



**Track on Case Law:
GC/CJ judgments and EUIPO BoA decisions
2022 Q2**

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21/06/2022

Speakers

3 speakers from EUIPO



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Programme

90'
Presentation

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

30'
Questions and answers

1

Procedural issues

Suspension of proceedings - Art. 71 (1) (b) EUTMDR

04/05/2022, T-619/21, TAXMARC / TAXMEN (fig.) , EU:T:2022:270

EUTM	Prior right (EUTM)
<p data-bbox="426 583 687 631">TAXMARC</p> <p data-bbox="639 746 904 773">Classes 9, 35 and 42</p>	 <p data-bbox="1495 746 1760 773">Classes 9, 35 and 42</p>



BoA annulled

Suspension of proceedings - Art. 71 (1) (b) EUTMDR

T-619/21, TAXMARC / TAXMEN (fig.)

- BoA could not reject the request for a suspension of proceedings merely because the cancellation action against the ER on which the opposition was based had been brought **after the filing of the appeal** (T-556/12, KAISERHOFF § 42) (§ 29)
- BoA has to carry out a *prima facie* assessment of the likelihood of success of the application for a **declaration of invalidity** and
- verify if that application could have resulted in a decision that would have had **an impact on the opposition** (not excluded here) (§ 32)

Mandatory representation – Art. 119(2) EUTMR

[29/04/2022, R 1159/2021-5, G-ACTIV \(fig.\) / Activ](#)

International registration designating EU	Earlier mark
<p data-bbox="394 554 699 620">G-ACTIV</p> <p data-bbox="720 751 950 777">Goods in Class 19</p>	<p data-bbox="1340 560 1528 620">ACTIV</p> <p data-bbox="1591 751 1821 777">Goods in Class 19</p>

× Appeal inadmissible

Mandatory representation – Art. 119(2) EUTMR

29/04/2022, R 1159/2021-5, G-ACTIV (fig.) / Activ

- ‘Brexit’ consequences
- Notice of appeal and the statement of grounds filed and signed by the opponent’s **employee** – infringement of the mandatory representation requirement pursuant to Article 119(2) EUTMR
- Inadmissibility of the appeal **cannot be ‘remedied’** by claiming that the representative had prepared the documents, that the signature of employee was a clerical oversight and that the representative continued to represent the opponent in the appeal proceedings

2

Absolute grounds

Invalidity under Art. 59(1)(a) in conjunction with Art. 7(1)(b) EUTMR

04/05/2022, T-117/21, cross on the side of a sports shoe (fig.), EU:T:2022:271

EUTM



Cl. 25 – *Sports Footwear*



EUTM remains registered

Invalidity under Art. 59(1)(a) in conjunction with Art. 7(1)(b) EUTMR

T-117/21, Cross on the side of a sport shoe

- ❑ A **simple** and **banal design** is unlikely to acquire distinctive character simply because it is **placed on the side of the shoe**, since many manufacturers of sports shoes use relatively simple patterns on the side of the shoe (§ 59)
- ❑ Cannot be said that the average consumer has learned to establish an **automatic link** between the sign featuring on the side of a sports shoe and a particular manufacturer (§ 60)
- ❑ However, in invalidity proceedings it is for the invalidity applicant to invoke the specific facts which call the validity of the mark into question (§ 62)

Invalidity under Art. 59(1)(a) in conjunction with Art. 7(1)(b) EUTMR

T-117/21, Cross on the side of a sport shoe

- ❑ The owner showed existence of **numerous** past and present TM **registrations** similar to the contested mark (§ 68)
- ❑ Conclusion can be made from the **revocation** Case T-68/16 (**implicit recognition of distinctiveness** at §73-75) (§ 69)
- ❑ Case-law on ‘**significant departure**’ is not relevant – the contested mark takes the form of a **design** intended to be placed on part of the designated goods and not the form of a **two-dimensional representation** of a shoe (§ 70)

Position mark – Art. 7(1)(a) and Art. 7(1)(b) EUTMR

08/03/2022, R 57/2021-2, POSITION OF A COMBINATION OF PRESENTATIONAL FEATURES

EUTM application



Class 7 – Agricultural, gardening and forestry machines and apparatus;
robotic mechanisms used in agriculture;
Class 12 – Tractors for agricultural purposes



Application rejected

Position mark – Art. 7(1)(a) and Art. 7(1)(b) EUTMR

08/03/2022, R 57/2021-2, POSITION OF A COMBINATION
OF PRESENTATIONAL FEATURES



- Clarity and precision** requirement
- Description** must accord with the representation, not extend its scope
- Article 7(1)(a) EUTMR applies to those goods on which the **positioning of the mark is unclear**
- Well-known fact** that the colours ‘red’ and yellow’ are frequently used for safety purposes ensuring the visibility of the goods concerned on all sort of equipment in various fields, including in the agricultural field
- Lack of distinctive character** under Art. 7(1)(b) EUTMR

3

Relative grounds

Art. 8 (1) (b) EUTMR – Likelihood of confusion

04/05/2022, T-298/21, ALEGRA DE BERONIA / ALEGRO, EU:T:2022:275

EUTM	Earlier ES mark
ALEGRA DE BERONIA Wines (Cl. 33)	ALEGRO Wines from Rioja (Cl. 33)



EUTM allowed

Likelihood of confusion - Art. 8 (1) (b) EUTMR

T-298/21, ALEGRA DE BERONIA / ALEGRO

- The fact that the element which differentiates the word marks
 - contains **more letters** and **syllables** than the common element
 - is not secondary

can **reduce** the degree of **visual** and **phonetic similarity** (T-250/15 CLAN MACGREGOR / CLAN § 63) (§ 37)

- Earlier mark not fully **included** in the EUTM (§ 39)

Likelihood of confusion - Art. 8 (1) (b) EUTMR

T-298/21, ALEGRA DE BERONIA / ALEGRO

- Average consumers will not systematically ignore the second part of word mark and memorise only the first part, especially in the alcoholic beverages sector, where consumers are accustomed to products designated by several word elements (§ 47)
- Rule that the first part of the signs is more important is offset by other factors (see § 49)
- The signs have only **low** degree of **visual**, **aural** and **conceptual** similarity (§ 75).

Likelihood of confusion – Art. 8(1)(b) EUTMR – Similarity of goods

13/04/2022, R 964/2020-G, ZORAYA / VIÑA ZORAYA

EUTM application

ZORAYA

Class 33 – Non-alcoholic beverages; flavoured carbonated beverages; waters; vitamin enriched sparkling water [beverages].

Earlier mark

VIÑA ZORAYA

Class 33 – Wines, spirits and liqueurs.



EUTM application partially allowed

Likelihood of confusion – Art. 8(1)(b) EUTMR – Similarity of goods

13/04/2022, R 964/2020-G, ZORAYA / VIÑA ZORAYA

- Similarity between non-alcoholic and alcoholic beverages
- Market practices** and the consumer's perception of **common commercial origin** of the goods concerned **may change** over time, so that the **result of the comparison of goods and services may also change**
- Shift of drinks industry to so-called '**no or low-alcohol**' ('**Nolo**') drinks
- Market reality of **non-alcoholic versions of alcoholic beverages** supports the finding of at least low degree of similarity between the general category of 'non-alcoholic beverages' and 'wine, spirits and liqueurs'

Conflict with PDO – Art. 8(6) EUTMR – Reputation – Art. 8(5) EUTMR

[22/04/2022, R 981/2021-1, CHENINE Brut PREMIUM CAVA BOTTLE \(3D\)/Council REGULADOR CAVA \(fig.\) et al.](#)

EUTM application



Class 33 – Wine produced in accordance with the specifications of the protected designation of origin cava.

✓ Application allowed

Earlier rights



CAVA DE PARAJE CALIFICADO

CAVA (PDO)

Class 33 – Sparkling wine (cava).

✗ Opposition rejected

Conflict with PDO – Art. 8(6) EUTMR – Reputation – Art. 8(5) EUTMR

22/04/2022, R 981/2021-1, CHENINE Brut PREMIUM CAVA BOTTLE (3D)/Council REGULADOR CAVA (fig.) et al.

- Contested sign **cannot be regarded as a ‘misleading indication’** within the meaning of Article 103(2)(c) of Regulation No 1308/2013
 - No proof that a substantial part of the relevant public is familiar with the grape variety ‘Chenin blanc’
 - No proof that the relevant public is aware of the detailed grape varieties used to produce ‘CAVA’
- No likelihood of confusion** in view of differences between the signs and low distinctive character of the word ‘CAVA’
- No proof of reputation** of the earlier marks

Proof of use - Art. 10 (3) EUTMDR

T-766/20, STONES

- Sales of beer for GBP 22 000 on average per annum (EUR 151 570 overall) - sufficient to show genuine use
- Real and genuine uses can be in volumes which are relatively modest when compared to the volume of the sector of the relevant product as a whole at EU level (e.g. craft or family run breweries) (§67)
- Use of the mark in the UK during the period from 21 August 2013 to 20 August 2018 constitutes use in the EU, as required by Art. 58(1)(a) EUTMR

Revocation – Art. 58(1)(a) – Proper reasons for non-use

[19/05/2022, R 1815/2020-4, Antico caffe' tre marie dal 1912](#)

EUTM

ANTICO CAFFE' TRE MARIE DAL 1912

Class 30 – Coffee;
Class 43 - Providing of food and drink;
temporary accommodation.

EUTM partially remains registered

Revocation – Art. 58(1)(a) – Proper reasons for non-use

19/05/2022, R 1815/2020-4, Antico caffè' tre marie dal 1912

- ❑ Earthquake of 6 April 2009 devastated the town of L'Aquila and the historical building in which the restaurant and café 'Tre Marie' was based
- ❑ No dispute that the EUTM proprietor has **not made genuine use** of the contested EUTM, but whether there existed **proper reasons for non-use**
- ❑ The concept of 'proper reasons' refers to **circumstances unconnected with the trade mark proprietor** rather than to circumstances associated with its commercial difficulties
- ❑ Thus, **proper reasons existed** for the non-use of the EUTM with regard to the services in Class 43, but not for the goods in Class 30

3

Relative grounds - Poll

POLL - Art. 8 (1) (b) EUTMR – Likelihood of confusion

T-298/21, ALEGRA DE BERONIA / ALEGRO

- The rule that the public pays more attention to the first part of the signs when assessing their visual and phonetic similarity:
 1. is a principle of outmost importance, although it has exceptions
 2. is not decisive in presence of other factors such as i) the second part of the signs is longer and distinctive ii) consumers are used to see trade marks with several verbal elements in the specific market sector concerned
 3. is increasingly put into question by the Court



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Law

In this section you will find the law relating to the European Union trade mark (EUTM) and the registered Community design (RCD), as well as to key international agreements.

You will also find our Executive Director's decisions and communications, along with the rules concerning the Boards of Appeal.

In this section



Directives and regulations – trade marks

EU trade mark legal texts



Directives and regulations – designs

Community design legal texts



Key agreements and laws for trade marks and designs

International treaties



EUIPO's Executive Director

Communications and decisions of the Executive Director

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CANCELLATION



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TAXMARC

4/05/22
PwC

Belastingadviseurs/EUIPO -
Haufe-Lexware

T-619/21

ECLI:EU:T:2022:270

Search 



19/01/2022

Deichmann/EUIPO
O – Munich

T-117/21

ECLI:EU:T:2022:271

Search 

**ALEGRA
DE
BERONIA**

4/05/2022

Alegra de
Beronia/ Alegro

T 298/21

ECLI:EU:T:2022:275

Search 

STONES

1/12/2021
PrenzMarien/
EUIPO - Molson
Coors Brewing
Company (UK)

T-766/20

ECLI:EU:T:2022:123

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22/03/2022
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COMBINATION
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R 0057/2022-2

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ZORAYA

13/04/2022

Zoraya /
Viña zoraya
R 0964/2022-
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22/04/2022
CHENINE Brut
PREMIUM
CAVA BOTTLE
(3D) /
CONSEJO
REGULADOR
CAVA (fig.) et
al.

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ANTICO
CAFFE'
TRE
MARIE

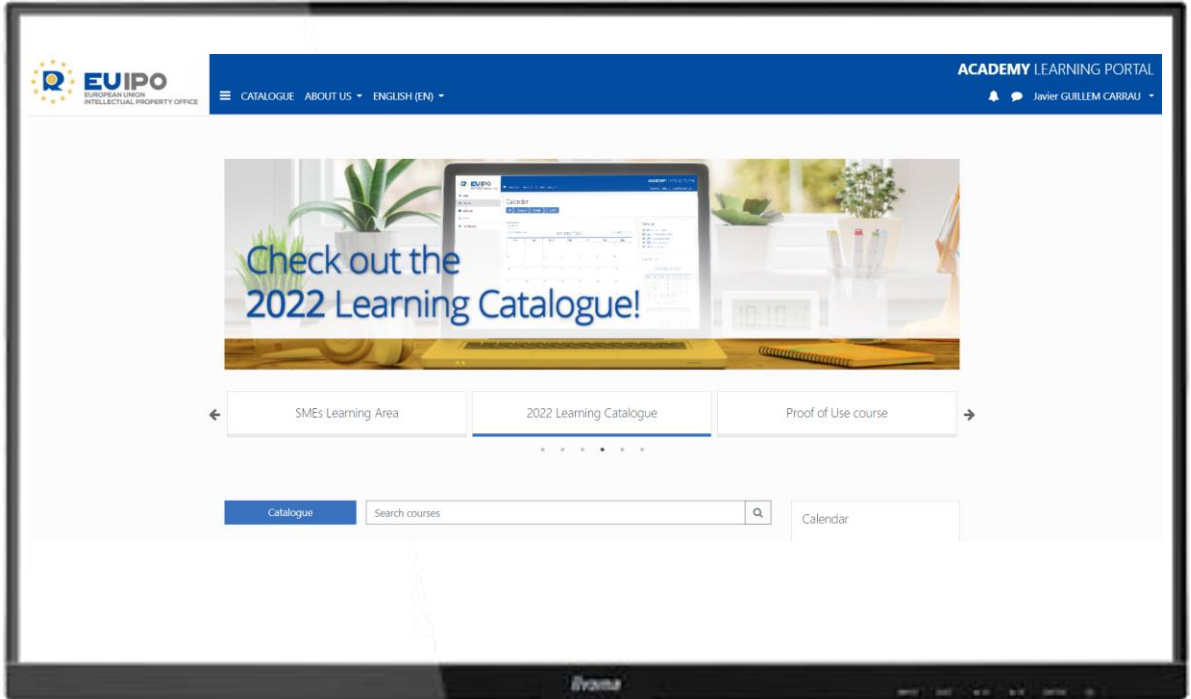
DAL 1912
19/05/2022

Antico caffe'
tre marie dal
1912

R 1815/2020-4

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