

Judgments of the Trimester of the General Court and the Court of Justice of the European Union

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T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

- OD: Opposition partially successful based on SLO and MT marks
- BoA: SLO and MT mark revoked during the proceedings before the BoA → remittal to OD to examine the other earlier rights
- OD: Opposition (again) partially successful based on SK mark
- Applicant appeals **and requests a suspension** → revocation request filed against the **earlier SK mark**

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

- BoA: rejects the suspension request, finds LoC
 - granting a suspension **would be warranted only if** it is accepted that the pending **cancellation proceedings** against the earlier Slovak mark **would, ‘regardless of the outcome of [those] proceedings’**, influence the legal effects of the earlier mark for the purposes of the opposition proceeding
 - earlier SK mark **‘was still in its grace period’** when the contested mark was published → later revocation of the earlier mark is not relevant

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

- BoA: rejects the suspension request, finds LoC
- 2 BoA's concerns:
 - Accepting that revocation requests based on non-use would render the opposition devoid of purpose:
 - Grace period would become illusory
 - Incentive to delaying tactics (until the earlier mark matures beyond the 5-year grace period)
- Suspension is not warranted

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

- Appeal to GC
- Earlier SK mark revoked in the meantime

Applicant: Earlier mark must be valid at the time of the BoA decision

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

GC: Rule 20(7)(c) of Reg. 2868/95: BoA may suspend if suspension appropriate under the circumstances

PRINCIPLES:

‘broad discretion’:

- General principles governing procedural fairness
- Decision must be made weighing the competing interests of all parties
- is subject to judicial review,
- *but is **limited** to cases of **manifest errors of assessment***

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

- pending revocation is in itself not sufficient to suspend the proceedings

But BoA reasons for not granting the suspension are incorrect:

(Whatever the outcome of revocation of earlier SK mark: no impact on the opposition proceedings (SK mark still in its grace period when the contested mark was published))

T-162/18 Altus (14/02/2019)

ALTUS

22 earlier marks containing the word **ALTOS**

GC:

- Earlier mark **must be valid at the time of the BoA decision**, otherwise the proceedings become devoid of purpose
- Failing to assess the chances of success of the proceedings brought against the earlier mark may constitute **manifest error of assessment**
- **BoA should have assessed the chances of success of the revocation** to properly weigh the competing interests
- **Grace period remains intact**
- **There is manifest error of assessment**

DECISION ANNULLED

T-82/18 Husky (21/11/2018)



vs



HUSKY

Two earlier marks:

Verbal mark registered in 1998

Figurative mark registered in 2005

The opponent based the opposition on both marks, but submitted arguments only as regards the earlier verbal mark

EUTM applicant: proof of use request for the earlier the verbal mark

Opponent: no evidence of use

T-82/18 Husky (21/11/2018)

 **HUSKY**

vs

 **HUSKY**

HUSKY

ACTION DISMISSED

Opposition division: likelihood of confusion **with the earlier figurative mark**

Board of Appeal: confirmed

Applicant before the GC:

- **Opposition was withdrawn as regards the earlier figurative mark**

General Court:

- No express provision for withdrawals of the opposition
- Article 43(1) Reg. 207/2009 (now 49(1) EUTMR) refers only to withdrawals of a trade mark application → T-219/00: withdrawal must be made **expressly and unconditionally**
- The scheme of EUTMR place **opponent and applicant** on an **equal footing** → that equality must extend to the possibility of withdrawing procedural documents
- **Withdrawal of opposition** must also be **express and unconditional**

T-82/17 Exxtra Deep (21/11/2018)

Exxtra Deep

inter alia for *potato crisps and other vegetable crisps preserved, dried, and cooked fruits and vegetables* in Class 29C

CD + BoA

Descriptive for *potato crisps and other vegetable crisps*, **but not for *preserved, dried, and cooked fruits and vegetables* in Class 29**

- unlike potato crisps, vegetables and fruits were generally not ridge-cut
- a potato crisp or snack may be made from vegetables without being a vegetable itself
- the relevant public could, at most, view the contested mark as an allusion to a particular cut of vegetables or fruits, but not as a description of the characteristics of those goods
- there is nothing that would indicate that the term ‘deep’ is intrinsically descriptive of vegetables or fruits. For the relevant public to draw the conclusion that that term describes a certain cut of preserved, dried, and cooked fruits or vegetables, a second mental step would therefore be required.

T-82/17 Exxtra Deep (21/11/2018)

Exxtra Deep

*inter alia for potato crisps and other vegetable crisps
preserved, dried, and cooked fruits and vegetables in Class 29*

GC:

are (1) extruded and pelletised or otherwise manufactured or processed vegetable and potato products for snacks **covered by** (2) preserved, dried, and cooked fruits and vegetables?

→ Yes

- Snacks are made from potatoes, which, it cannot be denied, are vegetables
- Crisps can be made from vegetables other than potatoes, or from fruit
- Crisps made from vegetables can be regarded as dried or cooked vegetables or fruits
- Fruit and vegetables in Class 29 are 'preserved, dried and cooked', i.e. not fresh

→ the BoA failed to draw consequences of the finding that Exxtra Deep was descriptive *snacks and crisps* for the assessment of descriptive character for *preserved, dried, and cooked fruits and vegetables*

DECISION ANNULLED

T-790/17 St Andrews (20/11/2018)

ST ANDREWS

Class 41: ‘Arranging and conducting entertainment conferences, congresses, events, competitions and seminars; Club services (entertainment or education); etc.

Examiner and BoA:

Services can all directly relate to golf sports, in other words, to the particular field for which the town of St Andrews (United Kingdom) is very well known

→ Consequently, the use of that expression in connection with those services will be perceived by the relevant public as a **descriptive indication of the geographical origin of those services.**

T-790/17 St Andrews (20/11/2018)

ST ANDREWS

GC: principles C–108/97 & C-109/97 *Chiemsee*

Geographical names are excluded from registration if:

- famous or known for the category of g/s concerned
- liable to be used by undertakings and must remain available to such undertakings

X

- Places unknown (at all or as designation of a geographical location)
- Places known but because of the type of place they designate the relevant public is unlikely to believe that the g/s originate there

T-790/17 St Andrews (20/11/2018)

ST ANDREWS

GC:

St Andrews **famous for golf sports**, particularly well known by golf professionals and enthusiasts

The **link to the services** (*arranging and conducting entertainment conferences, congresses, events, competitions and seminars; Club services (entertainment or education); etc*) **is sufficiently direct and specific**

ACTION DISMISSED

T-830/16 Plombir (13/12/2018)

PLOMBIR *compotes, eggs, milk and milk products*
ice cream, coffee, cocoa

Invalidity request: The mark is transliteration of „Пломбир“ : Russian expression for ice-cream

CD: invalidity request upheld

BoA:

- the cancellation applicant did not prove that a significant percentage of consumers in Germany (examination limited to Germany by the BoA) knows Russian
- not enough evidence that the mark means 'ice cream'
- two step process necessary (transliteration and attributing descriptive meaning)
- Invalidity decision annulled

T-830/16 Plombir (13/12/2018)

PLOMBIR *compotes, eggs, milk and milk products*
ice cream, coffee, cocoa

GC:

“**part of the EU**” within the meaning of Article 7(2) EUTMR

- C-25/05 Storck vs OHIM: “part of the EU can be one MS”

- **cannot be interpreted that it could not be less than one MS** (i.e. it can be part of one or more MS)

- **no obligatory reference to one of the official languages** of the EU

T-830/16 Plombir (13/12/2018)

PLOMBIR *compotes, eggs, milk and milk products*
ice cream, coffee, cocoa

GC:

- Relevant public: Russian speaking public
- The cancellation applicant proved that 3 million Russian speakers live in Germany
- Russian speakers in Baltic states: well-known fact
- PLOMBIR is faithful transliteration of „Пломбир“
- Russian speakers are used to transliteration of Russian words

DECISION ANNULLED

T-702/17 PAP Papouis Halloumi (23/11/2018)



VS

HALLOUMI

Earlier UK collective and certification marks

Opposition rejected:

OD: marks similar, but there is no likelihood of confusion

BoA: marks dissimilar → no need to assess other factors of LoC

Visually: only coincidence in the word Halloumi placed in the third position, figurative presentation of the contested mark strengthens the differences

Aurally: contested mark much longer, includes distinctive elements PAP PAPOUIS, coincidence only in the final part

Conceptually: the mere presence of the term 'halloumi' in the mark applied for is not such as to give rise to such similarity.

T-702/17 PAP Papouis Halloumi (23/11/2018)



VS

HALLOUMI

Earlier UK collective and certification marks

General Court: **marks are similar**

Visually: 'pap', 'papouis' and 'halloumi' are equally apparent and that they are also equally dominant; 'halloumi', situated in third position in that sign, is also situated in a central position, written in white letters surrounded by blue and gold, enabling it to be perceived easily and immediately; figurative elements not original → **weak visual similarity**

Aurally: part of the public will read the three dominant elements → inevitably results in **aural similarity (low)**

Conceptually: 'halloumi' in the contested mark only weakly distinctive but could be considered individually by the relevant public → **low degree of conceptual similarity**

DECISION ANNULLED

T-339/17 Sevenoak (21/11/2018)

 SEVENOAK

VS

 7SEVEN

Identical goods in Class 9 (optical lenses, cases for cameras)

Opposition division: no likelihood of confusion

Board of Appeal: likelihood of confusion

General Court:

distinctiveness of ‘seven’:

- ‘seven’ has a normal degree of distinctiveness, and ‘is not insignificant’ in the overall impression of the earlier mark, but it is not dominant, the number ‘7’ is relevant (at the beginning), both elements have independent distinctive role in the earlier mark, both should be taken into consideration

T-339/17 Sevenoak (21/11/2018)

SEVENOAK

VS

7SEVEN

Identical goods in Class 9 (optical lenses, cases for cameras)

General Court:

DECISION ANNULLED

Comparison of the signs:

- Visually: 'seven' is an 'indication of similarity', but overall the signs are **visually dissimilar**
- Aurally: **certain aural similarity**
- Conceptually: **some conceptual similarity**

- the marks at issue will generally be perceived visually prior to purchase. → the **visual differences outweigh the phonetic and conceptual similarities** → **marks not similar** → no likelihood of confusion, no application of principle of interdependence → even if low degree of similarity → still NoLoC

T-672/16 C=Commodore (13/12/2018)



- Trade mark owner grants licenses, does not produce goods
- In the relevant period had to face fraudulent, misleading and intimidatory litigation strategies of a third party
- Legal uncertainty: difficulties to grant licences

BoA: **no proper reasons for non-use** → EUTM revoked for some goods

- the EUTM proprietor itself showed that use was possible, for other goods
- The EUTM proprietor could have itself used the mark for the goods at issue
- fraudulent and intimidatory strategies 'cannot be per se proper reason for refraining from business activity', especially when the EUTM proprietor did not have doubts as to the legitimacy of its rights

T-672/16 C=Commodore (13/12/2018)



General Court: C-246/05 *Armin Haupl*: obstacles which have a sufficiently direct relationship with a trade mark, making its use **impossible or unreasonable**, and which arise **independently of the will of the proprietor of that mark**,

- It is **irrelevant that the use of the EUTM was possible**
- The BoA disregarded the fact that the sole activity of the EUTM owner was conclusion of licence agreements
- The EUTM proprietor did **not face mere commercial difficulties**, but ‘fraudulent’, ‘misleading’ and ‘intimidatory’ strategies by a third party
- **There were proper reasons for non-use**

DECISION ANNULLED

T-274/17 Monster Dip (13/12/2018)



Classes 2, 37, 40

VS



Reputation for non-alcoholic beverages

BoA: no link between the signs

General Court:

- Link/association between the marks: criteria C-252/07 *Intel*
- **Reputation** of the earlier mark **only for non-alcoholic drinks**
– those only are relevant for the assessment of the link
- The **products** covered by the conflicting marks are in **totally different sectors**, aiming at **completely different consumers** (non-alcoholic drinks vs paints, varnishes and related services)
- The **similarity between the marks is not high**

→ no link

ACTION DISMISSED

T-215/17 Pear (31/01/2019)



vs



Classes 9, 35, 42

OD and BoA: opposition upheld based on Article 8(5) EUTMR

Visual similarity:

- at most **remote visual similarity** and a weak conceptual similarity
- they depict sleek rounded silhouettes of fruit, with the oblong shape leaning to the right on top of the main object

Conceptual similarity:

- although apples and pears are two distinguishable fruits, they are **fruits which are closely related** in a biological sense (origin, size, colours, texture) and they are **associated together in many ways throughout the relevant territory** and are **common alternatives to each other**

T-215/17 Pear (31/01/2019)



VS



Classes 9, 35, 42

OD and BoA: opposition upheld based on Article 8(5) EUTMR

Link:

- the perception of the consumer admittedly involved making some mental steps, but that, because of the **uniqueness and the high reputation of the earlier mark**, the **allusive and 'somewhat mocking' image of the pear** depicted in the mark applied for would establish a mental link with the earlier mark.

Injury:

- **unfair advantage of the distinctive character or the repute of the earlier mark:**
 - **high reputation of the earlier mark in the market,**
 - **link between the signs at issue, use of a piece of fruit is highly distinctive and unusual**
 - **identity or similarity between the goods and services**
 - **the idea that the trade mark applied for 'imitated and at the same time mocked and defied' the earlier mark.**

T-215/17 Pear (31/01/2019)



VS



PEAR

Classes 9, 35, 42

General Court :

True that under Art. 8(5) EUTMR, the necessary similarity may be of a lesser degree than under Art. 8(1)(b) EUTMR

visual comparison:

- Depiction of different fruits;
- Shapes for figurative elements dissimilar (“stem” vs. “leaf”);
- Pear depicted as a compilation of many rounded squares of different sizes, apple one solid image;
- “bite” (apple) vs. no bite (pear)
- Word element (“pear”) vs. no word element

→ the marks visually dissimilar overall

T-215/17 Pear (31/01/2019)



VS



General Court :

conceptual comparison:

- the contested mark has the concept of “a pear with a stem”,
- the earlier mark has the concept of an “apple with a leaf, with a bite taken out of it”.

Semantic differences:

- Apple vs. pear
- Bite taken out vs. full fruit
- “Leaf” vs. “stem”

Communalities:

- Image of fruits: the mere existence of a generic term, under which both concepts fall, does not make them similar

- “external factors” unrelated to the depiction of the signs: apples and pears share several features in real life (texture, biological background, distribution channels, “antagonism”): **BoA was wrong to attach decisive importance on the above mentioned elements**

DECISION ANNULLED

→ No conceptual similarity



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Thank you