

Decisions of the Trimester of the GC and the CJEU

Luca Rampini
ICLAD
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C-84/17 P, (KitKat)

EUTM registration No 2 632 529



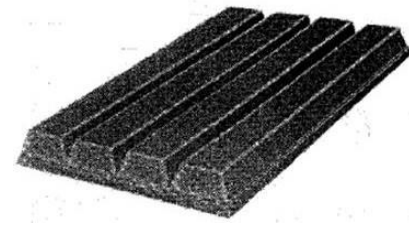
sweets; bakery products, pastries, biscuits; cakes, waffles in Class 30

C-84/17 P, (KitKat)

Article 7(1)(b); Article 7(3) - Article 52(2)

Background:

- 3d EUTM declared invalid by Cancellation Division;
- Board: annulled the CD decision;
- GC: Annulled the Board's decision
 - Art. 7(1)(b): EUTM declared invalid (CD)
 - Art. 7(1)(b) + 7(3): EUTM distinctive through use (BOA)



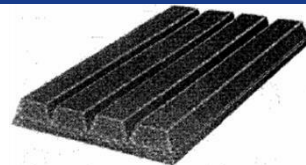
C-84/17 P, (KitKat)

Board:

- confirms that 7(1)(b) applies
- but considers that 7(3) was shown by
 - surveys in 10 MS (direct evidence)
 - indirect evidence' in 4 MS
sales volumes, promotional investments etc.)
 - Globally, acq distinct in respect of 50% public of about 90% of total EU pop.



C-84/17 P, (KitKat)



GC T-112/13:

- Confirmed the acquisition of distinctive character in 10 MS (§ 146-167)
- BoA failed to take expressly position about acq distinct in 4 remaining MS in 4 remaining MS (§ 173)
- distinctiveness only in a substantial part of the territory of the EU' is insufficient (§ 176)

C-84/17 P, (KitKat)

Article 52(2) and Article 7(3)

Appeal to the ECJ:

infringement of Article 52(2) with Article 7(3):

- Against the unitary character of the EUTM
- Incompatible with a single market in the EU
- Contrary to the relevant case-law



C-84/17 P, (KitKat)

Case-Law

C-149/11, Leno Merken:

- The unitary character of the EUTM implies that **territorial borders within the Union are to be disregarded** for the purposes of assessing the acquisition of distinctive character through use (Judgment of 19 December 2012, Leno Merken C-149/11, EU:C:2012:816);

C-84/17 P, (KitKat)

Case-Law

C-98/11, Chocoladefabriken Lindt & Sprüngli:

- Even if it is true that the acquisition by a mark of distinctive character through use must be proved for the part of the EU in which that mark did not, *ab initio*, have such character, it would be unreasonable to require proof of such acquisition **for each individual Member State** (Judgment of 24 May 2012, Chocoladefabriken Lindt & Sprüngli, C-98/11 P, EU:C:2012:307);

C-84/17 P, (KitKat)

Article 52(2) - Article 7(3) EUTMR

ECJ:

- No inherent distinctive character throughout the EU
- It must be shown throughout that territory
NOT only in a substantial part or the majority of the MS



C-84/17 P, (KitKat)

Article 52(2) - Article 7(3) EUTMR

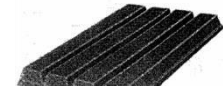
ECJ :

- proof may be produced:
 - globally for all the Member States
 - or separately for different MS
 - or groups of MS



C-84/17 P, (KitKat)

Article 52(2) - Article 7(3) EUTMR
however,



- it is not sufficient evidence that does not cover part of the EU
- even if the part is only one Member State (para 87)

C-84/17 P, (KitKat)

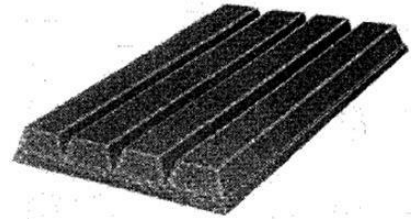
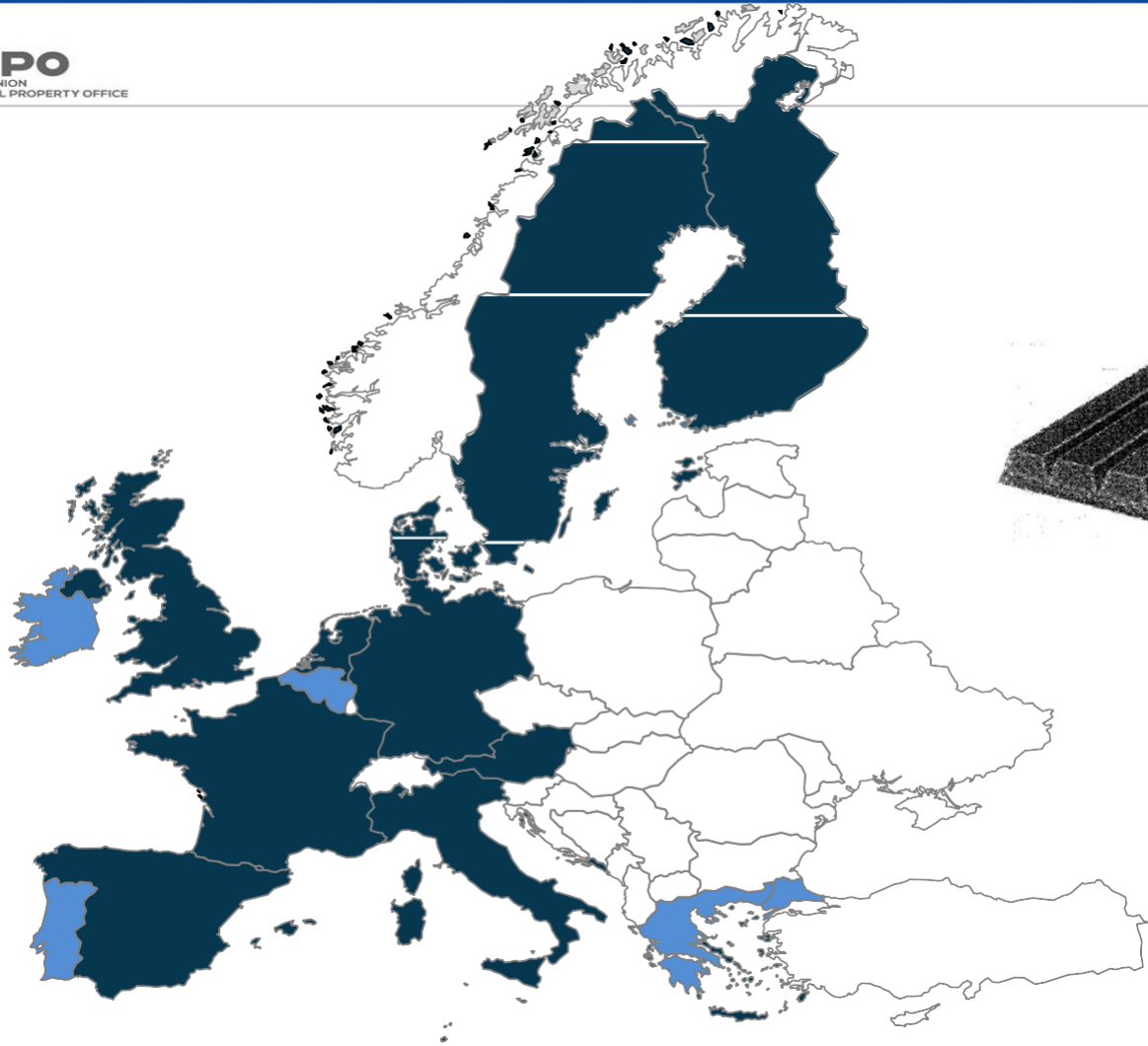
Article 52(2) - Article 7(3) EUTMR

error in law:

Applied Article 7(3)EUTMR

Without adjudicating on acquired distinctive character
in Belgium, Ireland, Greece and Portugal (para 87)





C-54/17 P, (Representation of three vertical colored stripes)

Figurative EUTM No. 12 880 481



Classes 18, 25 and 26

C-54/17 P, (Representation of three vertical colored stripes)

Article 7(1)(b); Article 7(3)

Background:

- EUTM not accepted for registration;
- Board: confirmed the examiner's decision;
- GC: confirmed the Board's decision



C-54/17 P, (Representation of three vertical colored stripes)

GC:

- evidence of acquisition for certain Member States whose population represents a significant fraction of the population of the U as a whole



- **NOT SUFFICIENT**

→)

→

HALLOUMI

Earlier UK certification mark

- Identical products (*cheese*)
- Article 8(1)(b) EUTMR
- OD: No LoC, no enhanced distinctiveness



EUTMA (individual mark)

HALLOUMI



BoA: Appeal is dismissed

- HALLOUMI is inherently weak ‘
- It is not a geographically descriptive term (para 23 and 24)
- the question as to whether a cheese can be called ‘HALLOUMI’ depends on its characteristics and its composition, and not whether the person marketing it belongs to a particular group of licensees (para 25)

Appeal to the GC:

infringement of Article 8(1)(b) EUTMR

- Distinctiveness of the earlier mark
- Assessment of the similarity of the marks
- Assessment of LoC

T-825-16 (Pallas Halloumi)

- Relevant public: Non-specialized UK public;
- “Halloumi” = type of cheese;
- Not associated to a certification process (para 65).

T-825-16 (Pallas Halloumi)

- A national certification mark has a certain degree of distinctiveness;
- No unconditional protection (para 65);

T-825-16 (Pallas Halloumi)

Assessment of similarity:

PALLAS is dominant (para 52) HALLOUMI plays a secondary role (para 53)

- Visual similarity is low (para 60)
- Phonetic similarity is average (para 63)
- The signs are not conceptually similar (para 65)

Assessment of likelihood of confusion:

- Signs are only slightly similar (as regards the descriptive term HALLOUMI)
- The UK concept of 'certification mark' and its sui generis distinctiveness is not relevant, moreover the UK public will not perceive the earlier mark as an indication of any certification
- The earlier mark is weak
- Only coincidence is in a descriptive element
- NoLoC

C-488-16 P (Neuschwanstein)

GC on Article 52(2) and Article 7(3):

Neuschwanstein Castle

- A museum location
- Not famous for the souvenir items



C-488-16 P (Neuschwanstein)

The assessment of the distinctive character:

- The G/S are for everyday use
- Without particular characteristics or specific qualities for which Neuschwanstein Castle would be traditionally known (para 43)

C-488-16 P (Neuschwanstein)

The assessment of the distinctive character:

- The fact the G/S are sold as souvenir items is irrelevant
- The memory of Neuschwanstein to the public is **not related** to an indication of a quality or an essential characteristic of the G/S

C-488-16 P (Neuschwanstein)

Article 52(2) and Article 7(3):

Neuschwanstein Castle

- is not, as such, a place where goods are produced or services are rendered (para 54)
- → it is not indicative of their geographical origin (para 54)

C-488-16 P (Neuschwanstein)

Article 52(1)(b) Badfaith

- Even if an application is made with the sole aim of competing unfairly with a competitor who is using a similar sign
- it may be in pursuit of a **legitimate objective**

T-807/16 - N & NF TRADING vs NF ENVIRONNEMENT (fig)



N & NF TRADING

Earlier mark

EUTMA

- Article 8(1)(b) EUTMR
- Identical services (Classes 35 and 39)
- Similar signs

T-807/16 - N & NF TRADING

Article 8(1)(b) EUTMR

- The sign NF enjoys a reputation in France as a sign of certification of goods and services (para. 62)
- It has thus been used for the sole purposes of the certification of services provided by undertakings (para. 63)

T-807/16 - N & NF TRADING

N & NF TRADING

Article 8(1)(b) EUTMR

- It cannot be found that the earlier mark has, among the French public, an enhanced ability to identify the services in Classes 35 and 39 as coming from a particular undertaking (para. 66)
- the BoA incorrectly attributed an enhanced level of distinctiveness to the earlier mark in respect of the French public (para. 70)

T-807/16 - N & NF TRADING

N & NFTRADING

Article 8(1)(b) EUTMR

- Although the earlier mark does not have enhanced distinctiveness in France for the services in Classes 35 and 39, the fact remains that the existence of likelihood of confusion is established (para. 85);
- The Board correctly found that there was LOC within the meaning of Article 8(1)(b) EUTMR.



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Thank you