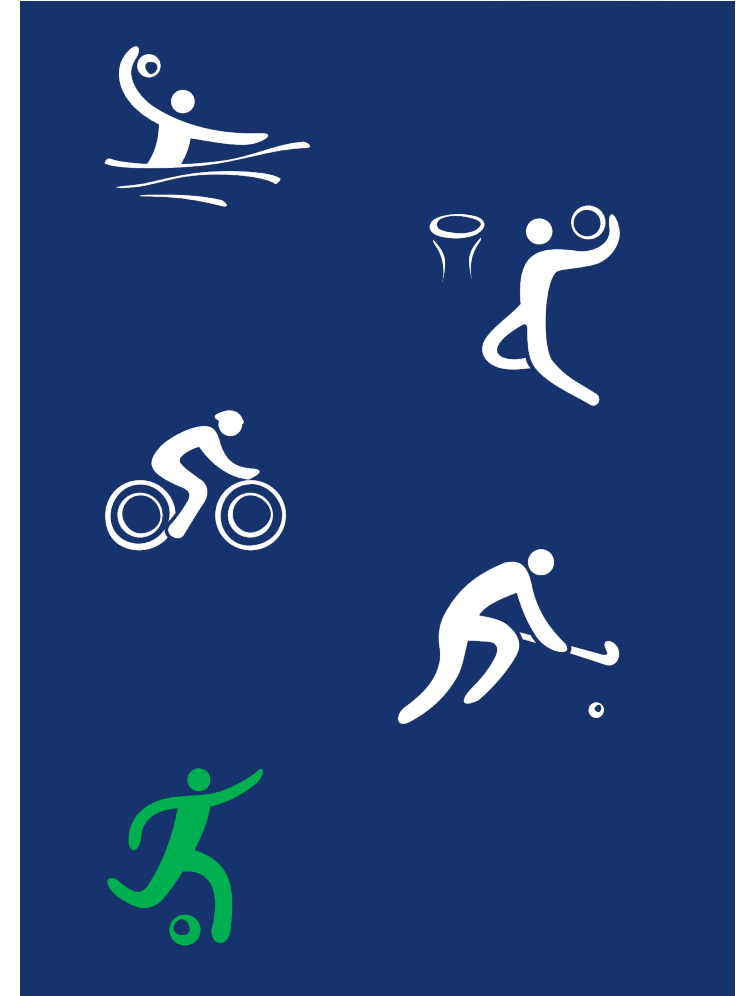
- a) Water Polo
- b) Basketball
- c) Cycling
- d) Hockey
- e) Football/Soccer

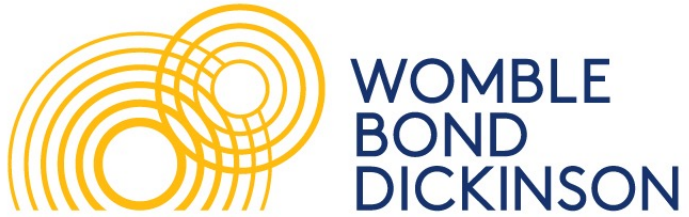




What is the most popular sport in Canada that is also featured in the summer Olympics?

- a) Water Polo
- b) Basketball
- c) Cycling
- d) Hockey
- e) Football/Soccer**





Thank You!

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