



Beatriz Bejarano

Barcelona court confirms legitimacy of Tommy Hilfiger's use of TH sign

GRAU & ANGULO
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Intellectual Property, Spain

🕒 Background

🕒 Decision

On 4 December 2019 the Barcelona Commercial Court No 6 dismissed an action for trademark infringement brought against Hilfiger Stores Spain, SL (HSS) and upheld its counterclaim, declaring partial revocation for non-use of the plaintiff's Spanish trademark registered for clothing, footwear and hats (Class 25) and leaving it registered exclusively for "occasion hats" and "women's formal party hats".

Background

The plaintiff owns the Spanish trademark TH TOLENTINO HAUTE HATS SEVILLA (mixed), which consists of the interlocking 'TH' lettering under the denomination 'TOLENTINO HAUTE HATS SEVILLA' and is registered for the aforementioned goods in Class 25. The plaintiff brought an action for infringement of its trademark against HSS for marketing certain products (eg, bags, wallets, ties and jewellery) bearing the TH sign (ie, the acronym of the Tommy Hilfiger company) together with other elements.

HSS rejected the existence of trademark infringement and counterclaimed by requesting the total cancellation of the plaintiff's trademark on the grounds that it was not using the sign as registered. Alternatively and to the extent that the court found that the plaintiff's trademark was being used, HSS brought an action for partial cancellation of the trademark on the grounds that it was indeed being used for only some of the goods for which it was registered – namely, "women's formal hats and occasion hats".

Decision

The Barcelona Commercial Court No 6 rendered its judgment on 4 December 2019.

Regarding the counterclaim for total and partial cancellation of the trademark for non-use, after examining Spanish and European Court of Justice (ECJ) case law requirements for proving genuine use of trademarks, the court examined the proof of use submitted by the plaintiff and held that:

- the proof submitted in relation to women's bags and wallets was irrelevant as a defence to the cancellation action, since the plaintiff's trademark was not registered for that type of goods, but only for goods in Class 25;
- the proof submitted by the counterclaimed plaintiff was deficient for the purpose of proving the

- extent, place, time and duration of the real and effective use of its registered trademark in relation to all of the goods for which it was registered (eg, order forms, invoices and delivery notes directly linked to the goods marked with the registered sign were not provided and many of the submitted documents were not dated or did not refer to the period of interest); and
- the trademark's use would exist as registered – at least in several elements linked to the marketing of goods such as boxes, packaging, business cards and website – but only for the sub-category of "occasion hats" and "women's formal hats for parties".

The court therefore declared partial cancellation of the plaintiff's trademark in respect of "footwear, clothing and hats", with the exception of "occasion hats" and "women's formal hats for parties".

As regards the trademark infringement action, the court clarified that the examination between goods is limited to those goods to which the plaintiff's trademark had been limited and those identified by the defendant with the sign in question: handbags, wallets and bags (Class 18), ties (Class 25) and jewellery (Class 14). Following ECJ case law, the Barcelona Commercial Court No 6 stated that it is a question of assessing whether there is identity or similarity between the signs and goods in question that would allow the existence of a likelihood of confusion to be affirmed.

On the comparison between the goods concerned, the court dismissed the identity between the goods at issue, as well as the similarity between hats and jewellery, since they were not competing or interchangeable goods. It only considered that there was a slight similarity between the plaintiff's hats and the handbags and wallets marketed by the defendant, since they were aimed at the same sector of the public and similarly displayed and accessed.

As regards the comparison of the signs, the court pointed out that the identity must be made between the plaintiff's TH TOLENTINO HAUTE HATS SEVILLA sign (in its registered form) and the sign used by the defendant on the market, which consisted of interlocking 'TH' lettering alongside other elements. Contrary to the plaintiff's allegations, the court rejected the identity between the conflicting signs. It also dismissed the likelihood of confusion between the signs at issue on the grounds that:

- the interlocking 'TH' lettering in the plaintiff's trademark is not the dominant element, but rather 'TOLENTINO' – which has a strong distinctive character – and the expression 'HAUTE HATS' (the plaintiff had highlighted the name TOLENTINO on its business cards and publications, which, according to the court, would be an acknowledgement that the sign fulfils the function of identifying the business origin of its products);
- even if the interlocking 'TH' lettering was the dominant element of the plaintiff's sign, an average consumer would remember it along with the other elements, especially with TOLENTINO, which cannot be ignored; and
- on the defendant HSS's handbags and wallets, the interlocking 'TH' lettering was placed together with the well-known brand name TOMMY HILFIGER, all of which supports the lack of any likelihood of confusion.

The court ordered the plaintiff to pay the costs of the claim and counterclaim.

This judgment is not final.

For further information on this topic please contact Beatriz Bejarano at Grau & Angulo by telephone (+34 93 202 34 56) or email (b.bejarano@ga-ip.com). The Grau & Angulo website can be accessed at www.ga-ip.com.

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