



# Track on Case Law: GC/CJ judgments and EUIPO BoA decisions 2024 Q2

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## Programme

**60'**  
**Presentation**

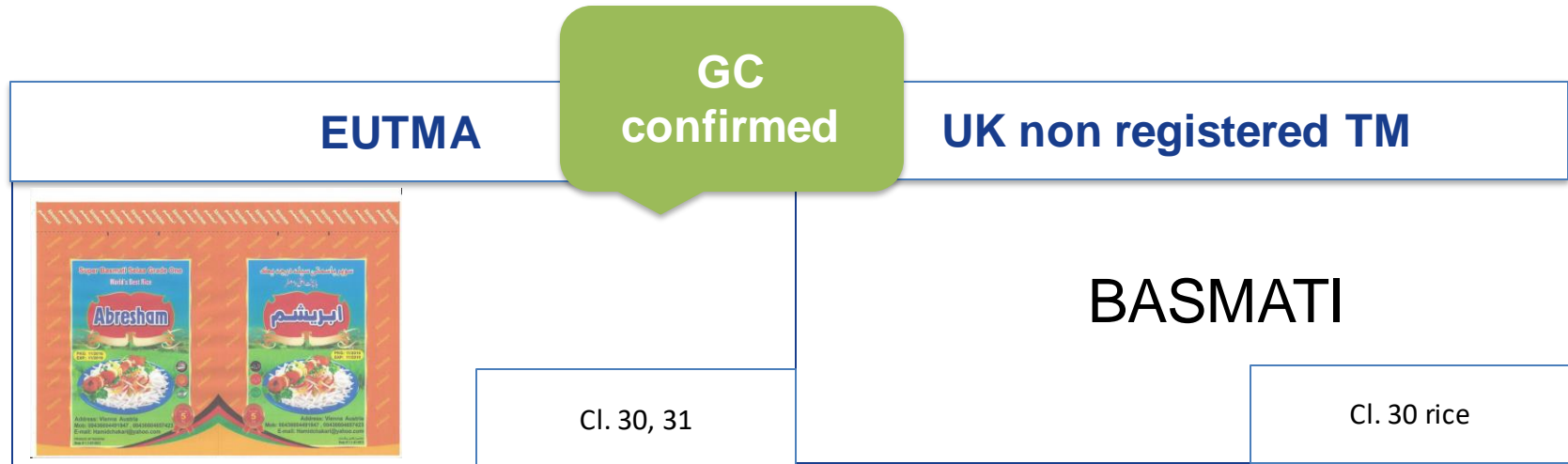
- 1) Procedural issues
- 2) Absolute grounds
- 3) Relative grounds
- 4) Proof of use

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

# 1 Procedural issues

## Art. 8(4) EUTMR – Interest in bringing proceedings before the GC

[20/06/2024, C-801/21 P, Basmati](#)



✓ Interest in bringing proceedings against the BoA decision continues to exist

## Interest in bringing proceedings before the GC

### C-801/21 P Basmati

- Disappearance** of the ER on which oppo is based at the judicial stage of the opposition proceedings does not impact Opponent's **interest in bringing proceedings** against the BoA decision (§§ 59-61, 80-82)
- BoA decision has not been **withdrawn** or **eliminated retroactively** (§ 61) and it is **detrimental** in particular to the opponent's economic interests (§ 82)
- The judgment only concerns the proceedings before the GC and does not impose a change of practice to EUIPO and its Boards of Appeal

## Effects of partial surrender – Art. 57(2) EUTMR

30/05/2024, R 1454/2022 5, PriSecco / Prosecco

EUTM

**PriSecco**

Class 32: *cocktails,  
non-alcoholic*



**EUTM cancelled**

Earlier PDO

**Prosecco**

Wines



**Application for invalidity upheld**

## Effects of partial surrender – Art. 57(2) EUTMR

30/05/2024, R 1454/2022 5, PriSecco / Prosecco

- ❑ Partial surrender pursuant to Art. 57 EUTMR is dealt with in *ex parte* proceedings between the EUTM proprietor and the Office
- ❑ Effects of partial surrender during the cancellation proceedings are *ex nunc* (Art. 57(2) EUTMR)
- ❑ It is for the invalidity applicant to demonstrate a **real, direct and present legitimate interest in obtaining a decision on the merits also in relation to the surrendered goods, so that to have effects of *ex tunc*** under Article 62(2) EUTMR

# 2 Absolute grounds



## Art. 7(1)(c) EUTMR – Descriptive character

12/06/2024, T-130/23, FOOTWARE

EUTM

BoA confirmed  
by the Court

# FOOTWARE

*Cl. 9: Computer hardware and software*  
*Cl. 38: Telecommunications*  
*Cl. 42: Cloud computing services*

**×** EUTM declared invalid

## Art. 7(1)(c) EUTMR – Descriptive character

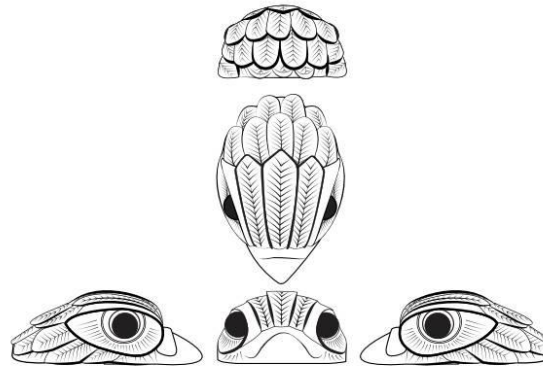
### T-130/23 FOOTWARE

- ❑ *Footware* provides info regarding the *intended purpose* of the G/S which can be used with footwear or shoe components → descriptive (§ 71)
- ❑ Not necessary to determine if the link between the mark and the G/S constitutes an intrinsic, permanent or objective characteristic of those G/S (§ 68)
- ❑ Qualification T-423/18 *vita* and T-133/19 *Off-white* case-law [whether the colour of a product was capable of constituting an ‘other characteristic’ within the meaning of Art. 7 (1)(c)]

## Shape mark – Distinctiveness – Art. 7(1)(b) EUTMR

28/05/2024, R 173/2024-5, SHAPE OF A BEJEWELLED EAGLE HEAD (3D)

### EUTM application



Class 9: *downloadable virtual goods, namely jewellery*  
Class 14: *jewellery and imitation jewellery*

**Application partly refused**

## Shape mark – Distinctiveness – Art. 7(1)(b) EUTMR

28/05/2024, R 173/2024-5, SHAPE OF A BEJEWELLED EAGLE HEAD (3D)

- In the **fashion sector**, it is a **common practice to use representations of wild, strong and exotic animals** in the commercial presentation or the decoration of goods such as those in Class 14 (T-564/22, DEVICE OF A LION HEAD)
- Well-known fact** that items of jewellery and bijouterie may take a variety of shapes, including that of animals (§ 33)
- The sign represents only an **aesthetic or decorative variation** compared to the shapes of jewellery and bijouterie items commonly present on the market (§ 39)
- The assessment of the distinctive character of a sign are fully applicable to **trade marks registered for virtual goods featuring real-world goods** (§ 31)
- Non-distinctive** pursuant to Art. 7(1)(b) EUTMR



## Characteristic of goods – Distinctiveness – Art. 7(1)(b), (c) EUTMR

[25/04/2024, R 501/2024-5, Ladybird \(fig.\)](#)

IR designating the EU

*Ladybird*

Goods in Class 14,  
including *jewellery*

✓ Application allowed

## Characteristic of goods – Distinctiveness – Art. 7(1)(b), (c) EUTMR

25/04/2024, R 501/2024-5, Ladybird (fig.)

- ❑ Even though it is true that items of jewellery are likely to take a variety of forms, in particular that of animals, it cannot be established that the relevant public associates the figurative sign *Ladybird* per se with jewellery items (§ 33, 34)
- ❑ The sign **does not describe any characteristics of the jewellery goods** (§ 40)
  - ❑ There are no grounds to consider that the sign will be perceived as a description of the shape or appearance of the goods concerned
- ❑ Relevant consumers **would not immediately associate the sign with jewellery in the shape of a ladybird**
- ❑ **Distinctive** pursuant to Art. 7(1)(b) EUTMR



## Relative grounds

## Art. 8(5) EUTMR – Unfair advantage

[24/04/2024, T-157/23, Joyful by nature / JOY et al.](#)

BoA confirmed  
by the Court

EUTMA	Earlier mark
JOYFUL BY NATURE	JOY
Cl. 3, 4, 35, 44	Cl. 3: perfumery and fragrances (...)

Application rejected

Opposition allowed



## Art. 8(5) EUTMR – Unfair advantage

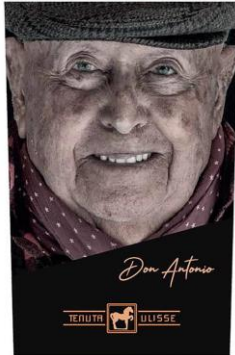
### T-12/23 JOYFUL BY NATURE

- Reputation** of a trade mark is, in general, acquired **progressively**. The same reasoning applies to the loss of such a reputation, which is also, in general, **lost gradually** (§ 38). No evidence of sudden disappearance in this case (§ 42)
- Earlier mark enjoys an image of luxury and stability (§ 84)
- Unfair advantage of the repute of the earlier mark taken (§ 88).

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

15/03/2024, R 10/2023-5, Don Antonio TENUTA ULISSE (fig.) / A photographic portrait of an old man (fig.)

EUTM application



Class 33: *wine*



Application allowed

Earlier mark



Class 33: *wine*



Opposition rejected

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

15/03/2024, R 10/2023-5, Don Antonio TENUTA ULISSE (fig.) / A photographic portrait of an old man (fig.)

- The earlier mark is protected for the specific image for which it was filed and registered, rather than for the abstract idea or concept of an old man's portrait *per se* used as a trade mark (§ 54)
- Consumers would easily notice the **differences between the signs**
  - Verbal elements of the contested sign
  - Contrasting emotional tones set by the expressions of the men, the distinct styles of attire, and the different overall colour schemes create **two separate identities for each portrait**
- Enhanced distinctiveness** of the earlier mark **not demonstrated**
- No likelihood of confusion**



## Proof of use

## Revocation – Use for the registered G/S – Art. 58(1)(a) EUTMR

05/06/2024, T-58/23 BIG MAC

EUTM

BoA partially  
annulled

**BIG MAC**

*Cl. 29: Foods prepared from meat products,  
meat sandwiches*

*Cl. 30: Edible sandwiches, meat sandwiches*

**EUTM remains registered**

## Art. 58(1)(a) EUTMR – Use for the registered G/S

### T-58/23, BIG MAC

- Genuine use in connection with services in Cl. 42 on account of
  - the link between those services and the *meat sandwich* for which genuine use had been proved
  - the high degree of reputation of the MCDONALD'S trade markcannot be accepted.
- The reputation of a mark in respect of certain G/S does not have a bearing on the scale of use of another mark (§ 99)
- Use in connection with goods could not prove use for specific service

## Revocation – Use as registered – Art. 58(1)(a) EUTMR

[17/04/2024, R 961/2023-2, DUE VITTORIE BOTTIGLIA \(3D\)](#)

EUTM



Class 29: *oils and products  
preserved in oil*  
Class 30: *vinegar; sauces*

**EUTM partly revoked**

## Revocation – Used as registered – Art. 58(1)(a) EUTMR

17/04/2024, R 961/2023-2, DUE VITTORIE BOTTIGLIA (3D)

- ❑ Concept of ‘used as registered’ in respect of a shape mark
  - applying labels to the bottle constitutes the **simultaneous use of independent signs**, each possessing its own distinctive character and unaffected by their concurrent existence
  - evidence demonstrates use of the registered 3D mark
- ❑ The issue of **whether the contested shape mark is distinctive cannot be relied on in cancellation proceedings for non-use**

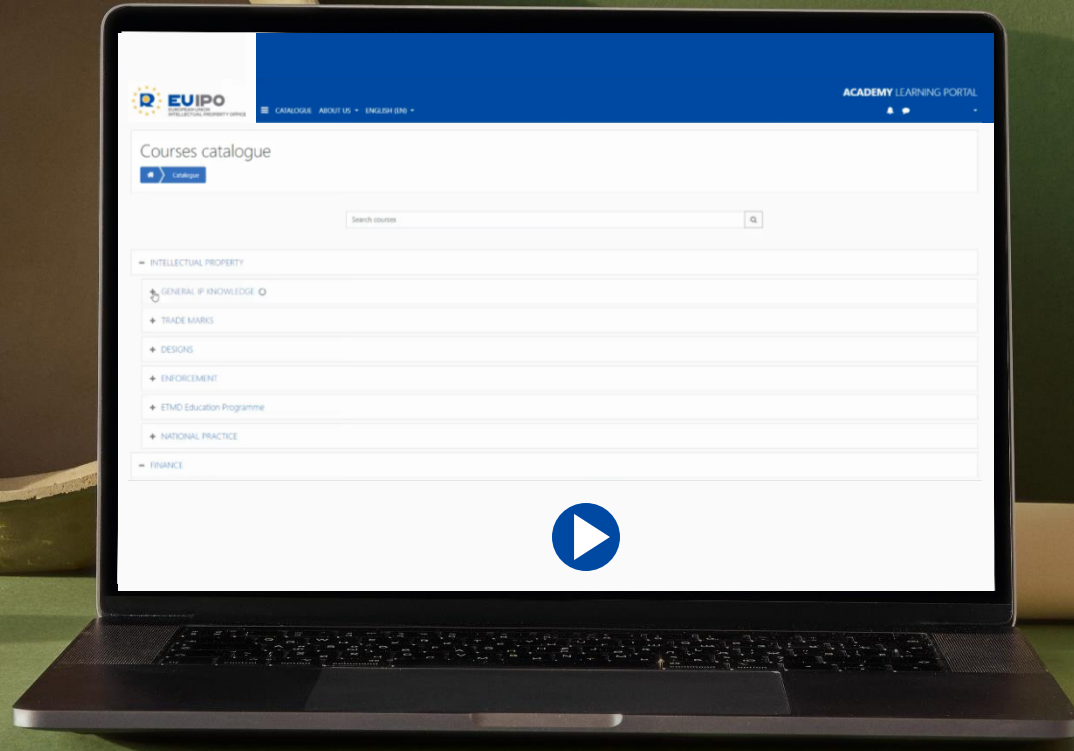




## Questions and answers

**In the BIG MAC case, the mark was registered in Class 42 not for ‘restaurant services’. The party wanted to prove genuine for these services by submitting evidence of sales of its own meat/chicken sandwiches. Oftentimes, when you sell your own goods, it does not count as a service rendered for third parties. Was that the issue or was the formulation of the service that the party has chosen more important or played less in its favor?**

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Complementarity of goods and services	2024 March	EN
Global assessment of the likelihood of confusion between trade marks in cases where their similarity essentially resides in a weak or non-distinctive element	2023 December	EN
Likelihood of confusion in the case of single-letter signs	2023 November	EN ES DE FR IT

## Speakers

### Speakers from EUIPO



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