

Decisions of the Trimester General Court & European Court of Justice

Judgments from 1st December 2015 to 29th February 2016

COURT	TOTAL DEC-JAN- FEB	(PARTIALLY) ANNULLED	DISMISSED /ORDERS*
CJ	14	1	13
GC	86	13	73

C-603/14 P

CTMA:

THE ENGLISH CUT* (25)

v

EL CORTE INGLES (25)





8(1)(b): Low degree of conceptual similarity → Signs dissimilar overall.

8(5): Not applicable, since the signs are dissimilar.



- It is not apparent either from the wording or from the case-law that the concept of similarity has a different meaning under Article 8 (1) (b) and 8 (5) CTMR (§ 39).
- So concept of similarity is the same.

C-603/14 P

CJEU

- “in a situation in which the degree of similarity in question does not prove to be sufficient to result in the application of Article 8(1)(b) of **Regulation No 207/2009**, it cannot be deduced from that that the application of paragraph 5 of that article is necessarily precluded”. (§ 40)
- The GC erred in law in ignoring that the degree of similarity of the signs necessary to apply Article 8 (1) (b) and 8 (5) CTMR is different - because LoC is required for one but not the other. (§ 41)
- Since a certain degree of (conceptual) similarity was found, the GC should have examined whether that degree of similarity with other relevant factors could give rise to relevant public to establish a link between those signs (§ 43 to 48).

Calvin Klein (**C-254/09 P**, EU:C:2010:488) and Ferrero (**C-552/09 P**, EU:C:2011:177) relate to different situations. Although, in those cases, there was a word or element which was common to the signs at issue, the General Court had formally held, contrary to what is the case in the judgment under appeal, that there was no similarity between the signs at issue. (§ 49)

T-692/14



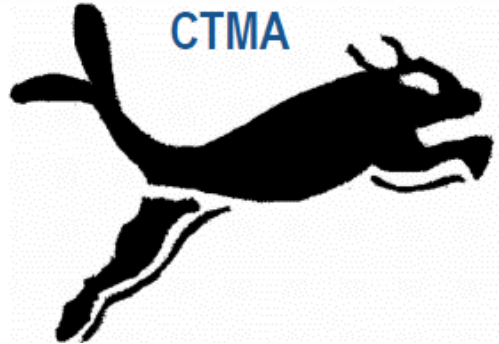
Class 25, opposition based on Art. 8(1)(b) CTMR

BoA **

- Visually, the signs do not coincide in any element. The earlier marks represent a jumping wildcat/puma whereas the mark applied for a silhouette of an unidentified creature ... The conflicting animals leap in different directions. Furthermore, the silhouette presented in the mark applied for is more thickset when compared with the shapelier form wildcat of the earlier marks. Consequently, the conflicting marks are considered visually dissimilar. (§ 24)
- From a semantic perspective, the earlier marks clearly reproduce a wildcat or puma whereas the mark applied for represents an unidentified animal. ... It would more likely be perceived as a fanciful, terrestrial creature whose body parts, however, may appear to show different parts of (aquatic and terrestrial) animals ... The Board considers ... that the conflicting figurative signs would not be perceived as referring to the same concept. (§ 26)

T-692/14





- both represent black silhouettes of animals in a similar bounding position, feet on the ground, the front legs bent under the jaws and tails of animals forming similar angles to the trunks. The curves of the back and underbelly of the two animals depicted are not identical but have undeniable similarities. (§ 33)
- BoA failed to take account of visual similarities. (§ 34)

The decision annulled and remitted to BoA. No guidance binding under Art. 65(6) CTMR as to the outcome.

T-640/13

CTMA:

CRETEO (Cl. 2)

← New mark

v

StoCretec (Cl. 2)

← Old marks

STOCRETE (Cl. 2)

Earlier signs: German.

Opponent's name: Sto SE & Co. KGaA

BoA  8(1)(b): No LoC, no similarity between the CRETEO and StoCretec.

Appeal to GC:

The coincide in the sequence of letters "CRETE". "Sto" is a company name and will be perceived separately from "CRETE" or "CRETEC". **German case law on role of company name*** in comparison and **T-318/03 ATOMIC BLITZ**", § 35, 36 OHIM to take account of national law.

* Clicking on the turquoise text will take you to a webinar on company names and interpretation of Article 8(4)

T-640/13



- ATOMIC BLITZ concerns only very general facts which are easy to verify - term of protection of a TM. (§ 45)
- If more specific national provision are in question it is up to the parties to establish the content of national law including the existence and extent of any national case law cited. (§ 45)
- Board not required to search the German law. (§ 46)
- German law not applicable anyway, because the comparison of signs and the global assessment follow the rules of the CTMR. (§ 47)
- Where the BoA ruled out LoC for goods that were identical, economy of procedure meant it was not required to examine the degree of similarity for products that are similar. (§ 90)

T-354/14

CTMA:

New mark →

zūmex

(Cl. 32)

v

JUMEX

(Cl. 32)

← Old mark

Art.42(2)(3): Proof of use, 4 invoices to Nidera General Merchandise B.V. in Rotterdam NL.

Applicant challenged evidence: Nidera General's website indicated exporting and distributing foodstuffs to West African buyers.

GC



- The buyer's establishment in the EU is insufficient on its own to prove use in the EU.
- Need to prove the entry of the goods in the EU market.

T-354/14



- The importation of the goods into the EU with the aim of re-exporting them to third countries cannot create or maintain a share in the market for the product or services protected by the mark.

NB

Art. 15(1)(b) CTMR, the affixing of the CTM to goods or to the packaging thereof in the EU solely for **export** purposes constitutes use.

T-711/13 and T-716/13



Earlier Swedish mark

HARRY'S BAR

← New mark

CTMA

Class 42 (now 43). Serving of food and drink through restaurant, pub and café services.

versus

Class 29: Meat; fish; poultry and game; meat extract; preserved fruits and vegetables; jellies, jams, fruit sauce; jams and jellies; jams; jams and marmalade; fruit sauces; eggs; milk and dairy products; butter; cheese; edible oils and fats; prepared cooked meals (except prepared cooked meals for animals); milk-based beverages; instant drinks based on milk; yoghurts.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; honey, treacles; salt, mustard; vinegar, sauces (condiments); relish; ice; coffee, tea or cocoa-based preparations for making beverages.

Class 32: Non-alcoholic beverages and preparations for making beverages (except coffee, tea or cocoa-based beverages and milk beverages); beers; mineral and aerated waters; fruit drinks and fruit juices; syrups.

Class 33: Alcoholic beverages (excluding beer).

T-711/13 and T-716/13

OD:

Similarity for all except: 'meat extract; eggs; milk and dairy products; butter; cheese; edible oils and fats; milk-based beverages; instant drinks based on milk; yoghurts' and 'sugar, rice, tapioca, sago, honey, treacles; salt, mustard; vinegar, sauces (condiments); relish; ice'.

BoA*:

Class 29 and 30 (except prepared cooked meals) – dissimilar to services in Class 43. Prepared cooked meals in Class 29 – remote degree of similarity.

Class 32 (except beers) – dissimilar.

Beers in Class 32 and alcoholic beverages in Class 33 – remote degree of similarity to services in Class 43.

* Clicking on 'BoA' will take you to the Decision of the Boards of Appeal

T-711/13 and T-716/13



All contested goods are similar to a certain degree to services.

Class 29

- It is indisputable that, in the light of the factors relating to their nature, their intended purpose or their method of use, they are not similar. (§ 58)
- However, those goods are necessarily used in the serving of food and drink, with the result that those goods and those services are complementary. Furthermore, food may be offered for sale in places in which food and drink are served. Such goods are therefore used and offered through restaurant, pub and café services. Those goods are consequently closely connected with those services. (§ 59)
- In the light of the foregoing, it must be held, contrary to what the BoA found, that there is a certain degree of similarity between the goods referred to in paragraph 58 above [CI 29] and the serving of food and drink covered by the earlier mark. (§ 60)

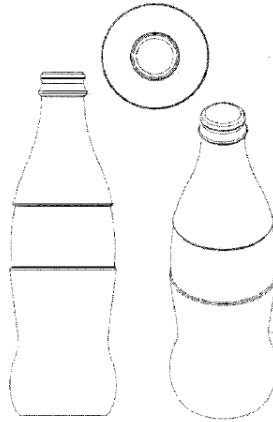
T-711/13 and T-716/13



- Class 30 – same principle as to class 29. (§ 65)
- Class 32 – The same reasoning as in relation to goods in Class 29 must be applied to the beverages and other goods in Class 32 covered by the mark applied for. Those beverages and goods are complementary to the serving of food and drink in Class 42 (now Class 43) covered by the earlier mark when they are used and offered through restaurant, pub and café services. (§ 69)
- Class 33 – same principle (§ 74)

“Complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services (para 52, also 11/05/2011, **T-74/10**, Flaco, EU:T:2011:207, § 40; 21/11/2012, T-558/11, Artis, EU:T:2012:615, § 25; 04/02/2013, **T-504/11**, Dignitude, EU:T:2013:57, § 44).

T-411/14, Coca Cola



Cl. 6, 21, 32

BoA dismissed appeal to objection under Article 7(1)(b) and also dismissed the applicant's application under Article 7(3) finding that:

- shape at issue did not differ substantially from the basic shapes of the goods in question and their packaging;
- rejected claim that 'contour bottle without fluting' had to be regarded as an evolution of the applicant's famous iconic bottle ('the contour bottle with fluting');
- the applicant had failed to establish that the mark applied for had acquired a distinctive character through use (independence of surveys – half of Members States covered).

T-411/14, Coca Cola



Article 7(1)(b)

- The lower section of the bottle does not possess any characteristics that distinguish it from other bottles available on the market. Lower sections of bottles can vary greatly but such variations do not, generally, enable the average consumer to infer commercial origin. (§ 45)
- Same for middle section, purpose, is to house a label stating the brand names, info etc. Slightly curved did not render the mark distinctive. (§ 46)
- Same for the top section of the mark applied for, which consists in a funnel shape. Even though that feature is somewhat original, it cannot be regarded as departing significantly from the norms and customs of the sector. (§ 47)

The mark is characterised by its shape which has a curved silhouette. However, that shape represents nothing more than the sum of the parts of the mark applied for, that is to say, a bottle like the majority of bottles on the market. (§ 50)

T-411/14, Coca Cola



Article 7(3)(b)

- Ground for Article 7(1)(b) applies throughout the EU. (§ 68)
- Doubts raised by the BoA on reliability of the surveys are unfounded but this does not affect the legality of the contested decision. (§ 74 & 75)
- Surveys did not cover 17 Member states result of 10 cannot be extrapolated. (§ 80)
- Surveys are not sufficient, in themselves, to prove acquired distinctiveness through use, throughout the EU. (§ 81)
- Advertising do not specifically relate to the mark applied for. (§ 82)
- Sales figures marred by inconsistencies and not possible to determine if it refers to mark in question. (§ 85)

The surveys covered only a part of the EU and that the other items of evidence do not, in view of their imprecisions and inconsistencies, compensate for that deficiency.

C-163/15 - "ARKTIS"



Standing of CTM Licensee

Art. 23(1) CTMR '[l]egal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark shall have effects vis-à-vis third parties... only after entry in the Register'. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.

Question:

Does the first sentence of Article 23(1) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark preclude a licensee who is not entered in the Register of Community trade marks from invoking claims for infringement of a Community trade mark?

C-163/15 - "ARKTIS"



In isolation, could be interpreted as such...(§ 18). But, necessary to consider not only wording but also the context (§ 19).

Context: 'Third parties who have, or are likely to have, rights in CTM'.

- Excludes 'third parties who have acquired rights' but who 'knew of the legal act at the date on which the rights were acquired' or acquired the CTM or rights by universal succession. (§ 20).
- Section 4 CTMR is entitled 'Community trade marks as objects of property'. (§ 21).
- Art. 22(3) CTMR, the licensee's right to bring proceedings for infringement is subject only to the proprietor's consent thereto. (§ 22).
- Article 17(6) of the Regulation would serve no useful purpose. (§ 24).

Article 23(1) CTMR DOES NOT PRECLUDE the holder of a licence which is not entered in the Register of CTMs from bringing proceedings for infringement of a Community trade mark.

T-690/14

Revocation action, lack of use, Art. 51(1)(a) CTMR



Registered



Used



- The distinctive character of the mark derives essentially from the word VIETA, not from the figurative elements; (§ 47-48).
- VIETA: high level of distinctiveness and important position in the overall impression; (§ 48)
- Figurative elements: mere ancillary position, relatively marginal visual impact (§ 48)

Contrast - T-83/14



 **NOT USE**

 **GC**

- ARTHUR is the dominant element
- But the distinctive character derives not only from ARTHUR, but also from the graphic element, which is secondary, but not banal or negligible.
- Stylised signature, asymmetric, dynamic v No signature; Classic, symmetric, static

T-485/14

CTMA

Earlier mark

New mark →



← Old mark

GC

CI 29

- “Bon Appétit” is commonly known amongst BG consumers, meaning “enjoy your meal”.
- These word elements will immediately be perceived as descriptive. (§ 43-44)
- Given the descriptive meaning of “Bon Appétit” and “Bon Apetì” and the sufficiently striking figurative elements, the BoA was right to conclude that the word element cannot have a decisive bearing in the overall assessment. (§ 73)

T-210/14

New mark →



← Old mark

- 'gummi' and 'gummy' being visually almost identical, the elements of dissimilarity are not capable of dispelling the impression on the part of the relevant public that there is a certain degree of visual similarity.
- 'gummi' and 'gummy' are pronounced identically - aurally similar
- since the earlier mark does not evoke anything specific, it cannot be held that there is a conceptual similarity between the signs at issue.

T-210/14



GUMMY

Global Assessment:

- Goods identical;
- Low level of attention of Spanish consumer;
- Average degree of distinctiveness of earlier mark;
- Visually: lowly similar; Aurally: similar; Conceptually: --

→ LoC

T-210/14 & T-485/14

LOC:



GUMMY

NO LOC:





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Thank you