

Decisions of the Trimester of the EUIPO Boards of Appeal

Dec 2018 – Feb 2019

Cinzia NEGRO, Member of the Boards of Appeals
Webinar, 12 March 2019

TOPICS

- PROCEDURAL ISSUES
- ABSOLUTE GROUNDS FOR REFUSAL/INVALIDITY
- RELATIVE GROUNDS FOR REFUSAL/INVALIDITY
- SPECIFIC TO CANCELLATION PROCEEDINGS



Recordal of transfer, Illegible fax

31/01/2019, R 1143/2018-1, DEMAG (fig.)

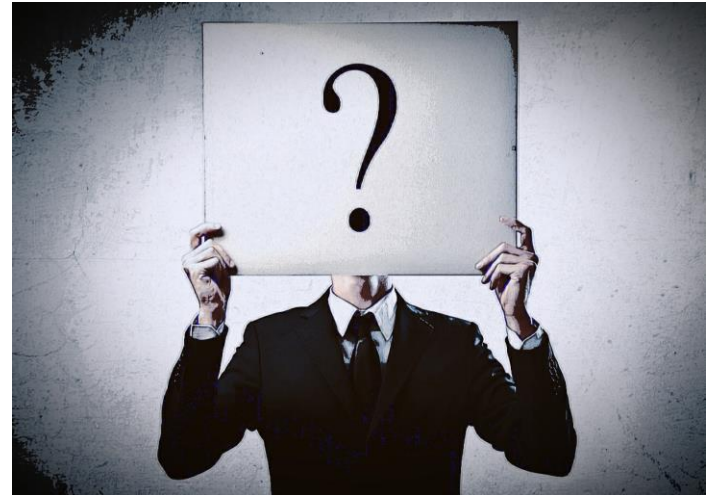
- Erroneous invitation to submit *new* document
- Substantial procedural violation
- Reimbursement of appeal fee



Admissibility

11/02/2019, R 1153/2018-4, FORM EINER TASSE (3D)

- **No information on legal form of the applicant**
- **Not further clarified**
- **Appeal inadmissible**



No grounds, new claim

10/12/2018, R 1239/2018-4, MICRO-PAK (fig.)

- The statement of grounds of appeal against the refusal decision based Article 7(1)(c) does not contain a clear and unambiguous identification of the grounds of appeal on which the annulment of the contested decision is requested
- It only contains a (new) claim of acquired distinctiveness under Article 7(3) EUTMR
- The Board cannot take such claim into account because it was raised for the first time during the appeal proceedings
- Appeal dismissed



Substantiation of earlier right, belated evidence

18/12/2018, R 1933/2018-2, TH TOWNHOUSE HOTELS (fig.) / Townhouse

- **Essential element to be translated**
- **Belated evidence admitted on appeal**
- **Deficiency rectified**



Absolute grounds + Classification objections

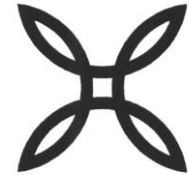
12/02/2019, R 1567/2018-2, Forests for all forever

Original specification	Amended specification
Class 35 Class 42	Class 35 Class 36 Class 42 Class 44

- **No mention of substantial classification amendments in notice of refusal**
- **+ failure to define relevant public and relevant degree of attention**
- **Lack of proper reasoning**
- **Substantial procedural violation**
- **Reimbursement of appeal fee**

Article 33(8) EUTMR declaration

04/12/2018, R 676/2018-2, RAPPRESENTAZIONE D'UN FIORE STILIZZATO (fig.)



Example: Class 25

Class Heading (VIII Edition Nice Classification)

Clothing, footwear, headgear

Declaration refused for:

Men's and women's underwear and swimwear for men and women; sarongs; bathing suits; sports clothing; wetsuits for water sports on the surface; flight suits

- **Decision correct in substance but unclearly reasoned**
- **Correct methodology to follow**

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

07/02/2019, R 1489/2018-2, RAPPRESENTAZIONE DI UNA FORMA DI UN PACCHETTO DI PASTA (fig.)



Class 30 - Pasta

Case-law on 3D marks applicable to figurative marks: to be distinctive, the sign must depart significantly from norms or customs of the sector

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

07/02/2019, R 1489/2018-2, RAPPRESENTAZIONE DI UNA FORMA DI UN PACCHETTO DI PASTA (fig.)



- Graphic elements EUTMA : even if not used as such, they represent minor variations of customary configuration
- Long standing use of the applicant's sign is irrelevant in the context of Article 7(1)(b)

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

04/02/2019, R 1309/2018-2, DEVICE OF A BELL ICON (fig.)



Class 9 (mobile devices, various items of hardware and software, various scientific apparatus)

- Would be seen by the relevant consumers as an icon signifying an alarm, a reminder or a (bell) sound
- → informative symbolic message

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

04/02/2019, R 1309/2018-2, DEVICE OF A BELL ICON (fig.)



Similar signs rejected by the Boards of Appeal for Class 9 :

- R 489/2016-2



- R 2256/2015-2



- R 1616/2015-5



- R 2985/2014-5



- R 1666/2012-1



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

15/01/2019, R 1870/2017-1, Colour Purple - 2587C (col.)



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.

- **Asthma medicines are designed in different colours – normally according to the relevant active ingredients, purpose and characteristics of the medicine**
- **Public interest in keeping colours available for competitors in the market of pharmaceuticals**

Distinctiveness acquired by use – Article 7(3) EUTMR

15/01/2019, R 1870/2017-1, Colour Purple - 2587C (col.)



- No surveys in a number of Member States
- In other member States, surveys do not target patients
- Lack of consistency as to the representation of the colour
- Marketing and advertising materials, sales data refer to a product with different colour combinations
→ Claim rejected

Article 7(1)(b) EUTMR

07/02/2019, R 900/2018-1, Frigola

FRIGOLA

Class 33 – "spirits and liquors"



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- Examiner considered the term non-distinctive and descriptive for "spirits and liquors" because it was found to mean "thyme" in Catalan
- However, the evidence on file shows that the term is a dialect form used only at local level, namely, on the islands of Ibiza and Formentera → insignificant part of relevant Spanish public
- Distinctiveness for Spanish public confirmed by Spanish courts
- Contested decision annulled

Conflict with geographical indication– Article 7(1)(j) EUTMR

07/12/2018, R 477/2017-1, CAFE Gran Colombiano con todo el aroma y sabor del buen café (fig.)





Class 30 – Coffee, coffee drinks and coffee substitutes

Class 32 – non-alcoholic beverages and beer with coffee flavour

- Examiner rejected the EUTMA based on Article 7(1)(c) and (b)
- Board notified further grounds for refusal based on Article 7(1)(j)
- EUTMA was rejected for all the goods for direct use of the Protected Geographical Indication CAFÉ DE COLOMBIA

Article 8(1)(b) EUTMR – Comparison of goods

[21/01/2019, R 1720/2017-G, ICEBERG \(fig.\) / ICEBERG et al.](#)

Contested EUTMA	Earlier marks (CZ, DE)
	
Class 32 – Mineral and aerated water; non-alcoholic beverages; fruit beverages and fruit juices	Class 33 - Vodka

- **The goods are DISSIMILAR → Opposition fails**
- **Contested decision annulled**

Article 8(1)(b) EUTMR – Comparison of marks



11/02/2019, R 1351/2018-2, Kenwell / Kenwood et al.

Contested EUTMA	Earlier mark (EU)
KENWELL	KENWOOD
Class 7 (electric kitchen appliances) Class 9 - Measuring, instruments Class 11 (cooking and heating kitchen apparatus)	Class 7 Class 9 (Proof of use not contested) Class 11

LIKELIHOOD OF CONFUSION

Article 8(1)(b) EUTMR – Comparison of marks


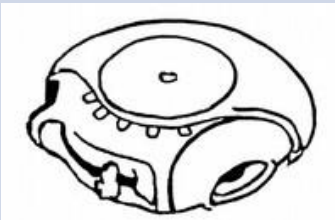
R0384/2017-2 PRIMAPRIX (fig.) / Dialprix (fig.) et al.

Contested EUTM	Earlier mark (EU)
	
Classes 9, 21, 35	Class 35

NO LIKELIHOOD OF CONFUSION
Contested decision partially annulled

Article 8(1)(b) EUTMR – Comparison of marks

07/01/2019, R 2096/2018-1, SALMEX (fig.) / SHAPE OF A DISC-LIKE DEVICE DIVIDED BY A WAVE INTO TWO PARTS (3D) et al.

Contested EUTM	Earlier mark (HU)
	
Class 5 – Inhalation products used for the treatment of asthma and chronic obstructive pulmonary disease Class 10 – Inhalers	Class 10 – Inhalers.

LIKELIHOOD OF CONFUSION

Article 8(1)(b) EUTMR – Comparison of marks


14/01/2019, R 812/2018-5, MY MONSTER COACH (fig.) / Monster energy et al.

Contested EUTMA	Earlier mark (EU)
	
Classes 9, 14, 41	Classes 9, 14, 41

NO LIKELIHOOD OF CONFUSION

Article 8(1)(b) EUTMR – Comparison of marks



R0850/2018-4 MORE THAN AFTER SUN (fig.) / Aftersun et al.

Contested EUTM	Earlier mark (ES)
	AFTERSUN
Class 3	Class 3

NO LIKELIHOOD OF CONFUSION

Article 8(1)(b) EUTMR – Comparison of marks



31/01/2019, R 633/2018-1, 4011 B552 CHAARA 4011 ATAY EL BENNA ORIGINALE (fig.) / 4011 B552 (fig.)

Contested EUTMA	Earlier mark (EU)
	
Classes 30, 31, 32	Classes 30, 31, 32

LIKELIHOOD OF CONFUSION

Article 8(1)(b) EUTMR – Comparison of marks



14/12/2018, R 49/2018-1, R 85/2018-1, B (fig.) / b (fig.)

Contested EUTM	Earlier mark (EU)
	
Classes 18, 25, 35	Classes 18, 24, 25

LIKELIHOOD OF CONFUSION
for identical/similar goods

Article 8(5) EUTMR – Reputation




07/01/2019, R 992/2018-5, BIG HORN (fig.) / DEVICE OF TWO BULLS RACING TOWARDS EACH OTHER (fig.) et al.

Contested EUTMA	Earlier mark (AT)
	
Class 32	Class 32

- **UNFAIR ADVANTAGE** taken from the earlier mark's exceptional reputation
- **Contested decision annulled**

Article 8(5) EUTMR – Reputation

25/02/2019, R 1322/2018-2, Raquel Superior Quality Cigarettes FILTER CIGARETTES (fig.) / FILTER CIGARETTES PM Marlboro 20 CLASS A CIGARETTES (fig.) et al.

Contested EUTMA	Earlier marks (EU)
	 
Class 34	Class 34

- **UNFAIR ADVANTAGE** taken from the earlier mark's very strong reputation
- **Contested decision annulled**

REVOCATION for becoming common name

07/12/2018, R 707/2018-5, Stopgrund

Stopgrund

Class 21 – Paints, primers



#202788149

- If the sign had become a common name in trade, the cancellation applicant should have been able to provide more ample and convincing evidence
- Few isolated examples not sufficient
- No proof that ‘STOPGRUND’ has come to be used and seen as a common name for ‘painting primers’ among a substantial part of the relevant public (German-, Danish-, Swedish- and Romanian-speaking)

REVOCATION for non-use

07/12/2018, R 265/2017-1, T pad (fig.)



Class 9 – Computer software for use in relation to telecommunications
Class 38 – Provision of access to the Internet

- **Extent of use not proven**
- **Software is not provided independently from the telecommunication services and is offered free to consumers as a tool to make phone calls → trade mark owner is not attempting to create a share in the market of software but in the market of telecommunications**



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Thank you