

# Overlap between RCDs and EUTMs

Gailé SAKALAITĖ  
Legal Department  
28<sup>th</sup> of February 2023

## PROGRAMME

**50'**  
**Presentation**

Overlap between EU trade marks and  
Community designs

1. The overlap between EUTMs and RCDs  
when obtaining protection
2. The overlap between EUTMs and RCDs  
when invalidating

**10'**  
**Questions and answers**

1

## The overlap between EUTMs and RCDs when obtaining protection



Is it true that EUTM and RCD protection can overlap?



# Cumulation of rights

## EUTM or RCD? Both?

Article 96(1) CDR allows for the **cumulative protection** of the same subject matter under the design and trade mark law

### EUTM 018400649

Classes:

- 3. Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; (...)
- 4. Candles; scented candles; table candles; (...)
- 8. Manicure sets; (...)
- 9. Bathroom scales; breathing apparatus for underwater swimming; (...)
- 14. Jewellery; (...)
- 16. Advertisement boards of paper or cardboard; (...)
- 30. Tea; coffee-based beverages; iced tea.



### RCD 1666421-0017

Class:

9.3. Packaging



## Where the overlap is most likely?

Article 3 CDR:

‘**design**’ means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

‘**product**’ means any industrial or handicraft item, including (...), packaging, get-up, graphic symbols and typographic typefaces, (...).’

Art. 4 EUTMR:

‘**An EU trade mark** may consist of any signs, in particular words, (...), or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, (...).’

## Shapes



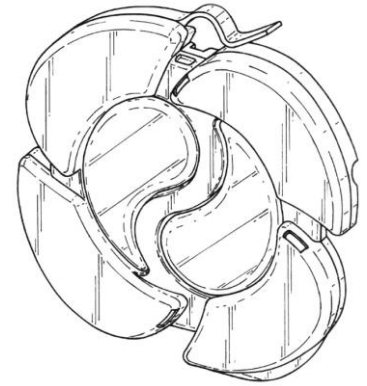
**RCD No 000 607 114**  
Class 9.1: Bottles



**EUTM No 5 221 536**  
Class 3: perfumery, make  
up and cosmetic preparations



**EUTM No 5 194 741**  
Class 3: laundry  
preparations for dry cleaners  
(...)



**RCD No 000 531 793**  
Containers  
Class 9.3

## Graphic symbols/logos

RCD 211-0001/  
EUTM 2995736



RCD 4213-0001/  
EUTM 2705770



RCD 22371-0001  
EUTM 3126265





**Subject matter of protection**  
**When does the cumulation become problematic?**

## Subject matter of protection

**EUTM** is a sign which serves to distinguish the goods and services of one undertaking from those of others.

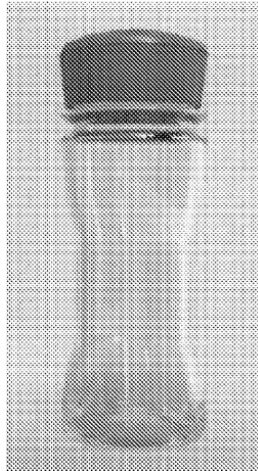
**RCD** protects the appearance of the whole or a part of a product which is new and has 'individual character'.

## Requirements for protection examined at the registration stage

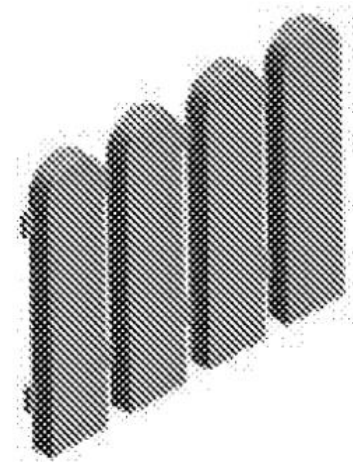
### Trade mark

Arts. 7(1)(b) and (c) EUTMR

A trade mark must be **distinctive**



**IR application 1206888**  
Class 29, inter alia, sauces.  
Rejected under 7(1)(b) EUTMR



**EUTM application 1165339**  
Class 21, inter alia, flower boxes,  
hanging baskets.  
Rejected under Art. 7(1)(b) EUTMR

## Requirements for protection examined at the registration stage

### Trade mark

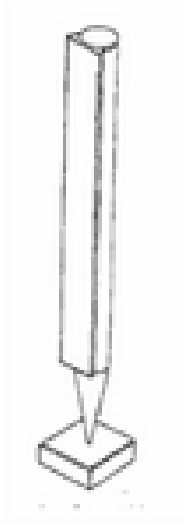
Article 7 (1) (e) EUTMR

1. The following shall not be registered:

(e) signs which consist exclusively of:

(...) the shape, or another characteristic, which results from the nature of the goods themselves;

(...) the shape, or another characteristic, which gives substantial value to the goods



#### **EUTM application 003354371**

Class 9: 'Electric and electronic apparatus and appliances for analogue, digital or optical reception, processing, reproduction, regulation or distribution of sound signals, loudspeakers; Class 20: music furniture.

Rejected under Article 7(1)(e)(iii) EUTMR

06/10/2011, T-508/08, Loudspeaker

## Requirements for protection examined at the registration stage

### Design



Article 4 CDR

A design shall be protected by a Community design to the extent that it is **new** and has **individual character**.



Article 3 CDR

A design has to be '**a design**'



Article 9 CDR

Design should not be contrary to **public policy** or **morality**

## The overlap becomes problematic because of different requirements for protection



**RCD 000 291 067: application granted**

21.03: Automatic machines for games of chance,  
Other amusement and entertainment articles



**EUTM No 4 273 439: application refused**

Class 21.03: Other amusement and entertainment  
articles, Automatic machines for games of chance

## The overlap becomes problematic because of different requirements for protection



**EUTM 015963994: application refused**  
Class 21, incl. drinking glasses, Class 30, incl. coffee,  
Class 32, incl. non-alcoholic beverages



**RCD 003850601-0025: application granted**  
Class 07.01 bowls



## The overlap becomes problematic because of different requirements for protection



**EUTM 014267652: application refused**  
Class 35: inter alia, wholesaling and retailing in the field of foodstuffs



**RCD 003023381-0002: application granted**  
Class 32: shop ornamentation and decoration





## The overlap becomes problematic because of different requirements for protection



### **EUTM 017868712: application refused**

Class 9: inter alia, software and software applications permitting users to monitor the interior and exterior of homes, retail stores, or offices for security and surveillance



### **RCD 7 706 304-0001 application granted**

Class 36: Surface patterns, Graphic designs [two-dimensional], Graphic symbols, Logos



# Procedures to obtain protection

## Procedures to obtain protection

### EUTM

Application + costs

Prior search + full examination

Acquired distinctiveness

Opposition

Registration



Class 30: 'Chocolate and chocolate products'

### RCD

Application + costs

No prior search + basic examination

No acquired distinctiveness

No opposition

Registration

## Conclusions

- EUTMs and RCDs are different IP rights with different subject matter of protection, and different procedures to obtain it.
- Cumulation remains possible if protection requirements are fulfilled
- Which IP right to choose is a strategic decision

2

## The overlap between EUTMs and RCDs when invalidating

?

Is there an overlap in the scope of protection after the registration?

Are designs 'weaker' and more likely to be invalidated when facing an earlier trade mark?

# **EUTM invalidity procedure - earlier design invoked**

## **Art. 60(2)(d) EUTMR**

**‘Different overall impression’ test a trade mark should stand**

## BoA, 03/07/2020, R 2930/2019-4, Logos

### CONTESTED EUTM

Classes 9, 16 and 41,  
inter alia, video games

Ancestors



### EARLIER INTERNATIONAL DESIGN REGISTRATION

**ANCESTORS**

Different overall impression

CD, 24/08/2022, C 51 988

## CONTESTED EUTM

Class 25: clothing; jackets [clothing]; underwear; shirts; swimsuits; footwear; headgear for wear; hosiery; gloves [clothing], in Class 25.

NovaBlast



## EARLIER UCD



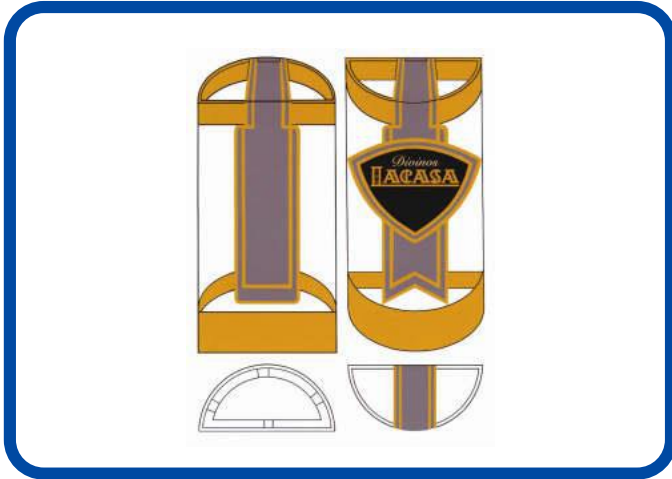
Different overall impression



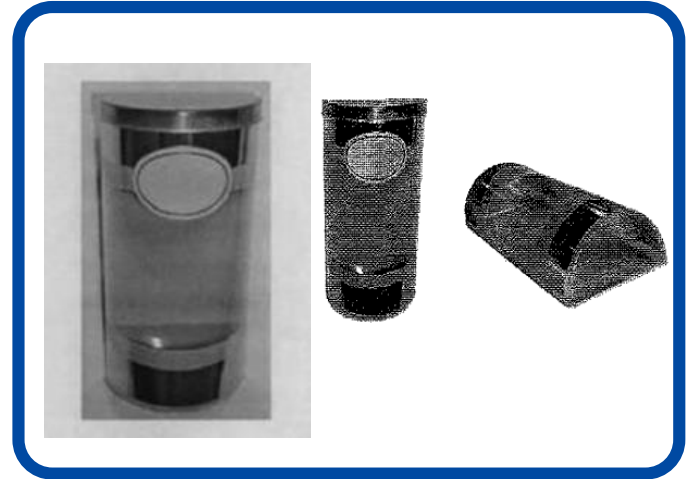
## BoA, 07/04/2014, R 579/2013-2, Divinos LACASA (3D MARK)

### CONTESTED EUTM

Class 30, inter alia, confectionery, pastries, nougat, chocolates, (...).



### EARLIER PORTUGUESE AND SPANISH INDUSTRIAL MODELS



Different overall impression

CD, 17/12/2019, 26 903 C

## CONTESTED EUTM

Class 33: Rose wines with a protected denomination of origin 'Rioja'



## EARLIER RCD

Class 09-01: Bottles

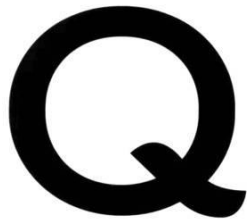


Different overall impression

**CD, 23/03/2022, C 49 046**

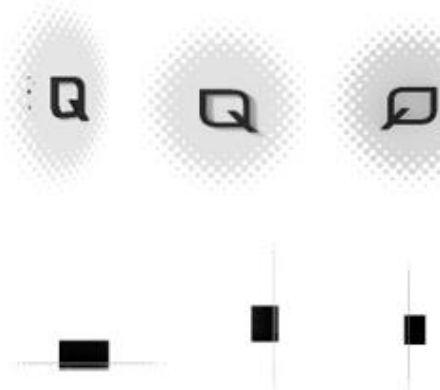
## CONTESTED EUTM

Class 3, inter alia, Aromatics [essential oils] and  
Class 34, inter alia, flavorings for electronic smoking  
devices and electronic cigarettes



## EARLIER RCD

Class 32: Shop ornamentation  
and decoration



**Different overall impression**

# RCD invalidity procedure - earlier trade mark invoked

## Art. 25(1)(e) CDR

‘Likelihood of confusion’ test a design should stand

**GC, 09/09/2015, T-278/14, DIESEL**

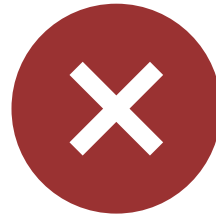
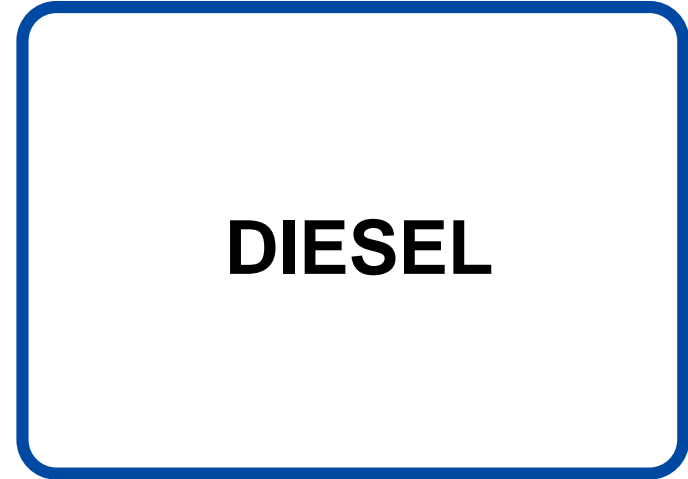
**CONTESTED RCD**

Class 02.07 Belts



**EARLIER TRADE MARK**

Class 25, incl. clothing

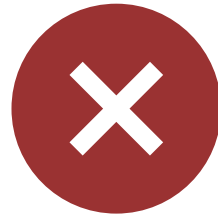


**Likelihood of confusion**

**GC, 07/02/2018, T-794/16, Ice cream cornet**

**CONTESTED RCD**

Class 09.03 Ice cream cornets



**EARLIER TRADE MARK**

Class 30: 'Cocoa, cakes, chocolates, chocolate creams, cakes with cocoa milk, chocolate cream

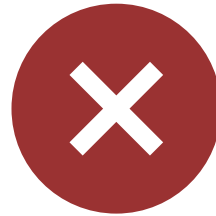
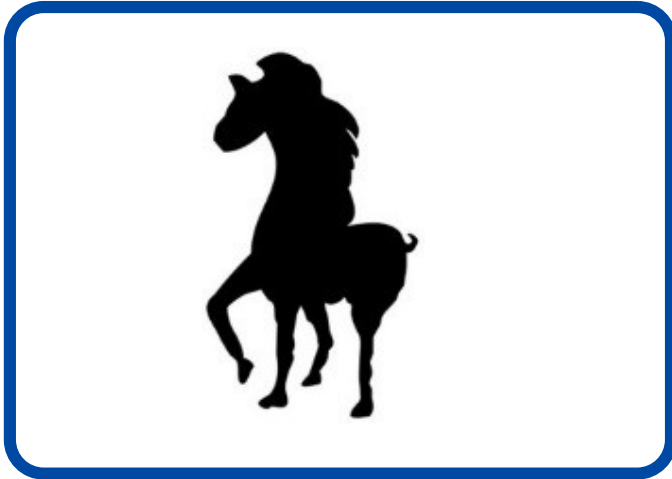


**Likelihood of confusion**

## BoA, 25/04/2013, R 34/2016-3, Ornamentation

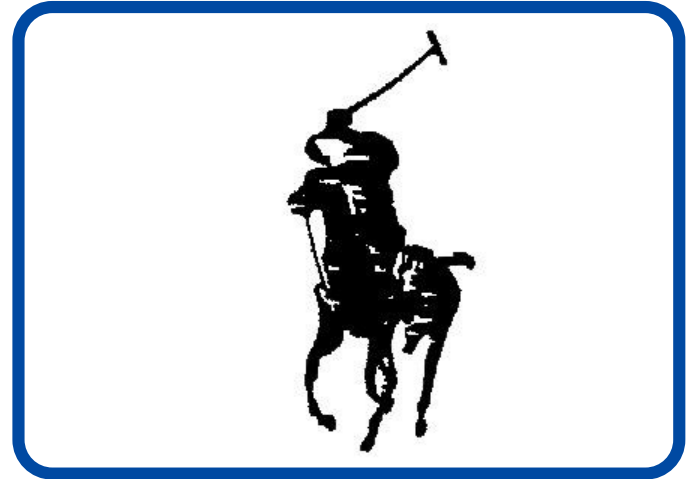
### CONTESTED RCD

Classes 32.00 Ornamentation



### EARLIER TRADE MARK

Classes 8, 16, 27, inter alia, Printed matter

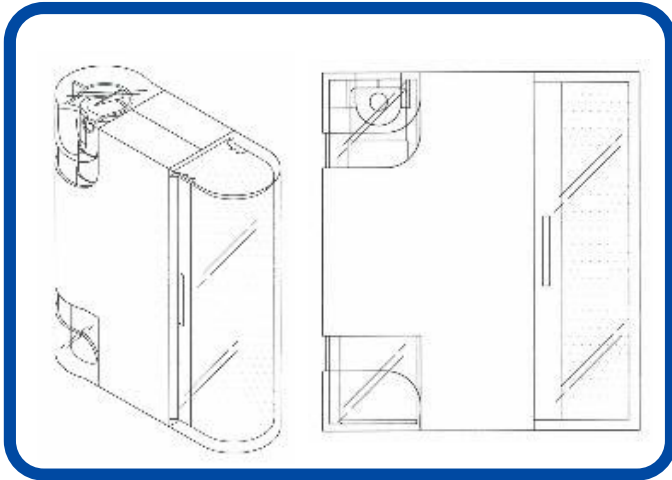


**Likelihood of confusion**

## GC, 25/04/2013, T-55/12, Cleaning devices

### CONTESTED RCD

Class 15.05 Cleaning devices



### EARLIER TRADE MARK

Class 3: inter alia, cleaning agents



**Likelihood of confusion**



**GC, 03/10/2017, T-695/15, Comfit box containers and CJ, 06/03/2019, C 693/17 P, Comfit box containers**

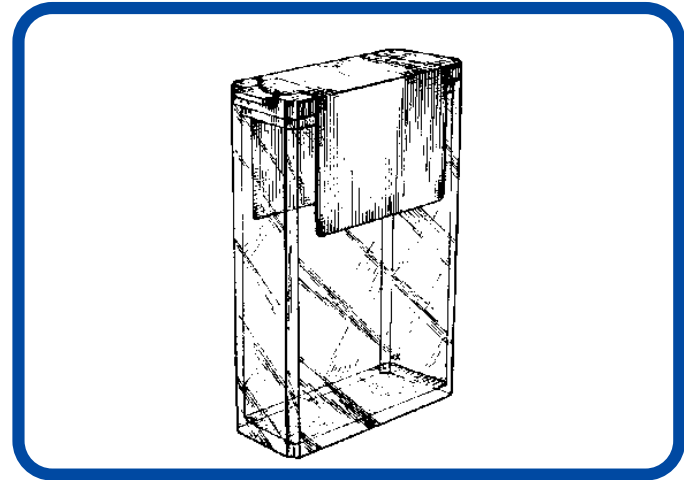
**CONTESTED RCD**

Class 09.03 Containers, Comfit boxes



**EARLIER TRADE MARK**

Class 30: Sweets



**Likelihood of confusion**

## GC, 24/07/2019, T-219/18, Motorcycles

### CONTESTED RCD

Class 12.11 Mopeds, Motorcycles



### EARLIER TRADE MARK

An unregistered three-dimensional 'de facto mark', used in Italy



**No likelihood of confusion**

## BoA, 06/06/2019, R 388/2018-3, Footwear

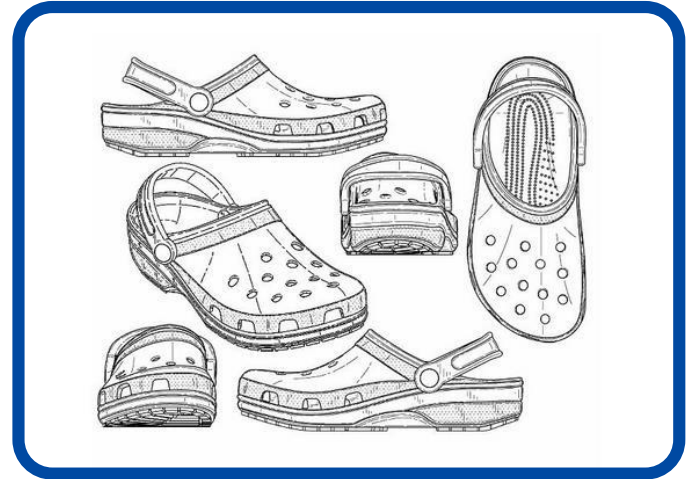
### CONTESTED RCD

Class 02.04 Footwear



### EARLIER TRADE MARK

Class 25 – Footwear; shoes; sandals; athletic shoes; boat shoes; beach shoes; clogs

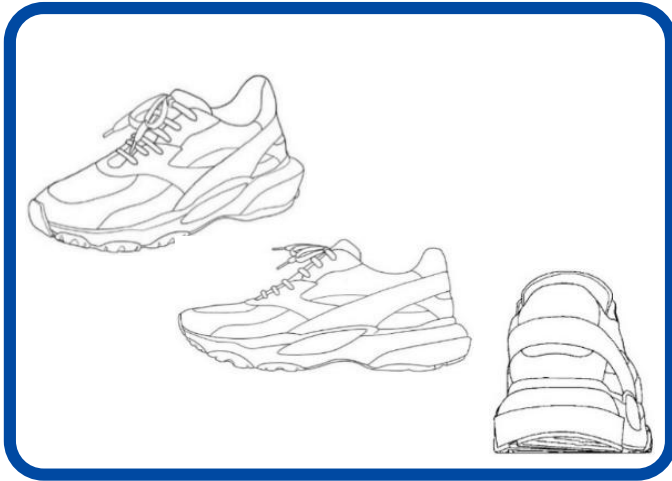


**No likelihood of confusion**

## BoA, 13/01/2022, R 781/2021-3, Shoes

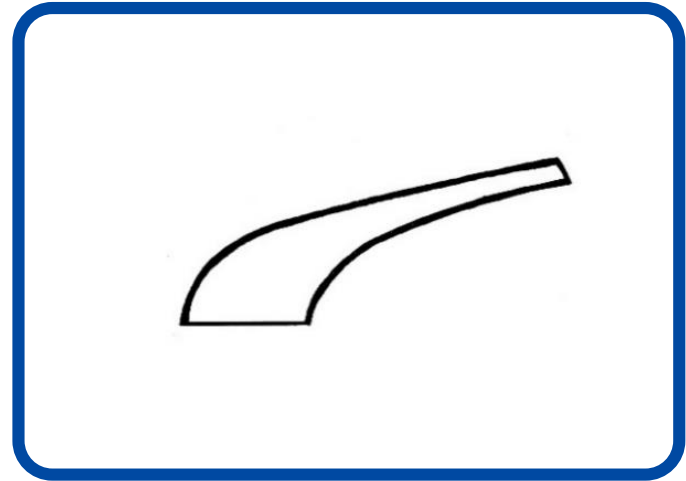
### CONTESTED IR

Class 02.04 Shoes



### EARLIER TRADE MARK

Class 25 – inter alia, footwear, boot uppers, footwear uppers



**No likelihood of confusion**

## Conclusions

- IP rights can be used against each other and fall within each other's scope of protection
- EUTM falls within the scope of an earlier RCD if...
- RCD falls within the scope of protection of the earlier EUTM if...

## Trade mark or design? Both?



**has acquired distinctiveness**

**EUTM 014460455**

Class 16, 18, 25 (incl. footwear)

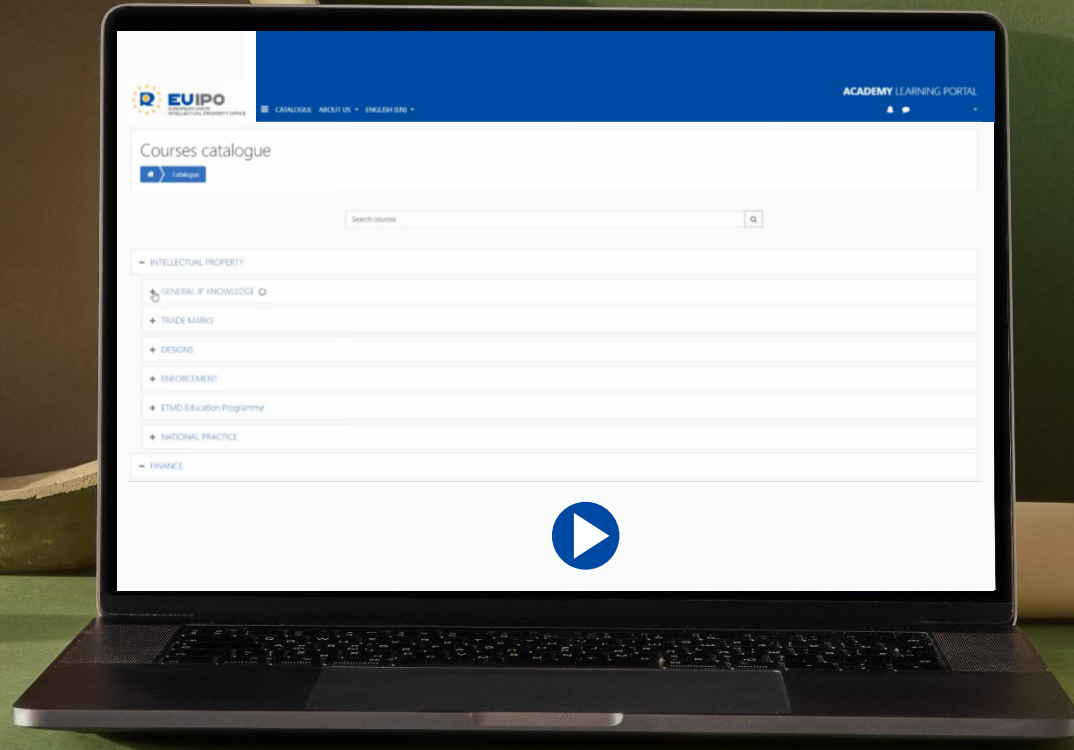


**RCD No 005276623-0004**

Class 02.04 Ladies' sandals (part of -), Heeled shoes  
(part of -),  
Shoes (part of -)



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