



Track on Case Law:
Judgments of the GC and decisions of the EUIPO BoA
2021 Q3

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PROGRAMME

90'
Presentation

- 1) Procedural issues
- 2) Absolute grounds
- 3) Relative grounds

30'
Questions and answers

1 Procedural issues

Earlier well known mark. Art. 8(2) (c) EUTMR – Art. 6 bis PC

Case reference :T-197/20

EUTM applied for



Cl. 9
Cl. 16
Cl. 41



TM registered

Prior rights



Musical group - Cl. 41



Opposition rejected

Art. 8(2) (c) EUTMR – Art. 6 bis PC

T-197/20

- ❑ Well-known character of prior right:
 - ❑ a point of law **necessary** to ensure the correct application of the EUTMR;
 - ❑ BoA **obliged to examine** the evidence proving well-known character **of its own motion** (§ 61).

2 Absolute grounds

Lack of distinctiveness (Article 7(1)(b) EUTMR)

Case reference : T-488/20

EUTM



Shape of an oblong,
tapered and cylindrical
lipstick

Class 3: lipsticks



Contested decision annulled



TM registered

Art. 7 (1) (b) EUTMR: Shape of a lipstick

T-488/20

- ❑ A sector with a **wide variety** of product shapes does not mean that any new shape will necessarily be perceived as one of them (§ 50);
- ❑ **Uncommon shape** for a lipstick:
 - It **differs from any other** shape existing on the market;
 - it **cannot be placed upright** so the uncommon visual aspect of the shape is reinforced (§ 56)



Invalidity under Article 59(1)(a) in conjunction with Article 7(1)(c) and (b) EUTMR

Case reference: R 1922/2020-5

EUTM

G7

Goods and services in
Classes 9 and 38

 **EUTM remains registered**

 **Decision annulled
Cancellation rejected**

G7

R 1922/2020-5

- ⑩ Registered EUTM enjoys **presumption of validity**
- ⑩ **Burden of proof** in invalidity proceedings lies with the person filing the application for declaration of invalidity
- ⑩ BoA cannot be called upon to carry out afresh the examination
- ⑩ This does not, however, preclude the BoA, in particular as regards the matters put forward by the party challenging the validity of the contested mark, **to take into account well-known facts**

G7

R 1922/2020-5

- ⑩ No convincing basis for asserting that, **at the filing date of the contested EUTM**, the sign ‘G7’ would have been perceived by the relevant public as the abbreviation of ‘7th generation’ or ‘Generation 7’
- ⑩ **Not devoid of intrinsic distinctive character** for the goods and services in question at the relevant date
- ⑩ Invalidity applicant has not proven also that, at the relevant date, the sign ‘G7’ could be classified as purely descriptive within the meaning of Article 7(1)(c) EUTMR

Collective mark - misleading character - Article 74 and 76(2) EUTMR

Case reference: R 777/2021-4

EUTM



Schleswig-Holstein
Der echte Norden

Goods and services in
Classes 1 to 45



EUTM allowed



Decision annulled

Schleswig-Holstein Der echte Norden (fig.)



Schleswig-Holstein
Der echte Norden

R 777/2021-4

- ⑩ Requirements for a collective mark filed by a legal person governed by public law
- ⑩ Contrary to the contested decision **such an applicant does not have to have 'members' in the strict sense to apply for a collective mark**
- ⑩ Consistency with previous decisions
- ⑩ 22/11/2011, R 828/2011-1, REACH
- ⑩ 10/05/2012, R 1007/2011-2, Représentation d'un drapeau avec des étoiles

Bad faith – Article 59(1)(b) EUTMR

Case reference: R 1125/2020-4

EUTM

MONSOON

Goods and services in
Classes 12, 28 and 36



EUTM declared invalid

MONSOON

R 1125/2020-4

- ⑩ EUTM proprietor's **filing strategy is built on a legally abusive model** considered by the GC in its judgment of 7 July 2016, T-82/14, Luceo
- ⑩ Bad faith exists inter alia where applications for trade marks are diverted from their initial purpose and filed speculatively
- ⑩ EUTM proprietor's conduct is in **breach of the 6-month priority period** pursuant to Article 34(1) EUTMR and the **5-year grace period** of use pursuant to Article 58(1)(a) EUTMR
- ⑩ No breach of the right to be heard

3 Relative grounds

Likelihood of confusion. Article 8(1) (b) EUTMR

Case reference :T-531/20

EUTM applied for



EROLF

Cl. 1, 4



TM registered

Prior right

WOLF

Cl. 1, 3, 4



Opposition rejected

Art. 8 (1) (b) EUTMR: conceptual comparison

T-531/20

- ⑩ For part of the relevant public (in particular EN speaking):
‘ROLF’ will be perceived as a male name, ‘WOLF’ will be associated with the animal.
- ⑩ Signs are not conceptually similar (§ 65).
 - ⑩ Fact that the two names are of Germanic origin does not, in itself, lead to the conclusion that there is a conceptual similarity - even taking into account the etymology of ‘ROLF’ (combination of ‘hrod’ (renown) and ‘wulf’ (wolf) (§ 66).
 - ⑩ Lack of conceptual similarity considered in the overall assessment of LOC

Likelihood of confusion. Article 8(1) (b) EUTMR

Case reference: T-23/20

EUTM applied for

the
DoubleF

Cl. 18 and 35

✗ Application rejected

Prior rights

**THE
DOUBLE**

Cl. 18

✓ Opposition upheld

Art. 8 (1) (b) EUTMR: conceptual comparison

T-23/20

- ⑩ the conceptual analysis of the earlier mark must be limited to the mark as such and cannot be derived from the analysis of the evidence of use (§ 110).
- ⑩ A sign is composed of words in common use does not automatically implies that the mark in question has a weak distinctive character (§ 122).

Conflict with PDO – Article 8(6) in conjunction with Article 13(1)(b) of Regulation (EU) No 1151/12 on quality schemes for agricultural products and foodstuffs

Case reference: R 879/2020-5

EUTM applied for



Goods in Classes
29 and 31



**Application partially
rejected**

Prior right

Pemento de Herbón

Peppers of the species *Capsicum annuum*, L, originating from local ecotypes of the variety 'Padrón'



**Decision annulled
Opposition allowed**

Padron AUTÉNTICO (fig.) / PDO Pemento de Herbón

R 879/2020-5

- ⑩ ‘evocation’ within the meaning of Regulation (EU) No 1151/2012
 - ⑩ covers a case in which the term used to designate a product incorporates part of a PDO
- ⑩ Contested sign will evoke the PDO ‘Pemento de Herbón’ for part of the Spanish-speaking consumers in the EU
 - ⑩ This connotation may encompass the geographical origin of the peppers in question, namely ‘Padrón’, a municipality in the province of A Coruña

Earlier non-registered mark – Article 8(4) EUTMR

Case reference: R 461/2019-5

EUTM applied for

Pi

Goods and services in
Classes 9, 41 and 42

Earlier mark

Pi supply

Goods and services in
Classes 9, 41 and 42



EUTM registered



**Decision annulled
Opposition rejected**

Pi / Pi supply

R 461/2019-5

- ⑩ 'Brexit' consequences
- ⑩ Lack of valid basis for the opposition at the moment when the decision on appeal is taken
- ⑩ Cases in which decision was rendered within the transition period are distinct, thus judgments of the GC in T-598/18, BROWNIE / BROWNIE, Brownie (series mark) and T-421/18, MUSIKISS / KISS et al. are inapplicable
- ⑩ Moreover, no demonstrated goodwill under the law of 'passing off' and no use shown in the course of trade of more than merely local significance



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CHAMPANILLO

C-783/19

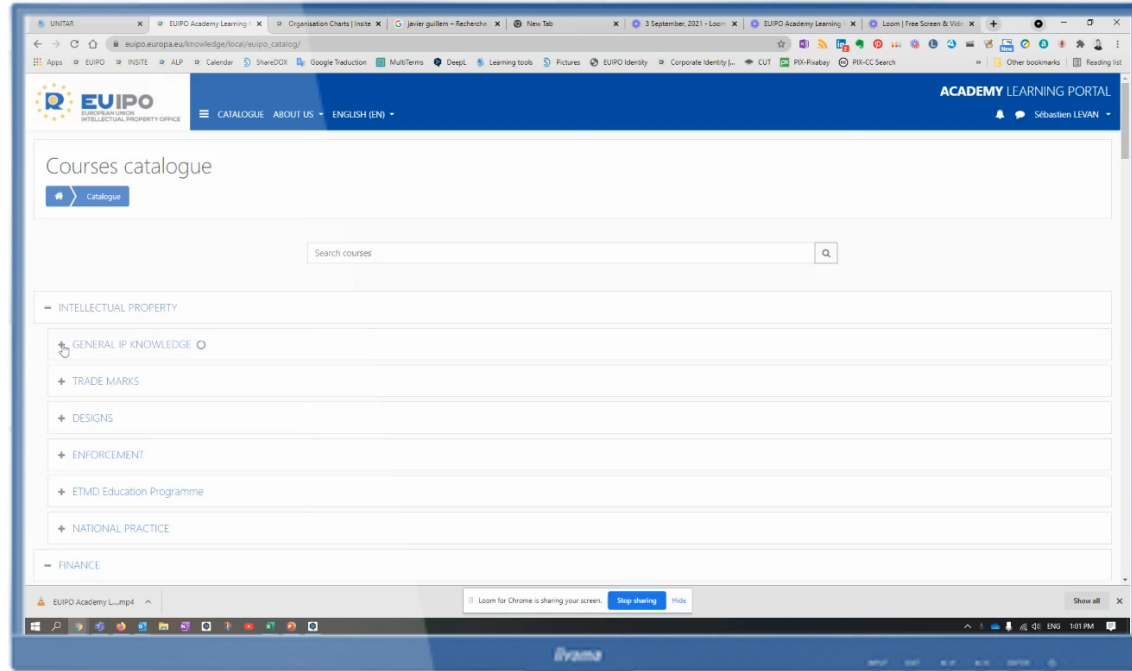
- the scope of a PDO protection extends not only to goods but also to services
- The notion of 'evocation' is not limited to comparable or similar products
- The concept of evocation is not subjected to an act of unfair competition



Champagne
PDO-FR-
A1359



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