

JUDGMENTS OF THE TRIMESTER

Susana Palmero Cabezas
ICLAD – Litigation Service
26 June 2018

INDEX

- **T- 419/17 (VSL#3)**
- **T-193/17, T-194/17 and T-195/17 (Device of component of prosthesis)**
- **T- 803/16 (SALMEX (fig.) / Shape of a disc-like device divided by a wave into two parts (3D) et al.)**
- **T- 34/17 (SKYLEADER (fig.))**
- **C- 85/16P and 86/16P (KENZO ESTATE / KENZO)**



T- 419/17 – VSL#3

VSL#3

***Cl. 5: Pharmaceutical, veterinary and sanitary goods;
dietetic substances adapted for medical use, food for
babies; nutraceuticals; dietary supplements***

T- 419/17 – VSL#3

Application for revocation on the grounds of
Article 51(1)(b) and (c) Regulation 207/2009

Rejected => Appeal dismissed

BOA:

- Insufficient evidence to prove the transformation of the mark into a common name, in trade, for the product at issue (*in relation to any sector of the public*)
- The message transmitted by the mark is not sufficiently clear. No possible misleading use of the mark

T- 419/17 – VSL#3

Judgment of the GC:

1st Plea: Infringement of Article 51(1)(b) of Regulation 207/2009

- The relevant circles for the assessment of this ground must be defined in the light of the characteristics of the product's market
 - => In this case:
 - ✓ Scientific community is not a relevant circle
 - ✓ End-consumer's recognition of the sign as a trade mark is insufficient to reject the application for revocation
 - ✓ No evidence of the perception of the mark as a common name

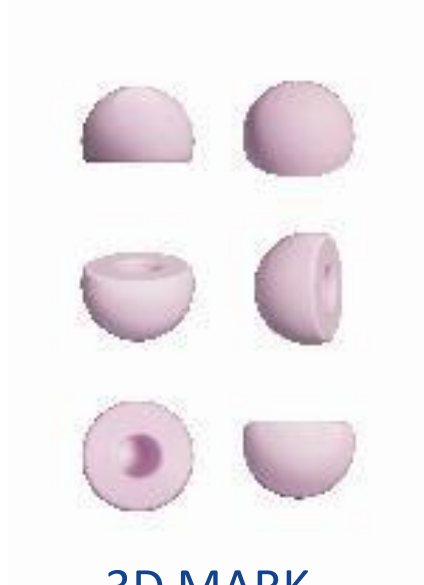
T- 419/17 – VSL#3

Judgment of the GC:

2nd Plea: Infringement of Article 51(1)(c) of Regulation 207/2009

- The mark will be revoked only if it conveys incorrect information concerning intrinsic characteristics of the product that consumers expect having regard to the message that the mark conveys
 - *This provision do not impose on the proprietors the obligation to ensure a certain level of quality (with an exception)*
- The regime enables the proprietors of an earlier mark to protect and exploit their substantial investment

T- 193/17, T-194/17 and T-195/17 - Device of component of prosthesis



3D MARK



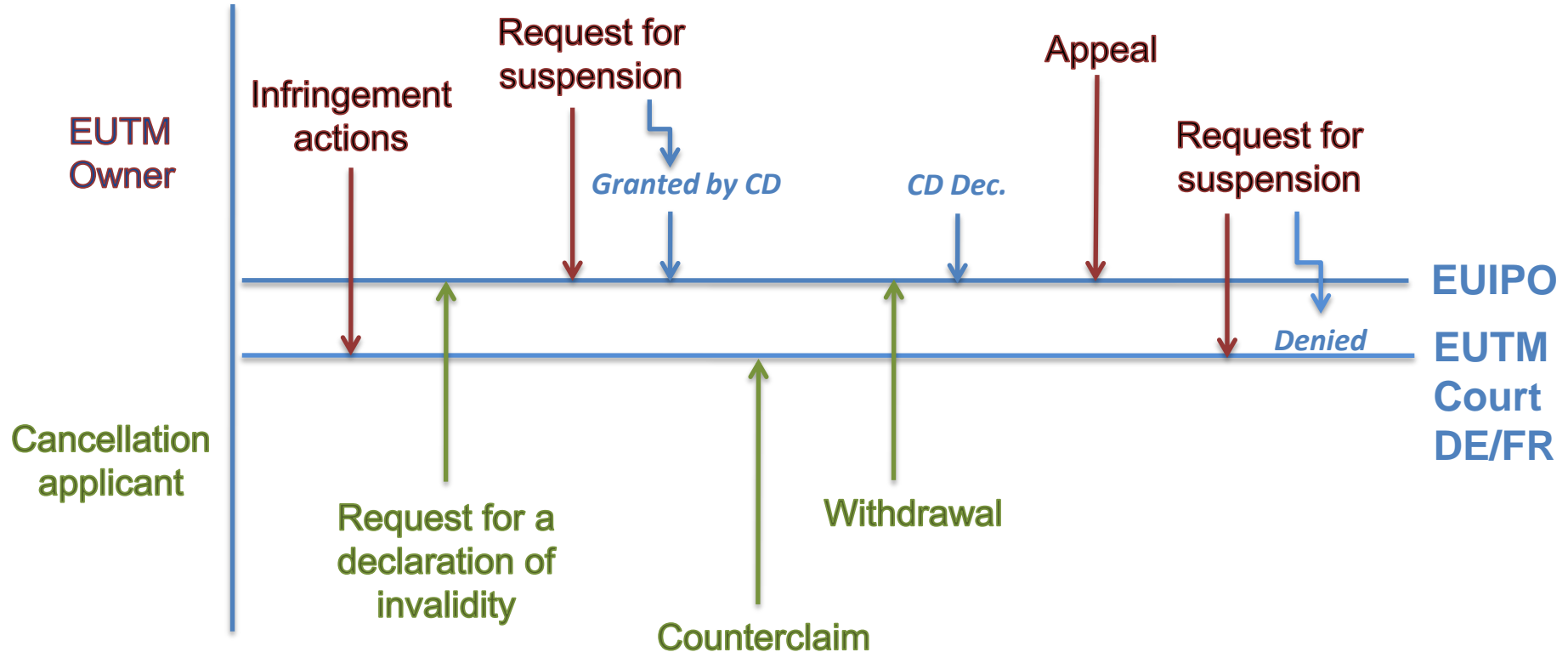
FIGURATIVE MARK



COLOUR MARK

*Class 10 – Ceramic parts for implants for osteosynthesis, articular surface replacement, bone spacer blocks; Hip joint balls, hip joint sockets and parts for knee joints;
All of the aforesaid goods for sale to manufacturers of implants.*

T- 193/17, T-194/17 and T-195/17- Device of component of prosthesis



T- 193/17, T-194/17 and T-195/17- Device of component of prosthesis

BOA:

- Not adversely affected
- Withdrawal procedurally correct
- No right to request a positive statement on the validity
- No veto right
- Doctrine on continuation after surrender – not applicable
- Art 83 Reg. 207/2009 – not applicable
- Not abusive

T- 193/17, T-194/17 and T-195/17- Device of component of prosthesis

Judgment of the GC:

1st Plea: Infringement of Articles 59 and 75 Regulation 207/2009

- EUTM proprietor is not adversely affected
 - No change in the status of the marks
 - No convincing arguments to justify an interest in continuing the proceedings.
 - ⇒ The theory of the continuation of invalidity proceedings following a surrender of the contested mark - not applicable
 - ⇒ The existence of proceedings before EUTM Courts has not effect on the conditions for admissibility of an appeal
 - ⇒ The alleged interest is future and uncertain
- Sufficient statement of reasons

T- 193/17, T-194/17 and T-195/17- Device of component of prosthesis

Judgment of the GC:

2nd Plea: Infringement of Articles 75 and 83 Regulation 207/2009

- Article 83 Regulation 207/2009 applies *only* in the event of a *lacuna or ambiguity* in the procedural provisions - this is not the case
- Doubtful that ‘*principles of procedural law generally recognised*’ can be inferred from the national provisions and case-law relating to civil procedure since the Boards of Appeal are not courts.
- The question of the *abuse of rights* is irrelevant in invalidity proceedings under Article 56(1)(a) Regulation 207/2009 – a fortiori, no intention *to abuse the system*

T- 803/16, SALMEX



EUTM

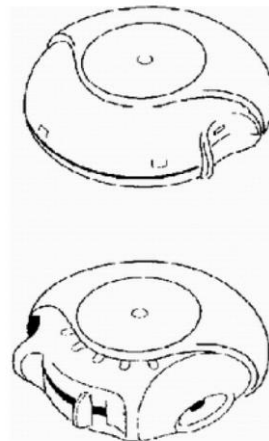
Cl. 5: Inhalation products
Cl. 10: Inhalers

**Art. 53(1)(a) in
conjunction with Art.
8(1)(b) and 8(5)
Regulation 207/2009**



FR TM *inter alia*

Cl. 10: Medical and surgical apparatus and instruments, inhalers.



T- 803/16, SALMEX

CD Decision – Genuine use for “inhalers” => LOC

BOA – Appeal well founded

**=> Genuine use examined of the Board’s own motion:
Insufficient evidence to establish genuine use**



Cancellation applicant: action before the GC

T- 803/16, SALMEX

The cancellation applicant:

- Erroneous Board's finding concerning the genuine use of the earlier marks

EUIPO:

- Board's infringement of Article 64(1) Regulation 207/2009
- Alternatively, dismiss the action

T- 803/16, SALMEX

Judgment of the GC:

- Nothing precludes EUIPO from endorsing the heads of claim of the applicant
- The lack of competence of the Board is a matter of public policy
- The Board did not have competence to make a ruling of its own motion on the issue of genuine use
- This finding is not contrary to the principle of continuity

T- 34/17, SKYLEADER



Class 12 – Vehicles; apparatus for locomotion by land, air or water;

Class 41 – Education; providing of training; entertainment; sporting and cultural activities

T- 34/17, SKYLEADER

Application for revocation

pursuant to Article 51(1)(a) Regulation 207/2009

Cancellation Division: Upheld the application

- The EUTM proprietor failed to prove genuine use of the contested EUTM within the time limit set by the Office.

BOA: Appeal Dismissed

- Peremptory nature of the time limit
- Article 76(2) Regulation 207/2009 does not apply
- No request of any means for rectifying the late submission

T- 34/17, SKYLEADER

Judgment of the General Court:

- The Board did not misinterpret Rule 40(5) of Regulation No 2868/95
- The fax merely referred to a list of annexes – It did not contain POU
 - ⇒ Slowness of postal service cannot call this into question
 - ⇒ Other arguments
- The Office does not have the obligation to advice about any particular remedy

C- 85/16P and C-86/16P - KENZO ESTATE / KENZO

Earlier EUTM

KENZO

IR (EU)

KENZO ESTATE

C- 85/16P and C-86/16P - KENZO ESTATE / KENZO



OD: Opposition Rejected

- **Insufficient Proof of Reputation**
=> No need to assess Proof of Use

C- 85/16P and C-86/16P - KENZO ESTATE / KENZO



BOA: Appeal (totally/partially) upheld

- **Reputation is established:**
 - **Existing precedents (identical evidence)**
=> Timely filed in this case? / No new factors

C- 85/16P and C-86/16P - KENZO ESTATE / KENZO

BOA:

- **Reputation is established:**
 - **Proof of Reputation & Proof of Use**

“are indissolubly linked; only an excessive and illegitimate formalism would dictate that the proof of use could not also be adduced as proof of reputation”

+ Substantial volume of sales = relevant factor for reputation

- **All the remaining conditions for the application of Art. 8(5) EUTMR have been satisfied**

C- 85/16P and C-86/16P - KENZO ESTATE / KENZO

Action before the GC => Pleas in law:

- Infringement of Article 76(2) of Regulation No 207/2009
- Infringement of Article 8(5) of Regulation No 207/2009

⇒ Action dismissed

Appeal before CJ => Points of law (*inter alia*):

- Discretion under Article 76(2) of Regulation No 207/2009
 - *Solely in the light of the third subparagraph of Rule 50(1)*
 - *Proof of use as proof of reputation*
- Due cause
 - Applicant's forename irrelevant as "due cause"

⇒ Appeal dismissed



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you