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Sweden: First judgment on reputation following CJEU's IMPULSE-judgment

David Leffler (Cirio Law Firm) · Thursday, March 10th, 2016

On March 3, the Swedish Court of Patent Appeals ('PBR') delivered a judgment on the effect of a reputed EUTM in a single member state. PBR held that even if the EUTM 'SKY' et al were extensively used and had proven reputation in the UK and Ireland, and therefore in the EU, no recognition of the marks was proven for Sweden. Consequently, 'SKY' et al could not benefit from their reputation in the proceedings in Sweden.



The case has case number 14-166 and concerns an opposition in Sweden against the Swedish trademark registration No 506.946 'SKYDOMINO' in classes 35 and 38 (can be found [here](#) in Swedish). In Sweden, oppositions are post-registration and the opponents Sky IP International Limited and Sky International AG therefore sought to invalidate the registration on the basis of, inter alia, their EUTM 'SKY' No 10 032 282 registered in, amongst others, classes 35 and 38.

In first instance, the Swedish Patent and Trademark Office ('PRV') had held that 'SKY' had shown reputation of its EUTM based on recognition in the UK and Ireland. However, PRV held that as the reputation is limited to the UK and Ireland, the EUTM could not benefit from the reputation or enhanced distinctiveness where Sweden is the relevant territory. Nevertheless, PRV held that even considering the inherent distinctiveness of the EUTM 'SKY', there was a likelihood of confusion in relation to the contested registration 'SKYDOMINO'. 'SKYDOMINO' was therefore invalidated in its entirety. PRV's decision is dated 16 October 2014 which means that it was delivered before the CJEU's judgment 3 September 2015, C-124/14, 'IMPULSE' (found [here](#)).

The proprietor of SKYDOMINO appealed the decision to PBR and argued that there was no likelihood of confusion between the signs. In their submissions to PBR, the two Sky-companies

argued heavily that an EUTM that is considered reputed because of sufficient recognitions within the EU, should benefit from the extended protection throughout the EU, including Sweden. The opponents therefore argued that PRV was wrong and that the contested trademark should be invalidated based on the reputation of the earlier rights.

In its decision, PBR held that the earlier trademark ‘SKY’ is known in a substantial part of the EU in relation to TV broadcasting services because of the relevant consumers’ recognition of the mark in the UK and Ireland. The trademark was therefore considered reputed in the EU. PBR, however, stated that the earlier trademark was not known by a substantial part of the relevant consumers in Sweden. PBR continued by making a reference to paragraphs 27-34 of the IMPULSE judgment and stated that if the earlier EUTM has already acquired a reputation in a substantial part of the territory of the EU, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the EUTM may benefit from the extended protection where it is shown that **a commercially significant part of that public is familiar with that mark**, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future (emphasis added by the author).

PBR consequently assessed the evidence submitted and concluded that the opponents had failed to provide any reliable evidence showing the relevant consumers’ knowledge of the trademark SKY in Sweden. As no recognition was proven, PBR, therefore, confirmed PRV’s decision in first instance in that the earlier marks could not benefit from any reputation or enhanced distinctiveness in Sweden.

In respect of a likelihood of confusion, PRV’s decision of a likelihood of confusion was also confirmed and the contested mark was invalidated in full.

This case is interesting as it is the first case in Sweden where a court has assessed the impact of a reputed EUTM which is not reputed in Sweden. Nevertheless, since the opponents failed to submit any reliable evidence in relation to the recognition in Sweden, we are still kept in the dark as to the threshold of CJEU’s new criteria of ‘commercially significant part of the public’ established in the IMPULSE judgment.

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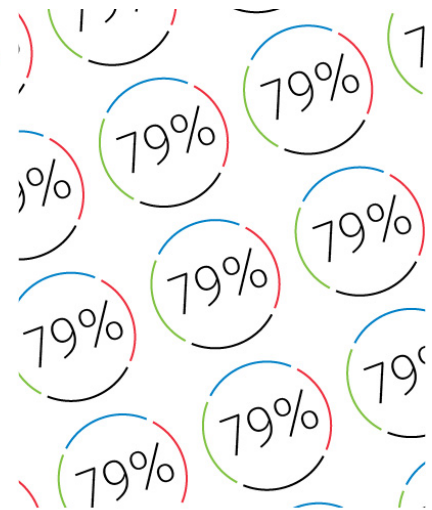
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