

# Judgments of the trimester of the Court of Justice and the General Court of the European Union

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## Judgments of the trimester of the CJEU and the GC

### Overview of the webinar

- I. Selection of judgments issued by the Court of Justice of the European Union ('CJEU'):
  1. in appeals involving the EUIPO as a party
  2. in requests for a preliminary ruling addressed by the courts of Member States of the European Union
- II. Selection of judgments issued by the General Court ('GC'):
  1. in disputes relating to European Union Trade Marks ('EUTM')
  2. in disputes relating to Registered Community Designs ('RCD')

## CJEU case-law

# Part I

## Selection of judgments issued by the CJEU

## CJEU case-law in appeals

### Part I – Section 1

Selection of judgments issued by the CJEU  
in appeals involving the EUIPO as a party

## CJEU case-law in appeals

### Presented judgments:

1. MASSI ./ MESSI, Case C-449/18 P, 17.09.2020
2. achtung! (fig.), Case C-214/19 P, 03.09.2020
3. EDISON (fig.), Case C-121/19 P, 16.09.2020

## CJEU case-law in appeals

MASSI ./ MESSI  
Case C-449/18 P  
17.09.2020

## MASSI / MESSI, Case C-449/18 P, 17.09.2020

**MASSI**  
(earlier word EUTM)



Genuine use accepted only for:  
Class 9: “bicycle helmets”  
Class 28: “bicycle gloves”

- Class 9: "Emergency (rescue) apparatus and instruments";
- Class 25: 'Clothing, footwear, headgear';
- Class 28: 'Gymnastic and sporting articles not included in other classes'

Opposition ground: Article 8(1)(b) EUTMR

## MASSI / MESSI, Case C-449/18 P, 17.09.2020

### **OD & BOA: LOC**

- Goods identical or similar.
- Signs similar, because their dominant elements 'massi' and 'messi' are almost identical visually and phonetically. A potential conceptual differentiation would affect only a part of the relevant public.

**GC: NOLOC – BOA annulled**

**CJEU: NOLOC – GC confirmed – BOA annulled – EUIPO & MASSI appeals dismissed**



## MASSI / MESSI, Case C-449/18 P, 17.09.2020

### CJEU findings:

- only a small negligible part of the relevant public would not directly associate the term 'messi' with the name of the famous football player (§ 35)
- the reputation of the football player Messi is such, that the average consumer will perceive the meaning of the MESSI sign as referring to the name of the famous football player and will perceive it primarily as a trade mark (§ 36)
- GC correctly found NOLOC based on conceptual dissimilarity for the whole public (§ 37)

## MASSI / MESSI, Case C-449/18 P, 17.09.2020

### CJEU findings:

- In the global assessment, account must also be taken of the possible notoriety / reputation of the person applying for her/his name to be registered as a trade mark, since that notoriety can clearly have an influence on the perception of the [later] mark by the relevant public – quoting C-51/09 P, BARBARA BECKER of 2010 - (§ 47)
- The notoriety of Mr Messi was a relevant factor for establishing a conceptual difference (§ 48)

## MASSI / MESSI, Case C-449/18 P, 17.09.2020

### CJEU findings:

- the reputation of the name Messi as the family name of a football player known worldwide and as a public figure constitutes a ‘well-known fact’ (§ 74)
- the conceptual differences between two signs may neutralize visual and phonetic similarities, provided that at least one of those signs – either the earlier or the later – has a clear and determined meaning, which the public is likely to understand it directly (§§ 85-87)

## CJEU case-law in appeals

achtung! (fig.)  
Case C-214/19 P  
03.09.2020

## achtung! (fig.), Case C-214/19 P, 03.09.2020



contested IR/EU application

Lengthy lists of goods & services in Classes 9, 16, 35, 37, 38, 41, 42 and 45

Absolute ground for refusal: Article 7(1)(b) EUTMR

**achtung! (fig.), Case C-214/19 P, 03.09.2020**

- **Examiner:** refused the mark as being devoid of distinctive force – it simply means “attention”
- **BOA:** confirmed the refusal – the mark is a common promotional message, which aims to attract the relevant public’s attention to purchase any G&S, including the specific G&S applied for
- **GC:** confirmed the refusal
- **CJEU:** confirmed GC and BOA

achtung! (fig.), Case C-214/19 P, 03.09.2020

## CJEU findings:

- The test of distinctiveness under Article 7(1)(b) EUTMR must be based on all possible forms of use of the sign applied for, namely all ‘practically significant’ uses - [quoting the judgment in the *#darferdas?* Case C-541/18 of 12.09.2019] - (§ 28)

## achtung! (fig.), Case C-214/19 P, 03.09.2020

### CJEU findings:

- The possible but ‘practically insignificant’ meanings / interpretations of a [word] sign cannot establish distinctive force (§ 29):
  - The German word “Achtung” can have four possible meanings: (1) attention, (2) esteem, (3) high regard and (4) respect.
  - Meanings #2, #3 and #4 are qualified as ‘practically insignificant’ and cannot render the sign distinctive.
  - The only ‘practically significant’ meaning #1 is non-distinctive.



## achtung! (fig.), Case C-214/19 P, 03.09.2020

### CJEU findings:

- Under Article 7(1)(b) EUTMR, a mark is necessarily non-distinctive when it is descriptive in the sense of Article 7(1)(c) EUTMR, namely even if **only one** of its various potential meanings denotes a characteristic of the G&S applied for - [the so-called '*Doublemint-principle*'] - (§ 34).

## achtung! (fig.), Case C-214/19 P, 03.09.2020

### CJEU findings:

- Nevertheless, the ‘*Doublemint*-principle’ cannot apply by analogy for refusing as non-distinctive signs for reasons other than descriptiveness, because
- **all** various potential meanings / interpretations of the sign must be examined under Article 7(1)(b) EUTMR (§ 35).

## CJEU case-law in appeals

EDISON (fig.)

C-121/19 P

16.09.2020

## EDISON (fig.) , Case C-121/19 P, 16.09.2020



**contested EUTM registration**

Electrical energy (within Class 4 of the 8<sup>th</sup> edition of the Nice Classification)

Inadmissible extension of the list of goods

## EDISON (fig.) , Case C-121/19 P, 16.09.2020

- **2003:** the EUTM was registered for all goods included in Class 4 of the eighth edition of the Nice Classification. ‘Electrical energy’ was not mentioned.
- **2015:** the EUTM owner requested a partial surrender (limitation), but included in the limited list of goods ‘electrical energy’ for the first time.
- **Examiner:** objected to the addition of ‘electrical energy’ – if the Office had accepted this addition, the EUTM’s scope of protection would have been unlawfully widened. This would result in an extension, instead of a limitation.
- **BOA:** confirmed the objection – the eighth edition of the Nice Classification did not mention ‘electrical energy’ either in the Class Heading or in the Alphabetical List of the goods in Class 4.
- **GC:** confirmed the objection.
- **CJEU:** confirmed GC and BoA.

## EDISON (fig.) , Case C-121/19 P, 16.09.2020

### CJEU findings:

- GC lawfully excluded ‘*electrical energy*’ from the goods in Class 4 of the eighth edition of the Nice Classification, by ruling that it did not fall under the terms ‘*fuels (including motor spirit)*’, ‘*illuminants*’ and ‘*carburants*’ / ‘*motor fuel*’, within the meaning of the eighth edition of the Nice Classification.
- GC lawfully assessed the scope of those terms on the basis of a **literal appraisal**, in accordance with their **customary** and **ordinary meaning** (§§ 38-46).

## EDISON (fig.) , Case C-121/19 P, 16.09.2020

### CJEU findings:

- the goods for which the protection by the trade mark is sought must be identified by the applicant in its application for registration with sufficient clarity and precision, in order to enable the competent authorities and the economic operators, on that basis **alone**, to determine the extent of the protection sought – quoting *IP Translator* Case C-307/10 (§ 41).
- even though ‘electrical energy’ is intangible, it is considered analogous to other tangible fuels, such as gasoline and kerosene that are in Class 4; despite that similarity from a **functional** perspective, electrical energy is not covered by the **literal** meaning of the concept of ‘fuel’ (§ 47).

## CJEU case-law in preliminary ruling requests

### Part I – Section 2

Selection of judgments and opinions issued by the CJEU and its Advocates General in requests for a preliminary ruling addressed by the courts of the EU Member States



## CJEU case-law in preliminary ruling requests

Presented CJEU judgments & AG opinions:

1. Judgment of the Court in Case C-684/19, 02.07.2020
2. Opinion of Advocate General PITRUZZELLA, Case C-490/19, 17.09.2020

## CJEU case-law in preliminary ruling requests

Judgment of the Court  
delivered on 2 July 2020  
Case C-684/19

Request for a preliminary ruling from the  
Higher Regional Court, Düsseldorf, Germany

## Judgment of the CJEU in Case C-684/19, 02.07.2020

### Context:

- This request for a preliminary ruling concerns the interpretation of the term **‘using’** in Article 5(1) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks.
- The request has been made in proceedings between MK Advokaten GbR and MBK Rechtsanwälte GbR concerning a prohibition imposed on the former on using the string of letters **‘MBK’** in the course of trade.

## Judgment of the CJEU in Case C-684/19, 02.07.2020

### Question:

- ‘Is a third party referenced on a website in an entry that contains a sign identical with a trade mark **‘using’** that trade mark, within the meaning of Article 5(1) of Directive 2008/95, if the entry was not placed there by the third party itself, but was reproduced by the website’s operator from another entry that the third party had placed in infringement of the trade mark?’

## Judgment of the CJEU in Case C-684/19, 02.07.2020

### Answer:

- Article 5(1) of Directive 2008/95/EC must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement which infringes another person's trade mark to be placed on a website **is not 'using'** a sign which is identical with that trade mark, where the operators of other websites reproduce that advertisement by placing it online, **on their own initiative and in their own name**, on other websites.

## CJEU case-law in preliminary ruling requests

OPINION  
of Advocate General PITRUZZELLA  
delivered on 17 September 2020  
Case C-490/19  
Request for a preliminary ruling from the  
Court of Cassation, France

## Opinion of AG PITRUZZELLA, Case C-490/19, 17.09.2020

### Context:

- In the request for a preliminary ruling, the Cour de Cassation asks the CJEU a question concerning the interpretation of Article 13(1) of Regulations (EC) No 510/2006 (2) and (EU) No 1151/2012.
- That question was raised in the context of a dispute regarding alleged acts of ‘unfair’ and ‘parasitic’ competition (free-riding) in disregard of the Protected Designation Of Origin (‘PDO’) ‘Morbier’.

## Opinion of AG PITRUZZELLA, Case C-490/19, 17.09.2020

### Question:

Must Article 13(1) of ... Regulation No 510/2006 ... and Article 13(1) of Regulation No 1151/2012 ... be interpreted as prohibiting:

- solely the use by a third party of the registered name?
- or also the presentation of a product protected by a designation of origin, in particular the reproduction of the shape or the appearance which are characteristic of it, which is liable to mislead the consumer as to the true origin of the product, **even if** the registered name is not used?



## Opinion of AG PITRUZZELLA, Case C-490/19, 17.09.2020

### Proposed answer:

1. [EU law] must be interpreted as meaning that it does not prohibit only the use by a third party of a registered name.
2. Reproducing the shape or appearance of a product covered by a registered name may constitute a prohibited practice under Article 13(1)(d) of Regulations No 510/2006 and No 1151/2012 if it is liable to mislead the consumer as to the true origin of the product.
3. It is for the national court to assess, in each individual case, whether such a practice is illegal in the light of all the relevant elements and referring to the perception of the average European consumer who is reasonably well informed and reasonably observant and circumspect.

## GC case-law

# Part II

## Selection of judgments issued by the GC

## GC case-law on EUTMs

### Part II – Section 1

## Selection of judgments issued by the GC in disputes relating to EUTMs

## GC case-law on EUTMs

### Presented judgments:

1. purple colour mark, Case T-187/19, 09.09.2020
2. FAIR ./ FAIR ZONE, Case T-589/19, 09.09.2020
3. Dayaday ./ Dayaday , Case T-50/19, 09.09.2020

## GC case-law on EUTMs

purple colour mark

Case T-187/19

09.09.2020

## purple colour mark, Case T-187/19, 09.09.2020



**Colour description: 'Purple – Pantone: 2587C'**

- Class 5: 'Pharmaceutical preparations for the treatment of asthma and/or chronic obstructive pulmonary disease'
- Class 10: 'Inhalers for the treatment of asthma and/or chronic obstructive pulmonary disease; parts of the aforesaid goods'

**Absolute ground for refusal: Article 7(1)(b) EUTMR - Article 7(3) EUTMR**

## purple colour mark, Case T-187/19, 09.09.2020

- **Examiner:**
  - refused the colour mark due to lack of inherent distinctiveness under Article 7(1)(b) and
  - rejected the claim of acquired distinctiveness under Article 7(3) EUTMR
- **BOA** confirmed the refusal and the rejection
- **GC:** confirmed BOA

## purple colour mark, Case T-187/19, 09.09.2020

### **GC findings on inherent distinctiveness:**

- the applicant's argument that it made extensive use of the shade Pantone 2587C for advertising purposes is irrelevant, since the evidence submitted does not make it possible to establish that the relevant public will necessarily associate the goods concerned with that specific shade and not with a lighter or darker shade of purple, also used by the applicant in connection with those goods (§ 50)



## purple colour mark, Case T-187/19, 09.09.2020

### **GC findings on inherent distinctiveness :**

- on the relevant market, colours can be used to convey to the public information relating to the characteristics of the goods.
- It was not proved that the goods covered by the contested mark constitute, within the relevant market, a specific category that escapes the rules and practice - formal or informal - applicable on that market (§ 52)

## purple colour mark, Case T-187/19, 09.09.2020

### **GC findings on inherent distinctiveness :**

- it would not be in the public interest for the availability of a colour such as the contested mark to be restricted for other traders selling goods of the same kind as those in respect of which registration is sought (§ 53).
- The contested mark lacks inherent distinctive character (§ 61).

## purple colour mark, Case T-187/19, 09.09.2020

### GC findings on acquired distinctiveness:

- the function of a trade mark as an indication of origin is **equally important** for the end user of a product [here: patients] and for the intermediaries who are involved in its marketing [here: prescribing doctors & pharmacists] (§ 79)
- in the event that the evidence submitted does not cover part of the European Union, even a part which is not substantial or consists of only one Member State, it cannot be concluded that distinctive character has been acquired **throughout** the European Union (§ 86)

## purple colour mark, Case T-187/19, 09.09.2020

### GC findings on acquired distinctiveness:

- The opinion surveys submitted are not capable of demonstrating that the mark applied for had acquired distinctive character through use in the Member States concerned. A fortiori, the results of those surveys cannot be extrapolated to other Member States (§ 105)
- Therefore, proof of that use cannot be provided by the mere provision of sales figures and advertising material, **even if** there is no doubt that the sales figures demonstrate that the applicant has sold large quantities of Seretide inhalers within the European Union (§ 108)

## GC case-law on EUTMs

FAIR ./ FAIR ZONE

Case T-589/19

09.09.2020

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020



Earlier EUTM

# FAIR ZONE

Contested word mark

Class 25: "Clothing; Footwear; Headgear  
Class 28: "Games; Toys; Gymnastic and  
sporting articles, included in class 28;  
Christmas tree decorations".

Class 21: "Household gloves; Gardening  
gloves";  
Class 25: "Wellington boots; Sneakers;  
Slippers; Garden shoes";  
Class 28: "Fitness bands; Balloons [toys];  
Balls; Toy".

Opposition ground: Article 8(1)(b) EUTMR

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

- **OD: LOC**
- **BOA:**
  - partially annulled OD, NOLOC as regards Class 21 products, which were found dissimilar
  - partially confirmed OD, LOC as regards Classes 25 and 28, which were found identical
  - Signs were assessed visually lowly similar, aurally similar and conceptually similar
- **GC: confirmed BOA**

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

### GC findings:

- The relevant public consists of the general public with average degree of attention (§ 34)
- The contested goods are identical (§ 37)
- The element „FAIR“ of the earlier mark will be observed by the consumers:
  - It is weakly distinctive, because it may be perceived by the relevant German public as reference to „fair trade“ (§ 47),
  - but it cannot be disregarded in the overall impression, considering also its central position within the remaining figurative elements (§§ 49-52)



## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

### GC findings:

- Likewise, the element „FAIR“ of the later mark is weakly distinctive but will be noticed by the average German consumer (§ 54)
- The element „ZONE“ will reinforce the message that the goods come from a fair trade zone (§ 56)
- Visually, the conflicting marks are similar to an **average** degree – and not just lowly similar as BOA found – due to common „FAIR“ (§ 59)

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

### GC findings:

- The marks are phonetically similar to an average degree – as BOA found – (§ 60)
- In light of the weak distinctiveness of the common element „FAIR“, the conceptual similarity found between the marks can only play a limited role in the global assessment of LOC (§ 62)
- GC agrees with BOA’s conclusion on LOC, but criticizes BOA for its global assessment (§ 68)

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

### GC findings:

- First error of BOA was that the inherent distinctiveness of the earlier mark should have been assessed as weak, not just „slightly weakened“ (§ 73)
- Second error of BOA was that it should have accorded to the conceptual similarity only a limited role (§ 74)
- Thirdly BOA committed a typographic error by noting that the phonetic similarity was „above average“, instead of the correct „average“ (§ 75)

## FAIR / FAIR ZONE, Case T-589/19, 09.09.2020

### GC findings:



However, these three mistakes of BOA do not undermine BOA's operative part (§ 76), since:

- even weakly distinctive marks may give rise to LOC according to the case-law (§ 77) and
- finally LOC was correctly assessed in view of:
  - the identity of the goods under comparison,
  - the average visual and aural similarity of the signs and
  - despite the weak distinctive character of the earlier mark (§ 78)

## GC case-law on EUTMs

Dayaday ./ Dayaday  
Case T-50/19  
09.09.2020

## Dayaday /J. Dayaday , Case T-50/19, 09.09.2020

 <p><u>five earlier Spanish marks</u></p>	 <p><u>Contested mark</u></p>
Classes 3, 14, 18, 25, 35 (long lists)	Classes 9, 16 and 24 (long lists)
Opposition grounds: <u>Article 8(1)(b)</u> & <u>Article 8(5) EUTMR</u>	

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

- **OD**: dismissed opposition in 2015
- **2<sup>nd</sup> BOA**: partially upheld the appeal in 2016
- **GC**: annulled 2<sup>nd</sup> BOA in 2018 (Case T-900/16)
- **5<sup>th</sup> BOA**: partially upheld the appeal in 2018:
  - on Article 8(1)(b) repeated 2<sup>nd</sup> BOA's assessment
    - LOC for Classes 16 and 24
    - NOLOC for Classes 9, 16 and 24
  - on Article 8(5) no reputation and no unfair benefit was proved

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC findings:

- BOA was correct to assess that the evidence provided, although showing the use of the mark in Spanish territory, was insufficient to recognize a certain degree of reputation acquired by the earlier marks among the relevant public (§ 59).
- Since no reputation was proven, BOA correctly rejected the opposition under Article 8(5)



## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC findings:

- BOA correctly assessed the level of attention to vary from average (as regards the general public) to higher than average (as regards specialized professionals) (§ 69)
- BOA correctly compared the signs as (§ 72):
  - visually highly similar & phonetically identical
  - conceptually identical, as regards the Spanish public who will understand their meaning „from day to day“ in the English language

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC findings:

- BOA correctly found dissimilarity between the contested goods in Class 9 and the earlier goods and services falling within Classes 3, 14, 18, 25 and 35 (§ 102)
- BOA incorrectly found dissimilarity between the contested protective glasses for sports in Class 9 and the earlier 'Clothing, footwear, headgear' included in Class 25:
  - said products may all be sold in the same establishments, are intended for the same consumers, may have the same manufacturers and the same distribution channels, and may be perceived as complementary insofar as one is important for the use of the other,
  - they are thus similar to a low degree (§ 100)

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC findings:

- BOA correctly assessed the contested goods falling in Class 16 as dissimilar to the earlier goods in Classes 3, 14, 18 and 25 and to the earlier retail sales services in Class 35 (§ 115)
- BOA correctly found most of the contested products in Class 24 dissimilar to the earlier products in Classes 18 and 25 (§ 132)

## Dayaday /J. Dayaday , Case T-50/19, 09.09.2020

### GC reasoning:

BOA **incorrectly** found dissimilarity between the contested 'small hand towels' in Class 24 and the earlier 'clothing' in Class 25 (§ 128):

- They are of the same nature and have the same purpose and a competing character, the manufacturers and the distribution channels may be the same
- They have an average degree of similarity.

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC reasoning:

BOA **incorrectly** found dissimilarity between the contested 'textile products and substitutes for textile products; fabrics; textiles not included in other classes' in Class 24 and the earlier 'leather and imitation leather' included in Class 18 (§ 130):

- They are competitive and interchangeable, have the same purpose, namely to be used to manufacture a finished or semi-finished product and are intended for the same user, namely the intermediate consumer
- They have an average degree of similarity.

## Dayaday / J. Dayaday , Case T-50/19, 09.09.2020

### GC conclusion:

- The contested BOA decision is partially **annulled** for the contested products in Classes 9 and 24 that were found similar by the GC (instead of dissimilar by BOA) (§ 139).
- GC did not go on to further examine the grounds of opposition for the annulled part (§ 142)

## GC case-law on RCDs

# Part II – Section 2

## Selection of judgments issued by the GC in disputes relating to RCDs

## GC case-law on RCDs

### Presented judgments:

1. pneumatic power tool, Case T-748/18, 08.07.2020
2. fluid distribution equipment, Cases T-838/19 to T-842/19, 15.07.2020



## GC case-law on RCDs

pneumatic power tool

Case T-748/18

08.07.2020

## pneumatic power tool, Case T-748/18, 08.07.2020

### Background:

- RCD registered for hammer drills and pneumatic power tools.
- An invalidity application was filed. The Invalidity Division (ID) declared the RCD invalid on the ground that it had no individual character.
- The BoA dismissed the appeal filed by the RCD proprietor.
- GC dismissed the action of the RCD proprietor.

## pneumatic power tool, Case T-748/18, 08.07.2020



Registered Community Design

Earlier design

## pneumatic power tool, Case T-748/18, 08.07.2020

### **GC findings on disclosure:**

- The RCD proprietor failed to provide evidence capable of establishing that, in the normal course of business, the disclosure of the earlier design could not reasonably have become known to the circles specialized in the sector concerned operating within the EU (§ 24).
- The effective distribution of a copy of the tool instruction manual and a parts catalogue relating to the relevant rock drill and its hydraulic support may be inferred from the fact that the invalidity applicant, as a member of the circles concerned, had in its possession a stamped copy of that catalogue signed by the applicant's representative (§ 26).
- The BoA rightly concluded that the earlier design had been made available within the meaning of Article 7 CDR (§ 28)

## pneumatic power tool, Case T-748/18, 08.07.2020

### GC findings on individual character:

- The sector concerned by the designs is that of hammer drills and pneumatic power tools (§ 36).
- The informed user of that product is a miner or mining engineer who is familiar with rock drills and informed about their essential characteristics (§ 37).
- The designer's degree of freedom is **average** since the technical requirements allow the designer sufficient freedom to at least vary the appearance of the product (§ 42).

## pneumatic power tool, Case T-748/18, 08.07.2020

### GC findings on individual character:

- As regards the overall impression, the contested design is intended to be incorporated into pneumatic rock drills, which comprise the same components with the same characteristics as those which make up the rock drills of the earlier design.
- Looking at the designs, the informed user will easily recognize the same shared characteristics, which contribute to producing an impression of ‘**déjà vu**’ on the informed user of the contested design in relation to the earlier design (§ 49).

## pneumatic power tool, Case T-748/18, 08.07.2020

### GC findings on individual character:

- The technical differences are not capable of affecting the overall impression produced by the designs, which is dictated by the appearance of the rock drills as a whole (§ 61).
- Despite the relatively high level of attention, the informed user does not notice minor differences that may exist between the designs (§ 62).
- The BoA did not err in finding that the designs produced the **same overall impression** on the informed user and that the contested design lacked individual character (§ 66).

## GC case-law on RCDs

fluid distribution equipment  
Cases T-838/19 to T-842/19  
15.07.2020



## fluid distribution equipment, Cases T-838/19 to T-842/19, 15.07.2020

### Background:

- Two separate applications for a declaration of invalidity were filed against the contested RCD. The Invalidity Division dealt with both applications in a single procedure and declared the contested design invalid.
- The BoA adopted an interim decision suspending the appeal proceedings, pending a definitive decision of GC in a parallel case.
- The RCD proprietor filed an action before the GC seeking the annulment of the contested BoA decision and a decision that the BoA should resume the proceedings.
- The GC dismissed the action as inadmissible.

## fluid distribution equipment, Cases T-838/19 to T-842/19, 15.07.2020

### **GC findings on inadmissibility:**

- An action for annulment is, in principle, only available against a measure by which the institution concerned [here: the EUIPO] definitively determines its position upon the conclusion of an administrative procedure. An intermediate measure whose aim is to prepare the final decision cannot form the subject matter of an action for annulment (§ 22).

## fluid distribution equipment, Cases T-838/19 to T-842/19, 15.07.2020

### GC findings on inadmissibility:

- The BoA's decision to suspend the proceedings before it - pending a definitive decision of the GC in a parallel case - constitutes an **intermediate** measure, the purpose of which is to prepare for the final decision to be adopted by the BoA.
- It is not intended to produce binding legal effects capable of affecting the interests of the applicant before the GC, by bringing about a distinct change in its legal position, in so far as it does not terminate the proceedings before the BoA and does not definitively determine the position of the BoA as to the outcome of the appeal before it (§ 25).

## fluid distribution equipment, Cases T-838/19 to T-842/19, 15.07.2020

### GC findings on inadmissibility:

- The RCD proprietor has the opportunity of relying on the possible unlawfulness of the BoA's decision to suspend the proceedings within an action before the GC, directed against the **final** decision of the BoA.
- If it considers, **at the end** of the proceedings before the BoA, that the EUIPO has infringed its obligations with regard to the duration of the proceedings, it will be able to assert its rights by bringing an action that it deems appropriate for that purpose.
- Consequently, the inadmissibility of the present action does not result in a lack of effective judicial protection for the applicant (§§ 27-28).



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