

# JUDGMENTS OF THE TRIMESTER

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## JUDGMENTS OF THE TRIMESTER

- **PROCEDURAL ISSUES (belated evidence, ancillary appeal)**
- **ABSOLUTE GROUNDS (descriptiveness, distinctiveness, bad faith)**
- **RELATIVE GROUNDS (likelihood of confusion, reputation)**
- **PROOF OF USE (form of use, repeated applications, territorial extent of use)**

## JUDGMENTS OF THE TRIMESTER

# PROCEDURAL ISSUES

## T-316-318/16, 12/10/2017 - SDC-554S et al.

- Opposition based on Article 8(4)
  - Belated evidence of national law – 1<sup>st</sup> time before BoA
  - BoA: no discretion (evidence is new)
  
  - GC:
  - The opponent must provide evidence of national law before EUIPO
  - *lura novit curia* only applies to EU law
    - only where the Office already has information available to it it must on its own motion inform itself on the latter
- ([C-530/12 National Lottery](#), [T-96/13 Macka](#))

## T-316-318/16, 12/10/2017 - SDC-554S

- The evidence of national law cannot be filed for the first time before the BoA, if there is no evidence filed before OD as to the existence, validity and scope of protection of the right relied on.
- The Office enjoys a broad discretion to accept belated evidence on account of Article 76(2) (now 95(2)) EUTMR -- in this case:
- NO DISCRETION to accept the evidence, as it cannot be considered additional or supplementary (Rule 50(1) EUTMIR) – ([C-597/14 P Bugui va](#))

### ([T-567/14](#) GROUP Company TOURISM & TRAVEL)

- National legislation is regarded as only one piece of evidence proving the acquisition, continued existence and scope of protection of the earlier right within the meaning of Article 8(4)

## T-456/16, GULLON DARVIDA / DAR VIDA (16/11/2017)

### Earlier International Registration

- Opposition filed by '**Hug AG**' but
- WIPO's Romarin database extract show '**Hug AG Zwieback & Biscuits**'
- OD: opposition rejected as not substantiated
  
- Proof of change of name of the opponent was filed for the first time before the BoA
- BoA accepted the evidence and annulled the decision of the Opposition Division
  
- GC:
  - it was additional (as opposed to *new*)
  - Board of Appeal has a discretion to accept it
  - the Board of Appeal exercised the discretion correctly, stating reasons for the acceptance of the belated evidence

## T-411/15 GAPPOL/ GAP (04/10/2017)

- Opposition Division: upheld opposition on Article 8(1)(b) EUTMR, rejected on 8(5) EUTMR
- the applicant filed an appeal, invoking infringement of Article 8(1)(b) EUTMR
- the opponent filed an **ancillary appeal**, invoking infringement of Article 8(5) EUTMR
  - Article 8(3) BoA RoP: ‘In *inter partes* proceedings, the defendant may, in his or her response, seek a decision annulling or altering the contested decision on a point not raised in the appeal. Such submissions shall cease to have effect should the appellant discontinue the proceedings.’
- the BoA rejected the applicant’s appeal and upheld the opponent’s ancillary appeal
- GC (confirms T-84/08 Comit): ancillary appeal cannot be considered *reformatio in peius*
  - BoA may exercise any power within the competence of the first instance (Art. 64(1) EUTMR, now Article 71(1))
  - Article 8(3) of the BoA RoP (now Article 68(2) of the main Regulation)
  - The ancillary appeal ceases to have effect if main appeal withdrawn

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# ABSOLUTE GROUNDS



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### T-878/16 **KARELIA** (06 October 2017)

'industrial oils and greases; lubricants; fuels (including motor spirit) and illuminants' in Class 4

- Geographically descriptive
- Should remain available to the public
- Indication of quality
- Known to the public?
- Link with the goods?

**- descriptive and non-distinctive in Finland**

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### T-233/15 **SCATTER SLOTS** (02 November 2017)

'Betting services; casinos; electronic games services provided by means of the internet; electronic games services, including provision of computer games on-line or by means of a global computer network; entertainment by means of telephone; game services provided by means of communications by computer terminals or mobile telephone; game services provided on-line from a computer network; entertainment services provided on-line from a computer database or the internet'

- Not basic English words: relevant public is the English speaking consumer in the EU
- Descriptive of the subject matter of the services: related to gambling machines with the 'scatter' function
- General reasoning for all the services is possible

**- descriptive and non-distinctive for English speakers in the EU**

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### T-857/16 SHAPE OF A TALL GLASS

Class 21, namely ‘glassware, porcelain and earthenware, so far as included in Class 21; unworked or semi-worked glass (except glass used in buildings); household or kitchen utensils and containers (not of metal or coated therewith)’.

- 3D trade mark indissociable from the appearance of the goods themselves
- Must depart significantly from the norms and customs of the relevant sector

**- non-distinctive**



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### T-798/16 **REAL** (30 November 2017)

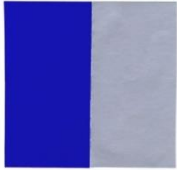
Goods classes 29, 30, 31 (foodstuffs)



- 'not artificial or simulated, genuine' in EN, RO, PT and ES
- Immediate connection with the goods in question
- **descriptive of the kind and nature of the goods**

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### T-101/15 and T-102/15 **BLUE AND SILVER** (30 November 2017)



*Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%*

*Indication of the colours 'blue (Pantone 2747C), silver (Pantone 877C); the two colours will be applied in equal proportion and juxtaposed to each other*

- Colours are normally property of things; but they can be a sign too
- A sign must be perceived unambiguously, uniformly and durably, to guarantee the function of indicating origin
- C-49/02 Heidelberger Bauchemie: combination of colours: need for **systematic arrangement by associating the colours concerned in a predetermined and uniform way; mere juxtaposition in every conceivable form is not clear and precise**; the consumer must be able to perceive and recall a particular combination, repeat the experience with certainty
- Does the mark allow numerous different combinations of the two colours? → yes
- The descriptions do not provide additional precision with regard to the systematic arrangement associating the colours in a predetermined and uniform way
- **Conclusion: not considered sufficiently precise** → the contested mark had been registered contrary to Article 7(1)(a) of Regulation No 207/2009.

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### T-687/16 **STYLO & KOTON** (30 November 2017)

- Absolute ground for invalidity: Bad faith filing
- Business relationship in 2004 between the parties
- In 2011 the contested mark is filed → opposition:
- Likelihood of confusion for identical and similar goods and services,
- **no likelihood of confusion for dissimilar services → 2014: the opponent filed a bad faith invalidity request**
- Rejected both by OD and BoA: absence of any dishonest intention, there is no bad faith in spite of previous business relation in 2004, if the mark was filed for dissimilar goods and services

**STYLO  
&  
KOTON**



## JUDGMENTS OF THE TRIMESTER

### T-687/16 **STYLO & KOTON** (30 November 2017)



**STYLO**  
&  
**KOTON**



- GC:
- First-to-file principle
- No bad faith if the mark applied for covers dissimilar goods
  
- Mere knowledge of an identical or similar earlier sign does not suffice to establish bad faith where there are no other relevant factors
- Moreover, no contact between the parties between 2004 and 2011

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# RELATIVE GROUNDS



**T-627/15 and T-628/15 BIANCALUNA / BIANCA et. al**

**BIANCALUNA**

Likelihood of  
Confusion

**bianca.**

**Visually, aurally and conceptually similar**



No Likelihood  
of Confusion

**bianca.**

**Visually dissimilar, phonetic dissimilarity 'cannot be ruled out' and the BoA erred in saying that the presence of the moon meant no conceptual difference**

## T-144/16 MULTIPHARMA / MUNDIPHARMA (07/11/2017)

### MULTIPHARMA

### MUNDIPHARMA

- Goods and services in Classes 5 and 35 (pharmaceuticals and retail of pharmaceuticals)
- Board of Appeal: no likelihood of confusion
- General Court: annuled to Board of appeal's decision:
  - high degree of attention BUT signs similar → **Likelihood of confusion**

## T-403/16 IMMUNOSTAD / IMMUNOSTIM (20/11/2017)

### Immunostad

### ImmunoStim

- Goods in Classes 5: *pharmaceuticals, dietetic substances adapted for medical use*
- Board of Appeal: likelihood of confusion
  
- General Court: confirmed likelihood of confusion
- high degree of attention for pharmaceuticals and average/high for dietetic substances; goods identical;
- 'Immuno' is 'descriptive and therefore weakly distinctive', but still relevant, at the beginning of the signs, contributes to the overall impression given by the marks
- First part of the mark has greater impact, visually and phonetically the marks are highly similar
- Conceptually also similar as they refer to the notion of 'immunity' (even if 'stim' is understood as referring to 'stimulate')

**→ Likelihood of confusion**

## T-441/16 SeboCalm / Sebotherm (23/10/2017)

### SeboCalm

### Sebotherm

- Goods in Class 3
- Board of Appeal: likelihood of confusion in Slovakia, Bulgaria and Estonia

- GC:

True that 'sebo' is used for 'seborrhoea' in dermatology and in the cosmetic sector – evidenced by high number of TM

but: average consumers in Slovakia, Bulgaria and Estonia do not understand that term (territorial 'shortcut')

→ signs similar → **Likelihood of confusion**

## T-754/16 OAKLEY vs EUIPO (08/11/2017)



Classes 9, 18 and 25

Board of Appeal: signs dissimilar

GC: annulled the Contested Decision

- The interruption of the trade mark is not striking (e.g. not asymmetrical)
- The contested mark does not give the impression of two independent elements
- The global visual impression of the mark is similar

## T-685/15 Sulayr GLOBAL SERVICE / SULAYR (26/10/2017)

Class 40: *Recycling, treatment and transformation of plastic materials, selection of recyclable material (transformation).*

Class 42: *Industrial analysis.*

Board of Appeal: services similar to a medium degree, as both related to environmental conservation in industrial context and are therefore complementary

General Court:

- The fact that both services are related to environmental protection is relevant but not sufficient on its own
- The services are not complementary (correct criterion was not applied)
- Similarity of the services has not been shown – the Board of Appeal decision is annulled

## T-411/15 GAPPOL/ GAP (04/10/2017)



*Class 25 and Class 20 'Furniture'*



*Class 25*

BoA: Likelihood of confusion for Class 25;  
Article 8(5): unfair advantage of the repute for class 20 goods

GC: - confirmed likelihood of confusion for Class 25

- very limited degree of proximity between *furniture* and Class 25 goods
- Article 8(5) can be upheld only if sufficiently strong reputation – not indicated by the BoA → decision annulled on that point; *It is necessary to establish the strength of the earlier trade mark's reputation* (GC [T-624/13 Darjeeling](#) and [T-362/15 Henley](#))

## **C-501/15 CACTUS OF PEACE CACTUS DE LA PAZ / CACTUS (11/10/2017)**

### Opposition proceedings

- Earlier EUTM registered in 2002 for class heading in Class 35
- BoA: the earlier mark does not cover the services of *‘retailing of natural plants and flowers, grains; fresh fruits and vegetables’*
- Communication No 4/03: ‘the use of all the general indications listed in the class heading of a particular class constitutes a claim to **all the goods or services falling within this particular class.**’
- C-307/10 IP Translator
- Communication No 2/12: As regards [EU] trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, [EUIPO] considers that the intention of the applicant, in view of the contents of the previous Communication No 4/03, was to cover **all the goods or services included in the alphabetical list of that class** in the edition in force at the time when the filing was made.’



## **C-501/15 CACTUS OF PEACE CACTUS DE LA PAZ / CACTUS (11/10/2017)**

GC+CJ

Legal certainty + protection of legitimate expectations

**C-307/10 *IP Translator*** does not apply retroactively

- The scope of protection may not be altered on the basis of a non-binding communication which has no function other than to provide clarification for applicants as to the practices of EUIPO

**C-418/02 *Praktiker Bau*** (the applicant must nevertheless be required to specify, for the purposes of registering a trade mark, the goods or the types of goods to which the retail trade relates) does not apply retroactively either

- The line of authority derived from *Praktiker Bau* concerns only applications for EUTM and does not concern the scope of the protection of the trade marks registered at the date of that judgment's delivery

**Declaration according to Article 28(8) (now Article 33(8))** – possibility to amend the specification, but only items from the alphabetical list; if no declaration – only literal meaning is covered

## JUDGMENTS OF THE TRIMESTER

# GENUINE USE



## C-501/15 CACTUS OF PEACE CACTUS DE LA PAZ / CACTUS (11/10/2017)



- 'abbreviated form'
- the same semantic content
- the consumer equates the abbreviated form of that mark with its registered form (factual question – not in the competence of CJ)
- 'Cactus' could not be regarded as possessing a distinctive character that was different from that of the stylised cactus
- the absence of that word element in the abbreviated version of the earlier figurative mark was not sufficiently important in the perception of that mark as a whole as to alter its distinctive character



## T-736/15 SKY/ SKYLITE (19/10/2017)

- SKY filed opposition against goods in Class 9 and 18 (*cases for laptops and different kinds of trunks and bags*), based on its SKY trade mark for Class 9 and 18 goods
- Grace period for the earlier mark has not lapsed yet.
- The applicant claimed exceptional application of Article 42(2) and 43 EUTMR, because the opponent made **repeated filings of its trade mark between 1995 and 2009**
- Request for proof of use admissible?

- GC:
- bad faith is an absolute ground for invalidity
  - in opposition proceedings EUIPO is required to presume that the earlier mark is valid
  - in the context of opposition proceedings EUIPO cannot examine bad faith of the opponent when he was filing the earlier mark

## T-386/16 silente PORTE & PORTE (06/10/2017)



- EUTM Classes 6, 19, 20: inter alia doors.
- Request for revocation
- Cancellation Division: partial revocation, but genuine use for doors
- BoA: revocation for all goods
  - Use of an EUTM in Italy is territorially insufficient since EU market for doors not limited to Italy

## T-386/16 silente PORTE & PORTE (06/10/2017)

- Article 75-76 EUTMR:
- Scope of review by the Board of Appeal
- BoA was allowed to examine territorial scope and nature of use, even if the cancellation applicant only relied on the absence of consent given by EUTM proprietor to third party for the use



## T-386/16 *silente PORTE & PORTE* (06/10/2017)

- Art. 51(a) EUTMR
- C-149/11 Leno Merken
- Examination of genuine use is made without consideration of borders
- There is some justification for thinking that a EUTM should - because it enjoys more extensive territorial protection than a national trade mark- be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', **but it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a EUTM has been registered is in fact restricted to the territory of a single Member State.** In such a case, use of the EUTM on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark

## T-386/16 *silente PORTE & PORTE* (06/10/2017)

- In this case, use is limited to Italy and the goods do not have any territorial specificity which would justify that use should be confined to Italy (para 50)
- The EUTM holder has not challenged that the market for doors was limited to Italy (para 51)
- As a consequence, BoA rightly considered that the ‘territorial criterion’ for the use was not satisfied

T-287/15 *Real* – Germany is a substantial part of the EU – use in Germany is enough

T-2/16 *Pret A Diner*: use of an EUTM in the UK may be geographically sufficient

T-367/14 *Fruitfuls*



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Thank you