

Decisions of the Trimester General Court & European Court of Justice

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List of cases:

[T-333/14](#), 14.2.2017 – SportEyes / EYE SPORT et al.

[T-64/16](#), 28.01.2017 – Tasty Puff

[T-735/15](#), 6.12.2016 – SHOP ART / art

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T-333/14, 14.2.2017

SportEyes / EYE SPORT et al.

Legal effects of cancelled marks

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

- **EUTMA:** “Sport Eyes”, goods in Class 25
- **Opposition:** based on Art. 8(1)(b), successful under one earlier EUTM (T-342/02, ‘MGM’)
- **BoA:** appeal dismissed
- Appeal before **GC:** infringement of Art. 8(1)(b)
- All **earlier EUTMs - cancelled:** one declared revoked, three declared invalid; decisions final

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

- In the light of adoption of these cancellation decisions, does the action before GC continue to serve any purpose?
- What are the legal effects of a mark declared invalid or a mark declared revoked?

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

Art. 55 (1) EUTMR: EUTM shall be deemed not to have had, as from the **date of the application for revocation**, or of the counter claim, the **effects** specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

Art. 55(2) EUTMR: EUTM shall be deemed not to have had, as **from the outset**, the effects specified in this Regulation, to the extent that the trade mark has been declared **invalid**.

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

The only earlier right on the basis of which the opposition was declared to be well founded was **declared invalid** (disappeared) → the opposition proceedings became devoid of purpose. Consequently, in accordance to Art. 131 RPGC, the present action has become devoid of purpose → **no need to adjudicate** on it (§ 24).

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

Effects of the order declaring no need to adjudicate:

Since actions before the Court have a suspensory effect (Art. 64(3) EUTMR) → **neither** the first instance decision **nor** the contested decision **take effect** → the contested EUTM application may proceed to registration.

T-333/14, 16.2.2017 – Sport Eyes /EYE SPORT et al.

The earlier right has been revoked (lack of use):

Its legal validity ended after the contested decision had been adopted (*ex-nunc* effect of revocation) →

The legality of a decision which allows an opposition cannot be affected by the revocation of the earlier mark that occurred after the adoption of that decision.

That earlier mark was not examined by BoA (subject matter of proceedings).

T-64/16, 28.01.2017 – Tasty Puff

Absolute grounds for refusal
Descriptive character - Lack of distinctiveness

T-64/16, 28.01.2017 – Tasty Puff

Tasty Puff

Class 34: tobacco goods

T-64/16, 28.01.2017 – Tasty Puff

- EUTMA rejected based on Art. 7(1)(b) and (c)
- BoA dismissed the appeal
- Appeal before GC:
 - (1) Infringement of Art. 7(1)(b) EUTMR
 - (2) Infringement of Art. 7(1)(c) EUTMR

Relevant public:

- English-speaking EU consumer with an average level of attention
- The Applicant's claim about a high attention of the relevant consumer of tobacco products was not supported by any evidence

Figurative elements:

- The typeface and various dots – insufficient to divert consumer’s attention from the verbal part
- They emphasise the descriptive message of the words Tasty Puff
- The rounded typeface and the dots could be associated with puffs of smoke

T-64/16, 28.01.2017 – Tasty Puff

Verbal elements:

- The sign must always be assessed in relation to the goods or services concerned.
- Other possible meanings – irrelevant.
- In the context of smoking, the sign will be perceived as ‘delicious smoke or delicious smoking’.
- Not merely allusive – directly descriptive of a good taste of tobacco or the ability to enhance the good taste of tobacco by means of articles used with tobacco.

T-735/15, 6.12.2016 – SHOP ART / art

T-735/15, 6.12.2016 – SHOP ART / art

**Relative grounds for refusal – Weak components –
Non-distinctive components**

T-735/15, 6.12.2016 – SHOP ART / art

EUTMA

SHOP★ART

Class 18: Leather and goods made of leather or imitations thereof;

Class 25: Clothing, headgear, footwear.

EUTM & Spanish TM

***art**

Class 18: Leather and goods made of leather or imitations thereof;

Class 25: Clothing, headgear, footwear;

Class 35: Retailing of the goods indicated in Classes 18 and 25.

T-735/15, 6.12.2016 – SHOP ART / art

Opposition: successful under Art. 8(1)(b) - likelihood of confusion

- Signs: visually, phonetically and conceptually similar
- Goods: identical
- Interdependency principle applicable → LoC

BoA: opposition decision annuled

- Signs: visually not similar, phonetically remotely similar, conceptually evoked different ideas
- Goods: the identity of the goods – not disputed
- The common element ‚art‘ is weak → No LoC

T-735/15, 6.12.2016 – SHOP ART / art

GC: annuled the decision of the BoA

Visually, the signs are **similar to an average degree** (share *art)

- ‚SHOP‘ at the beginning does not preclude similarity
- Stylisations of words and stars – minimal (imperfect picture)
- The same combination of a star and ‚art‘ is present in both signs

Phonetically, the signs are **similar to an average degree** (share art)

Conceptually, the signs are **similar to an average degree** (share *art)

Distinctiveness of ‘SHOP’ and ‘ART’:

‘SHOP’: a descriptive reference to the place where the goods at issue are sold (a well-known fact) → **devoid of distinctiveness** (§ 43, 48)

‘ART’: evokes the idea that the G&S are the result of artistic design work → valuable aesthetic character → laudatory → limited distinctive character → **weak** (§ 47, 49)

T-735/15, 6.12.2016 – SHOP ART / art

Common Communication on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components), 2.10.2014

<https://www.tmdn.org/network/documents/10181/aed01c40-9004-4d9a-950c-6590768f6498>

T-735/15, 6.12.2016 – SHOP ART / art

A coincidence in an element with a low degree of distinctiveness will not normally on its own lead to LOC.

However, there may be LOC if:

- **The other components are of a lower (or equally low) degree of distinctiveness** or are of insignificant visual impact and the overall impression of the marks is similar.

OR

- The overall impression of the marks is highly similar or identical.

T-735/15, 6.12.2016 – SHOP ART / art

Conclusion:

- ‘ART’: the most distinctive element of the contested mark
- ‘ART’ : identical to the single word element making up the earlier mark
- Figurative elements representing stars: similar and occupy the same position (in front of ‘ART’)
- Non-distinctive ‘SHOP’ cannot offset the overall similarity between the marks
- Conclusion that there was no LOC - wrong

T-735/15, 6.12.2016 – SHOP ART / art

T-351/14, 17.2.2017 – GATEWIT/Wit software

**Relative grounds for refusal - Relevant public –
Dominant elements – Distinctive elements**

T-351/14, 17.2.2017 – GATEWIT/ Wit software

EUTMA

GATEWIT

Class 42: Design of computer systems; Creation and maintenance of websites, for others; Research and development (for others); Computer software design; Consultancy in the field of computer hardware.

EUTM



wit
software

Class 9: Computer programs and software;
Class 38: Telecommunications;
Class 42: Consultancy in the field of computer hardware and software; computer programming; computer system design; maintenance of computer software; research and development for others; updating of computer software; computer software design.

T-351/14, 17.02.2017 – GATEWIT / WIT software

Relevant public and level of attention:

- *Consultancy in the field of computer hardware and software*
- general public – normal level of attention (§ 52, 53)
- *Design of computer systems, creation and maintenance of websites, research & development, software design, computer programming* – mostly specialists and dealers – high level of attention (§ 54)

T-351/14, 17.02.2017 – GATEWIT / WIT software

Dominant and descriptive elements: GATEWIT/



WIT: dominant (fanciful & big); **software** - descript.

GATEWIT: Not a logical unit in any language;

WIT - known to public with a good command of English

GATE – known to consumers specialising in computing (members of the general public or professionals)

T-351/14, 17.02.2017 – GATEWIT / WIT software

Comparison of the signs:

Visually – similarity is normal (GC), not low (BoA)

Phonetically – similarity confirmed

Conceptually – similarity found by BoA denied by GC
(,wit' will be perceived as fanciful, no specific meaning
in relation to the respective services)

T-351/14, 17.02.2017 – GATEWIT / WIT software

- Even assuming that some consumers having a thorough knowledge of English among the consumers specialising in computing are aware of the meaning of the word ‘wit’ in English, they will be unable to attribute a specific meaning to it in relation to the services concerned. Accordingly, the element ‘**wit**’ will be conceptually perceived by all the consumers specialising in computing as **fanciful** (§ 96).
- The Board of Appeal erred in finding that the marks were conceptually similar due to the common element ,wit’ (§ 98)

T-351/14, 17.02.2017 – GATEWIT / WIT software

Global assessment:

- Consumers specialising in computing (sufficiently significant and non-negligible part of the relevant public)
- Identity of the services at issue
- Similarity of the signs (differ only in weak elements)



Despite high level of attention **LoC** cannot be safely excluded

Consumers specialising in computing will believe that the services of the contested application represent a new variant of those offered under the earlier mark

T-735/15, 6.12.2016 – SHOP ART / art

T-71/15, 16.2.2017
Land Glider / LAND ROVER

**Relative grounds for refusal – Reputation – Link
between the marks – Descriptive elements**

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

EUTMA

Land Glider

Class 12: Electric vehicles (concept cars), except two-wheel vehicles.

EUTMs

LAND ROVER



Class 12: Land vehicles and their engines; parts, components and accessories for land vehicles.

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

Opposition: filed under Art. 8(1)(b) and 8(5) EUTMR

Likelihood of confusion was not examined.

- ‚Land‘ understood → weak in EN, DE, NL but not in all MS
- Reputation – link – unfair advantage established
- Opposition upheld under **Art. 8(5)**

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

BoA: appeal upheld

Art. 8(1)(b) EUTMR:

- ‚Land‘ understood → weak throughout EU
- Signs: visually, phonetically and conceptually only lowly similar
- Inherent distinctiveness of the earlier marks: average
- Enhanced distinctiveness through use: not proven
- Enhanced level of attention of the relevant public
- No LoC even assuming enhanced distinctiveness of earlier marks

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

BoA:

Art. 8(5) EUTMR:

The common element ‚land‘ was not sufficient to lead the consumer to establish a **relevant link** between the marks at issue that would allow the conclusion that the use of the trade mark applied for took **unfair advantage** of the distinctiveness and reputation of the earlier trade marks or was **detrimental** to them.

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

Findings of the Court (only plea under Art. 8(5) was examined):

DISTINCTIVENESS OF THE COMMON ELEMENT

- ‚Land‘ (solid part of the Earth’s surface): not understood in all MS (not a well-known fact) → not descriptive → not weak (regarding a not inconsiderable part of the relevant EU public);
- The reasoning of the contested decision was based on an incorrect premiss that ‚land‘ was descriptive → weak → or even devoid of distinctiveness for the entire relevant public in EU

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

ESTABLISHMENT OF A LINK

- Is the common element ‘LAND’ enough to create a link?
- Are the signs sufficiently similar?

GC: Wrong premise taken into account – ‘LAND’ will not be perceived as descriptive in the entire EU territory

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

ASSESSMENT OF THE EARLIER MARK'S REPUTATION

- No comprehensive analysis of the evidence (2.500 pages)
- Mere assertion without any reasoning why 2.500 pages were not sufficient to establish enhanced distinctiveness or reputation

T-71/15, 16.2.2017 – Land Glider / LAND ROVER

CONCLUSION

Failure to examine in detail:

- i. The earlier mark's reputation
- ii. The relevant factors for establishing a link between the marks
- iii. The risk of unfair advantage of the earlier marks' distinctive character / repute or detriment to them

T-735/15, 6.12.2016 – SHOP ART / art

C-30/15 P, 10.11.2016

Rubik's Cube

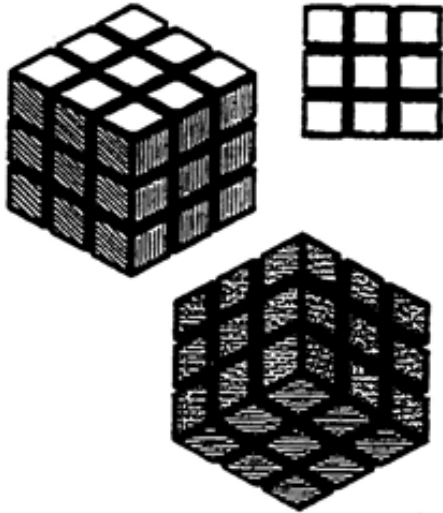
**Absolute grounds for refusal – Shapes necessary to
obtain a technical result**

Art. 7(1)(e) EUTMR - signs which consist exclusively of:

- i. the shape, or another characteristic, which results from the *nature* of the goods themselves;
- ii. the shape, or another characteristic of goods, which is **necessary to obtain a *technical result***;
- iii. the shape, or another characteristic, which gives *substantial value* to the goods.

are excluded from registration. T-735/15, 6.12.2016 – SHOP ART / art

C-30/15 P, 10.11.2016 – Rubik's Cube



Class 28: three-dimensional puzzles

C-30/15 P, 10.11.2016 – Rubik's Cube

THE



ART / art



C-30/15 P, 10.11.2016 – Rubik's Cube

- **EUTM:** registered as a 3-D B&W mark in 1999
- **Cancellation:** based, *inter alia*, on **Art. 7(1)(e)(ii)**
EUTMR - dismissed
- **BoA:** appeal dismissed
- **GC:** action dismissed

Reasoning of GC (T- 450/09):

- The essential characteristics of the shape: the **cube** and the **grid structure** (§ 45)
- No technical solution implied (§ 61)
- A rotating capability of the puzzle – irrelevant (§ 64)
- No technical function can be determined from the graphic representation of the mark (§ 72)

→ Cancellation on Art. 7(1)(e)(ii) EUTMR ruled out

Court of Justice (GC judgment - set aside):

- Identification of the essential characteristics of the mark is confirmed (the cubic form and a grid structure).
- The **essential characteristics** of the cubic shape should have been assessed in the light of the **technical function** of the **actual goods** represented.
- The functionality of the grid structure in the light of the rotating capability of individual elements in a 3-D mark (puzzle type) should have been examined.

C-30/15 P, 10.11.2016 – Rubik's Cube

- Enough that some 3-D puzzles have a rotating capability.
- The importance of safeguarding public interest regarding technical solutions.



Thank you!



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Thank you