

# Decisions of the Trimester of the EUIPO's Boards of Appeal

*March 2019 – June 2019*

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Webinar, 9 July 2019

## TOPICS

- PROCEDURAL ISSUES / ADMISSIBILITY
- ABSOLUTE GROUNDS FOR REFUSAL / INVALIDITY
- RELATIVE GROUNDS FOR REFUSAL / INVALIDITY
- SPECIFIC TO CANCELLATION PROCEEDINGS
- PROOF OF USE / ASSESSMENT OF EVIDENCE



## Admissibility before EUIPO

08/05/2019, R 1407/2018-1, T take (fig.) / TecTake et al.

- **OD:**
  - ❖ **Request for PoU found inadmissible as not filed on a separate document.**

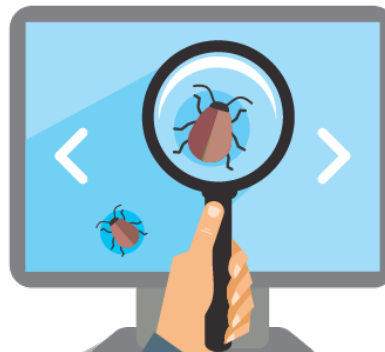


- **BoA:**
  - ❖ **Requirement of ‘separate document’ as set out in Article 10(1) EUTMDR satisfied:**

*Request has been filed in the first part of the appeal on the very first page with a clear heading indicating ‘REQUEST FOR PROOF OF USE’ containing all the pertinent information [..]. In the second part of the appeal, under the Heading ‘OBSERVATIONS’ the applicant made submissions concerning the non-existence of LOC.*
  - ❖ **OD decision annulled.**

## Admissibility

05/04/2019, R 1079/2018-1, Qaware / Quantaware



- **'Bug' in the e-comm system, so opposition filed by fax on an old 'notice of opposition' form (no 'tick boxes' for country code), indicating the trade mark name, type of mark, filing and registration dates and registration number of the earlier mark;**
- **Earlier mark could be identified by the Office's online TM search tools;**
- **Requirement of Article 2(2)(b)(i) EUTMDR ('clear identification') met.**

## Substantial procedural requirements/ right to be heard

03/04/2019, R 1163/2018-2, Fleurette (fig.) / Vin de Pays des Bouches du Rhone Florette (fig.)

OD

- ❖ Rejected opposition on the basis of the failure to substantiate the earlier mark.

BoA:

- ❖ OD decision annulled;
- ❖ The opponent should have been heard on the issues of the colour claim and its translation of the earlier registered trade mark – which was caused by the inconsistency in the French database with the original documents – before the OD took its decision;
- ❖ Infringement of rights of defence.



## Lack of reasoning / right to be heard; non-distinctive

27/03/2019, R 1948/2018-2, X ( fig.)



- ❖ Examiner failed to notify the applicant of third-party observations – the applicant was not given the opportunity to file comments;
- ❖ Contested decision based the refusal on descriptiveness only;
- ❖ Sign should have been refused because of its lack of distinctiveness, since it consists of overly simple crossed lines, and/or because of its descriptiveness on the basis of the different meanings of ‘X’ mentioned in the third-party observations and based on the Boards’ case-law;
- ❖ Sign should not only have been refused for goods in Classes 25 and 28 but also for additional goods and services, in particular those in Class 41;
- ❖ Contested decision annulled and remitted back to the examiner.

## Substantial procedural violation

[12/04/2019, R 2254/2018-5, PARFEN \(fig.\) / Refan et al.](#)

- OD acknowledged that the opposition was based on that ground of refusal as well as on that laid down by Article 8(5) EUTMR, however the contested decision only contained the assessment of the opposition, rejected pursuant to Article 8(1)(b) EUTMR, and did not analyse the existence of a ‘link’ between the signs according to Article 8(5) EUTMR or the evidence of reputation;
- Lack of proper reasoning;
- Substantial procedural violation;
- Reimbursement of the appeal fee.



## Lack of distinctiveness – Article 7(1)(b) EUTMR

27/05/2019, R 149/2019-5, BOTTLE DESIGN (3D)



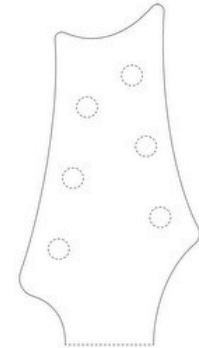
- Contested mark: 3D mark consisting of a depiction of a bottle shape;
- Considering that the market for the contested goods is characterised by a huge variety of bottle shapes, the contested decision cannot be considered to be vitiated by errors of fact or law;
- Contested mark unable to distinguish the contested goods by identifying their commercial origin;
- Application **rejected**.



## Lack of distinctiveness – Article 7(1)(b) EUTMR

01/04/2019, R 1656/2019-4, DEVICE OF A HEADSTOCK OF A GUITAR (fig.)

*Class 15: Musical instruments; Guitars.*



- Mark was applied for as a **figurative mark**, not 3D **BUT** clearly depicts the shape of a distinct guitar headstock;
- Criteria for assessing the distinctive character of 3D marks are no different than those applicable to other categories of marks. **BUT** consumers are not in the habit of making assumptions concerning the origin of the products on the basis of their shape;
- Mark is no more than a combination of different features which, taken on their own, do not depart from the features typical of headstocks and therefore, even when taken together, do not represent an appreciable departure from the shape of a headstock customary in the sector;
- Application **rejected**.

## Lack of distinctiveness – Article 7(1)(b) EUTMR

14/05/2019, R 2094/2018-5, Rechter Winkel (fig.)



- Contested EUTM identical to the re-filing of a trade mark, which had been declared invalid due to its lack of distinctiveness three years earlier;
- BoA confirms the examiner's assessment that the sign at issue (a right angle with round edges) is devoid of any distinctiveness;
- BoA refused the applicant's argument that the sign would be perceived as the letter 'L'. No evidence was filed to support this;
- Application **rejected**.

## Lack of distinctiveness – Article 7(1)(b) EUTMR

15/04/2019, R 836/2018-2, READYTOdo by NATURIS (fig.)



- The Board confirms the examiner's finding that the sign is descriptive and lacks distinctive character for the English-speaking public in the EU;
- The descriptive/non-distinctive element, 'READYTOGO' is predominant;
- Neither the colours/stylisation of the sign nor the presence of the words 'byNATURIS', which are so small so as to go unnoticed by the consumer, are able to rule out the applicability of Article 7(1)(b) and (c) EUTMR;
- Application **rejected**.

## Article 7(1)(h) EUTMR / Article 59(1)(a) EUTMR / Article 6ter Paris Convention

22/05/2019, R 2109/2018-2, Malteser (fig.)



**Malteser**



22/05/2019, R 2110/2018-2, DARSTELLUNG EINES EMBLEMS (fig.)

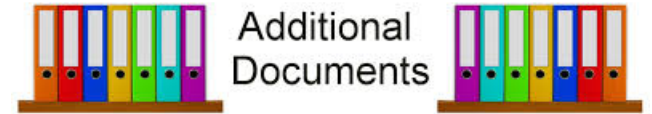
- **Contested mark : Maltese cross protected by ex Article 6ter of the Paris Convention by the Republic of Malta;**
- **Fact that the applicant is part of the Order of Malta does not change this finding, although it may continue to use the mark, pursuant to Article 14 EUTMR;**
- **The applicant did not file any authorisation issued by the Republic of Malta;**
- **Other registered EUTMs in the name of other members of the Order of Malta, such as the Knights of St. John, are not relevant.**

## Article 58(1)(a) EUTMR – Revocation for non-use

[23/04/2019, R 937/2018-2, RED LIPS \(fig.\)](#)



- CD:
- ❖ Mark revoked as the EUTM proprietor failed to prove genuine use.
- BOA:
- ❖ Additional evidence filed on appeal considered complementary evidence;
- ❖ Remit case back to CD in order to give the cancellation applicant an opportunity to be heard since it failed to file observations in response to the appeal.



## Article 58(1)(a) EUTMR – revocation for non-use

01/04/2019, R 1771/2018-5, MIAU (fig.)



- **CD:**
- **Mark cancelled based on its lack of use and no proper reasons for non-use.**
- **BoA:**
- **Confirms contested decision;**
- **Judicial actions dealing with bankruptcy proceedings in which the owner acquired the mark NOT proper justification for non-use.**

## Article 8(1)(b) EUTMR / Article 60(1)(a) EUTMR – Likelihood of confusion

17/04/2019, R 2048/2018-5, SEAWATER EXPERIENCE MEDITERRANEA (fig.) / Mediterranea nut company

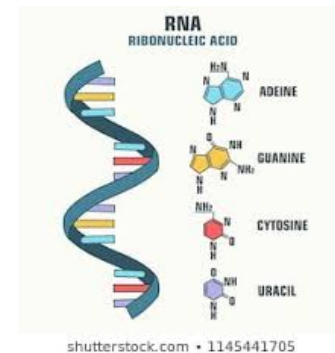


- Both marks cover range of food products/foodstuff and related goods in Classes 29 , 30 and 31;
- Goods partly identical and partly similar;
- Dominant element ‘MEDITERRANEA’ identical in both marks;
- Other elements: either lower distinctive element, equally weak or with little visual impact: insufficient to avoid LoC;
- Imperfect image and principle of interdependence;
- Contested decision upheld.

## Article 8(1)(b) EUTMR – professional public

11/04/2019, R 1050/2018-1, Axiomer / Axiom

Earlier EUTM	Contested EUTM
<b>AXIOM</b> Cl. 1, 9, 40 and 42	<b>AXIOMER</b> Cl. 5 Pharmaceutical preparations based on oligonucleotides, for use in RNA editing for the treatment of genetic diseases



- Earlier goods and services are for scientific and laboratory research and analysis purposes in Classes 1, 9 and 42 and they are used in particular for testing, analysing and diagnosing genetic diseases which can be treated with RNA editing (contested goods in Class 5);
- Highly professional public will see a link between the conflicting goods/services; the signs are visually highly similar and aurally similar;
- Conceptually, the relevant professional public will see a link between the signs since the contested sign also contains a reference to the term 'AXIOM';
- Opposition **allowed**.



## Article 8(1)(b)/Article 60(1)(a) EUTMR

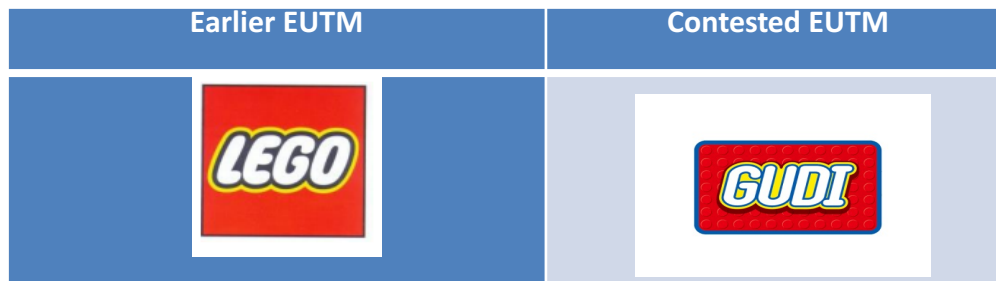
03/04/2019, R 10/2018-2, AmBiL (fig.) / Ambisome et al.

Earlier EUTM	Contested EUTM
AMBisome	AmBiL <sup>®</sup>

- Highly professional public;
- Goods in Class 5 identical;
- Visually and aurally similar – share common beginning ‘AMBi’;
- Arguments of the EUTM proprietor regarding the generic nature of the common element ‘AmB’ to refer to Amphotericin B (an active ingredient of the goods at hand) were not convincing;
- ‘AMB / AMBI’ seen as a fanciful term enjoying an average degree of distinctiveness for the conflicting goods;
- For this part of the relevant public – despite its high level of attention – the similarities between the signs outweigh their dissimilarities;
- BoA **annulled invalidity decision**. EUTM declared **invalid**.

## Article 8(5)/60(1)(a) EUTMR – marks with a reputation



15/05/2019, R 2170/2018-5, GUDI (fig.)



- The earlier sign's high level of reputation;
- Visual similarity given overall corresponding visual arrangement of the signs;
- Use of the contested sign will give the EUTM proprietor an unfair advantage and will be detrimental to the well-known character and long established reputation of the cancellation applicant's mark;
- **BoA annulled Cancellation Division's decision . EUTM cancelled.**

## Article 8(5)/60(1)(a) EUTMR – marks with a reputation

[25/04/2019, R 2495/2018-5, apo \(fig.\) / DEVICE OF AN APPLE WITH A BITE \(fig.\) et al.](#)

Earlier EUTM	Contested EUTM
	

- **Remittal from GC** (13/09/2018, T-104/17, apo (fig.) / DEVICE OF AN APPLE WITH A BITE (fig.) et al., EU:T:2018:536);
- BoA, following the findings of the GC, found that the signs were conceptually and visually similar to a certain degree, both of them referring to an apple;
- Earlier sign enjoys a reputation;
- Risk of the applicant taking an unfair advantage of the earlier right;
- Contested decision was **annulled** and the **EUTM was rejected**.

## Article 8(5)/60(1)(a) EUTMR – marks with a reputation

18/03/2019, R 2135/2017-5, FORMULA WINCARS / FORMULA 1 et al.

Earlier EUTM	Contested EUTM
FORMULA 1	FORMULA WINCARS

- Goods and services all relate to toys, games and gaming;
- Evidence insufficient to show reputation: it was insufficient to show that the earlier right had also become so uniquely associated, by virtue of its use with a single supplier (the group of companies of which the opponent is one), that it now acts as a 'mark of trade', that is maps the activities undertaken under the name to a specific commercial supplier;
- No third-party evidence to corroborate figures/submissions;
- Absence of reputation: Article 8(5) EUTMR rejected;
- No likelihood of confusion was found: 'Formula 1' is weak and the element 'WINCARS' too different from the '1' in the earlier right;
- Appeal **dismissed**.

## Articles 8(6) / 60(1)(d) EUTMR – Geographical indications

23/04/2019, R 2723/2017-5, Lucky Lasso Kentucky Straight Bourbon Whiskey / Protected designation of origin or a geographical indication Bourbon Whiskey

Contested EUTM

### Lucky Lasso Kentucky Straight Bourbon Whiskey



- Goods applied for ‘Bourbon Whiskey’ in Class 33;
- The effect of international agreements that preceded protections in GI law in the EU;
- Such agreements, where they find expression in EU law (as confirmed by advice from DG Agri) are under the full protection of EU law in relation to GIs, in this case EC 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks;
- Contested EUTM references the product it labels. Term ‘Lucky Lasso’ does nothing to distance this finding; if anything the phrase further emphasises the ‘*bona fides*’ of the product at issue by clearly making a reference to ‘a lasso’, its association with cowboys and the geographic significance in relation to the USA;
- Mark refused under Article 25 EC 110/2008 and Article 8(6) EUTMR.

## Article 8(6)/60(1)(d) EUTMR – Geographical indications

07/03/2019, R 831/2018-2, PUERTO FINO (fig.)

**PUERTO FINO**



- Cancellation Division only focused on the Spanish public. However evocation must be examined for all the EU;
- Evocation of the PDO ‘Porto’ therefore at least for Portuguese consumers when they encounter the contested sign ‘PUERTO FINO’;
- Due to the similar structure that ‘PUERTO’ and ‘Porto’ possess, and to the fact that ‘fino’ is a traditional term for wine from the PDO Porto, the contested sign will immediately evoke the earlier PDO at least for the Portuguese public;
- Finding evocation for at least the Portuguese public is sufficient to proceed with the examination of the cancellation application on the basis of Article 8(4) EUTMR;
- Appeal **upheld**. Case remitted back to Cancellation Division.

## Revocation - Proof of use and assessment of evidence

[29/04/2019, R 136/2019-5, Chocolate](#)

- **Extent of use: Few invoices for small amounts of euros not insufficient to show extent of use for wines in a market such as Spain;**
- **No proof of use so the mark is revoked;**
- **BoA confirms the contested decision and upholds the revocation request.**



**INVOICE** 

Invoice number: 0001      Date of issue: 2019/05/05

Billed to: Client Name      Your company name  
Street address:      123 Your Street  
City, State, Country:      your@email.com  
ZIP Code:      yourwebsite.com

Description	Unit cost	Qty. for sale	Amount
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Your best wine	\$0	1	\$0
Subtotal:			\$0
Payment:			\$0
City tax:			\$0
Tax:			\$0
Invoice total:			\$2,000


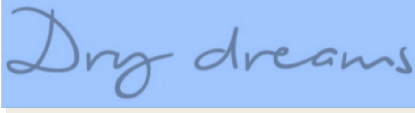
Terms  
E.g. Please pay Invoice by 09/05/2019

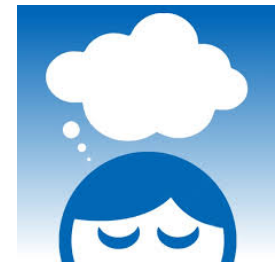
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## Article 8(1)(b) EUTMR - Proof of use and assessment of evidence

[03/05/2019, R 1670/2018-5, Dry dreams \(fig\) / Dreams et al.](#)

- Evidence, as a whole, suffices to establish that the cancellation applicant has given prior consent in accordance with Article 18(2) EUTMR;
- Genuine use for 'facial tissues and toilet tissues' in Class 16, which are found similar to the contested goods, including sanitary articles, disposable nappies and diapers and related goods, in Class 5;
- Signs similar overall due to the coincidence in the distinctive element 'DREAMS';
- There is a likelihood of confusion despite the different initial parts of the signs and the higher level of attention of the public in relation to some goods.

	Earlier EUTM	Contested EUTM
		







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Thank you