QORTI CIVILI PRIM' AWLA

S.T.O. PRIM IMHALLEF MARK CHETCUTI

Illum l-Erbgha, 17 ta' Marzu, 2021

Numru 1

Rikors Guramentat Nru. 460/2020

Avukat Dottor Luigi A. Sansone LL.B. (Hons.), LL.D.,
bhala mandatarju specjali ta' Bedrock SA, socjeta estera
registrata fl-Isvizzera u b'indirizz ta'
4 Chemin des Vergers, CH-1208 Ginevra, Svizzera

vs

Bedrock Investments Limited

Il-Qorti,

Rat ir-rikors guramentat tal-attur nomine tad-19 ta' Gunju, 2020 li jghid hekk:

1. illi s-socjeta attrici, boutique company indipendenti li tipprovdi servizzi globali ta' investiment oltre ghal konsulenza finanzjarja u mprenditorjali, hija wahda mill-intraprizi ewlenin fis-settur taghha fl-Ewropa fejn ilha topera b'success kbir sa mis-sena 2004. B'rizultat ta' hila, invenzjoni u promozzjoni reklamattiva, it-trade marks BEDROCK tas-socjeta attrici dwar tali servizzi kisbu reputazzjoni u avvjament konsiderevoli;

2. illi fost ohrajn, is-socjeta attrici tgawdi minn registrazzjoni f'isimha ghat-territorju tal-Unjoni Ewropea u tar-Renju Unit (din tal-ahhar parti ntegrali tas-sistema tal-EU trade marks sal-ahhar tas-sena 2020), tal-EU trade mark BEDROCK (kelma, numru 011482296), registrata b'effett mill-11 ta' Jannar 2013 fi klassijiet 35 u 36 rispettivament tal-Klassifikazzjoni Nternazzjonali ta' Prodotti u Servizzi taht in-Nice Agreement (kif sussegwentement emendat), dwar is-segwenti servizzi:

(a) klassi 35: Business management; business administration: office functions: commcercial research services, including collection, storage and processing of business and financial information, analysis of research and provision of reports; economic forecasting and analysis for business and financial purposes; business risk assessment and management services; business management of real estate (for others); advisory services relating to real estate valuations advertising services; marketing services; promotion services; database management services; personnel management consultancy and administration services; payroll system consultancy and administration services; systemization of personnel management information into computer databases; taxation services; tax planning services: information, advisory and consultancy services related to all the aforesaid services; u

(b) klassi 36: Financial services; providing of financial products; financial information and evaluations; financial management; insurance information and consultancy, financial affairs; financial services by means of computer systems; providing of investment funds and other financial products: wealth management services; banking services; merchant banking services; consultancy to companies and individuals regarding wealth management; portfolio management; loans; debt collection, issuing of travelers' cheques and letters of credit; underwriting services; hedge fund services; project finance; management and brokerage of funds, financial consultancy; mutual fund distribution and brokerage services, investment counselling services, real estate investment services, mutual fund administration and investment advisory services; services relating to monetary affairs; financial affairs and banking; providing of financial information via cornputer systems; electronic banking services via a global computer network (internet banking); interactive electronic handling of financial and banking services via global computer networks; stock exchange affairs, including trading in securities, derivatives and currencies: monetary affairs; financial advice relating to wills; brokerage services and contract brokerage and/or consultancy in connection with insurance, financial affairs, banking, real estate affairs and monetary affairs; real-estate affairs; real estate investment; real estate agency services: leasing of real estate; real estate appraisals; real estate brokerage services; real estate management; financial evaluation of real estate; real estate valuations; real-estate management; real estate affairs; management of pooled real estate investments; management of real estate companies; services relating to real estate affairs: property investments; real estate financing; financial consultancy in ihe field of payment systems; managment of hedge fund institutions; financial transaction services; consultancy in the field of financial planning and financial management; services in the field of investment and risk management; financial management; trust financial services; fiscal valuations; drooping up financial reports; valuation of assets; financial sponsorship; asset and fund management; arranging and advising on the financial aspects of joint ventures, limited partnerships, leveraged leases, sales and lease backs, and side-by-side leasehold structures: property unit trusts; arranging equity sharing deals; developing and organising securitization financial structures; fund investment; capital investment; lease-purchase financing; insurance in relation to real estate; stock and bonds brokerage; credit bureaux; debt collection agencies; foreign exchange bureau; financial analysis; savings banks; retirement savings plans; credit card services; debit card services; debit card services; surely services; mutual funds; financial, insurance, financial investment, stock market consultancy; stock exchange quotations; securities brokerage; credit bureau; deposits of valuables; safety deposit services; issuing of

tokens of' value; issuing of cheques, verification of cheques; issuing of travellers' cheques; issuing bills of exchange, letters of credit, credit cards, identity cards; payment cheque, letters of credit, bills of exchange; dispensing banknotes and coins: savings; investment funds; pension funds; capital investments; capital investment brokerage; exchanging money; banking; monetary transactions: instalment loans; payment of funds; loans (financing); lending against securities; financial transactions; electronic funds transfers; financial information; financial and banking management; research and canvassing of financial markets with a view to the investment and management of transferable securities; online banking; online information on bank accounts, foreign exchange and foreign exchange rates, on stock market quotations, unit trusts; portfolio management; payment, loan, surety services: debt collection; factoring; management of collective savings for others; management of unit trusts for companies with save-as-you-earn schemes; fiscal assessments; tax estimates; tax advisory services; lift assurance; insurance brokerage; issuing of electronic purses; underwriting services; debt collection; issuing of travellers' cheques and letters of credit; portfolio management; financial evaluation (insurance, banking, real estate); financing services; mutual funds; direct banking; loans (financing); lending against security; financial and banking management; research and prospecting of financial markets and of the management of transferable securities; mediation in the purchase and sale of shares and other forms of participation in company partnerships, legal persons, enterprises and other similar entities; consultancy and negotiation for others in relation to financial arrangements; all of these services may be provided via the internet; management of transferable securities; information, consultancy and advisory services with regard to all the aforesaid services.;

3. illi s-socjeta attrici ghandha fil-pussess taghha evidenza cara li turi li, minghajr il-kunsens taghha, il-kumpanija konvenuta giet inkorporata fit-22 ta' Gunju 2015 bl-isem ta' "Bedrock Investments Limited" u ghadha sallum tezisti b'dan I-isem, u kwindi isem li tinkorpora mhux biss it-trade mark tal-Unjoni Ewropea BEDROCK tas-socjeta attrici izda anke deskrizzjoni ta' attivitajiet imprenditorjali fin-natura ta' investimenti, cioe ezattament generu ta' servizzi li dwarhom il-marka attrici hawn qabel indikata tinsab registrata u wzata b'success fl-Unjoni Ewropea;

4. illi fil-fatt, bhala I-ewwel zewg ghanijiet indikati fl-istatut socjetarju taghha meta debitament irregistrata, il-kumpanija konvenuta ndikat is-segwenti:
"(a) To purchase, acquire, own, hold, manage, lease, administer, sell or otherwise dispose of property of any kind, whether immovable or movable, personal or real, and whether or not belonging to the Company.

(b) To subscribe for, take, purchase, sell, invest in, exchange or otherwise acquire, hold, manage, develop, deal with and turn into account any bonds, debentures, shares (whether fully paid or not), stocks, options or securities of governments, states, municipalities, public authorities, or public or private, limited or unlimited companies, and whether on a cash or margin basis and including short sales and to lend or borrow money against the security of such bonds, debentures, shares, stocks, options or other securities;

(c) To acquire, hold, develop and exploit patents, licences, trademarks, royalties, copyrights, grants, options, concessions and intellectual property rights of whatever

nature and by whatsoever name called and other exclusive and non-exclusive rights and to grant licences or rights in respect thereof;"

5. illi jidher li mill-ewwel wara li kienet giet inkorporata il-kumpanija konvenuta kienet bdiet tiivolgi attivitajiet kummercjali tant hu hekk li wara biss ftit aktar minn xahar minn meta giet imwaqqfa, u aktar precizament fid-29 ta' Lulju 2015, l-istess kumpanija konvenuta kienet avzat ufficjalment lir-Registratur tal-Kumpaniji ta' Malta bis-segwenti:
"the company is carrying on business, or has business interests to the extent of more than ninety per cent outside Malta... .";

6. illi fis-7 ta' Jannar 2016 il-kumpanija konvenuta biddlet l-istatut socjetarju taghha billi l-main objects clauses saru s-segwenti:
"(a) To provide buisiness and management consultancy services to any individual or any type of business entity located in any part of the world and to provide advisory services on methods of developing and improving such business entities in the fields of technology, industry and commerce as well as on matters relating to organisation, human resources and administration, the introduction of systems and methodologies or processes ofproduction, storage, distribution, marketing of products and systems of sales and sales promotion and to undertake research and special studies on all abovementioned matters;

(b) To acquire, hold and resell franchises, licenses, rights, patents, trademarks and any other type of intellectual property as well as to sub-franchises and sub-licenses such franchises, licenses, rights, patents and trademarks. To sublease to any business entity in any part of the world any type of intellectual property relating to any field whatsoever;"

7. illi skont l-audited accounts registrati fit-23 ta' Settembru 2016 (dwar il-perjodu 22 ta' Gunju 2015 sal-31 ta' Dicembru 2015) l-attivitajiet principali tal-kumpanija konvenuta gew deskritti bhala "to hold investments and lend funds, give advances and other credit facilities to group companies.", filwaqt li skont l-audited accounts registrati fil-5 ta' Jannar 2018 (dwar il-perjodu li ntemm fil-31 ta' Dicembru 2016), is-socjeta konvenuta ma ndikatx effettivament f'xiex kienu jikkonsistu l-attivitajiet principali taghha izda l-awdituri osservaw li:
"the company incurred a loss of €103,819 during the year ended 31 December 2016 and, as of that date, the company's total liabilities exceeded its total assets by €334,944. these events or conditions indicate that a material uncertainty exists that may cast significant doubt on the company's ability to continue as a going concern…".
Ma hemm ebda sett ta' audited accounts ulterjuri pprezentati mill-kumpanija konvenuta fir-Registru tal-Kumpaniji ta' Malta;

8. illi di piu, jidher li l-qaghdha finanzjarja tal-kumpanija konvenuta kompliet taggrava ruhha maz-zmien, tant hu hekk li:
(a) fl-2018, jidher li dwar il-kumpanija Portogiza Atlas Koechlin Engineering And Design, Unipessoal Lda (indikata fl-audited accounts prezentati mill-kumpanija konvenuta bhala ta' proprjeta esklussiva taghha), inbdew procedimenti ta' insolvenza;

(b) fl-2019, il-kumpanija lokali Fairwinds Management Limited baghtet ittra lir-Registratur tal-Kumpaniji (liema ittra giet inkorporata bhala dokument mhux registrat flimkien mad-dokumenti ufficjali dwar il-kumpanija konvenuta matul l-ewwel nofs ta' Mejju 2019) fejn indikat li l-kumpanija konvenuta qed izzomm l-indirizz registrat taghha ta' Abacus Business Centre, Level 1, Dun Karm Street, B'kara Bypass, Birkirkara BKR9037, Malta, minghajr il-kunsens u awtorizzazzjoni tal-istess Fairwinds Management Limited; u

(c) sallum, l-audited accounts ghall-perjodi li ntemmu 31 ta' Dicembru 2017 u 31 ta' Dicembru 2018 u li kellhom jigu sottomessi sat-12 ta' Dicembru 2018 u 12 ta' Dicembru 2019 rispettivament, kif ukoll l-annual return tas-sena 2019 li kellha tigi sottomessa sat-3 ta' Awwissu 2019, jidher li ma gewx sottomessi;

9. illi l-attivitajiet tal-kumpanija konvenuta taht l-uzu tal-isem socjetarju "Bedrock Investments Limited" hawn aktar qabel indikati, sehhew ruhhom/qed isehhu minghajr il-kunsens tas-socjeta attrici kif hawn qabel indikat u bi pregudizzju ghall-jeddijiet tal-istess socjeta attrici fid-dawl ta' ksur min-naha tal-kumpanija konvenuta, dwar l-EU trade mark bin-numru 011482296 — BEDROCK tas-socjeta attrici,
fl-ewwel lok, tal-Artikolu 9.(2)(b) tar-Regolament U.E. 2017/1001 fuq il-European Union trade mark, li jaghti lis-socjeta attrici d-dritt to prevent all third parties not having his consent from using in the course of trade, in relation to ... services, any sign where: .. the sign is ... similar to, the EU trade mark and is used in relation to ... services which are identical with, or similar to, the ... services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark. ,
u
fit-tieni lok, tal-Artikolu 9.(2)(c) tar-Regolament U.E. 2017/1001 fuq il-European Union trade mark, li jaghti lis-socjeta attrici d-dritt to prevent all third parties not having his consent from using in the course of trade, in relation to ... services, any sign where: .. the sign is similar to, the EU trade mark ... in relation to ... services which are identical with, similar to ... those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to the repute ofthe EU trade mark.;

10. illi dwar likelihood of confusion li jikkomprendi likelihood of association, jigi rilevat li hawnhekk si tratta ta' partijiet kontendenti li t-tnejn jipprovdu servizzi dwar investimenti u business management. B'daqstant, f'dan il-kaz il-core services huma simili u, jew talvolta prattikament identici mill-perspettiva tal-konsumatur rilevanti. Tenut kont ukoll ta' dan, oltre ghall-fatt li s-sinjal kontravvenjenti "Bedrock Investments Limited" huwa tant simili ghall-EU trade mark tas-socjeta attrici BEDROCK, ifisser li l-probabbilta ta' konfuzjoni minn naha tal-pubbliku, inkluza l-probabbilita ta' assocjazzjoni bejn is-sinjal konfliggenti "Bedrock Investments Limited" u din l-istess EU trade mark BEDROCK u kwindi ideja qarrieqa ta' ness ekonomiku bejn il-partijiet f'din il-kawza meta fil-fatt tali ness ma jezistix, hija cara u manifesta;

11. illi dwar vantagg ingust/detriment, jigu rilevati s-segwenti:
fl-ewwel lok, free riding: bl-agir taghha, il-kumpanija konvenuta qed tisfrutta r-reputazzjoni madwar l-Unjoni Ewropea fl-EU trade mark tas-socjeta attrici hawn

qabel specifikata u debitament assocjata ma' l-oghla livelli fil-kampi tas-servizzi ta' investiment u business management, billi qed tirkeb b'xejn (free riding) minn fuq is-success ta' din l-istess marka registrata u kwindi tibbenefika kummercjalment mill-attrazzjoni, mir-reputazzjoni u mill-prestigju tal-istess;

fit-tieni lok, detriment/dilution: l-uzu kontravvenjenti hawn qabel specifikat min-naha tal-kumpanija konvenuta, qed ikollu l-effett li jiznatura u jippregudika l-funzjoni bazika tal-istess EU trade mark tas-socjeta attrici hawn qabel specifikata, cioe dik li biha s-servizzi tas-socjeta attrici huma distinti minn ta' dawk ta' terzi; u

fit-tielet lok, tarnishment: kemm l-agir tal-kumpanija konvenuta kif ukoll certi konsegwenzi ta' dan l-istess agir (li jinkludu l-fatt li l-kumpanija konvenuta jidher li tinsab fi stat finanzjarjament prekarju u sahansitra, fl-ewwel lok, ghandha s-sussidjarja taghha Atlas Koechlin Engineering And Design, Unipessoal Lda li jidher li minn Frar 2018, qieghda fi proceduri ta' insolvenza, fit-teni lok, jidher li lanqas biss ma tinsab awtorizzata tkompli tuza l-indirizz registrat attwali taghha u, fit-tielet lok, jidher li tinsab in mora dwar il-prezentata tal-audited accounts u l-annual return statutorji min-naha taghha kif hawn aktar qabel specifikat), jistghu jheggu konsumaturi rilevanti (attwali u potenzjali) sabiex jahsbu negattivament dwar is-servizzi tas-socjeta attrici u b'daqstant dwar is-socjeta attrici stess, dan kollu ghad-detriment tar-reputazzjoni tal-istess EU trade mark tas-socjeta attrici hawn qabel specifikata. Dan huwa aktar u aktar gravi f'cirkustanzi fejn fil-kamp tal-konsulenza f'investimenti finanzjarji r-reputazzjoni u l-integrita tas-service provider huma tant essenzjali;

12. illi dwar dawn is-sitwazzjonijiet ta' ksur ta' jeddijiet u danni konsegwenzjali anke tenut kont tal-Att li jirregola l-Infurzar ta' Drittijiet ta' Proprjeta Intellettwali (Kapitolu erbgha mija tmienja u tmenin (488) tal-Ligijiet ta' Malta), is-socjeta attrici ghandha rimedji appoziti spettanti lilha skont il-ligi in materja, u konsegwentement qed tippromwovi din il-kawza quddiem din l-Onorabbli Qorti bhala l-EU trade mark court ta' prim'istanza kompetenti f Malta;

13. illi nonostante l-hrug ta' ittra nterpellatorja min-naha tas-socjeta attrici datata 7 ta' Frar 2020, il-kumpanija konvenuta xorta wahda baqghet inadempjenti;

14. illi l-fatti hawn kollha dikjarati huma maghrufin personalment mill-esponenti;

15. illi ghalhekk kellha ssir din il-kawza;

Ghaldaqstant ghar-ragunijiet hawn qabel premessi l-attur nomine umilment jitlob li din l-Onorabbli Qorti:

(1) tiddikjara li l-uzu fil-kors tal-kummerc da parti tal-kumpanija konvenuta, tas-sinjal "Bedrock Investments Limited", jikkontravvjeni l-jeddijiet tas-socjeta attrici dwar l-EU trade mark bin-numru 011482296 — BEDROCK, kontenuti fl-Artikolu disgha (9) subartikolu tnejn (2.) paragrafu "b" tar-Regolament U.E. numru elf u wiehed (1001) tas-sena elfejn u sbatax (2017) (Council Regulation (EC) No 2017/1001) dwar il-European Union trade mark;

(2) tiddikjara li l-uzu fil-kors tal-kummerc da parti tal-kumpanija konvenuta, tas-sinjal "Bedrock Investments Limited", jikkontravvjeni l-jeddijiet tas-socjeta attrici dwar l-EU trade mark bin-numru 011482296 — BEDROCK, kontenuti fl-Artikolu disgha (9) subartikolu tnejn (2.) paragrafu "c" tar-Regolament U.E. numru elf u wiehed (1001) tas-sena elfejn u sbatax (2017) (Council Regulation (EC) No 2017/1001) dwar il-European Union trade mark;

(3) tordna fil-konfront tal-kumpanija konvenuta, projbizzjoni ta' tkomplija tal-azzjonijiet kontravvenjenti taghha, inkluza ordni ta' tibdil fl-isem socjetarju tal-kumpanija konvenuta ghal isem iehor mhux leziv tal-jeddijiet tas-socjeta attrici fir-rigward tal-EU trade mark bin-numru 011482296 — BEDROCK, u dan taht kwalunkwe kundizzjoni li din l-Onorabbli Qorti thoss li tkun gusta u xierqa fic-cirkustanzi sabiex jigi assigurat li l-kumpanija konvenuta tattjeni ruhha ma' tali ordni ta' projbizzjoni.

Bl-ispejjez ta' din l-istanza, ta' kwalunkwe procedura fl-atti gudizzjarji taghha u, jew relatata maghha, u tal-ittra nterpellatorja datata 7 ta' Frar 2020, ilkoll kontra l-kumpanija konvenuta li tibqa' minn issa ngunta ghas-subizzjoni taghha.

Rat li s-socjeta konvenuta hi kontumaci;

Rat l-atti u semghet lid-difensur tas-socjeta attrici;

Rat li l-kawza thalliet ghas-sentenza.

Ikkunsidrat

Provi

Dr Claudette Fenech, legal advisor mar-Registratur tal-kumpaniji pprezentat Dok. CF1 kopja legali tal-file kollu tal-kumpanija Bedrock Investments Ltd C 71149.

Dr Luigi Sansone xehed li s-socjeta minnu rapprezentata ghandha European Union Trade Mark registrata fil-klassi 35 u 36. Is-socjeta attrici kisbet reputazzjoni maz-zmien fir-Renju Unit. Il-kawza saret meta ir-Renju Unit kien ghadu membru tal-Unjoni. Il-kumpanija attrici ssostni li l-kumpanija konvenuta qed ikollha *deleterious effect* fuq ir-reputazzjoni tat-trademark taghhom u dana johrog mid-dokumenti tal-Malta Business Registry. Din il-kumpanija kienet qed tinnegozja barra minn Malta bl-isem BedRock Investments Limited fejn disghin fil-mija tan-negozju kien isir fl-esteru. Dan l-investiment kien f'kumpanija Portugiza u mill-audited accounts jidher li l-investiment mar hazin u l-kumpanija tinstab fi stat ta' falliment u hemm Court Liquidation Procedure (Dok. E u J). Hija kienet qed taghmel *class 35 activity* fl-istess

klassi li fiha hija registrata s-socjeta attrici. F’Dok. L (fol. 65) hemm li l-liability tal-kumpanija kien jeccedi t-total assets b’€334,944. Jirrizulta wkoll li hemm audited accounts li ghadom ma gewxipprezentati kif jidher mill website online tal-Malta Business Registry. It-trade mark tal-kumpanija attrici mhux biss hija uzata imma akkwistat ukoll reputazzzjoni. Anke kieku t-trademark ma kellhiex din ir-reputazzjoni fir-Renju Unit taht l-artikolu 9(2)(c) hemm l-artikolu 98(2)(b) li jipprovdi ghal ‘likelihood of confusion’ ghax il-kumpanija konvenuta qed tikser id-drittijiet tas-socjeta attrici (xhieda ta’ Dr Sansone).

Kontumaci

Jigi rrilevat li ghalkemm is-socjeta konvenuta hija kontumaci, dan ma jfissirx li din hi xi forma ta’ ammissjoni. Illi l-istitut tal-kontumacja ma jfissirx abbandun tal-kontestazzjoni. Ghalkemm il-konvenuti jibqghu kontumaci, dan ma jaghtix lok ghall-prezunzjoni tal-abbandun tal-liti, ghad-difett ta’ eccezzjonijiet legittimi, jew ghal adezjoni ghad-domanda. Il-gudikant ghandu jezamina jekk it-talba hix gustifikata indipendentement mill-kontumacja tal-konvenut (**Giuseppe Wismayer vs Giovanni Magro**, Kost 24/11/1934, Kollez. Vol. XXIX, P III, pg 35). Ladarba l-kontumacja ma tfissirx ammissjoni imma tfisser kontestazzjoni, l-attur xorta ghandu jipprova t-talbiet tieghu u l-premessi ghalihom (**Joseph Edmond sive Jesmond Mizzi vs Brian Mizzi nomine**, App 27/03/1996).

Talbiet

Illi s-socjeta attrici ppremettiet li l-attivitajiet tal-kumpanija konvenuta taht l-isem "Bedrock Investments Limited" minghajr il-kunsens tas-socjeta attrici u bi pregudizzju ghall-jeddijiet tal-istess socjeta attrici jiksru l-EU *trade mark* taghha bin-numru 011482296 – BEDROCK.

Ghalhekk talbet li din il-Qorti

-tiddikjara li l-uzu tas-sinjal "Bedrock Investments Limited", jikkontravvjeni l-jeddijiet tas-socjeta attrici dwar l-EU *trade mark* bin-numru 011482296 - BEDROCK, ai termini tal-Artikolu 9(2)(b) u (c) tal-*Council Regulation (EC) No 2017/1001)* dwar l-*European Union trade mark;*

-tordna fil-konfront tal-kumpanija konvenuta, l-projbizzjoni ta' tkomplija tal-azzjonijiet

kontravvenjenti taghha, inkluza ordni ta' tibdil fl-isem socjetarju tal-kumpanija konvenuta ghal isem iehor.

Ligi

Is-socjeta attrici qed tippromwovi din il-kawza quddiem din l-Qorti bhala l-EU *trade mark court* ta' prim'istanza kompetenti f'Malta.

Id-drittijiet moghtija taht il-Council Regulations EU 2017/1001 huma:

> 1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.
> 2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:
> (a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;
> (b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
> (c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.

Konsiderazzjonijiet tal-Qorti

Il-Qorti se tibda billi tezamina l-ilment tas-socjeta attrici taht l-artikolu 9(2)(b) tal-Council Regulation EU 2017/1001 li jelenka r-rekwiziti taht dan is-sub-artikolu:

The sign is identical with, or similar to, the EU trade mark

Is-socjeta attrici ghandha registrazzjoni ghat-territorju tal-Unjoni Ewropea u tar-Renju Unit tal-EU *trade mark* BEDROCK numru 011482296, registrata b'effett mill-11 ta' Jannar 2013 fi klassijiet 35 u 36 tal-*Nice Agreement* (Class 35 Advertising; business management; business administration; office functions. Class 36 Insurance; financial affairs; monetary affairs; real estate affair). Min-naha l-ohra l-kumpanija konvenuta

giet inkorporata fit-22 ta' Gunju 2015 bl-isem ta' "Bedrock Investments Limited" hawn Malta imma topera anke barra minn Malta.

Jidher li l-isem tas-socjeta konvenuta jinkludi l-istess isem BEDROCK tas-socjeta attrici kif ukoll id-deskrizzjoni tal-attivitajiet imprenditorja li fin-natura ta' investimenti, hija ezattament fl-istess generu ta' servizzi li dwarhom il-marka attrici hi registrata. L-isem tal-kumpanija konvenuta gie registrat minghajr il-kunsens tas-socjeta attrici.

> **The sign is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered.**

Is-socjeta attrici, tipprovdi servizzi globali ta' investiment oltre ghal konsulenza finanzjarja u mprenditorjali fis-settur taghha fejn ilha topera b'success fl-Ewropa sa mis-sena 2004

Il-kumpanija konvenuta li giet inkorporata fit-2015 topera fl-istess settur tal-kumpanija attrici. Hi kienet indikat l-ghanijiet taghha fl-istatut taghha meta gie debitament irregistrata u fid-29 ta' Lulju 2015, l-kumpanija konvenuta kienet avzat ufficjalment lir-Registratur tal-Kumpaniji ta' Malta li:

> *"the company is carrying on business, or has business interests to the extent of more than ninety per cent outside Malta ....* ";

Illi ghalhekk is-socjeta konvenuta mhux biss qed topera fl-istess servizzi bhas-socjeta attrici, imma anke fl-isfera geografika fejn topera s-socjeta attrici.

> **If there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.**

Is-socjeta attrici tghid li l-agir tas-socjeta konvenuta qed johloq konfuzjoni fis-suq u qed jirrekalha dannu.

Hu mghallem li:

> A number of elements can be taken into account when determining whether or not exists a likelihood of confusion. In ***Sabel v. Puma**,* the European Court of Justice lists, in a non-exhaustive way, a number of factors that are to be taken into account by the national courts in arriving at their decision on the point of likelihood of confusion, and adds that account must be taken of

> all factors that are relevant in the circumstances of each individual case. These include the degree of recognition of the trade mark on the market, the degree of similarity between the sign and the trademark and between the goods and services that are labelled, as well as the possibilities to make associations with the registered trade mark.
> What is assessed is whether there is a likelihood of confusion in that the public might believe that the goods or services originate from the same undertaking or from economically linked under-takings.
> One must also take into account the distinctive character of the earlier mark. In particular, its reputation must be taken into account when determining whether the likelihood of confusion (**Holyoak & Torremans**, *Intellectual Property Law*, p 410).

Fil-kaz in ezami dwar *likelihood of confusion* li jinkludi *likelihood of association,* hawnhekk si tratta ta' partijiet li t-tnejn jipprovdu servizzi dwar investimenti u *business management. Il-core services* huma simili jekk mhux identici mill-perspettiva tal-konsumatur rilevanti. Inoltre l-fatt li s-sinjal "Bedrock Investments Limited" huwa tant simili ghall-EU *trade mark* tas-societa' attrici BEDROCK, ifisser li hemm probabbilta kbira ta' konfuzioni min-naha tal-pubbliku, inkluz il-probabbilita ta' assocjazzjoni bejn is-sinjal konfliggenti u kwindi idea qarrieqa ta' ness ekonomiku bejn il-partijiet **f'**din il-kawza meta fil-fatt tali ness ma jezistix.

Is-socjeta attrici ukoll ressqet provi biex turi li l-kumpanija konvenuta jidher li tinsab fi stat finanzjarjament prekarju u li jista` jwassal lill-konsumaturi jahsbu negattivament dwar is-servizzi tas-socjeta attrici b'detriment tar-reputazzjoni tal-istess EU *trade mark* taghha.

Illi ghalhekk il-Qorti qed issib ksur tad-drittijiet tas-socjeta attrici taht l-artikolu 9(2)(b) Council Regulations EU 2017/1001.

La darba l-Qorti qeda ssib li hemm ksur tad-drittijiet tas-socjeta attrici taht l-artikolu 9(2)(b), stante li l-marki huma simili u anke jikkrejaw konfuzjoni mhux il-kaz li l-Qorti tinoltra ruhha biex tezamina ksur taht is-subartikolu 2(c) abbbazi tar-reputazzjoni li s-socjeta attrici tghid li tgawdi fl-Unjoni Ewropea.

Decide

Ghal dawn il-motivi l-Qorti tiddeciedi billi tilqa` l-ewwel talba u tiddikjara li l-uzu fil-

kors tal-kummerc da parti tal-kumpanija konvenuta, tas-sinjal "Bedrock Investments Limited", jikkontravvjeni l-jeddijiet tas-socjeta attrici dwar l-EU *trade mark* bin-numru 011482296 - BEDROCK, kontenuti fl-artikolu disgha (9) subartikolu tnejn (2.) paragrafu "b" tar-Regolament U.E. numru elf u wiehed (1001) tas-sena elfejn u sbatax (2017) (*Council Regulation (EC) No 2017/1001)* dwar l-*European Union trade mark;*

Tastjeni milli tkompli tiehu konjizzjoni tat-tieni talba billi giet milqugha l-ewwel talba.

Tordna fil-konfront tal-kumpanija konvenuta, projbizzjoni ta' tkomplija tal-azzjonijiet kontravvenjenti taghha, u tordna t-tibdil fl-isem socjetarju tal-kumpanija konvenuta ghal isem iehor mhux leziv tal-jeddijiet tas-socjeta attrici fir-rigward tal-EU *trade mark* bin-numru 011482296 - BEDROCK, taht penali ta' €50 kull jum fin-nuqqas.

Tali tibdil fl-isem ghandu jsir fi zmien xahar.

Tali sentenza ghanda tigi notifikata lill-Malta Financial Services Authority u lill-Malta Business Registry, sabiex fin-nuqqas illi jinbidel l-isem tas-socjeta konvenuta mill-istess socjeta konvenuta fiz-zmien indikat, jiehdu dawk il-mizuri sabiex is-sentenza tigi mharsa.

Spejjez ghas-socjeta konvenuta.

Mark Chetcuti
Prim Imhallef

Anne Xuereb
Deputat Registratur