

DECISIONS OF THE QUARTER

Important Decisions of the Boards of Appeal – 4th Quarter 2016

Christoph Bartos

Member, Boards of Appeal - EUIPO

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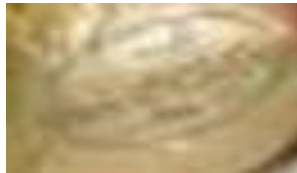
- Formalities
 - Change of sign
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And again, a number

Formalities

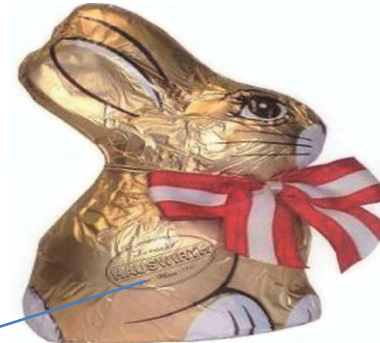
R0892/2015-4 Hase

EUTM applied for



Remark:
one of three views

Request for change of sign



Remark:
one of two views

R0381/2016-1 hww hermann wienberg wilhelm

Facts

- Office requests payment of additional class fees before 21/10/2015
- No additional class fees paid
- Applicant files appeal and
 - Payment of appeal fee
 - Payment of additional class fees

Absolute Grounds of Refusal

And again, a number

[R0339/2016-2 Pictogram](#), [R0343/2016-2 Pictogram](#),
[R0489/2016-2 Pictogram](#), [R0556/2016-2 Pictogram](#)

EUTMs applied for



- Cl. 9, 38, 41, 42

R2517/2015-1 red dot

EUTM applied for



- Cl. 5, 9, 16, 28, 29, 31, 32, 35, 38, 41, 42, 43

R0659/2016-2 glass

EUTM applied for



-

- Cl. 21

R0512/2016-2 & 0552/2016-2 TWO STICKS

Registered EUTM



Description:

The trade mark consists of the representation of two beige and light brown oblong sticks, forming a V shape. The light brown section is covered by a dark brown spiral. One of the sticks has a cut in its end, with brown fragments encircling it.

- Cl. 30

R2141/2015-5 GÜVEN

EUTM applied for

- **GÜVEN**
- Cl. 29

R0695/2016-4 PINK

EUTM applied for

• **PINK**

- Cl. 9, 18, 24

R0580/2016-5 KARELIA

R1562/2015-5 KARELIA

EUTM applied for No 13 450 077

- **KARELIA**
- Cl. 3, 5, 7, 18, 21, 24, 25, 26, 28, 30, 35, 36, *inter alia* for
 - Cosmetics
 - Medicated confectionery
 - Automatic vending machines;
 - Bags, luggage and rucksacks;
 - Household and kitchen utensils
 - Bed linen
 - Clothing, footwear, headgear
 - Lace embroidery
 - Toys
 - Artificial coffee
 - Advertising
 - financial services

EUTM applied for No 964 502

- **KARELIA**
- Cl. 4, 10
 - Industrial oils and greases, lubricants, fuels, candles
 - condoms, rubber surgical and medical apparatus and instruments

R2318/2015-5 TARRAGONA 2017

EUTM applied for

- TARRAGONA 2017
- Cl. 6, 14, 25, 35, 41,

R2373/2015-5 CHATEAU

EUTM applied for



Description:

The mark consists of a representation of a quadrilateral stylized frame, decorated with fanciful decorative elements; within the frame, it is represented a farmhouse with countryside setting, trees, flowerbeds and ornamental fountain.



Likelihood of confusion

And again, a number

Comparison of Goods & Services

R1837/2015-5 CL/CL

G&S applied for

- Cl. 16 Printed matters, teaching materials

Earlier G&S

- Cl. 9 Magnetic data carriers

R0561/2016-2 buhoo/BOOHOO

G&S applied for

- Cl. 18 saddlery, whips and animal apparel; casings, of leather, for springs; valves of leather

Earlier G&S

- Cl. 18 leather

R0419/2016-2 redarbour/shape of a tree

G&S applied for

- Cl. 36 real estate services

Earlier G&S (DE)

- Cl. 18 financial services

R0279/2016-4 K/K

G&S applied for

- Cl. 9 apparatus and instruments for conducting and accumulating electricity

Earlier G&S _(DE)

- Cl. 9 Photography, cinematographic, optical and signalling devices and instruments; apparatus for recording, transmission or reproduction of sound of images; magnetic data carriers; sound and image recording discs; videotapes, CDs, CDis, CD-ROMs and DVDs; magnetic or coded club and membership cards; video-, audio- and computing devices; apparatus for games adapted for use with television receivers only

R0053/2016-2 h/h

G&S applied for

- Cl. 9 photographs

Earlier G&S _(DE)

- Cl. 9 computer software and hardware related to photography, [- -], digital photo albums
- Cl. 38 providing access to an online platform containing a collection of data and pictures

General Assessment

R2030/2015-4 V/V

EUTM applied for



- Cl. 18, 25

Earlier trade mark (IR-EU)



- Cl. 18, 25

R2233/2015-1 R/Ri

EUTM applied for



- Cl. 9

Earlier trade mark (EU)



- Cl. 9

R0053/2016-2 h/h

EUTM applied for



- Cl. 9, 16, 20, 28, 35, 39, 41

Earlier trade mark (EU)



- Cl. 9, 35, 38, 39, 42

R0182/2016-2 COCONUT DREAM/K CLASSIC COCONUT

EUTM applied for

- **COCONUT DREAM**
- Cl. 29, 30, 32
 - All containing coconut

Earlier trade mark (IR-EU)



- Cl. 29
 - confectionary

R1656/2015-1 VITALITY MIX/VITALIA

EUTM applied for

Earlier trade mark (EU)



- Vitality
 - Cl. 29, 30, 31
- Vitalia
 - Cl. 29, 30, 31

R0649/2016-2 SANGRE DE CASTILLA/SANGRE DE TORO

EUTM applied for

- SANGRE DE CASTILLA
- Cl. 33

Earlier trade mark _(EU)

- SANGRE DE TORO
- Cl. 33

Bad Faith

And again, a number

R1376/2014-2 PARASYNC

Facts

- 2000: parties start business relationship
- 2006: EUTM proprietor acquires majority shares of cancellation applicant
- 2008: company established by parties
- 2010: agreement of the parties to split
 - EUTM proprietor is owner of many trademarks in Cl. 9 containing the prefix 'para'
 - Cancellation applicant not allowed to use prefix 'para'
 - Next day the EUTM proprietor filed the 'PARASYNC'
- Both parties were in sale of the same products under the same name

R2036/2015-1 RE-CORD

Facts

- EUTM applied for in 2012 for goods in Cl. 4
- Cancellation applicants predecessor is proprietor of a Hungarian trade mark in Cl. 4, which lapses in 2009
- Cancellation applicant(s predecessor) uses the trade mark without interruption between 2006 and 2012 for goods in Cl. 4
- EUTM proprietor has knowledge of (unregistered) trade mark
 - Business partners over years
 - Judgment of Hungarian Courts
 - Hungarian Trade Mark Office rejected national application



R2211/2015-1 VdeV

Facts

- EUTM proprietor's CEO (and family) involved in various companies, which were owners of a French trade marks identical to the EUTM
- French trade marks were assigned to other companies
- EUTM was filed by third party
 - Link to EUTM proprietor's CEO (and family) exists

R1670/2015-4 E...

Facts

- EUTM proprietor was the lawyer of the cancellation applicant
 - Legal representation terminated
- Trade mark filed
 - National two days after termination of representation
 - EUTM within less than 6 months

Back from GC

And again, a number

R1010/2016-4 Vieta [R2100/2013-2, T-690/14]

Facts

- **R2100/2013-2**

Trade mark used for ‘television sets’

- **T-0690/14**

63 ... the expression ‘apparatus for the reproduction of sound and images’ cannot be considered to be defined sufficiently ‘precisely and narrowly’

66 ... the expression ‘apparatus for the reproduction of sound and images’, understood in its natural and usual sense, is capable of including a wide array of audio-visual and electronic equipment, including equipment for which the Cancellation division found, in this case, that proof of genuine use had not been provided, such as video cameras or photographic apparatus.

R1010/2016-4 Vieta
[R2100/2013-2, T-0690/14]

Board of Appeal

R0247/2016-4

[R0609/2011-4, T-382/14]

Facts

- **Earlier trade mark**

 - Class 29 – Milk products; protein, in particular in powder form;

 - Class 32 – Preparations, particularly protein, particularly in powder form, for beverage preparation.

- **R2100/2013-2**

 - Trade mark used for goods in Class 32

- **T-0690/14**

 - 59 ... it is not clearly and unequivocally apparent whether the Board of Appeal concurred or not with the Opposition Division's assessment that the applicant had proved genuine use of his earlier marks in connection with certain goods in Class 29, which had to be taken into consideration for the purposes of assessing the likelihood of confusion. The Board of Appeal did not rule expressly on that assessment of the Opposition Division, either by confirming or overturning it.

R0247/2016-4

[R0609/2011-4, T-0382/14]

Board of Appeal

Solution

Thanks for your attention

CONTACT :



Christoph Bartos
(+ 34) 965 139 743

christoph.bartos@euipo.europa.eu
mediator-bartos@euipo.europa.eu

CONTACT

US:



(+ 34) 965 139 100 (switchboard)

(+ 34) 965 139 400 (e-business technical incidents)

(+ 34) 965 131 344 (main fax)

information@euipo.europa.eu

e-businesshelp@euipo.europa.eu



[twitter/@EU_IPO](https://twitter.com/EU_IPO)

www.euipo.europa.eu

Danke!