

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

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# ABSOLUTE GROUNDS

Judgment of 03/10/2018, T 313/17, FORM EINER FLASCHE (3D) [Article 7(1)(b)]

Judgment of 24/10/2018, T 447/16, DEVICE OF PIRELLI TYRE TREAD (fig.) [Article 7(1)(e)(ii)]

## Judgment of 3 October 2018, T-313/17, Wajos GmbH (shape of a bottle)

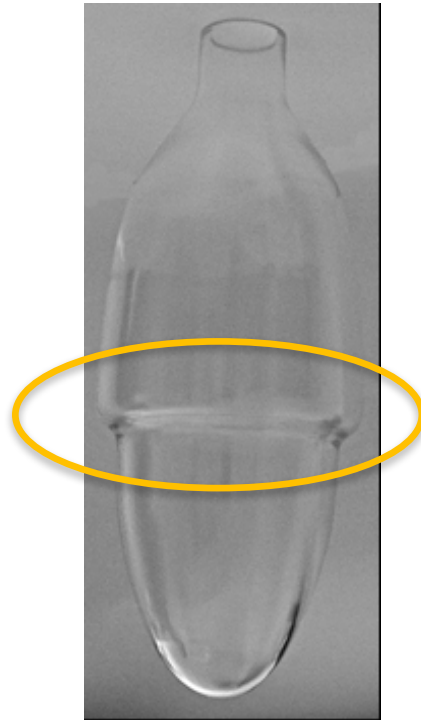


EUTM No 14 886 097 (Cl. 29, 30, 32, 33)

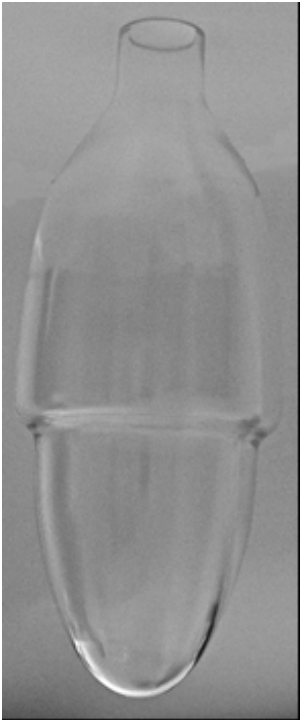
*Inherent distinctiveness?*

[Article 7(1)(b) of Regulation No 207/2009]

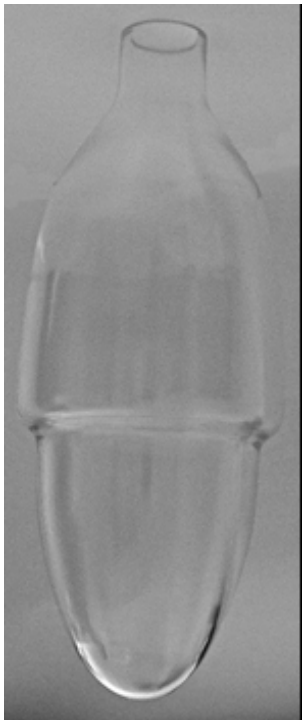
- **Examiner & BOA:** EUTM does not depart from the norms and customs of the sector (lack of distinctive character)



- **EUIPO's Guidelines (Part B, Examination, p. 21):** 'Functional shapes or features of a shape mark will be perceived by the consumer as such. For example, for washing tablets, bevelled edges avoid damage to laundry, and layers of different colours represent the presence of different active ingredients'.



- Consumers are not used to such an *accentuated curved* form in the middle of a bottle (§34).
- The form departs from classical amphoras, in particular because amphoras are not normally made of glass (§34).
- Although the ridge constitutes a technical and functional feature, it also adds *aesthetic value* to the contested mark (§ 35).
- Taking into account the *overall aesthetic result*, the shape is capable of holding the attention of the public concerned, enabling that public to distinguish the goods covered from those having a different commercial origin (§36).



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**ANNULLED**

## Judgment of 24 October 2018, T-447/16, Pirelli Tyre SpA ('L-shaped groove')

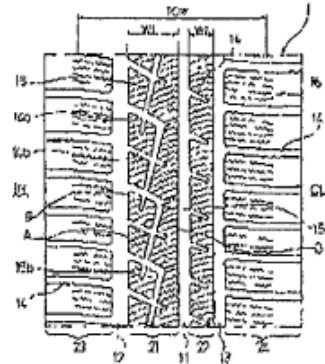


Cl. 12 *'tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds'*

*Technical function?*

[Article 7(1)(e)(ii) of Regulation No 207/2009]

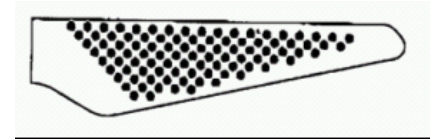
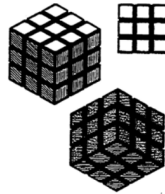




- **Cancellation Division:** upheld the invalidity action
- **BOA:** dismissed the appeal



55 (...) the contested sign (...) is (...) **only a very limited part, namely a single groove, of another part, namely a tyre tread, which is formed of multiple interlacing elements.** That tyre tread is itself a part which, together with other parts, particularly sidewalls, constitutes the goods in question covered by the contested mark, namely tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds. **The contested sign therefore does not represent the goods in question covered by the contested mark, or a tyre tread.**



- Application by analogy of the Judgments in *Lego*, *Philips*, *Simba toys* and *Yoshida* (no)?

64 (...) the conclusion that the EU Courts reached in those cases **cannot (...)** be applied to a sign, such as the one contested in the present case, **which does not reveal the outline of the goods covered by the contested mark and which represents only a very small part of those goods.**

69 (...) it is true that the scope of the absolute ground for refusal provided for in Article 7(1)(e)(ii) of Regulation No 40/94 is not limited solely to signs formed exclusively of the shape of ‘goods’ as such. Indeed (...) the general interest which underlies that provision could require signs consisting of the shape of part of a product that is necessary to obtain a technical result to also be refused registration. **That would be the case if that shape represented, quantitatively and qualitatively, a significant part of that product.**



70 However (...) in the present case, **the contested sign represents a single groove of a tyre tread.** Accordingly, in the context of the goods in question, **the contested sign does not represent a tyre tread since it does not incorporate the other elements of a tyre tread,** with which that sign creates numerous shapes, which are complex and different from the shape of each of the grooves and of each of the elements considered in isolation.

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**ANNULLED**

# GROUNDS FOR REVOCATION

**Judgment of 08/11/2018, T 718/16, SPINNING [Article 58(1)(b) EUTMR]**

## Judgment of 8 November 2018, Mad Dogg Athletics (SPINNING)

# SPINNING

EUTM No 175117

Cl. 28: 'Exercise equipment';

Cl. 41: 'Exercise training'.

*Common name?*

Article 51(1)(b) of Regulation No  
207/2009 (now Article 58(1)(b)  
EUTMR)

## BOA:

- **Objective condition:** The term ‘spinning’ had become, in the Czech Republic, the *common name* for a type of ‘exercise training’ and for the ‘exercise equipment’ used for that training.
- **Subjective condition:** This was due to *insufficient activity* by the applicant to protect its trade mark in the Czech Republic.

## Application for annulment:

- Infringement of (i) Article 51(1)(b) of Regulation No 207/2009
  - Relevant date
  - Relevant territory
  - Relevant public



## General Court – Relevant date (§§12-28):

- The **date of the application for revocation** or, at the request of one of the parties, an earlier date on which one of the grounds for that revocation occurred
  - Wording of Article 55(1) of Regulation No 207/2009 [Now 62(1) EUTMR]
  - Analogy with the ground of revocation for lack of genuine use.
  
- **Circumstances arising after the application for revocation is filed are irrelevant** (unless it confirms or makes it possible to better assess circumstances arising before, or prevailing on, the date of the application for revocation).

## General Court – Relevant territory (§§29-50):

- It is sufficient that the transformation of such a mark into a common name be established in a **single Member State** for its proprietor's rights to be revoked in respect of the whole of the European Union (§34).
  - Unitary character of the EUTM
  - Objectives pursued by the EUTM Regulation

## General Court – Relevant public (§§51-65):

- The question whether a trade mark has become the common name in the trade (...) must be assessed not only in the light of the perception of consumers or end users **but also, depending on the characteristics of the market concerned, in the light of the perception of professionals**, such as sellers. However, in general, the perception of consumers or end users will play a decisive role (§53). [C-409/12, Kornspitz, §§28-29]
- **End users very rarely buy its indoor cycles** owing to their high purchase price. (...) [the Applicant's] indoor cycles were sold to professional customers in 95% of cases (§57-58)
- *Error of assessment of the Board of Appeal – Annulment*

**ANNULLED**

## Conclusion:

- **Relevant date:** date of the application for revocation
- **Relevant territory:** one single Member State may suffice
- **Relevant public:** assessment required from the perspective of both the end users and the professionals (depending on the characteristics of the market)





# RELATIVE GROUNDS

Judgment of 24/10/2018, T 261/17, SALOSPIR 500 mg (fig.) / Aspirin et al.  
[Article 8(1)(b), 8(4) and 8(5) EUTMR]

Judgment of 25/09/2018, T 238/17, GUGLER (fig.) / GUGLER FRANCE  
[Article 8(4) EUTMR]

Judgment of 15/10/2018, T 7/17, MINERAL MAGIC / MAGIC MINERALS BY  
JEROME ALEXANDER et al. [Article 8(3) EUTMR]

# Judgment of 24 October 2018, T-261/17, SALOSPIR

Earlier rights	EUTM application
<p><u>Aspirin</u>      a) German TM</p> <p><b>Aspirin</b>      b) German TM</p>  <p>c) EUTM</p>  <p>d) EUTM</p>  <p>e) Non registered German mark</p>	
<p><b>Class: 5</b></p>	<p><b>Class: 5</b></p>

OD: dismissed the opposition.

BoA: dismissed the appeal

- The signs are different
- No proof that German law granted protection to the non-registered sign

Application for annulment:

- Wrong assessment of the similarity of the signs
- Misinterpretation of two surveys

## Dominant / distinctive elements:

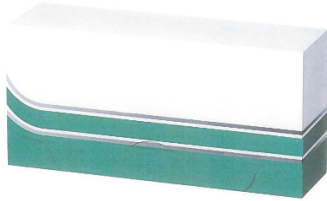
- ‘ (...) taking account of its large size and its central position on a white background, the Board of Appeal was right to find that the **word element ‘salospir’ dominated the overall impression** conveyed by the mark applied for, all the more so since the figurative elements of that mark are either descriptive of the pharmaceuticals at issue, or fairly common within the sector (...).’ [§38]
- ‘given that pharmaceuticals issued without prescription are purchased in a pharmacy and the purchaser, as a general rule, **will say their name**, the word element of the mark applied for must be held to be dominant for that reason too.’ [§39]



## Independent distinctive role (NO):

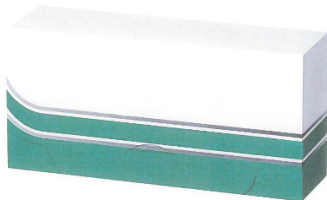
- ‘In contrast to the case which gave rise to the judgment [Thomson life, C-120/04], in which one of the elements of the contested sign consisted of an earlier mark, in the present case **the mark applied for does not incorporate an earlier mark as one of its components.**’  
(§45)

## Evidential value of surveys:



- ‘(...) the legal principles applicable to the assessment of likelihood of confusion between the signs at issue constitute a **point of law** (...) the existence of a likelihood of confusion presupposes in particular that the signs at issue are identical or similar. (...) since the signs at issue are dissimilar (...) that condition is not satisfied. That principle (...) cannot be contradicted by a survey commissioned by one of the parties to the dispute, seeking to prove that there is a likelihood of confusion (§59).

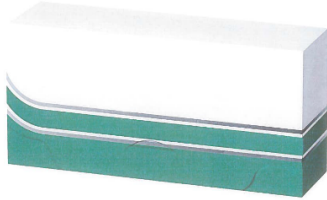
## Methodology of the surveys:



- ‘The neutralised packaging survey and the Salospir survey were not carried out in the objective circumstances in which the marks at issue are present, or may be present, on the market’ (§65):
  - OTC pharmaceuticals are generally ordered orally, and neutralised packaging not present on the market as such
  - Surveys conducted at the homes of the participants, while pharmaceuticals are normally purchased in pharmacies
  - SALOSPIR not sold in Germany: the persons interviewed are unlikely to have been confronted with the product



## Methodology of the surveys (2):



- ‘the probative value of surveys also depends upon whether the persons interviewed have been shown **several images** in order to be able to spontaneously associate one of those images with a trade mark or an undertaking, instead of being shown one image only’

// T-262/04, Shape of a lighter, §84



## Judgment of 25 September 2018, T -238/17, GUGLER



**GUGLER**

**EUTM Registration** filed in 2003  
by German manufacturer of  
windows (since 60's)  
(‘Gugler Germany’)

Earlier **company name** protected in France  
since 2002 (art. 8(4))  
Distributor of the German manufacturer from  
2002 to 2010 (‘Gugler France’)

# GUGLER Germany ↔ GUGLER France

- **Economic link** between the companies:
  - Gugler France = distributor of Gugler Germany's goods in France (since 2000)
  - Since July 2002, Gugler Germany held 498 shares in the Gugler France's capital
- **BoA** (§47): '(...) the risk of confusion must exist for the public, not the parties to an agreement, and there is no evidence that the existence of this distributorship agreement, which moreover has not been set out in writing, is known to the public.'

## Consequences of the existence of an economic link?

- **Essential function**: the finding of a likelihood of confusion is intended to protect the trade mark's function (...) if **there is a risk that consumers may be misled as to the origin of the goods or services in question**, on the **false assumption** that the goods and services covered by the signs at issue come from the same undertaking or from economically-linked undertakings.' (§ 39-41)
  
- **Present case**: 'the goods covered by the contested mark are manufactured by Gugler GmbH and the proprietor of the earlier company name is the distributor of those goods.' (§43)
  - The fact that the consumer might believe that the goods and services in question come from economically-linked undertakings **does not constitute an error as to their origin** [By analogy: C-9/93 IHT, Ideal Standard, §37]

## Awareness of the public? (Irrelevant)

- ‘The assessment of the likelihood of confusion is an **objective one**’. (§46)
  - ‘it is not necessary that the consumer should be aware that he is mistaken’ and the consumer ‘cannot be required to know that he will not err as to the origin of the goods because he is aware of the existence of an economic link between the proprietors’
- It is not necessary, in order to exclude the likelihood of confusion where the proprietors of the conflicting signs are economically linked, that the consumer must be aware of that economic link (§48)
- The economic link between Gugler France and Gugler Germany on the date on which the application was filed ***precluded a finding of a likelihood of confusion.***



## Judgment of 15 October 2018, T-7/17, MINERAL MAGIC

### MINERAL MAGIC

**Contested EUTM filed by a distributor  
(agent)**

Cl. 3: hair lotions, abrasive preparations, soaps, perfumery, essential oils, cosmetics; preparations for cleaning and care of the skin, scalp and hair; deodorants for personal use

### MAGIC MINERALS BY JEROME ALEXANDER

**Earlier US Trademark**

Cl. 3: face powder featuring mineral enhancements

- **Article 8(3) EUTMR:** Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where **an agent or representative** of the proprietor of the trade mark **applies for registration thereof** in his own name without the proprietor's consent, unless the agent or representative justifies his action.

**Article 8(3) EUTMR:** Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where **an agent or representative** of the proprietor of the trade mark **applies for registration thereof** in his own name without the proprietor's consent, unless the agent or representative justifies his action.

// **Article 6septies (1) Paris Convention:** 'If the agent or representative of the person who is the proprietor of the mark (...) applies (...) **for the registration of the mark in his own name** (...).

### **Guidelines:**

- 'Such an explicit reference to the principal's trade mark gives the **prima facie impression that the EUTM applied for must be the same as the earlier mark.**'
- 'However, applying Article 8(3) EUTMR exclusively to identical signs for identical goods or services **would render this provision largely ineffective**, as it would allow the applicant to escape its consequences by merely making slight modifications either to the earlier mark or to the specification of goods and services.'
- In view of the need to effectively protect the legitimate proprietor against unfair practices by its representatives, **a restrictive interpretation of Article 8(3) EUTMR must be avoided.**

### Opposition Division: Opposition rejected

- 'It cannot be considered that the signs only differ in elements which do not substantially affect their distinctiveness' [8(1)(a) 'Arthur et Félicie' test]
- 'the signs differ in elements that substantially affect their distinctiveness' [Article 18(1)(a) test]

### Board of Appeal: Appeal upheld

- 'Various links' between the goods in comparison: same ingredients, manufacturers and retail outlets.
- The **signs are similar**: they share the same two words just inverted and the contested EUTM application has additional element 'BY JEROME ALEXANDER' which is likely to be identified as a 'house mark'. Consequently, 'MAGIC MINERALS' as the product name. As such, the contested application 'MINERAL MAGIC' bears striking resemblance to this element 'MAGIC MINERALS'
- The registration of the contested mark could mean a serious obstacle for [the proprietor of the earlier mark] for a potential entry onto the EU market .

## General Court: Annulment

- '[Article 8(3)] requires that there should be a **direct link** [the marks in comparison]. **Such a link can exist only if the trade marks in question match**' (§25)
  - Interpretation supported by the *Travaux préparatoires* (§26-32)
  - Consistent with the wording Article 6 *septies* PUC (§33-35)
- 'The intention of the EU legislature was that Article 8(3) of Regulation No 207/2009 can be applied only if the proprietor's trade mark and the mark applied for by the agent or representative of the proprietor **are identical and not merely similar.**' (§37)

## General Court: Level of ‘identity’ required under Article 8(3)?

- ‘Identity’ within the meaning of *Arthur et Félicie* [Article 8(1)(a) EUTMR] or within the meaning of *Bainbridge* [Article 18 EUTMR]?
  - ***Arthur et Félicie***: differences so insignificant that they may go unnoticed by the consumer, relying on its imperfect recollection of the marks
  - ***Bainbrige***: negligible differences between the signs, which are ‘broadly equivalent’
- Or... a combination of both?
  - ‘It should be determined whether the signs at issue are identical within the meaning of the judgment of 3 December 2015, *iDrive* (T-105/14, // *Arthur et Félicie*, C-291/00), **taking into consideration** the criteria set out in the judgment of 23 February 2006, *BAINBRIDGE*’ (§40).

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Thank you