

Decisions of the Trimester of the GC and the CJEU

Martin Fischer
ICLAD
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T-69/17 (Fack Ju Göthe)

Fack Ju Göthe

(EUTMA No 13 971 163)

(cl. 3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38, 41)

BoA:

- Relevant public: Non-specialized German-speaking public of the EU;
- “Fack Ju Göthe” = “Fuck you Goethe”;
- “Fack Ju”: offensive sexual connotation, and, in any event, vulgar insult;
- “Göthe”: posthumous defamation adds potential additional layer of insult;
- Success of the movie irrelevant;

→ Art. 7(1)(f) EUTMR (+): Contrary to accepted principles of morality;

→ Application rejected

T-69/17 (Fack Ju Göthe)

Fack Ju Göthe

GC:

- Relevant public: Public of the EU or part of EU, which may be comprised, in some circumstances, of a single Member State;
- “Fack”/”Fuck”: - original meaning: vulgar sexual connotation;
- secondary meaning: vulgar expression of disappointment and defiance;
- “Göthe”/”Goethe”: does not mitigate the **intrinsically obscene** character;
- **Misspelling not sufficient** for satirical, humorous or playful interpretation of juvenile slang for “school related frustrations”.

T-69/17 (Fack Ju Göthe)

Fack Ju Göthe

GC:

- Success of movie \neq EUTMA not obscene;
 - Not proven that public will in their daily shopping activities, associate the film with the EUTM and perceive it as a “joke”;
 - Different standards in art than in Trade Mark Law;
 - Constellation not comparable with R 2889/2014-4 (“Wanderhure”),
 - Art. 7(1)(f) EUTM (+)
 - **Appeal dismissed**

T-1/17 (La Mafia se sienta a la mesa)

Art. 52(1)(a) / Art. 7(1)(f) EUTMR:

BoA:

- “Mafia” = criminal organization originating from Italy;
- EUTM manifestly promotes “Mafia” and its full text conveys a message of conviviality by trivializing the word element “Mafia”;
- Frequent use in literature/cinema and prior registrations including the word “Mafia” irrelevant;
 - Art. 7(1)(f) (+): EUTM contrary to public policy;
 - EUTM declared invalid



(EUTMA No 5510921)

(Cl. 25, 35, 45)

T-1/17 (La Mafia se sienta a la mesa)

Art. 52(1)(a) / Art. 7(1)(f) EUTMR:

GC:

- Relevant public: circumstances common to all MS and particular circumstances of individual MS;
- “La Mafia” dominant element of EUTM;
- “Mafia” understood world-wide as criminal organisation, responsible for serious **breaches of public policy**:

→ breach of values of EU, Art. 2 TEU Art. 2, 3, 6 Charter of Fundamental Rights;



(EUTMA No 5510921)

(Cl. 25, 35, 45)

T-1/17 (La Mafia se sienta a la mesa)

Art. 52(1)(a) / Art. 7(1)(f) EUTMR:

GC:

- Use in literature/movies (alluding to *Godfather* series)?
 - irrelevant for negative perception;
 - no element of EUTM directly refers to movies;
 - the fact that there are many books etc. on the Mafia does not alter the perception of the harm done by that organization;
- “Red rose” + “se sienta a la mesa” convokes conviviality and trivializes the illicit activities of the Mafia;
- Prior registrations (incl. in Italy!) irrelevant: autonomous EU system;
 - **Art. 7(1)(f) (+): Appeal dismissed**



(EUTMA No 5510921)

(Cl. 25, 35, 45)

T-105/16 (Marlboro vs. Raquel)



CD: No LoC + no evidence of reputation filed

BoA: No LoC + evidence filed is new → no discretion

T-105/16 (Marlboro vs. Raquel)

- **Art 76(2)** of Reg. No 207/2009 + **Rule 50(1)** of Reg. No 2868/95
 - R 50(1) 3rd subpara. applicable by analogy to canc. proceedings;
 - Discretion of BoA to take into account belated **additional** evidence;
 - “Rule 50 of Regulation No 2868/95 cannot be interpreted as meaning that it extends the discretion of the Boards of Appeal to new evidence, but only to evidence ‘additional’ or ‘supplementary’ to relevant evidence which was lodged within the time limit set.” (§ 41)*
- “BoA was, **in principle**, required **not** to take the evidence into account.” (§ 48)

T-105/16 (Marlboro vs. Raquel)

- Reputation of “rooftop” device acknowledged in a previous BoA decision;
- No automatic acceptance of reputation, neither a well-known fact;
but...

*„EUIPO is under a duty to exercise its powers in accordance with the general principles of EU law, such as the **principle of sound administration**. According to Article 41(1) of the Charter of Fundamental Rights of the European Union the right to good administration includes the right of every person to have his or her affairs handled fairly”. (§ 62)*

T-105/16 (Marlboro vs. Raquel)

- It is clearly in the interest of sound administration of justice that the BoA is able to make a **fully informed decision**;
- Previous decision was a clear indication that the mark might have reputation and the new evidence was clearly likely to be genuinely relevant to the outcome;
- *“Notwithstanding the interpretation of Rule 50 and Article 76(2), as set out above,[...] the **broad discretion** enjoyed by EUIPO in the performance of its duties cannot exempt it from its **duty to assemble all the elements of fact and law necessary** for the exercise of its discretion in cases where the refusal to take account of certain evidence submitted late would **breach the principle of sound administration.**” (§ 67)*
- Breach of the principle of Equality of arms? (-)

→BoA decision annulled

T-398/16 (Starbucks vs. Coffee Rocks)

EUTMA



EUTM



UK



ES



Opposition based on 8(1)(b) and 8(5) EUTMR:

OD + BoA: signs visually, phonetically, conceptually dissimilar;

→ overall, the marks are dissimilar;

→ **opposition rejected;**

T-398/16 (Starbucks vs. Coffee Rocks)



GC: visually:

- 1.) general appearance;
- 2.) same colours, same font;
- 3.) common word “coffee” - not negligible!

→ it cannot be held that marks are visually dissimilar.

T-398/16 (Starbucks vs. Coffee Rocks)



GC: phonetically:

- 1.) "Coffee";
- 2.) "Rocks"/"...bucks"

→ it cannot be held that marks are phonetically dissimilar.

T-398/16 (Starbucks vs. Coffee Rocks)



GC: conceptually:

“Mermaid“ \leftrightarrow musical notes / rock? (-)

but...

\rightarrow concept of a “coffee house“(+))

\rightarrow it cannot be held that marks are conceptually dissimilar.

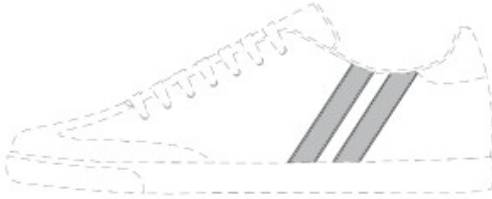
T-398/16 (Starbucks vs. Coffee Rocks)



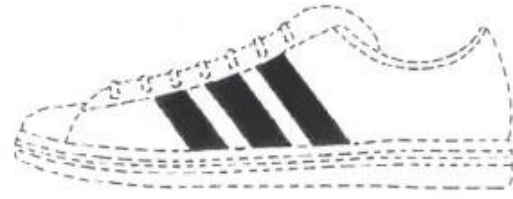
GC:

- Art. 8(1)(b): since marks are similar, global assessment necessary!
- Art 8(5): same concept of similarity as in Art. 8(1)(b);
 - but different (lower) degree of similarity sufficient for a link;
- BoA should have examined further conditions of Art. 8(5);
 - **BoA decision annulled**

T-85/16, T-629/16 (Three stripes vs. Two stripes)



cl. 9 (footwear; safety footwear)



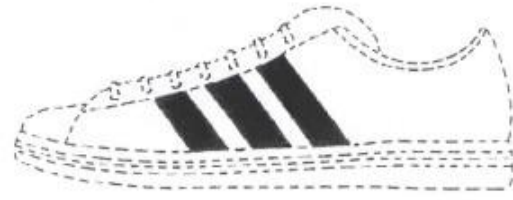
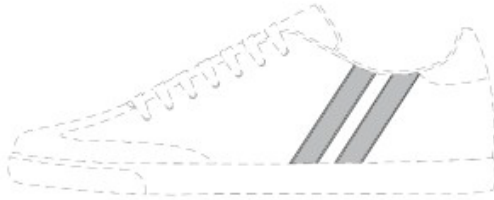
cl. 9 (footwear)

Opposition based on Art. 8(1)(b) and 8(5) EUTMR:

- BoA:
- certain degree of similarity of marks;
 - similarity/identity of goods;
 - high reputation of earlier mark;
 - link;
 - risk of unfair advantage of the repute of earlier mark;

→ Art. 8(5) (+) → **EUTMA rejected**

T-85/16 ,T-629/16 (Three stripes vs. Two stripes)

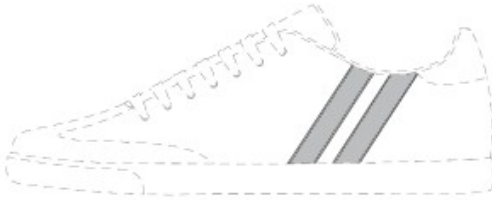


GC: Unfair advantage:

- 1.) Similar goods + high reputation strongly increases probability of unfair advantage;
- 2.) Relevant evidence for unfair advantage was provided;
- 3.) Use of the slogan “**Two stripes are enough**“ in ES/PT (1x!)

→ Sufficient to demonstrate genuine risk of free-riding

T-85/16 ,T-629/16 (Three stripes vs. Two stripes)



GC: Due cause?

- 1.) real effective use;
- 2.) commenced prior to the filing of the earlier mark;
- 3.) throughout the territory of the EU (-)
- 4.) peaceful coexistence (-)
- 5.) use in good faith (-)

→ **Appeal dismissed**



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Thank you