
INTELLECTUAL PROPERTY CASE WATCH *January 2010*

Daimler AG v Sany Group Limited

In October 2009, a multinational trade mark dispute between Daimler AG and Sany Group Limited was decided in Sany's favour by English court as it was deemed the two marks in dispute were not similar enough.

Daimler's "three-pointed star" is the earlier mark and agreed by all parties to be a famous mark. It has been used by Daimler since 1921, beginning in Europe and subsequently throughout the world, upon vehicles of many kinds.

Sany's three-pointed roundel device has been used since 1985 upon a range of heavy construction equipment and machinery, beginning in China and subsequently in many other countries.



Daimler's mark



Sany's mark

Daimler AG sought to prevent the use and registration of the Sany mark. Prior to the decision by the English court, Daimler had succeeded against Sany in France and Germany, but failed in New Zealand.

High Court Decision

Daimler alleged infringement and passing off. Sany counter-attacked Daimler's registrations by alleging non-use, in whole or in part, because the Daimler registrations had issued more than five years before and all such registrations are vulnerable to non-use revocation challenge.

At the hearing, Daimler withdrew its claim of passing-off, and restricted its infringement claim purely to Article 9(1)c of the Community Trade Marks Regulation and the parallel words in Section 10(3) of the UK Trade Marks Act 1994, namely that

(3) A person infringes a registered trade mark if he uses in the course of trade in relation to goods or services a sign which is identical with or similar to the trade mark, where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

However, the action failed because, the judge ruled that the marks simply did not meet the required level of similarity, so that the necessary link between Daimler's mark and Sany's sign was absent.