



**Track on Case Law:
GC/CJ judgments and EUIPO BoA decisions
2023 Q1**

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Programme

60'
Presentation

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

30'
Questions and answers



Procedural issues

Art. 22 (1) (b) (c) EUTMDR – Statement of grounds of appeal

08/03/2023, T-372/21, Sympathy Inside / Inside, EU:T:2023:111

EUTM	Earlier mark
INSIDE	Sympathy Inside



BoA confirmed

Art. 22 (1) (b) and (c) EUTMDR – Statement of grounds of appeal

T-372/21, INSIDE

- A statement setting out the grounds of appeal is to contain a **clear and unambiguous identification** of the facts, evidence and arguments in support of the grounds invoked (§ 48)
- BoA **not required to respond** to arguments which are not raised in that SoG, in particular arguments presented in submission to OD (§ 49)
- SoG of Appeal has an **autonomous legal value**, parties have to criticize, clearly and unambiguously, what is wrong in the 1st instance decision (§ 49)

Art. 95 (1) EUTMR – EUIPO duty to examine facts of its own motion

01/02/2023, T-772/21, Efbet (fig.), EU:T:2023:36

EUTM

The logo for Efbet, featuring three stars above the word "efbet" in a bold, lowercase, sans-serif font.

Cl. 9, 16, 28, 35, 38 and 41

BoA confirmed

Art. 95 (1) EUTMR – EUIPO duty to examine facts of its own motion

T-772/21, EFBET (fig.)

- ❑ EUTM owner's burden of proof in revocation proceedings entails inapplicability of Art. 95(1) EUTMR (§ 17-21, C-610/11P *Centrotherm* § 63-64)
- ❑ EUTM owner bears the burden of proof and has to **clearly indicate**, in response to the application for revocation, **for which G/S it had provided evidence** to show genuine of the mark (§ 28)
- ❑ CD cannot examine of its own motion, within all the evidence produced before it, whether that evidence could establish genuine use in respect of **G/S other than those claimed** by the EUTM owner (§ 29)

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Absolute grounds

Art. 7 (1)(b) EUTMR

15/03/2023, T-133/22, The future is plant based, EU:T:2023:129

EUTM

THE FUTURE IS PLANT-BASED

Cl. 5 (food supplements)

Cl. 30 (bakery goods, confectionery, ice cream, coffee, cocoa; cocoa products etc.),

32 effervescent powder (for beverages)



EUTM rejected

Art. 7(1)(b) EUTMR

T-133/22, The Future is Plant Based

- the relevant public will not perceive any conceptual tension or contradiction between the terms making up the sign (§ 31)
- The mere fact that some of the words making up composite marks may be understood in **different ways** or have **a more vague** meaning does not make such sign necessarily distinctive (§ 32, T-94/18 *fit+fun* § 29).
- Four slogans / laudatory expressions which have been considered distinctive by the Court do not help in this case... and the Court explains why (§ 38-41)

Sign referring to goods in metaverse – Art. 7(1)(b) EUTMR

[28/02/2023, 2357/2022-2, METAVVERSE FOOD](#)

EUTM application

METAVVERSE FOOD

Wide range of goods in
Classes 5, 29, 30 and 32

✗ Application rejected

Sign referring to goods in metaverse – Art. 7(1)(b) EUTMR

28/02/2023, 2357/2022-2, METAVERSE FOOD

- Trade marks in metaverse** (virtual environment) and for **virtual goods***
- The **borderline** between the real world and the virtual world **is not clear**
- Interconnection between real-life goods and metaverse / virtual goods**
- The sign merely informs the relevant public that the goods applied for are various types of medicinal and food products which are offered or which can be purchased in the virtual space
- Non-distinctive** pursuant to Art. 7(1)(b) EUTMR

*EUIPO practice on classification of ‘virtual goods’ and ‘non-fungible tokens’ (‘NFTs’) will be reflected in the 2023 edition of the Guidelines (as from 31/03/2023)



Relative grounds

Art. 8(1) (b) EUTMR – Counteraction theory

15/02/2023, T-341/22, Avanza Tu negocio (fig.) / Avanza Credit de Deutsche Bank (fig.), EU:T:2023:73

EUTM application



Cl. 36

✓ Application allowed

Earlier ES mark

Avanza Credit de Deutsche Bank

Cl. 36

✗ Opposition rejected

Art. 8(1)(b) EUTMR – Counteraction theory

T-341/22 Avanza Tu negocio / Avanza Credit

- ❑ The assessment of conceptual similarity must be based on the **overall impression** given by the marks. The relevant ES public will not perceive ‘AVANZA’ independently in both marks, and in particular in the expression ‘AVANZA TU NEGOCIO’ (§ 90, T-905/16 NUIPRECIEUSE § 64)
- ❑ The ‘counteraction theory’ refers to the situation where a **particularly pronounced** and **obvious** conceptual difference between the signs may counteract any visual and phonetic similarity found between them (§ 98)

Art. 8(1)(b) EUTMR – Counteraction theory

T-341/22 Avanza Tu negocio / Avanza Credit

- ❑ In this case, although the signs under comparison, as a whole, convey **different concepts**, that difference is not **particularly pronounced** and **obvious** due to the presence of the common element ‘AVANZA’ so that it cannot counteract the visual and phonetic similarities (§ 99)
- ❑ However, in view of the **low degree** of visual and phonetic similarity of the signs and the conceptual **differences** between them, as well as the **high** level of **attention** of the relevant public, no LoC (§ 100-101)

Reputation – Art. 8(5) EUTMR – Link between the signs

01/02/2023, T-568/21, GC GOOGLE CAR (fig.) / Google, EU:T:2023:37

EUTM applications

GC
G O O G L E
C A R

Vehicles and
conveyances (Cl. 12)

 Applications rejected

Earlier mark

GOOGLE

Cl. 9, 35,
38 and 42

 Oppositions allowed

Art. 8(5) EUTMR – Link between the signs

T-568/21 Google car / Google

- ❑ **Overlap** between commercial activities of the parties owing to, inter alia, the opponent's **activity** in the **automotive** sector - self-driving car project, reported in the press
- ❑ Even though i) that new activity is not the opponent's main activity and ii) the earlier mark is not protected in respect of those goods, consumer **may have the impression** that the goods applied for originate from the opponent or involve elements / are equipped with services rendered by the opponent (§ 55)

Reputation – Art. 8(5) EUTMR – Link between the signs

[23/01/2023, R 2420/2020-1, BERTRAND PUMA \(fig.\) / PUMA \(fig.\) et al.](#)

EUTM application



Goods in
Classes 7
and 11

✓ Application allowed

Earlier mark



Goods in
Class 25

✗ Opposition rejected

Reputation – Art. 8(5) EUTMR – Link between the signs

23/01/2023, R 2420/2020-1, BERTRAND PUMA (fig.) / PUMA (fig.) et al.

- ❑ Test under Art. 8(5) EUTMR
 - any **similarity** between the signs at issue
 - any **reputation** of the earlier trade mark
 - any **link** between the marks at issue
 - any **detriment** to the reputation or to the distinctive character of the earlier mark or any **unfair advantage** being taken of the reputation or the distinctive character of the earlier mark
- ❑ **Relevant public** – contested goods in Classes 7 and 11 target mainly **professionals with the level of attention higher than average**

Reputation – Art. 8(5) EUTMR – Link between the signs

23/01/2023, R 2420/2020-1, BERTRAND PUMA (fig.) / PUMA (fig.) et al.

- The earlier PUMA trade mark enjoys a **very high reputation for sport apparel, footwear and clothing in the entire EU**
- Despite this**, there is **no link** within the meaning of Article 8(5) EUTMR as the contested goods belong to a radically different market sector (see, 26/09/2018, T-62/16; 10/03/2021, T-71/20; 21/12/2022, T-4/22)
- Even if consumers made a link, **there are no reasons to believe that any association would be detrimental to the earlier mark**
- A professional** purchasing machines and apparatus is unlikely to be influenced by an association with an image enjoyed by the earlier mark

Conflict with an earlier Geographical Indication – Art. 8(6) EUTMR

17/02/2023, R 531/2022-2, NERO CHAMPAGNE / Champagne

EUTM application

NERO CHAMPAGNE

Wine complying with the specifications of the protected designation of origin 'Champagne' in Class 33, and services in Classes 35 and 41

✓ Application partly allowed

Earlier PDO

CHAMPAGNE

Wine

✗ Opposition partly rejected

Conflict with an earlier Geographical Indication – Art. 8(6) EUTMR

17/02/2023, R 531/2022-2, NERO CHAMPAGNE / Champagne

- ❑ PDO ‘Champagne’ enjoys an **exceptional reputation** in the EU
- ❑ Protection of a PDO pursuant to Article 103(2)(a)(ii) of Regulation No 1308/2013 may be invoked not only against goods, but **also against services** (09/09/2021, C-783/19, Champanillo, § 50-52)
- ❑ Use of the contested sign for ‘*advertising; business management; business administration; office functions*’ (Class 35) would **exploit the reputation of the PDO ‘Champagne’** within the meaning of Article 103(2)(a)(ii) of Regulation No 1308/2013

Conflict with an earlier Geographical Indication – Art. 8(6) EUTMR

17/02/2023, R 531/2022-2, NERO CHAMPAGNE / Champagne

- But the sign **can be registered** for *‘wine complying with the specifications of the PDO ‘Champagne’* (Class 33) and services in relation to wine bearing the protected designation of origin *‘Champagne’* (Classes 35 and 41)
- The word *‘NERO’* in the contested sign **is not misleading** within the meaning of Article 103(2)(c) of Regulation No 1308/2013 in relation to *‘wine complying with the specifications of the PDO ‘Champagne’* (Class 33)

Revocation – Common name (generic) in trade – Art. 58(1)(b) EUTMR

01/02/2023, R 1511/2020-1, Xerox

EUTM

XEROX

Class 2: Toners, dry inks and printer's inks
Class 7: Machines
Class 9: Copiers; portable copiers; photocopying apparatus; reprographic apparatus
Class 16: Paper, copying paper



EUTM remains registered

Revocation – Common name (generic) in trade – Art. 58(1)(b)

01/02/2023, R 1511/2020-1, Xerox

- Art. 58(1)(b) EUTM applies, if in consequence of **acts or inactivity of the proprietor**, the trade mark **has become the common name in the trade** for a product or service in respect of which it is registered
- Situation where the trade mark is **no longer capable of fulfilling its function as an indication of origin** (29/04/2004, C-371/02, Bostongurka, § 22)
- Restrictive interpretation** owing to the serious consequences that it may have for the proprietor of a trade mark (29/04/2004, C-371/02, Bostongurka, § 24)

Revocation – Common name (generic) in trade – Art. 58(1)(b)

01/02/2023, R 1511/2020-1, Xerox

- Burden of proof** lies with the revocation applicant
- Revocation applicant failed to explain **at which moment in time** the contested EUTM **has** allegedly **become generic**
 - If the mark was generic **at the time of registration**, invalidity proceedings on the grounds of Art. 59(1)(a) EUTMR in connection with Art. 7(1)(d) EUTMR should have been initiated
- No evidence that the contested mark has been **used in trade to describe the goods at issue**
- No inactivity** of the EUTM proprietor **to protect the mark**

Proof of use – Art. 47(2) EUTMR – Place and extent of use – Art. 10(3) EUTMDR

01/03/2023, R 603/2022-5, HAVANA SOCIAL (fig.) / H HAVANNA (fig.)

EUTM application



Services in
Class 43

Earlier mark



Class 42: *Providing of food and drink; cafes, cafeterias, snack-bars, catering services*

Contested decision partially annulled

Proof of use – Art. 47(2) EUTMR – Place and extent of use – Art. 10(3) EUTMDR

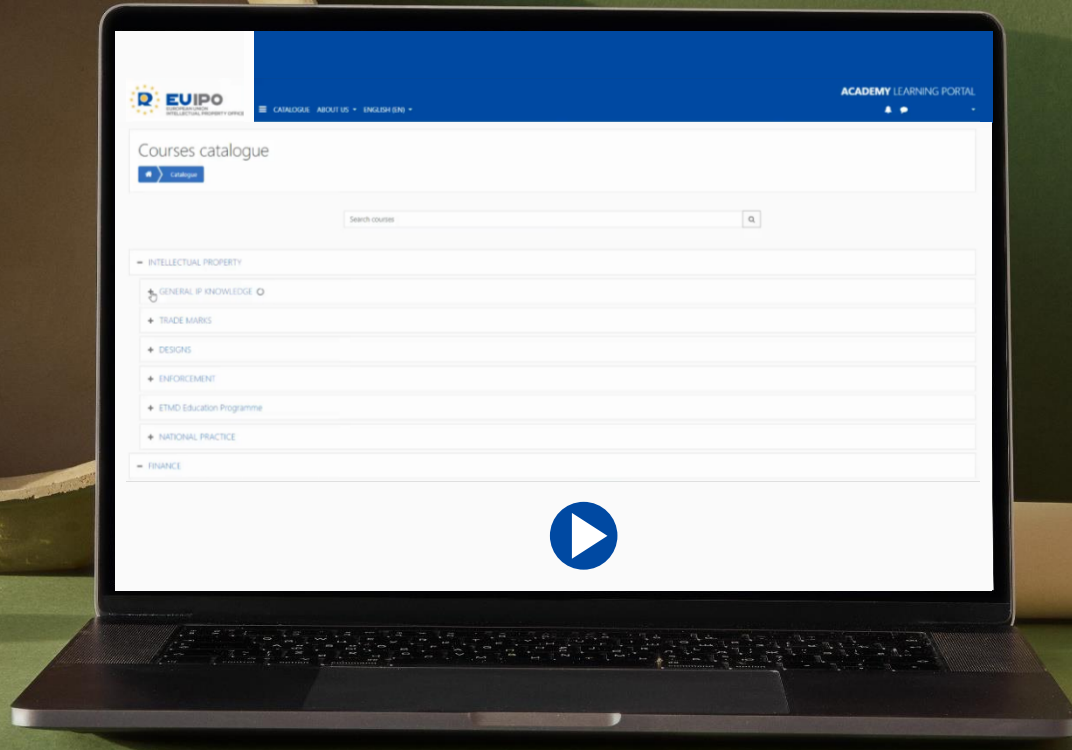
01/03/2023, R 603/2022-5, HAVANA SOCIAL (fig.) / H HAVANNA (fig.)

- ❑ Use of the mark need **not always be quantitatively significant** in order to be deemed genuine (05/10/2022, T-429/21, Aldiano, § 19)
- ❑ As regards the territorial scope of use, ***de minimis* rule cannot be laid down** (19/12/2012, C-149/11, Leno, § 54-55)
- ❑ It does not follow from Article 47(2) EUTMR that use of a mark can only be considered effective if it extends to a substantial part of the relevant territory (23/09/2020, T-737/19, MontiSierra, § 42)
- ❑ **Use in relation to two establishments** (cafeterias) in Barcelona, Spain found **sufficient** to constitute use in Spain and also in the EU



Questions?

Keep in touch with EUIPO Academy



Speakers

3 speakers from EUIPO



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THANK YOU

Presentation		
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