



**Track on Case Law:  
GC/CJ judgments and EUIPO BoA decisions  
2022 Q3-Q4**

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## Programme

**90'**  
**Presentation**

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

**30'**  
**Questions and answers**



# Procedural issues

## Art. 63 (2) and Art. 95 (1) EUTMR

19/10/2022, T-486/20, SWISSE, EU:T:2022:642

EUTM



**Class 5:** *Vitamins, vitamin preparations, mineral supplements and nutritive elements including vitamins*  
...



BoA annulled

## Art. 63 (2) and Art. 95 (1) EUTMR

### T-486/20, SWISSE

- Article 7(1)(b) only selected in the online form. **No arguments or evidence** provided in respect of this specific ground (§ 50)
- EUIPO nevertheless relied on that ground to invalidate the mark (**infringement** of Art. 63(2) EUTMR) (§ 68)
- In invalidity proceedings, EUIPO is to **limit** its examination to the grounds and arguments submitted by the parties (Art. 95(1) EUTMR, 2<sup>nd</sup> sentence) (§ 75-76)

## Art. 63 (2) and Art. 95 (1) EUTMR

### T-486/20, SWISSE

- Article 95(1) is a statement of the **duty of diligence**, the Office has to examine **carefully** and **impartially** all the relevant factual and legal aspects of the case (§ 77)
- by declaring the EUTM invalid on the basis of its lack of distinctive character, BoA went **beyond** the grounds and arguments put forward by the CA (§ 79)
- BoA has to adopt a **position of impartiality** in the context of invalidity proceedings based on AG (§ 81)

## Decision on merits in revocation proceedings where the contested EUTM expired

[04/08/2022, R 2227/2021-1, Marc by Marc Jacobs \(fig.\)](#)

EUTM



Goods in Classes  
9, 14, 18 and 25

**X** Appeal proceedings closed without a decision on the merits

## Decision on merits in revocation proceedings where the contested EUTM expired

04/08/2022, R 2227/2021-1, Marc by Marc Jacobs (fig.)

- ❑ General principle – **closure of proceedings** pursuant to Article 109(4) EUTMR
- ❑ Article 17(5) EUTMDR, allowing to obtain a **decision on the merits if there is a legitimate interest demonstrated**, is an **exception and the provision has to be interpreted narrowly**
- ❑ **Legitimate interest** which must be **real, direct and present**
  - ❑ e.g. ongoing litigation between the parties concerning the period before the expiry of the trade mark



**2**

## **Absolute grounds**

## Art. 7 (1)(c) EUTMR

14/09/2022, T-498/21, Black Irish, EU:T:2022:543

**EUTM**

**BLACK IRISH**

Goods in Classes 30, 32  
and 33



**EUTM rejected**

## Art. 7(1)(c) EUTMR

### T-498/21, Black Irish

- ❑ Relevant public may perceive the sign as indicating that the beverages at issue are **very dark** in colour and have been produced in **Ireland** (§ 33, 34 and 37)
- ❑ The colour black may reasonably be perceived as a **significant characteristic** of the goods (§ 42, T-375/17 Blue § 31-32). Many examples of very dark-coloured or black beverages
- ❑ Consistent with T-133/19 OFF-WHITE (§ 43)

## Art. 7(1)(c) EUTMR

### T-498/21, Black Irish

- ❑ 'black' will be understood as **information** regarding the chocolate content, as an indication of the colour of the coffee, as a type of tea (black tea) or even as an indication of the very dark colour of the alcoholic beverages
- ❑ refers to a characteristic which is **objective** and **inherent** to the nature of the goods at issue and **intrinsic** and **permanent** with regard to those goods (§ 47)
- ❑ In **combination** with another descriptive adjective, more likely to be perceived as a **descriptive** indication of the colour of the relevant goods (§ 48)

## Name of a colour as a characteristic of a product – Art. 7(1)(c) and (b) EUTMR

[06/10/2022, R 450/2022-5, GRAU](#)

EUTM application

**GRAU**

Class 9 – light dimmers, cables, electric conductor tracks, electric plugs, electric switches, electric dimmers, electric socket outlets, sensors, terminals (electricity), optical reflectors;  
Class 11 – lighting apparatus.

**✗ Application rejected**

## Name of a colour as a characteristic of a product – Art. 7(1)(c) and (b)EUTMR

06/10/2022, R 450/2022-5, GRAU

- A characteristic, within the meaning of Art. 7(1)(c) EUTMR, must be **objective** and **inherent to the nature of that product or service** and **intrinsic and permanent** with regard to it
- It cannot be ruled out a priori that the **colour of a product may be one of the characteristics referred to in Art. 7(1)(c) EUTMR** (T-133/19, Off-White (fig.), § 37, 43; T-498/21, Black Irish, § 43)
- ‘GRAU’ concerns a **physical characteristic** which is **crucial for the good’s external appearance** (e.g. lighting apparatus made from metal or concrete)
- Lack of distinctive character** under Art. 7(1)(b) EUTMR

**Bad faith – Art. 59(1)(b) EUTMR, Non-distinctive/Descriptive – Art. 7(1)(b),(c) EUTMR**

**25/10/2022, R 1246/2021-5, DEVICE OF A BANKSY'S MONKEY (fig.)**

**EUTM**



Goods and services  
in Classes 9, 16, 25,  
28 and 41

**Invalidity application rejected**

**EUTM remains registered**

**Bad faith – Art. 59(1)(b) EUTMR, Non-distinctive/Descriptive – Art. 7(1)(b),(c) EUTMR**

**25/10/2022, R 1246/2021-5, DEVICE OF A BANKSY'S MONKEY (fig.)**



**Flower  
Thrower**

trade mark  
n°012575155



**Laugh Now**

trade mark  
n°017981629



**Girl with an  
Umbrella**

trade mark  
n°017981633



**Radar Rat**

trade mark  
n°017981636



**Love Rat**

trade mark  
n°017981624



**Bomb Hugger**

trade mark  
n°017981637



## Art. 59(1)(a) EUTMR, Non-distinctive/Descriptive – Art. 7(1)(b) and (c) EUTMR

25/10/2022, R 1246/2021-5, DEVICE OF A BANKSY'S MONKEY (fig.)

- Relation between BANKSY and the EUTM proprietor
- The sign **neither lacks distinctive character, nor it is descriptive** in the meaning of Art. 7(1)(b) and (c) EUTMR
- The fact that the contested sign is an artwork is not an obstacle for the sign in order to be also a mark indicating the origin of the goods and services at hand**
- The conclusion that the sign would be the subject matter of the goods and services does not follow automatically from the fact that the sign contains an artwork

## Bad faith – Art. 59(1)(b) EUTMR

25/10/2022, R 1246/2021-5, DEVICE OF A BANKSY'S MONKEY (fig.)

- ❑ Alleged **non-intention to use the mark**
  - The assumption that the need of staying anonymous was the reason to opt out from copyright protection and go for trade mark protection, even if it would be correct, **cannot justify a finding that the EUTM proprietor had no intention to use the contested mark**
  - Banksy's statement '**Copyright is for losers**' has **no bearing** at all for the case at hand
- ❑ Alleged **circumvention of provisions of copyright law**
  - The same **artwork can be** protected by copyright and by trade mark law

# 3 Relative grounds

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

12/10/2022, T-222/21, SHOPPY (fig.) / SHOPIFY, EU:T:2022:633

EUTM



Cl. 9, 35 and 38

Earlier mark

SHOPIFY

Cl. 9, 35, 36 and 42

✓ EUTM allowed

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

### T-222/21, Shoppy (fig.) / Shopify

- The **descriptiveness** of an element which is common to two signs **considerably reduces** the relative weight of such an element in the comparison of those signs (§ 60)
- where conceptual similarity is based on a weakly distinctive / descriptive element, it plays a **limited** role and has **less impact** on the assessment of LoC (§ 73)
- Inherent distinctiveness** of the earlier mark is **low** for EN speaking public and ‘slightly higher than minimum level’ for the rest (§ 80-82)

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

### T-222/21, Shoppy (fig) / Shopify

- Enhanced distinctiveness** of the earlier mark not proven (§ 114-115), use in the UK disregarded (§ 101-102)
- the presence of the shared element ‘shop’, which is weak and non-dominant, is **not decisive** and has only a **minor impact** (§ 124)
- With regard to a weak mark, the degree of similarity between the signs should be **high** to justify a LoC - otherwise risk of excessive protection (§ 125)

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

09/11/2022, T-610/21, K K WATER (fig.) / K (fig.), EU:T:2022:700

**EUTM**



hair preparations and  
treatments ... (Cl. 3)

**Earlier mark**



shampoos and  
lotions for cosmetic  
purposes (Cl. 3)



**EUTM allowed**

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

### T-610/21, K K WATER (fig.) / K (fig.)

- ❑ The graphic and stylistic differences are **clearly visible**. Differences are easily grasped in the case of very short elements (§ 36)
- ❑ The elements ‘k water’ cannot be underestimated, they reduce phonetic similarity and render the signs conceptually **different** (§ 44 and 51)
- ❑ Finding LoC between a sign consisting of a highly stylised, single capital letter and another sign consisting of the same capital letter written in a different stylisation and combined with other word elements, would de facto amount to granting a **monopoly** over one capital letter of the alphabet for a specific range of goods (§ 68, T-521/15 §72)



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

08/09/2022, R 1759/2021-5, FRANCO NERO (fig.) / DEVICE OF TWO POLO PLAYERS (fig.)

EUTM application



Goods and services in Classes 18, 25 and 35

✓ Application allowed

Earlier mark



Goods in Classes 18 and 25

✗ Opposition rejected

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

08/09/2022, R 1759/2021-5, FRANCO NERO (fig.) / DEVICE OF TWO POLO PLAYERS (fig.)

- ❑ **Fanciful name ‘FRANCO NERO’** in the contested sign, which in addition might be associated with the eponymous Italian actor at least by a part of the relevant Italian public, **is more distinctive than the device of two polo players**
- ❑ The device of **two polo players alludes to a characteristic of the goods and services**, namely that they can be used for polo
- ❑ Although the signs are conceptually similar as far as the devices are concerned, the words ‘FRANCO NERO’ of the contested sign evoke **different associations**

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

08/09/2022, R 1759/2021-5, FRANCO NERO (fig.) / DEVICE OF TWO POLO PLAYERS (fig.)

- Enhanced distinctiveness not proven**
  - Most of the evidence refers to the brand ‘La Martina’ and not to the earlier trade mark
  - Italian Court judgment acknowledging a reputation of the ‘La Martina’ logo in Italy does not concern the polo players device alone
- The **visual aspect plays an important role** in relation to fashion goods and retail for those goods
- No likelihood of confusion**

## Revocation – Art. 58(1)(a) – Place of use of the mark

13/08/2022, T-768/20, The Standard (fig.), EU:T:2022:458

EUTM

**The Standard**

Class 43 - Hotel, restaurant, bar, cafe,  
cocktail lounge services; catering  
services (...)



BoA Annulled

## Art. 58 (1) (a) EUTMR – proof of use

### T-768/20, The Standard (fig.)

- The fact that the services at issue are provided outside the EU does not imply that the acts of use of the contested mark seeking to **promote** and to **offer for sale** such services are necessarily taking place outside that territory
- Reference to EUIPO GL: where the G/S covered by the contested mark are provided abroad, such as holiday accommodation or particular products, **advertising** alone may be sufficient to show genuine use (§ 37-39)

## Revocation – Art. 58(1)(a) – Place of use and extent of use

06/09/2022, R 1841/2021-5, OSCAR

EUTM

**OSCAR**

Class 41 - Entertainment and educational services, namely, conducting an annual award ceremony recognizing exceptional achievement in the film industry, and giving people the incentive to excel in the film industry through the awarding of prizes.



EUTM remains registered

## Revocation – Art. 58(1)(a) – Place of use and extent of use

06/09/2022, R 1841/2021-5, OSCAR

- 'Brexit' consequences** as regards the proof of use
- Although the evidence shows that the services at issue are physically conducted in the US, this is not sufficient to exclude that they can still be directed to the relevant consumers in the EU
- A distinction must be drawn between the **place where the services are provided** and the **place of use of the mark**. **Only the latter is relevant to examination of the genuine use of an EU trade mark** (T-768/20, The standard (fig.), § 34).

## Revocation – Art. 58(1)(a) – Place of use and extent of use

06/09/2022, R 1841/2021-5, OSCAR

- The evidence submitted by the EUTM proprietor shows that the ‘OSCAR’ ceremony is broadcast on television within the EU on various channels and provides indications of the commercial exploitation generated by the broadcasting of the event on those channels
- However, this does not indicate that the EUTM proprietor actually uses the contested mark to provide broadcasting services
- It is clear from the evidence that the main objective of conducting **an award ceremony such as the ‘OSCAR’ awards is entertainment** (T-478/21, Ballon d'or, § 56).





## Relative grounds - Poll

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

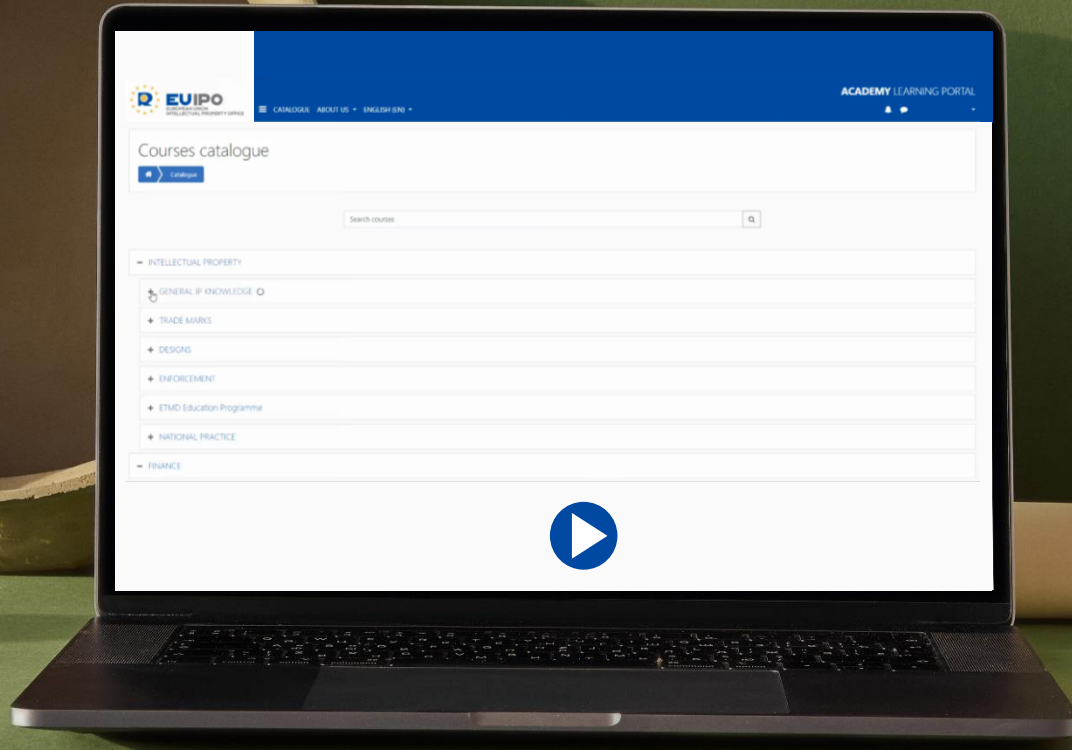
### T-222/21, Shoppy (fig.) / Shopify

- ❑ In the context of Article 8 (1) (b) EUTMR, when the marks under comparison share a weak or non distinctive element
  1. Weakness of the common element has an impact only in the global assessment of the signs
  2. The impact of such element of similarity on the global assessment of LoC is low
  3. Weakness of the common element does not play any role when assessing LoC



**Questions?**

## Keep in touch with EUIPO Academy



## Speakers

### 3 speakers from EUIPO



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