

Decisions of the Trimester

January – March 2016

The Menu

Procedural Questions

- Renewal or no renewal?

Absolute grounds of refusal

- Figurative trade marks
- Trade marks trade marks
- Deceptiveness?
- Acquired distinctiveness

Proof of use

- **What constitutes use?**

Relative grounds of refusal

- Similarity of goods and services
- Likelihood of confusion

Just another figure

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PROCEDURAL QUESTIONS

R0526/2015-5 PIMP MY

Facts

- CTM due for renewal on 08/02/2015
- 22/12/2014: renewal request for CI 9 & 38
- 23/12/2014: further renewal request for CI 25 & 41

- Office rejects additional renewal request

Editor's note: Reference is made by the speaker to a judgment by the General Court to a similar case: T-572/12 - CVTC

R0526/2015-5 PIMP MY

Board of Appeal

- Requests were made before the end of protection granted
- Renewal has effects only as of the date of the end of protection granted
 - public interest does not prevent an additional request

Result

- Appeal **allowed**
- Renewal **granted** for additional classes

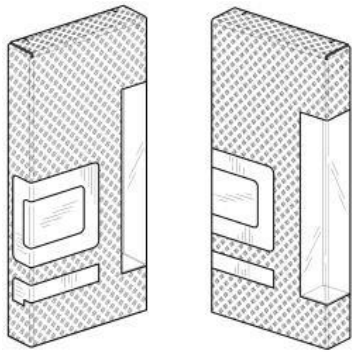
ABSOLUTE GROUNDS OF REFUSAL

Just another figure

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R1137/2015-4 Rectangular Box

CTM applied for



- Cl. 29, 30, 32
 - All related to milk

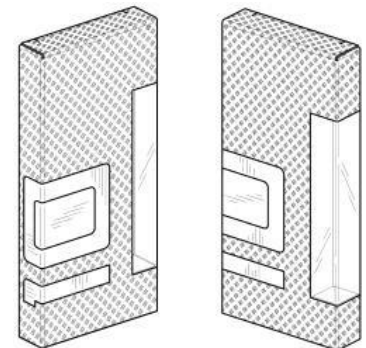
R1137/2015-4 Rectangular Box

Board of Appeal

- Rectangular shape
- No number '10'

Result

- Contested decision **confirmed**
- CTM applied for **rejected**



R0494/2015-1 AEROPLANE AND A GLOBE

CTM applied for



- Cl. 16, 39

R0494/2015-1 AEROPLANE AND A GLOBE

Board of Appeal

- Clear reference to travelling by plane
- Representation of grid lines are not unusual


Result

- Contested decision **confirmed**
- CTM applied for **rejected**



R0694/2015-5 4 IMAGES

CTM applied for

- 
- Cl. 9, 42, 45
 - Software and computer related

R0694/2015-5 4 IMAGES

Board of Appeal

• ●●●○ Vodafone ES 16:54 ↗ 84 % 🔋



each symbol has a meaning and is non-distinctive. combination remains non-distinctive. #ctma #rejected



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Twittern

Result

- Contested decision **confirmed**
- CTM applied for **rejected**



R0314/2015-1 COW COW

CTM applied for

- **COW COW**
- Cl. 29, 30, 32
 - All related to milk

R0314/2015-1 COW COW

Board of Appeal

- 'cow' is descriptive - all products originate from cows
- Doubling does not change perception of consumer

Result

- Contested decision **confirmed**
- CTM applied for **rejected**

Editor's note: The speaker makes a reference to one of the Convergence Programs - CP3 - [Learn more from the following video](#)



R 1710/2015-4 DR. SUWELACK COFFEE

CTM applied for'

-  **Dr. Suwelack Coffee**
- Cl. 30 and 35
 - Beverages, pastries, hamburgers, pizza, sauces etc.
 - Rejected as 'deceptive' for
 - tea, artificial coffee and other beverages

R 1710/2015-4 DR. SUWELACK COFFEE

Board of Appeal

- Sign does not consist of 'coffee' alone
- Common to use in a trade mark the main field of activity of a company

Result

- Contested decision **annulled**
- CTM applied for **may proceed to publication**



R2931/2014-5 Economy Car Rentals

CTM applied for



- Cl. 39

R2931/2014-5 Economy Car Rentals

Board of Appeal

- sign must be assessed in its entirety
- verbal elements have no capacity to distinguish the services per se
- •Animated money box on wheels

Result

- Appeal allowed
- CTM remains on register



R1083/2015-5 ECONOMY CAR RENTALS

CTM applied for

- **ECONOMY CAR RENTALS**
- Cl. 39
 - Car rental servcies

R1083/2015-5 ECONOMY CAR RENTALS

Board of Appeal

- Sign is descriptive
- Sign used  **ECONOMY CAR RENTALS**TM
 - no distinctive character acquired through use

Result

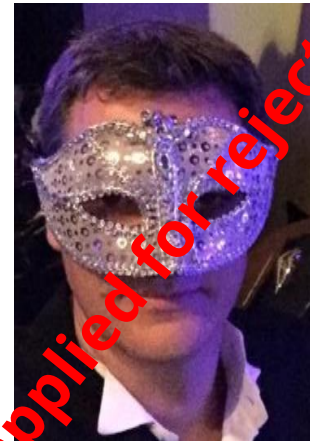
- Appeal **dismissed**
- CTM applied for **rejected**



R1145/2015-1 Selfies

CTM applied for

- **Selfies**
- Cl. 9, 16, 35, 38, 41, 42



CTM applied for rejected


PROOF OF USE

Just another figure

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R 2897/2014-5

CTM applied for

- 
- Cl. 10, 18, 22, 25, 28, 29, 30,32, 33, 34, 35, 39
 - Incl. Alcoholic beverages (except beer)

Earlier individual Trade Mark (PT, IR)

- **VINHO VERDE**
- Cl. 33
 - Ordinary wines from the respective demarcated region

R 2897/2014-5



Boards of Appeal

Proof of use

- Use only as a designation of origin but not as a trade mark

Result

- Appeal **dismissed**
- CTM applied for **may proceed to registration**

RELATIVE GROUNDS OF REFUSAL

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R2860/2014-1 ORACOMEGA/OMEGA

CTM applied for

- **ORACOMEGA**
- **Cl. 5**
 - Food and dietary supplements; nutritional preparations and substances; herbal and marine substances, enzymes, plant and fish oils, ...

Earlier trade mark ^(EU)

- **OMEGA**
- **Cl. 29, 30, 35**
 - Meat, fish, poultry and game; ...;preserved, dried and cooked fruits and vegetables; ... coffee, tea, ...; non-alcoholic drinks fruit drinks and fruit juices.

R2860/2014-1 ORACOMEGA/OMEGA

Board of Appeal

- Cl. 5 does not include 'meal replacements, dietetic food and beverages not for medical or veterinary use'
- Cl. 5 supports a specific diet – particular health benefits
- Goods are neither in competition nor complementary

Result

- Appeal **dismissed**
- CTM applied for **may proceed to registration**

R2208/2014-2 Monssalus/Lanjarón

CTM applied for



- Cl. 32

Earlier trade mark ^(ES)



- Cl. 32

R2208/2014-2 Monssalus/Lanjarón



Board of Appeal

- Visually similar to the extent that they both have –different – representations of snowy mountains
- Conceptually dissimilar, since verbal elements have dissimilar connotations

Result

- Appeal **dismissed**
- CTM applied for **may proceed to registration**



R1907/2014-2 CHINA FRIENDLY/CHINESE FRIENDLY

CTM applied for



- Cl. 35, 38, 42, 43

Earlier trade mark ^(EU)



- Cl. 35, 41, 43

R1907/2014-2 CHINA FRIENDLY/CHINESE FRIENDLY

友好中国
chinese friendly

Board of Appeal

- verbal elements are more important
 - Visually similar to a low degree
- Aurally and conceptually highly similar


Result

- Appeal **dismissed**
- CTM applied for **rejected**



R3294/2014-1 IMPERIAL/ИМПЕРИЯ

CTM applied for

-  **IMPERIAL Claims Services**
Your reliable partner
- Cl. 35, 36, 45

Earlier trade mark _(EU)

- **ИМПЕРИЯ**
- C. 35, 36

R3294/2014-1 IMPERIAL/ИМПЕРИЯ

IMPERIAL Claims Services
Your reliable partner

Board of Appeal

- Visually dissimilar
- Aurally, dominant elements are almost identical for or Bulgarian consumer
- Conceptually similar

Result

- Appeal **dismissed**
- CTM applied for **rejected**

R2775/2014-1 Raquel/Marlboro

Registered CTM



- Cl. 34

Earlier trade mark (IR-EU, et al)

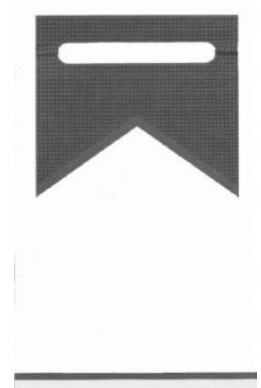


- Cl. 34

R2775/2014-1 Raquel/Marlboro

Board of Appeal

- Dominant verbal elements are dissimilar
 - Signs are dissimilar
- No evidence concerning reputation
 - Would only be helpful with respect to Article 8(5) CTMR



Result

- Appeal **dismissed**
- CTM **remains in register**



Just another figure

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Just another figure

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**The countdown runs:
In 181 hours we will be ...**



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Thank You for your Attention

CONTACT :

Christoph Bartos

Member of the Board of Appeal

(+ 34) 965 139 743

christoph.bartos@euipo.europa.eu

mediator-bartos@euipo.europa.eu



www.euipo.europa.eu



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Thank you