

Decisions of the Trimester General Court & European Court of Justice

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C-577/14P, 16.2.2017 – LAMBRETTA (Brandconcern)

- **Communication 4/03 (use of all the general indications listed in the Class Heading of a class = all the goods and services falling within that class)**
- **Proof of use of the mark LAMBRETTA, registered in Class 12**
- **BoA disregarded the proof of use for spare parts: literal approach. ‘Vehicles; apparatus for locomotion by land, air or water’ in Class 12. ONLY THAT.**
- **June 2012: IP Translator Preliminary Ruling**
- **Comm. 2/12: EUIPO considers that pre-IPT registrations for Class Headings cover all the G&S in the alphabetical list**

General Court: annuls the BoA decision.

- EUIPO had created **legitimate expectations**
- The BoA should have examined whether the earlier mark had been used with regard to ‘spare parts for scooters’.

Appeal before the CJ: the GC had erred in law:

- BoA did **not** have to examine whether genuine use had been proved for **spare parts**. Only **literal approach**: vehicles, apparatus for locomotion by land, air or water.
- **IPT** produces effects **retroactively**: Literal approach for all

- **Para. 61 of IPT** (clarity, precision, imposed by Directive 2008/95: specify whether the application is intended to cover all the G/S in the alpha list or only some –and which ones) ‘does not concern the proprietors of tm already registered, but only applicants for trade marks’ (p. 29)
- **P. 61 IPT** **only** specified the requirements to be respected by **new applicants** who use all the general indications in a Class. (p. 30)

- **CJ, p. 31: 👍 Communication 4/03.
p. 61 IPT does not apply to the registration of
LAMBRETTA, which took place before IPT.**
- **CJ, p. 32: 👍 Communication 2/12. It was
appropriate for the words ‘vehicles, apparatus
for locomotion by land, air or water’ cl. 12 to
be interpreted as seeking to protect that mark
for all the goods in the alpha list of Class 12.**

- The interpretation of the Lambretta registration by the GC is substantiated by the new **Art. 28(8) EUTMR**: transitional provision allowing the **proprietors** of EUTM applied for before 22/6/12 (IPT) and registered in respect of the entire heading of a Class to declare, before 24/9/16 that their intention was to apply for protection of G/S other than those covered by the literal meaning.

The notion of ‘review of legality’ implies that the GC may not rule on points of fact or law on which the Board of Appeal did not or could not take a position.

This is why documents, evidence and arguments which were not presented in due time during the administrative proceedings before EUIPO are, except for rare exceptions, inadmissible

C-598/14P Laguiole, paras. 35-50

Nevertheless, given the *retroactive effect* of the **case-law**, the legality of a decision may be examined in the light of an interpreting judgment of the **Court of Justice** that is adopted *at a later date*.

C-598/14P Laguiole, paras. 35-50

Furthermore, the GC may assess the compatibility of a **decision that applies national law**, in the context of Article 8(4) EUTMR, with a **judgment of a court of the Member State** in question, **even** if this judgment was ***adopted after the decision***.

It is irrelevant whether this judgment simply provides *clarification* of the earlier case-law or effects an unexpected *turnaround* after the decision was adopted by the Board of Appeal: **‘Nobody can claim a vested right to an unchanging case-law’**

T-132/16, 5.5.2017 – VENMO

BAD FAITH



OR...

OF THE EUTM OWNER???

BAD FATE



- Cancellation Division: **bad faith**, EUTM invalid
- BoA: annulled CD decision. **No bad faith**
- GC...

FACTS:

EUTM OWNER created the sign VEN	INVALIDITY APPLICANT (PayPal) VENMO
2007 „VEN“ AS A DIGITAL CURRENCY US TMA „VEN“	
	2009 „VENMO“ COMPANY ESTABLISHED.
2010 Contacts the Invalidity Applicant : FEAR OF POSSIBLE CONFUSION. NO ANSWER	
7/10/2010: claims use of the sign VEN MONEY and registers the domain VENMONEY.NET	
8/11/2010 MEETING OF LEGAL REPRESENTATIVES	
9/10/2010 EUTM APP. „ VENMO “	
	27/6/2013 INVALIDITY REQUEST

- GC: EUTM owner *knew* about VENMO'S use of an identical sign. Not sufficient in itself to find bad faith
- Necessary to examine **other objective circumstances**
- Registration of VENMO: **Logical commercial trajectory?**
- **VEN** → Ven Money, venmoney.net → **VENMO** ?
 - No proof of use of **Ven Money**.
 - **Venmoney.net**, mere redirection
 - Suffix –**MO** : not understood as abbreviation of Money
 - Why not to apply for **VEN MONEY** to protect VEN?

- EUTMA was filed in the *context of direct relations* with Venmo
- Instead of further exploring possibilities of commercial resolution, VEN chose to ‘**appropriate**’ the **VENMO** sign without informing Venmo. ‘**Concealed act**’ (para. 62).
- *No intention to use* the sign: In certain circumstances *may be* an element of bad faith.
- It is irrelevant that Venmo is unregistered and not reputed.
- What is relevant is that the EUTM owner *knew* that a *3rd party was using the sign VENMO for identical /sim G&S*

T-107/16, 16.5.2017 – AIR HOLE FACE MASKS YOU IDIOT



- **Consent for filing another proprietor's trade mark**
Burden and standard of proof
- **Bad faith**

- **Contested EUTM: *identical* to invalidity applicant's prior US and Canada trade marks**
- **EUTM proprietor: when filing the EUTM application it was the invalidity applicant's distributor for six EU Member States**
- **Grounds for invalidity request:**
 - Article 8(3) EUTMR: **filing by unauthorized agent**
 - Article 52(1)(b) EUTMR: **bad faith**
- **CD: bad faith**
- **BoA: neither unauthorized filing nor bad faith**
- **GC: bad faith** (alters the BoA decision: the BoA was required to find that the EUTM proprietor acted in bad faith)

Main issue: **consent**

- **Consent** excludes in principle both
 - lack of authorization (Article 8(3) EUTMR)
 - bad faith
- Filing was **authorized** by the **invalidity applicant** ...
 - ... but it was **not explicit** whether the consent was
 - limited to filing in **invalidity applicant's name**, or
 - extended to filing in **EUTM proprietor's own name**
- **Burden of proof ? Standard of proof ?**

Burden of proof of the consent:

- **Principle: burden of proof on the invalidity applicant**
- **Exception: lack of consent** to file the mark
 - ‘negative fact’ difficult (or impossible) to establish
 - existence of **consent** to be shown by **EUTM owner**
- **Reversal of burden of proof recognized by case-law as regards exhaustion of TM rights**
(C-414/99 Zino Davidoff, §54)

Consent: level of proof


- **‘Sufficiently clear, specific and unconditional’**
([T-6/05](#) First Defense I, § 48; [T-537/10](#) Fagumit § 23)
 - Guidelines: **tacit/IMPLIED** consent, only **exceptionally**, where evidence as to intentions is sufficiently clear
 - Whenever there are **DOUBTS** as regards
 - **existence** of consent
 - **extent** of consent
- => lack of consent**

GC's factual findings

- Key factual findings:
 - lack of consent to file contested mark in its own name
 - intention to **usurp** the invalidity applicant's rights
- Consequence: bad faith

Assessment of consent

- **Basic requirement confirmed: consent needs to be sufficiently clear, specific and unconditional (§ 25)**
- **Extent of consent cannot be presumed: mere request to file TM does not necessarily extend to filing in its own name (§ 26)**
- **Circumstances postdating authorization to be taken into account (§ 28)**
- **All objective circumstances of the case need to be considered for assessing the extent of consent (§ 29)**

- VBB: **association**, owner of EUTM  for textiles, registered in 2008. Sign had been *used for decades*
- Since registration, licence agreements with members of the association. Use of the mark only for goods made from good-quality cotton
 - **Gözze**: not a member of VBB, **no licence**. Used the sign for decades.
 - VBB: infringement proceedings

Is ‘**genuine** use’ under Art. 15(1) the affixing of an *individual* EUTM on goods as a **label of quality**?

- the essential function of **individual** marks is to guarantee the identity of origin of the G/S by enabling the consumer to distinguish them from others with another origin

Is ‘**genuine** use’ under Art. 15(1) the affixing of an *individual* EUTM on goods as a **label of quality**?

- § 46: where the use of an individual mark, despite certifying the composition or quality of the G/S does **not guarantee** to consumers that they come from a **single undertaking** which controls their manufacture/supply and which is responsible for their quality, such use is **not made in accordance with the function of indicating origin**.

VBB: *external* to the production of goods by its licensees. **Not responsible** for those goods.

- the fact that VBB verifies that licensees use only good-quality cotton fibres is not evidence of genuine use. At most, it implies that VBB **certifies the quality** of the raw material used
- Such a certification may suffice to find that **a mark other than an individual mark** fulfils its function as an indication of origin:
 - Art. 66: collective marks
 - Art. 74a: certification marks.

- Colour mark registered for ‘wind energy converters and parts therefor’.
- Cancellation Division: invalid, 7(1)(b)
- Board of Appeal: decorative element. It only conveys an aesthetic message, not a reference to the origin. 7(1)(b)
 - Green, colour of nature: ecological or environmentally friendly wind energy converters
 - Arrangement: uniform and logical. Incapable to attract consumers’ attention
 - High-value capital goods: identified by trade names and word marks, not by decoration or external presentation.

GENERAL COURT:

- Five shades of the primary colour green, associated with nature
- Converters often located in green areas: the use of green reduces the contrast between the vegetation and the goods at issue. Purely aesthetic message.
- Specialist consumers will neither identify nor purchase these goods by reference to decoration or external presentation, but will be guided by precise and accurate information on the origin of the goods (p. 51)

- EUTM applied for G&S in Classes 9, 35, 37, 39, 40, 41, 42, 45.
- Examiner: 7(1)(b)
- BoA: commonplace promotional tag, mere ‘claim of superior quality’. The figurative element is not sufficient to confer distinctive character.



General Court: annulled the BoA decision.

- Over 90 g&s, in 8 different Classes and relating to different fields.
- They display such differences in their nature, characteristics, intended use and way of marketing that they can**not** be considered as a **homogeneous category** allowing the BoA to adopt a **general reasoning**.

Court of Justice: annulled the GC judgment.

- It **cannot be ruled out a priori** that all the G&S applied for present a **relevant characteristic** for the analysis of an absolute ground for refusal and that they can all be placed for those purposes in a **sufficiently homogeneous single category or group** (p. 34).
- BoA: without exception, all the goods can be presented as **being of superior quality**, all the services can be presented as **providing superior quality**

Court of Justice:

- All the G&S present the characteristic of having or providing superior quality; therefore, they are all part of a **sufficiently homogeneous single category or group** for the analysis of the absolute ground for refusal.

Court of Justice:

- The GC failed to have regard to the possibility that, despite their differences, all the G&S could have a common characteristic which could justify their placement within a single homogeneous group and the use by the BoA of a general reasoning in relation to them (P. 41).

E-5/16, 06/04/17 Municipality of Oslo / Patentstyret (Gustav Vigeland)



[R 1724/2013-2](#):
refusal under
7(1)(e)(iii) for
funerary monuments,
jewelry etc.

E-5/16, 06/04/17 Municipality of Oslo / Patentstyret (Gustav Vigeland)

EEA Court: interprets EU law for Iceland, Liechtenstein and Norway

Trade Mark directive 2008/95/EC applies to EEA

Copyright directive 2006/16/EC does not

The registration as a trade mark of a sign which consists of works for which the copyright protection period has expired, is not in itself contrary to **public policy** or accepted principles of **morality** within the meaning of Article 3(1)(f) of Directive 2008/95/EC

Whether registration for signs that consist of works of art as a trade mark shall be refused on the basis of accepted principles of **morality** within the meaning of Article 3(1)(f) of TMDirective depends, in particular, on the status or perception of the artwork in the relevant EEA State.

The risk of **misappropriation** or **desecration** of a work may be relevant in this assessment

→ in particular if the mark is granted for goods or services that contradict the values of the artist or the message communicated through the artwork in question (§ 92)
(case by case analysis)

E-5/16, 06/04/17 Municipality of Oslo / Patentstyret (Gustav Vigeland)

Registration of a sign may only be refused on basis of the **public policy** exception (Article 3(1)(f) of Dir. 2008/95/EC)

- if the sign **consists exclusively** of a work pertaining to the **public domain**
- and registration of this sign would constitute a genuine and sufficiently **serious threat to a fundamental interest of society** (§ 95)
- Only in **exceptional circumstances** (§ 96)

E-5/16, 06/04/17 Municipality of Oslo / Patentstyret (Gustav Vigeland)

Article 3(1)(e)(iii) of Directive 2008/95/EC may apply to two-dimensional representations of three-dimensional shapes, including sculptures [[T-331/10](#), Yoshida Metal Industry Co. Ltd, para 27]

Article 3(1)(c) of Directive 2008/95/EC must be interpreted as being applicable to two-dimensional and three-dimensional representations of the shape of a good [[C-53/01](#), C-54/01, et C- 55/01, Linde, paras 44-45]



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