

PRACTICAL CASES ON TRADEMARKS

Belgrade – 11.04.2025

CASE 1

1. By order of 15 July 2015, received at the Court on 10 August 2015, the Supreme Court of Ireland referred to the Court of Justice of the European Union for a preliminary ruling under Article 267 of the Treaty on the Functioning of the European Union a question on the interpretation of Article 5(1)(b) of Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks.

2. That question arose in proceedings between the South Korean company KyunTech Corporation and the Canadian company SilverScreen Productions Inc., formerly Nova Entertainment Group, following SilverScreen's application in Ireland in 2013 for registration of the word trade mark "SilvrScenes" to be used in connection with the following goods and services: "digital streaming services, distribution of audiovisual content, and production of web-based films."

3. Referring to Section 7(1) of the Irish Trade Marks Act 1996, KyunTech opposed that application before the The Intellectual Property Office of Ireland, asserting that it infringed its earlier word trade mark "SilverScene," registered in Ireland for goods including "cinema projectors, streaming equipment, recording devices, and multimedia production software."

4. The first examiner of the The Intellectual Property Office of Ireland found the two marks analogous and refused registration, citing that the respective goods and services were similar under Section 10(2)(a) of the Irish Trade Marks Act. However, a second examiner reversed this decision, dismissing the opposition due to insufficient similarity.

5. The Irish Trade Mark Tribunal dismissed KyunTech's appeal, ruling that the goods and services were not similar enough under Section 10(2)(a). It stated that similarity could only be acknowledged where the goods and services were so related that consumers might assume they originated from the same

enterprise due to their distinguishing signs. The tribunal decided that this condition was not met in the present case.

6. KyunTech brought a further appeal before the Supreme Court of Ireland, arguing that the marks were likely to cause confusion among consumers and harm their established trade mark rights.

What would you decide in this case if the Supreme Court would ask you a preliminary ruling if you sit at the European Court of Justice?

CASE 2

1. On 12 May 2018, InnovTech Ltd applied under Article 49 of Regulation (EU) 2017/1001 to register the designation "EduPath" as a European Union trade mark. To define the services covered by that registration, InnovTech used the general terms of the heading of Class 41 of the Nice Classification, namely, "Education; providing of training; entertainment; sporting and cultural activities."

2. On 15 September 2018, the European Union Intellectual Property Office (EUIPO) refused the application under Article 7(1)(b) and (c) of Regulation (EU) 2017/1001. EUIPO interpreted the application determining that it encompassed not only the services explicitly outlined by InnovTech but also additional services within Class 41, including career consultancy. EUIPO argued that for career consultancy, the designation "EduPath" lacked distinctiveness and was descriptive in nature. Furthermore, InnovTech had not submitted any evidence demonstrating that "EduPath" had acquired distinctiveness through use for such services prior to the application date. No request to exclude career consultancy services had been included in the application.

3. On 5 October 2018, InnovTech filed an appeal before the EUIPO Board of Appeal, contending that its application did not specify, and thus did not include, career consultancy services within Class 41. InnovTech argued that EUIPO's objections were unfounded and that its trade mark application had been improperly refused.

4. The EUIPO Board of Appeal observed that career consultancy services were not traditionally regarded as part of "education," "providing of training," "entertainment," or "sporting and cultural activities."

5. Moreover, the Board noted that, in addition to the alphabetical list containing 200 entries for services under Class 41 of the Nice Classification, EUIPO's database contained more than 3,000 specific entries for services in Class 41. These entries highlighted a broad and varied classification framework for trade mark applications.

6. The Board emphasized that if the initial decision were upheld,

InnovTech's application would extend to services not explicitly covered by its original specification. This interpretation, the Board contended, contradicted the principle requiring goods and services in trade mark applications to be identified with clarity and precision.

In light of these considerations, the EUIPO Board of Appeal suspended proceedings and referred the following questions to the Court of Justice of the European Union for a preliminary ruling:

a. Should goods or services specified in a trade mark application be identified with a particular degree of clarity and precision, and if so, what criteria should be applied?

b. Is it permissible to use the general headings of the Nice Classification to identify goods and services in trade mark applications?

c. Should such general terms be interpreted in line with Communication No 4/03 of the Nice Classification, and how does this affect the scope of trade mark protection?

CASE 3

James Mapleton designs and produces premium handbags.

1. On 15 March 2015, Mr. Mapleton filed an application for registration of a trademark with the European Union Intellectual Property Office (EUIPO), leading to the registration, on 10 April 2015, under number 1259876, of a trademark for goods in Class 18 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and corresponding to the following description: "Handbags and purses (excluding medical or orthopedic goods)".

2. The mark is described as follows: "The mark consists of the pattern 'Pearl Wave' applied to the exterior of a handbag, as shown in the attached illustration. The shape of the handbag is not part of the trademark but is intended to demonstrate the positioning of the mark."

3. On 5 June 2020, an amendment to the registration limited the goods covered to "luxury handbags and clutches."

4. In mid-2020, Luxe Collective, a retail chain operating in Spain, sold handbags bearing a pattern identical to the registered mark "Pearl Wave."

5. On 12 August 2020, James Mapleton initiated legal proceedings before the Audiencia Provincial de Madrid (Provincial Court, Madrid, Spain), claiming that Luxe Collective had infringed the mark at issue. On 30 September 2020, the court issued an interim injunction partially upholding Mr. Mapleton's claims.

6. Luxe Collective appealed the judgment, arguing that the mark at issue was invalid under Article 4 of Regulation (EU) 2017/1001. They contended that the registered mark was a decorative element and not a distinctive feature indicative of origin.

7. The Audiencia Provincial de Madrid (Provincial Court) observed that the "Pearl Wave" pattern, when applied to handbags, could not be regarded purely as a two-dimensional decorative design. It considered that consumers in Spain associated the "Pearl Wave" pattern with Mapleton's brand due to its

exclusivity and aesthetic uniqueness. However, the court questioned whether the aesthetic appeal of the pattern could disqualify it from trademark protection under EU law.

8. Moreover, the court noted that, as of 2020, a significant number of consumers in the EU recognized Mapleton's handbags by the "Pearl Wave" pattern, linking it directly to his brand.

9. Finally, the court considered whether the "Pearl Wave" pattern was an essential characteristic that added substantial value to the handbags, making it subject to limitations under Article 4 of Regulation (EU) 2017/1001. The court queried whether the notion of "shape" in the regulation could extend beyond three-dimensional properties to include surface patterns and textures.

10. In light of these considerations, the Audiencia Provincial de Madrid decided to suspend the proceedings and referred the following question to the European Court of Justice for a preliminary ruling:

"Does the concept of 'shape,' as provided in Article 4(1)(e)(iii) of Regulation (EU) 2017/1001, cover only the three-dimensional attributes of a product, or can it also include non-three-dimensional properties, such as surface patterns or textures?"

How would you answer to this question?

CASE 4

The ‘Bellagio’ sign is widely recognised internationally, mainly for the ‘Bellagio Spark’ mineral water, available in various options. This sign is not registered as a single trade mark in the European Union, but as a national trade mark, both word and figurative, in all the Member States of the European Union and the European Economic Area (EEA). These national trade marks are essentially identical.

Initially, all the Bellagio brands registered in the EEA (the so-called ‘parallel brands’) belonged to Global Waters Inc.

In 2005, Global Waters Inc. sold RefreshCo a part of these parallel brands, particularly those registered in France. Global Waters Inc. retained ownership of another part of these parallel brands, including those registered in Germany.

Following various reorganisations and changes, the parallel brands held by Global Waters Inc. now belong to PureFlow International, a company based in Canada.

This latter company has granted an exclusive licence to AquaBell to exploit the German parallel marks involved in the main proceedings.

Both AquaBell and PureFlow International are controlled by PureFlow Holdings BV, a holding company based in the Netherlands.

On 18 June 2014, AquaBell filed a lawsuit against BlueWave Distribution, accusing it of trademark infringement. BlueWave allegedly imported and distributed bottles of mineral water bearing the name Bellagio, originating in France, in Germany. AquaBell claims that these bottles were manufactured and commercialised without its consent, but by RefreshCo, which, according to AquaBell, has no economic or legal links with the PureFlow group. It also argues that, given the identical use of the name and the bottles, consumers cannot distinguish the origin of these products.

In defence, BlueWave argues that the trademark right has been exhausted under Article 7(1) of Directive 2008/95/EC, claiming that tacit consent to

the sale should be considered due to the long coexistence between the RefreshCo and PureFlow groups in the exploitation of the 'Bellagio' sign.

What solution would you give to this case?