

Decisions of the Trimester General Court & European Court of Justice

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Overview

- [C-207/15 P](#), 22.6.2016 – CVTC
- [C-226/15 P](#), 21.7.2016 – PINK LADY
- [T-167/15](#), 5.7.2016 – Neuschwanstein
- [T-804/14](#), 21.7.2016 – TROPICAL
- [T-745/14](#), 20.7.2016 – e@sy Credit/Easy Credit
- [T-518/13](#), 5.7.2016 – MACCOFFEE/McDONALD's

C-207/15 P, 22.6.2016 – CVTC

C-207/15 P, 22.6.2016 – CVTC

Art. 47(3): “The request for renewal shall be submitted in the six-month period prior to the expiry of the registration. The basic fee for the renewal, and [the class fee] shall also be paid within this period. *Failing this*, the request may be submitted [...] within a further period of six months following the expiry of registration, provided that an additional fee [is paid]”.

C-207/15 P, 22.6.2016 – CVTC

Art. 47(5): “Where the request is submitted or the fees paid in respect of only some of the goods or services for which the EU trade mark is registered, registration shall be renewed for those goods or services only.”

C-207/15 P, 22.6.2016 – CVTC

- EUTM registered for goods in Classes 7, 9 and 12
- First renewal request within the regular period for goods in Classes 7 and 12 only
- After expiry of regular period, EUIPO renewed as requested and cancelled EUTM as regards goods in Class 9
- Second request for renewal within the ‘grace period’ for goods in Class 9

C-207/15 P, 22.6.2016 – CVTC

Art. 47(3): “The request for renewal shall be submitted in the six-month period prior to the expiry of the registration. The basic fee for the renewal, and [the class fee] shall also be paid within this period. *Failing this*, the request may be submitted [...] within a further period of six months following the expiry of registration, [...]”.

C-207/15 P, 22.6.2016 – CVTC

- Wording of Art. 47(3) allows additional renewal request within the “grace period”: “Failing this...” is not a condition with respect to the request but only sets out the requirement to pay an additional fee.
- Objective to facilitate the retention of proprietor’s exclusive right
- Legal certainty does not require preclusion of right to renewal in ‘grace period’

C-207/15 P, 22.6.2016 – CVTC

EUIPO implementation:

- Guidelines, Part E, Register Operations, Section 4, Renewal

C-226/15 P, 21.7.2016 – PINK LADY

C-226/15 P, 21.7.2016 – PINK LADY

- EUIPO: Opposition against EUTMA “ENGLISH PINK” based on earlier “Pink Lady” EU marks.
- EUTM court annulled Benelux mark “ENGLISH PINK” of EUTMA applicant based on the same earlier “Pink Lady” EU marks as invoked in opposition proceedings.
- BoA rejected opposition without making any reference to final EU trade mark court decision.

C-226/15 P, 21.7.2016 – PINK LADY

- EUIPO:

“Pink Lady” marks → EUTMA “ENGLISH PINK”: **No LOC**

- EUTM court:

“Pink Lady” marks → BLX “ENGLISH PUNK”: **LOC**

C-226/15 P, 21.7.2016 – PINK LADY

- T-378/13, 25.03.15:
 - BoA did not comply with requirement to state reasons (Art. 75) + infringement of principle of sound administration.
 - BoA was not bound by virtue of the principle of *res judicata* to uphold the opposition.

C-226/15 P, 21.7.2016 – PINK LADY

- No provision concerning interplay between an infringement action and opposition proceedings, which are based on same earlier marks directed against a national and a corresponding EU sign.
- Principle of *res judicata*:
 - Same parties
 - Same subject matter
 - Same course of action

C-226/15 P, 21.7.2016 – PINK LADY

- Not the same subject matter
 - EUTM court: annulment of Benelux mark “ENGLISH PINK” + use prohibition
 - EUIPO: opposition against EUTMA “ENGLISH PINK”
- No *res judicata* of final EU trade mark court decision for EUIPO in application/opposition proceedings

T-167/15, 5.7.2016 – Neuschwanstein



T-167/15, 5.7.2016 – Neuschwanstein

Class 3: Perfumery goods; articles for body and beauty-care. **Class 8:** Cutlery of precious metals. **Class 14:** Jewellery; clocks and watches. **Class 15:** Musical instruments. **Class 16:** Writing and note paper; fountain pens and ink. **Class 18:** Leather and imitations of leather; umbrellas; travelling bags; handbags; suit carriers; suitcases; briefcases; vanity cases (not fitted); **Class 21:** Glassware, porcelain and earthenware not included in other classes; teapots not of precious metal. **Class 25:** Clothing; footwear; headgear. **Class 28:** Games and playthings. **Class 30:** Coffee; tea; cocoa; sugar; honey; pastries; cakes; cookies; sweets; ice-cream. **Class 32:** Soft drinks; beers. **Class 33:** Alcoholic beverages (except beers). **Class 34:** Matches; cigarette cases, ashtrays. **Class 35:** Advertising agency services. **Class 36:** Insurance; finance; monetary affairs; real estate affairs. **Class 38:** Telecommunication and communication services. **Class 44:** Hygienic and beauty care for human beings.

T-167/15, 5.7.2016 – Neuschwanstein

Art. 7(1)(c): geographical origin?

- GC recalls case-law for “geographical origin” (Windsurfing Chiemsee and Oldenburger)
- Neuschwanstein is a castle, which can be localised, but it is not a geographical place. It is a famous, museum-like site. Its main function is to conserve cultural heritage and not to produce/market souvenir articles or to render the services.

T-167/15, 5.7.2016 – Neuschwanstein

→ It does not indicate a geographical origin under Art. 7(1)(c).

T-167/15, 5.7.2016 – Neuschwanstein

Applicant: In the castle and its surroundings, souvenir articles are commonly sold and hence the mark indicates the geographical origin of the souvenirs.

[T-167/15](#), 5.7.2016 – Neuschwanstein

GC: Like for other cultural sites, the sale of souvenir articles is a side business of operating the site in order to raise revenues in addition to the entrance fees.

The souvenir articles are everyday consumer goods, for which the site is not specifically known.

→ No sufficiently direct and specific link between the sign and the g/s

[T-167/15](#), 5.7.2016 – Neuschwanstein

Art. 7(1)(b): lack of distinctiveness?

- Everyday consumer goods which can be distinguished from souvenir articles only by means of their designation (EUTM)

T-167/15, 5.7.2016 – Neuschwanstein

Class 3: Perfumery goods; articles for body and beauty-care. **Class 8:** Cutlery of precious metals. **Class 14:** Jewellery; clocks and watches. **Class 15:** Musical instruments. **Class 16:** Writing and note paper; fountain pens and ink. **Class 18:** Leather and imitations of leather; umbrellas; travelling bags; handbags; suit carriers; suitcases; briefcases; vanity cases (not fitted); **Class 21:** Glassware, porcelain and earthenware not included in other classes; teapots not of precious metal. **Class 25:** Clothing; footwear; headgear. **Class 28:** Games and playthings. **Class 30:** Coffee; tea; cocoa; sugar; honey; pastries; cakes; cookies; sweets; ice-cream. **Class 32:** Soft drinks; beers. **Class 33:** Alcoholic beverages (except beers). **Class 34:** Matches; cigarette cases, ashtrays. **Class 35:** Advertising agency services. **Class 36:** Insurance; finance; monetary affairs; real estate affairs. **Class 38:** Telecommunication and communication services. **Class 44:** Hygienic and beauty care for human beings.

[T-167/15](#), 5.7.2016 – Neuschwanstein

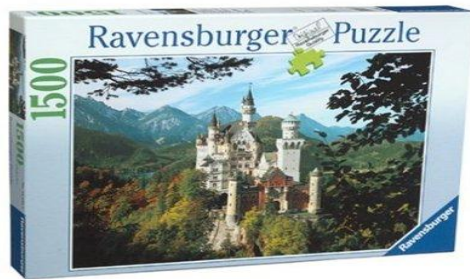
Art. 7(1)(b): lack of distinctiveness?

- Everyday consumer goods
 - EUTM corresponds to the fantasy name of a castle without any descriptive meaning for the g/s
 - EUTM allows to distinguish g/s from those offered at other commercial or touristic places.
- Relevant public will assume that g/s are offered under the control of the EUTM owner.

T-167/15, 5.7.2016 – Neuschwanstein

Good news for cultural sites?

The mark is attached to everyday consumer goods to allow its exploitation.



T-804/14, 21.7.2016 – TROPICAL

T-804/14, 21.7.2016 – TROPICAL

T-804/14, 21.7.2016 –

EUTM

/

Portuguese word mark



TROPICAL

Class 5: “Veterinary, therapeutic, disinfecting and sanitary products and preparations for use in aquaristics, terraristics, fauna breeding and flora cultivation”;

Class 31: “Food in the form of flakes, granulates, grains, extrudates and tablets, dried and lyophilised natural food for fauna,” etc.

Class 31: “Food for fish”, etc.

T-804/14, 21.7.2016 – TROPICAL

‘Food in the form of flakes, granulates, grains, extrudates and tablets, dried and lyophilised natural food for fauna, especially for fish, ornamental fish, birds, reptiles, amphibians and breded small animals, food for fauna containing nutritives, products and preparations for the cultivation of plants and aquarium plants and for the breeding of fish, ornamental fish, birds, reptiles, amphibians and breded small animals; excluding bird feed and bird treats’

T-804/14, 21.7.2016 – TROPICAL

‘Food in the form of flakes, granulates, grains, extrudates and tablets, dried and lyophilised natural food for fauna, especially for fish, ornamental fish, birds, reptiles, amphibians and breded small animals, food for fauna containing nutritives, products and preparations for the cultivation of plants and aquarium plants and for the breeding of fish, ornamental fish, birds, reptiles, amphibians and breded small animals; excluding bird feed and bird treats’

T-804/14, 21.7.2016 – TROPICAL

‘Food in the form of flakes, granulates, grains, extrudates and tablets, **dried and lyophilised natural food for fauna, especially for fish, ornamental fish, birds, reptiles, amphibians and breded small animals**, food for fauna containing nutritives, products and preparations for the cultivation of plants and aquarium plants and for the breeding of fish, ornamental fish, birds, reptiles, amphibians and breded small animals; excluding bird feed and bird treats’

T-804/14, 21.7.2016 – TROPICAL

Class 5: ‘Veterinary, therapeutic, disinfecting and sanitary products and preparations for use in aquaristics, terraristics, fauna breeding and flora cultivation’

BoA: distributed by the same companies, have the same points of sale and are directed at the same end-consumers → average similarity

T-804/14, 21.7.2016 –

General Court:

- No evidence for distribution by the same company and at the same point of sale.
 - Even assuming the same point of sale, an average degree of similarity could not be deduced from that finding alone since all kinds of goods can be found there.
 - Conflicting goods address different publics. Persons buying ‘food for fish’ may buy the Class 5 goods but also very different products such as filters or aquarium decoration.
- Criteria employed by BoA insufficient for average similarity

T-804/14, 21.7.2016 –

EUTM

/

Portuguese word mark



TROPICAL

BoA: signs are aurally identical; visually and conceptually highly similar

Applicant: common word element non-distinctive and descriptive since it indicates that goods are for tropical fish

T-804/14, 21.7.2016 –

EUTM

/

Portuguese word mark



TROPICAL

GC:

- Word element of earlier mark cannot be discounted for the comparison of the signs
- Word element is not more directly allusive or descriptive than the figurative element which refers directly to the animals for the goods are intended.

T-804/14, 21.7.2016 – TROPICAL

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-804/14, 21.7.2016 – TROPICAL

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.

NO LOC

- [T-102/14](#), 13.5.2015 – TPG POST / POST

A word forming part of a composite sign may be perceived differently than when used on its own or in a different context. This applies even more so when the word is preceded by the indication of a different commercial origin (“TPG”). In these circumstances, the element “POST” is considerably less distinctive than the element “TPG”. In addition, it is common practice in the postal market to use company initials composed of three capital letters. (para. 45).

NO LOC

- [T-485/14](#), 2.2.2016 – Bon Appétit / Bon Apetí



- [T-247/14](#), 4.2.2016 – Stick MiniMINI Beretta / MINI WINI



MINI WINI

LOC

- [T-326/14](#), 19.4.2016 – HOT JOKER / Joker



BoA could not deny that the word element ‘joker’, and, as a result, the earlier mark as a whole, had any distinctive character because in so doing it would deprive that earlier mark of any real scope of protection, which would contravene the system of the coexistence of EU trade marks and national trade marks established by the EU legislature (see, to the effect, judgment of 24 May 2012 in *Formula One Licensing v OHIM*, [C-196/11 P](#), para. 40 to 47).

LOC

- [T-745/14](#), 20.7.2016 – e@sy Credit / Easy Credit



**e@sy
Credit**



“ [...]the services covered by the marks at issue are identical [...], the signs are visually highly similar [...], and phonetically and conceptually identical [...]. Furthermore, the word element, which is common to the marks at issue, dominates the overall impression they give, despite its potentially descriptive nature in respect of the services in question.”

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- EUTM: “MACCOFFEE” for foodstuffs and beverages in Classes 29, 30 and 32
- Invalidity request under Art. 8(5) (in conjunction with Art. 52(1)(a)) based on earlier EUTM “McDONALD’S”
- Genuine use of earlier marks contested
- Invalidity Division declared EUTM invalid
- BoA dismissed the appeal

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- Considerable reputation of earlier mark for fast-food restaurant services not disputed
- Sufficient degree of similarity between marks?
 - No visual similarity (contrary to BoA finding)
 - Certain phonetic similarity
 - Conceptually → next slide

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- “MAC”/”Mc” are associated with same idea of a Gaelic surname prefix;
written interchangeably;
association of prefix “MAC”/”Mc” with an everyday word not unusual
MACCOFFEE (probably) understood as a reference to a beverage produced by a person of Scottish or Irish origin
→ Certain conceptual similarity since they refer to a surname of Gaelic origin

T-518/13, 5.07.2016 – MACCOFFEE / McDONALD's

- Visual dissimilarity more important than similarity on phonetic and conceptual level due to method of marketing of goods/services?

Not negligible and remains “as important as ever” since oral communication prior to purchase or advertisement on radio or by other consumers takes place (para. 33)

T-518/13, 5.07.2016 – MACCOFFEE / McDONALD’S

- Establishment of a link?
 - Family of marks “Mc” + another word a relevant factor?
 - Evidence show use of “McDONALD’S” + McFISH, McRIB, McCHICKEN, etc.
 - MACCOFFEE fits in

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- Certain degree of similarity of goods / services?
Foodstuffs /drinks versus restaurant services
 - Foodstuffs used and offered in the context of restaurant services
 - Services are offered in the same place where foodstuff is sold
 - Foodstuffs may originate from restaurants selling ready-made food to take away
- Certain degree of similarity

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- Risk of unfair advantage of the repute?

Riding on the coat-tail of the mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation, the marketing effort made to create and maintain the image of that mark.

T-518/13, 5.7.2016 – MACCOFFEE / McDONALD's

- Risk of unfair advantage of the repute?

Image transfer possible due to

- a) considerable reputation,
- b) distinctive character of “Mc” + name of menu item/foodstuff,
- c) reproduction of same structure, and
- d) certain degree of similarity of goods/services

Thank you!



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Thank you