

Track on Case Law: Judgments of the GC and CJEU- Decisions of the EUIPO BoA, 2021 Q1

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Boards of Appeal, Litigation Service

PROGRAMME

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Presentation

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10'
Questions and answers

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INTRODUCTION : The 6 'Must Read' Decisions

1. GC, 24/03/2021, T-193/18, GREY AND ORANGE (col.), R 200/2017-2 [**Clarity of the sign**, Art 7(1)(a) EUTMR];
2. GC, 20/01/2021, T-253/20 It's like milk but made for humans, R-02446/2019-5 [**Distinctiveness of slogans**, Art. 7(1)(b) EUTMR];
3. GC, T-328/17 (RENV), BBQLOUMI (fig.) / HALLOUMI et al. , R-00497/2016-4 , 20/01/2021 [**Weak marks/elements**, Art 8(1)(b) EUTMR
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5. GC, T-71/20, Puma-system / PUMA (fig.) et al., R-00404/2019-1, 10/03/2021 [**Reputation** (Art 8(5) EUTMR)];
6. BoA, 09/02/2021, R 237/2020-4, Sol de Mallorca / Mallorca [**Conflict with PGI** (Art 8(6) EUTMR)]

Procedural Issues

1

Absolute Grounds

Relative Grounds

Scope of the dispute before the General Court: T-61/20 B-direct / izdirect (fig.), R-00088/2019-1, 24/02/2021

The fact that the applicant did not dispute the similarity of the goods of the opposing signs before the BoA cannot deprive it of the right to challenge before the GC the findings of the BoA in that respect, the latter having endorsed the grounds for the OD's decision (§ 36)

CJEU, 18 juin 2020, aff. C 702/18 P, Primart c/ Prima, § 41-46

1

**Restitutio in Integrum (Article 67(1) CDR): T-276/20 Air deodorizing apparatus R-02396/2019-3,
DES 20/01/2021**

The risk inherent in sending a document by **ordinary mail**, which is the method of communication chosen by the representative before the Office, cannot be borne by the addressee of that letter, where the addressee of that letter makes various claims such as to cast reasonable doubt as to the receipt of the document in question (§ 29, 32)

An effective system of internal supervision and monitoring of compliance with time limits, where posting of mail by ordinary mail is used as a method of communication, must include verification that such mail has been received by its addressee (§ 38)

Absolute Grounds

2

Procedural Issues

Relative Grounds

Clarity of representation (Art 7(1)(a) EUTMR): GC, 24/03/2021, T 193/18, GREY AND ORANGE (col.),



Description:

'The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw'

2

Clarity of representation (Art 7(1)(a) EUTMR): GC, 24/03/2021, T 193/18, GREY AND ORANGE (col.),

The juxtaposition of two colours, without shape or contours, does not amount to claiming protection of such colours ‘in every conceivable form’, **where the description makes it clear that the combination of colours follows a predetermined arrangement**, such as a vertical repartition of the colours on the housing of chainsaws divided into one upper and one lower part (§ 37-39).

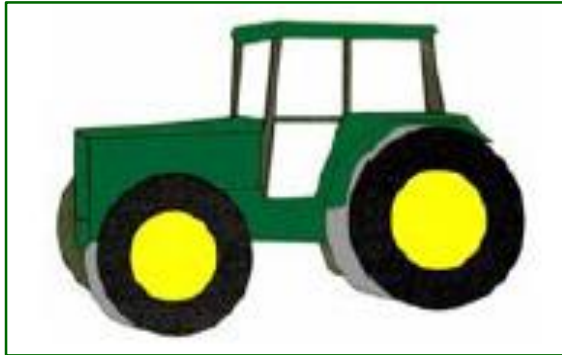
This ‘clarification’ ‘places a greater limit on the shapes which the chainsaw housing may take’ (§ 37). This bars a claim of protection extending to the colours ‘in every conceivable form’ (§ 38).

GC, 24/03/2021, T 193/18, GREY AND ORANGE (col.),

Having regard to the fact that chainsaw housings may have different shapes to which the spatial arrangement of the colours must adapt, this might imply slight variations of the colours' ratios and configuration. This is however not decisive because the 'average consumer' (in general) identifies trade marks based on their imperfect recollection (§ 39).

The General Court supports this conclusion by noting that the specific 'average consumer' in this case is a specialist (§ 41).

R 0222/ 2007-2, John Deere (T-137/08, C-553/09 P)



‘the **combinaison** of green and yellow colors, in particular green vehicle body & yellow wheels’



The figurative element reinforces this descriptive message and, in any event, cannot distract the consumers' attention away from the descriptive word's message. Overall, the mark is descriptive as a whole (§ 62).

Distinctive character (Art 7(1)(b) EUTMR)GC, T-253/20 It's like milk but made for humans R-02446/2019-5, 20/01/2021

By means of such a meaning, the mark applied for calls into question the **commonly accepted idea** that milk is a key element of the human diet, as is shown by the evidence which the applicant put forward before the Board of Appeal and then the Court, from which it is apparent that the launch of the mark applied for gave rise to controversy in the Netherlands, Sweden and the United Kingdom (§ 45)

The mark applied for therefore conveys a message which **is capable of setting off a cognitive process** in the minds of the relevant public making it easy to remember and which is consequently capable of distinguishing the applicant's goods from goods which have another commercial origin (§ 46)

GC, T-19/20 I love (fig.) R-00005/2019-5 CANC 12/02/2021 (Order)



The fact that the contested trade mark is affixed to the goods as a logo or in accordance with the identification practices of the clothing sector does not invalidate this finding (§ 88). The mark must be assessed **as it was filed, not as it is used** (§ 90).

GC, T-19/20 I love (fig.) R-00005/2019-5 CANC 12/02/2021 (Order)



The applicant filed the mark applied for without adding a description to restrict the scope of protection to a logo or a label and without specifying where the mark might be positioned on its products. It is therefore not possible to assess the distinctive character of the contested trade mark in relation to a particular use

(See 03/12/2019, T 658/18, CHECKERED GINGHAM PATTERN, § 36) (§ 90). [Comp. CJEU, 12/09/2019, C-541/18, Darferdas, § 25-30]

Generic signs (Art 7(1)(d) EUTMR) : GC, 17/03/2021, T 878/19, K-9

Documents originating from outside the EU can be taken into account **only if** they are capable of proving circumstances having a bearing on the perception of the sign by the relevant public of the EU (§ 34 35).

Such demonstration cannot be limited to isolated cases or sporadic examples but must establish, in particular, the existence of ‘established’ practices of trade known by a significant part of the relevant public in a *substantial part* of the territory of the EU (by analogy, 11/06/2020, C 115/19 P, CCB (fig.) / CB (fig.) et al, EU:C:2020:469, § 57) (§ 50).

Signs contrary to public policy & morality (Art 7(1)(f) EUTMR) : BoA, 09/02/2021, R2890/2019, THE TERPS DONUTS (fig.) + 04/03/2021, R 213/2021-5 Well Weed



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Relative Grounds

Procedural Issues

Absolute Grounds

3

Clarity & Precision of G&S indication: GC, T-56/20 Vroom / Pop & Vroom, R-01288/2019-5,
24/02/2021 [LoC]

Contested goods: *Software for educational purposes*

Earlier goods: *Software + variety of specific software relating to car sharing services*

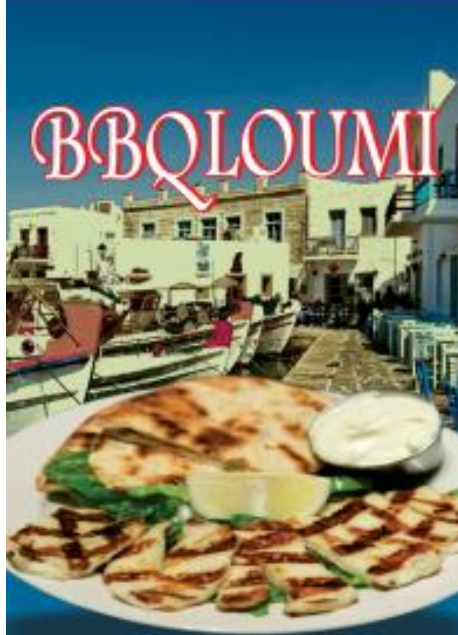
Even if it were assumed that the product indication software in the earlier mark were vague, this would **not affect the possibility of a comparison with the contested goods.**

[Comp. 29/04/2015, T-717/13, Shadow Complex, § 32-33: Software is clear enough]

Clarity & Precision of G&S indication: GC, T-56/20 Vroom / Pop & Vroom, R-01288/2019-5,
24/02/2021 [LoC]

The specific field of application of the general indication ‘software’ cannot be inferred either from the other goods and services covered by the earlier mark or from the actual fields of activity of the parties (§ 29-33).

Weak marks/elements: GC, T-328/17 (RENV), BBQLOUMI (fig.) / HALLOUMI et al. , R-00497/2016-4, 20/01/2021 [No LoC]



Distinctiveness of an earlier EU collective mark **cannot** be assessed in a specific way on the ground that it is a collective mark (§ 67).

Where the elements of similarity between two signs arise from the fact that they share a component which has weak inherent distinctiveness, the **impact of such elements on the global assessment of the likelihood of confusion is itself low** (§ 64).

Weak marks/éléments: GC, T-844/19, discount apotheke.de (fig.) / APODISCOUNTER et al
R-02309/2018-5 20/01/2021 [No LoC]



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APODISCOUNTER

3

Weak marks/éléments: GC, T-829/19 BLEND 42 VODKA (fig.) / 42 below et al.
R-02531/2018-2, 20/01/2021, § 89 [LoC]. Comp. GC, T-435/12, « 42 Below / Vodka 42 », § 106 -113

BLEND



VODKA

42 BELOW



3

Weak marks/éléments: GC, T-817/19 Hydrovision (fig.) / Hylo-vision, R-02371/2018-2, 27/01/2021, § 93-95 [LoC]

Hydrovision

Cl 5: Pharmaceutical preparations for the treatment of eye diseases and conditions

HYLO-VISION

*Cl 5: Dietary supplements and dietetic preparations;
Medical and veterinary preparations and articles*

3

Weak marks/éléments: GC, T-61/20 B-direct / izdirect (fig.) R-00088/2019-1, 24/02/2021 [LoC]

B-Direct

CI 9: Software for auditive correction



CI 9: Software

3

Coexistence : GC, T-693/19, KERRYMAID / KERRYGOLD, 10/03/2021

The fact that, in part of the European Union (Ireland and the UK), an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that, **in another part of the EU**, where peaceful coexistence is absent, there is no likelihood of confusion between that EU trade mark and that sign (*20/07/2017, C 93/16, kerrygold, EU:C:2017:571, § 38*) (§ 130, 134).

Where the opposition to the registration of an EU trade mark is based on an earlier EU trade mark, coexistence must be proved for the **entire territory of the European Union** (§ 159-161).

Final national judgments relating to infringement actions are not binding on EUIPO when it examines oppositions.

Reputation (Art 8(5) EUTMR) : GC, T-71/20, Puma-system / PUMA (fig.) et al., R-00404/2019-1,
10/03/2021

Cutting machines, software & IT services vs Clothing & sports articles

The fact that the marks are similar and that the earlier mark has an exceptional reputation cannot automatically be sufficient for a link between those marks to be found (§ 71). This is the case even if it is established that the specialised public targeted by the goods protected by the contested mark is aware of the earlier mark, whose reputation goes beyond the public of the goods covered by the earlier mark (§ 85).

Reputation (Art 8(5) EUTMR) : GC, T-71/20, Puma-system / PUMA (fig.) et al., R-00404/2019-1,
10/03/2021

BoA was not obliged to respond expressly to the argument by which the applicant relied on a previous EUIPO decision. That EUIPO decision was not relied on as **evidence** of a factual situation such as that relating to the reputation of the earlier mark, but merely to claim that legal provisions should be applied in the same way to comparable factual situations (§ 92-94).

Conflict with PGI (Art 8(6) EUTMR) : BoA, 09/02/2021, R 237/2020-4, Sol de Mallorca / Mallorca

‘Alcohol-free wine’ is a comparable product to ‘wine’, in accordance with Article 103(2)(a)(i) of Regulation No 1308/2013.

The same applies to the contested ‘soft drinks’, since this general term covers ‘alcohol-free wine’. The Board cannot split the general term into subcategories; it is therefore irrelevant that the general term comprises various goods which are different from ‘alcohol-free wine’.

Since the sign applied for contains a protected geographical indication, the conditions of Article 8(6) EUTMR are fulfilled and the opposition is allowed entirely. The Board annuls the contested decision and rejects the EUTM entirely.

Right to a name (Art 60(2)(a) EUTMR) : BoA, 29/01/2021, R 1100/2020-5, GAUDÍ ORIGINAL INSPIRATED (fig.) / Antoni Gaudí et al.



Antoni Gaudí

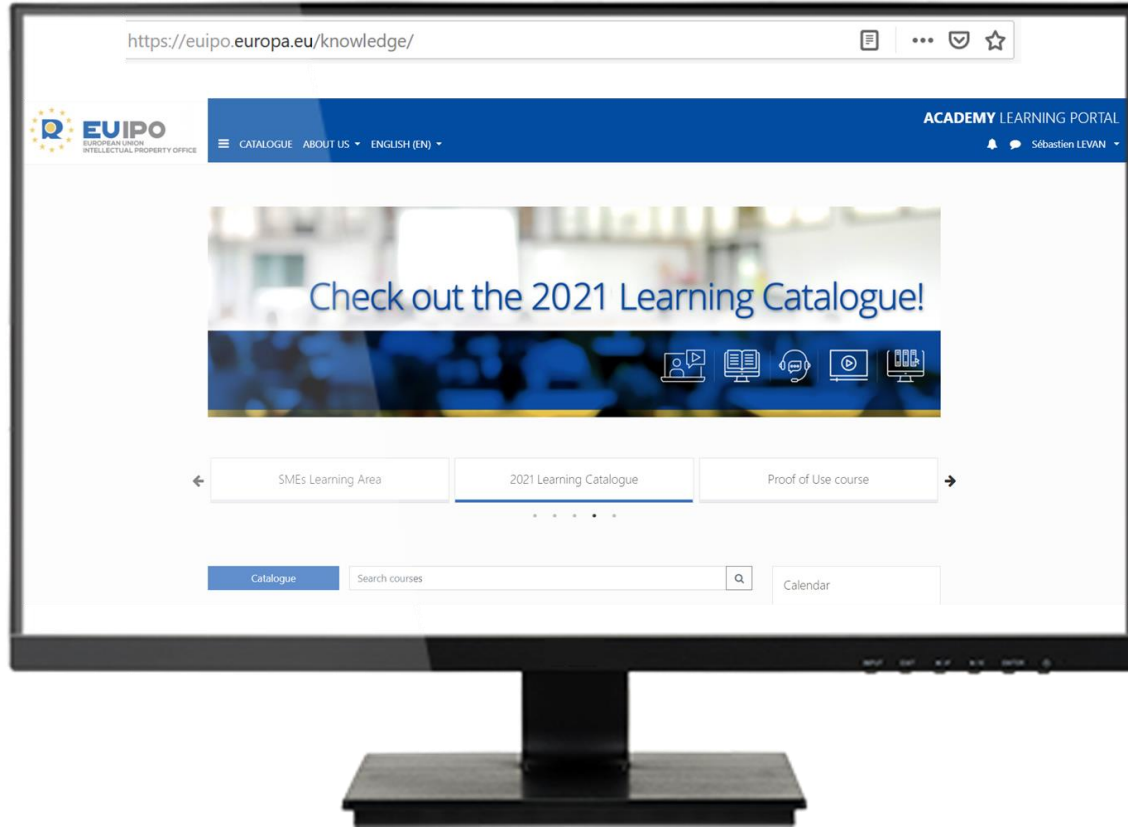
The contested EUTM violates the cancellation applicant's **right to the name** Antoni Gaudí, the famous Catalan architect. The Board confirms that cancellation applicant is entitled, as the architect's heir, to bring the relevant action against the EUTM registration.

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