

# Alicante News

Up to date information on IP and EUIPO-related matters

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**Reminder:**  
Change of bank account at  
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## Editorial

### Reminder: Change of Bank Account at EUIPO

On 17 February 2018, one of the two bank accounts used by the Office changed. The BBVA bank account was replaced by one with Banco Santander.

Users who still use the BBVA account to make payments either have or will receive a letter from EUIPO informing them of the account change and inviting them to pay via the accounts the Office holds with CaixaBank and Banco Santander.

This change does not affect the account held by the Office at CaixaBank. Therefore, to transfer fees, replenish current accounts and pay charges, users are requested to use one of the following two bank accounts:

BANK	LOGO	ADDRESS	BANK ACCOUNT (IBAN)	BIC
Caixabank		Alicante (Spain)	ES03 2100 2353 0107 0000 0888	CAIXESBBXXX
Banco Santander		Alicante (Spain)	ES08 0049 6659 0121 1622 4792	BSCHEMMXXX

All current account holders have already received a letter from us informing them about the account change. Please read this letter carefully, and if you have any questions, [contact us](#).

More details on the change are contained in the [Communication No 1/2018](#) of the Executive Director of the Office of 16 February 2018.



EUIPO's online e-filing application has been fully updated with details of the new bank account number. Users will see the following message in the e-filing system when they pay by bank transfer:

The screenshot shows a payment confirmation page. At the top, it says 'Payment' with a green 'Secure payment' indicator. Below that, 'Purchase information' shows a total of 850.00 €. A table lists payment descriptions with amounts, showing a total of 850.00 €. There are three payment methods: Credit/debit card payment (CC), Bank transfer (BT), and EUIPO current account (CA). The Bank transfer section is highlighted and shows two options: La Caixa and Santander, with their respective account numbers, addresses, BIC codes, and IBANs. A warning icon indicates a change of bank accounts. Below the table, there is a 'fast track' section with instructions for users to confirm the payment and understand the terms.

Should you have any doubts or queries about the change of bank account at EUIPO, our Information Centre can be contacted on [information@euiipo.europa.eu](mailto:information@euiipo.europa.eu).

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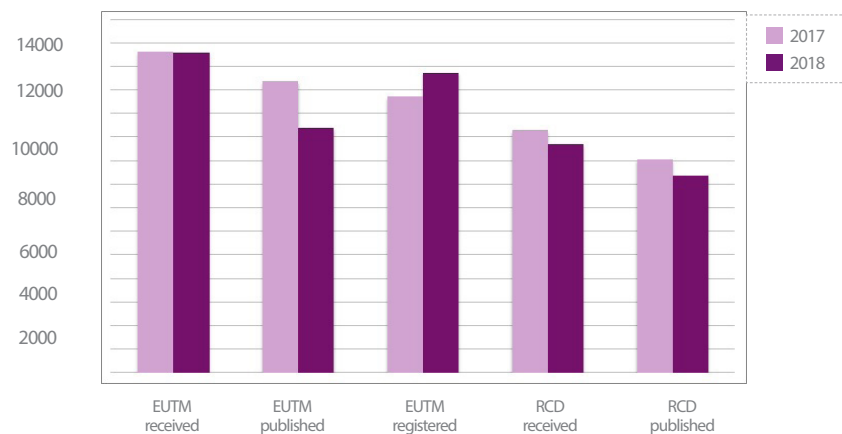


## Statistical Highlights



Monthly statistical highlights March*	2017	2018
European Union Trade Mark applications received	13615	13591
European Union Trade Mark applications published	12372	10388
European Union Trade Marks registered (certificates issued)	11719	12735
Registered Community Designs received	10287	9704
Registered Community Designs published	9045	8372

\* Statistical data for the month in course is not definitive. Figures may vary slightly thereafter.



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### New integrations into TMview and Designview

In April 2018, the National Institute of Industrial Property Office of Chile (INAPI) made its trade mark data (more than 575 000 trade marks) available to the TMview search tool.

Also in April, the Jordanian Industrial Property Protection Directorate under the Ministry of Industry, Trade and Supply (IPPD) made its trade mark and design data available to TMview (146 000 trade marks) and DesignView (2 100 designs).

TMview now contains over 49 million trade marks, and Designview contains more than 13.5 million designs.

### Switzerland joins Agorateka

On 29 March 2018, Switzerland joined the [Agorateka initiative](#) with a link to its platform, the Swiss Association for the Fight against Piracy (SAFE).

SAFE, which was founded in 1988, carries out various activities in coordination with its members to combat copyright piracy.

The association supports its members in civil and criminal lawsuits and collaborates with anti-piracy organisations in Germany, France, Italy and Austria.

The portal shows a selection of legal online offers (free

or paid) for movies, music and television content in Switzerland.

Switzerland is the first country outside the EU to join Agorateka.

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### Trade mark reform – Publication of ‘replacement’ Delegated and Implementing regulations

On 24 April, Delegated Regulation (EU) 2018/625 and Implementing Regulation (EU) 2018/626 were published in the Official Journal of the European Union (OJEU). Both acts enter into force on 14th May.

In substance they are the same as the legislation they repeal (EU 2017/143 and EU 2017/1431, respectively) but the new acts cross refer to the new codified EUTMR (EU) 2017/1001 and they contain some stylistic changes.

Both texts are available in all official EU languages below:

[Delegated Regulation \(EU\) 2018/625](#)

[Implementing Regulation \(EU\) 2018/62](#)

### Stakeholder Quality Assurance Panels Project (SQAP) audit on 9-11 April 2018

On 9-11 April 2018, EUIPO welcomed the fifth audit performed by users on the quality of opposition decisions. This audit followed a series of four pilot quarterly audits which began in 2017.

Over the course of two days, 15 auditors representing 11 User Associations met at the EUIPO’s premises to check EUIPO opposition decisions in order to assess their quality in accordance with the established Office quality criteria.

As part of its 2020 Strategic Plan, EUIPO set the goal of enhancing customer-driven quality services by being user-oriented and focusing on the quality of the EUIPO’s products and services.

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### Luxembourg trade mark and design news

B: General Court: Orders and Judgements on appeals against decisions of the EUIPO

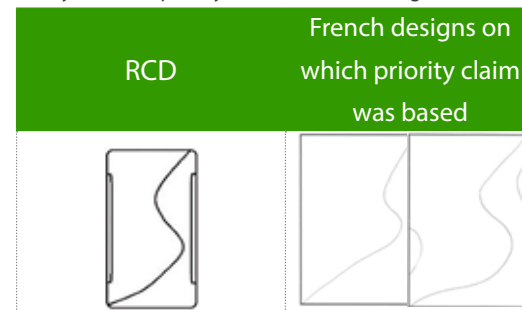
T-166/15; Sacs pour ordinateurs portables; Claus Gramberg v EUIPO; Judgment of 27 February 2018; EU:T:2018:100; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Database printout, Declaration

FACTS: The Office registered a design with a priority date of 30 June 2011, intended to be used for covers for telephones, laptop bags, cases (for mobile phones), cases for computers, and cases for mobile phones in Class 03.01. The applicant submitted an application for a declaration of invalidity of the contested design for lack of novelty, because it sells accessories for mobile phones under the brand 'mumbi', including cases for these devices, mainly on the online sales portal 'amazon.de' under the seller name of 'HandyNow'. The applicant argued that the contested design had been disclosed before the priority date and he submitted proof in this regard (invoices, screenshots/printouts of websites (Amazon, eBay), declarations). The Cancellation Division (CD) considered that the evidence provided was valid for a prior disclosure and declared the invalidity of the design because of the lack of individual character. The RCD holder appealed against the CD's decision. The applicant

submitted three new pieces of evidence. The Board of Appeal (BoA) annulled the CD's decision and rejected the declaration of invalidity because it considered that the evidence was insufficient to prove disclosure of the design. The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 5(1)(b) and Article 7(1) CDR, (ii) infringement of an essential procedural requirement, (iii) the BoA did not take into account the fact that the RCD holder could not validly claim the priority of the contested design.



SUBSTANCE: REGARDING THE FINDINGS OF THE PROBATIVE VALUE OF THE 'AMAZON.DE' SCREENSHOTS: the applicant referred to a specific reference number corresponding to a single offer contained in the annex produced (D4a and D4b), namely ASIN B0058COLXM. This reference appears before the date of the availability of the offer on the e-shop 'amazon.de' and it is provided by the 'Amazon' page when the product is offered for the first time in the Amazon catalogue (paras 44-45). The ASIN number assigned to a single offer necessarily reflects the reliability of the said annexes and demonstrates the



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disclosure of the contested design before 30 June 2011. Therefore, the BoA was incorrect when it disregarded these annexes but was correct regarding Annex D2, as it did not contain this ASIN number (para. 55). Annexes D3 and D5 corroborate the disclosure of the contested design as of 26 May 2011, as the invoice sent by the applicant to a customer (D3) contains a description of the case similar to that on the website 'amazon.de' ('Silikon Case mumbi HTC Desire HD Silicon Tasche Hülle — DesireHD Schutzhülle'). Moreover, it has the same price (EUR 6.99) as the product bearing the number ASIN B0052TD5OM and it has been available on this site since 26 May 2011. The order to buy this case is dated 27 May 2011 (paras 61-62). The GC found that the photograph of the case (D5) reveals the shape, similar to the contested design, and the file refers to the author, 'HandyNow', on 26 May 2011, and to the applicant's mark, 'mumbi', which is also included in the description on the website 'amazon.de' and mentioned in Annexes D2, D4a and D4b (paras 65-66). The assessment the BoA made of the probative value of Annex D4b was incorrect, as it has common characteristics compared with the contested design (paras 69-72). Regarding Annex D11, the Office argued that the applicant's explanations of the doubts expressed by the RCD holder were irrelevant, since they were given for the first time before the GC (para. 76). The BoA made an incorrect assessment of D11, as the quality of the image is good and has similar characteristics when compared with the contested design (paras 82-83). The images contained in D7 are clear and they look sufficiently like those of the contested design (para. 87). REGARDING THE PROBATIVE VALUE OF THE EMAILS INCLUDING THE ALIBABA.COM NEWSLETTER: the document in Annex

D7 does not consist solely of an email, it also includes a newsletter sent to the applicant by the online sales company 'Alibaba.com' (para. 93). Therefore, the GC considered that the errors in assessment of the evidence made by the BoA led to the annulment of the contested decision (para. 95). Since one ground is sufficient, there was no need to examine the two other pleas in law (para. 96).

T-438/16; CIPRIANI / HOTEL CIPRIANI et al.; Altunis-Trading, Gestão e Serviços, Lda v EUIPO; Judgment of 1 March 2018; EU:T:2018:110; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Visual similarity

FACTS: The applicant filed an application for protection of international registration No 11 27 870 for the word mark CIPRIANI for beers; mineral and aerated waters and other non-alcoholic drinks; fruit beverages and fruit juices; syrups and other preparations for making beverages in Class 32. An opposition based on the earlier word mark HOTEL CIPRIANI was filed pursuant to Article 8(1) (b) EUTMR, designating the following services in Class 42 (now Class 43): hotels, hotel reservation, restaurants, cafeterias, public eating places, bars, catering; delivery of drinks and beverages for immediate consumption. The Opposition Division (OD) upheld the opposition for all the goods in Class 32. The applicant appealed the OD's

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decision. The BoA dismissed the appeal as (i) genuine use of the earlier mark was proven; (ii) there was an average degree of similarity between the goods in question and the services protected by the earlier trade mark; and (iii) the degree of similarity between the marks was rather high, so that there was a likelihood of confusion (LOC) concerning all of the contested goods. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 15 and Article 42(2) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The applicant also submitted that any action brought by the opponent against the Cipriani Group concerning the name 'Cipriani' constituted an infringement of the 1967 agreement.

EUTM application	Earlier trade mark
CIPRIANI	HOTEL CIPRIANI

**SUBSTANCE:** ON WHETHER THE BAR AND RESTAURANT SERVICES ARE ANCILLARY TO THE HOTEL SERVICES: the Office refuted the ancillary nature claim, emphasising that the evidence of use demonstrated that the bar and restaurant services had been provided separately and independently from the hotel services. They were also offered to customers from outside the Hotel Cipriani and represented a significant proportion of the hotel's revenue (para. 27). The GC found that the evidence of use demonstrates that, even though the restaurants and bars located in the hotel had their own name, customers

chose them and recognised them because of the sign 'HOTEL CIPRIANI' (para. 30). It dismissed the alleged ancillary nature of the bar and restaurant services and found that there had been genuine use of the earlier mark for cafeterias, bars, catering, delivery of beverages for immediate consumption in Class 42 (paras 32-33). ON THE USE OF DIFFERENT MARKS IN RESPECT OF THE BAR AND RESTAURANT SERVICES: it is apparent from the evidence on file that the earlier mark is always indicated in bold and in capitals, whereas the other signs are barely visible (para. 39). The BoA was thus fully entitled to find that there had been genuine use of the earlier mark, including for the services of cafeterias, bars, catering; delivery of beverages for immediate consumption (para. 41). ON THE LIKELIHOOD OF CONFUSION: the contested goods are complementary to the services of the earlier mark and there is a certain degree of similarity with the services relating to the serving of food and drink covered by the earlier mark (paras 50 and 61). The earlier sign is of average distinctiveness and the marks at issue are word marks that are visually and phonetically highly similar, insofar as they coincide in the word element 'CIPRIANI' (para. 63). In view of the normal distinctiveness of the earlier trade mark, the average degree of similarity between the goods and services at issue, the high degree of visual and phonetic similarity between the signs at issue and the neutral degree of conceptual similarity between those signs, there was a LOC on the part of the relevant public (para. 74). The existence of an agreement signed in 1967 between the parties did not alter the fact that there was a LOC (paras 76-83).

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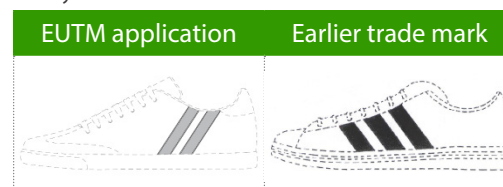
T-629/16; DEVICE OF TWO PARALLEL STRIPES (other) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al.; Shoe Branding Europe BVBA v EUIPO; Judgment of 1 March 2018; EU:T:2018:108; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Coexistence of trade marks, Due cause, Evidence of use, Extent of use, Figurative trade mark, Identity of the goods and services, Proof of use, Reputation, Res judicata, Similarity of the signs, Survey, Tarnishment of reputation, Unfair advantage

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 25. An opposition based, inter alia, on the earlier EU figurative mark represented below registered for goods in Class 25 was filed, based on Article 8(1)(b) and Article 8(5) EUTMR. The opposition was dismissed, and the opponent filed an appeal, which was dismissed by the BoA. It ruled that the trade marks were different overall and there was no LOC on the part of the relevant public. The opponent filed an action before the GC, which was upheld, as the GC found that the BoA erred in concluding that there was no similarity between the marks and this led to a distorted assessment regarding the LOC. The applicant filed an appeal before the Court of Justice (CJ). The CJ dismissed the appeal and the BoA re-examined the appeal brought before it against the OD's decision. It upheld the appeal and allowed the opposition on the basis of Article 8(5) EUTMR. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(5)

EUTMR, divided into three parts as to errors of assessment: (i) the evidence of the reputation of the earlier mark, (ii) the existence of damage to the reputation or distinctive character of that trade mark and (iii) the absence of any due cause for the use of the contested mark.



SUBSTANCE: EVIDENCE ON REPUTATION OF EARLIER MARK: the evidence submitted, taken as a whole, was sufficient to prove reputation of the earlier mark, and specifically the following: an affidavit about the considerable turnover and the advertising expenditure, surveys on the market share of the undertaking using considerable representative samples (and revealing a high degree of awareness), decisions of national courts (according to which that mark, when affixed to shoes, had a significant reputation or renown), as well as proof of the significant sponsorship activity (paras 70, 72-73 and 84). The fact that some earlier marks were primarily used in Germany was sufficient, since the territory of Germany may be regarded as a substantial part of the territory of the EU for the proof of reputation of the earlier mark, in addition to the fact that some evidence proved established reputation of the earlier mark in several other EU countries (paras 81-82). INJURY TO THE REPUTE OR TO THE DISTINCTIVE CHARACTER OF THE EARLIER MARK: (i) The BoA fully complied with the annulling judgment (res judicata) by [correctly] finding

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an average degree of attention of the relevant public, since the goods were for mass consumption, purchased frequently and used by the average EU consumer (paras 104 and 107). (ii) Likewise, the issue of the similarity of the marks was also covered by res judicata. In any event, the differences regarding the colour and length of the parallel stripes between the marks cannot rule out the similarity of the marks (paras 112 and 119). (iii) The alleged weakness is compensated by the consistent use of the marks over time on a large scale, leading to at least a normal distinctive character. Moreover, an earlier mark can have a particularly distinctive character because of the reputation it enjoys with the public (paras 132 and 135-136). (iv) The existence of a risk of unfair advantage of the repute of an earlier trade mark suffices to establish risk of detriment (para. 148). (v) Given the average degree of attention, the identity of the goods, the 'lesser' similarity of the signs, in addition to the normal distinctiveness and the long-held, enduring, significant and global reputation of the earlier mark, the BoA correctly established a link between the marks in the mind of the relevant public (para. 167). The significant marketing efforts on behalf of the proprietor of the earlier mark make coat-tail riding even more tempting in order to benefit from its power of attraction, reputation and prestige (para. 190) The 2007 promotion campaign run in Spain and Portugal (the slogan 'two stripes are enough') must be regarded as an attempt to exploit the reputation of the earlier mark (para. 192). DUE CAUSE FOR USE: in view of the legal dispute in Germany in 1990 and of the previous opposition proceedings in 2004, the alleged coexistence on the market cannot be categorised as peaceful (para. 179). In any event, a

coexistence of the marks was mentioned only regarding the German market and there was no claim for real use of the marks consisting of two parallel stripes affixed to a shoe registered in other Member States (para. 208).

T-843/16; Foto Paradies; dm-drogerie markt GmbH & Co. KG v EUIPO; Judgment of 28 February 2018; EU:T:2018:102;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element

FACTS: The EUTM applicant had registered the word mark Foto Paradies for, inter alia, goods and services in Classes 1, 9, 16, 20, 38, 40 and 42. The intervener filed an application for a declaration of invalidity pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The CD rejected the application and the intervener filed a notice of appeal against the CD's decision. The BoA annulled the CD's decision and declared the contested mark invalid for the contested goods and services. The EUTM applicant filed an action before the GC, relying on a single plea in law: infringement of Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR.

SUBSTANCE: The relevant public consisted of average German-speaking consumers, who are normally informed and reasonably attentive and knowledgeable, and are interested in photography, as amateurs or as professionals (para. 22). The contested mark was composed of two terms with a meaning in German: 'Foto' (internationally understandable) and 'Paradies', understandable by the German-speaking public. LACK OF DISTINCTIVENESS:

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the term 'Foto' is a common abbreviation of the German term 'fotografie' (meaning photography) and refers to the process of using light and chemicals to record an image. Meanwhile, the term 'Paradies' preceded by a noun means in German 'an ideal place' or it offers perfect conditions of well-being or for any activity, or at least represents an affirmative statement on the above noun. By connecting the term 'Foto', which refers to photography in general for the German-speaking consumer, with the term 'Paradies', the contested mark therefore referred to an ideal location for photography or a good price for a product in the field of photography. This meaning is understood as a purely advertising eulogy (para. 27). The goods covered by the contested mark, included in Classes 1, 9 and 16, may be sold as part of a large and multiple offer of a store in the field of photography. The services included in Classes 38, 40 and 42 may all target the photography field. Therefore, the contested mark would be perceived as a purely promotional message and would not be recognised as an indication of origin. The BoA rightly considered that the term would be recognised as an advertising slogan, which is not appropriate to indicate the commercial origin of the goods and services concerned (para. 29). Foto Paradies and 'Fotoparadies' would be understood in the same way by the relevant public, who would still perceive the mark as an advertising eulogy (paras 31-32). Moreover, the contested mark was a word mark consisting exclusively of letters, words or associations of words, written in block letters in a normal font, without any specific graphic element, and the protection of such a mark is limited to the word and does not take into account possible figurative representations of the term. Therefore, even if in this case

the two words were written with a capital letter, this did not change the meaning (paras 33 and 37). Foto Paradies and 'Fotoparadies' convey the same meaning, and the first one is written in full compliance with the rules of German grammar and corresponds to the usual use in German of compound nouns, inasmuch as the first word specifies the meaning of the second word (para. 35). As the meaning of the two words 'Foto' and 'Paradies' remains the same if they are separated by a space or not, the contested mark had no originality nor did it require any effort of reflection or interpretation by the consumer (para. 36). Phonetically, it was not proven that the pronunciation of the two words would be perceptible orally, since the combined or separate writing of the two terms had no effect on the number of pronounced syllables, prosody or accentuation (para. 38).

T-824/16; K (fig.) / K (fig.) et al.; Kiosked Oy Ab v EUIPO;  
Judgment of 13 March 2018; EU:T:2018:133; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual identity, Figurative trade mark, Identity of the goods and services, Letter mark, Likelihood of confusion, Phonetic identity, Similarity of the signs, Visual dissimilarity

FACTS: The applicant obtained an international registration (IR) designating the European Union for the figurative mark represented below for goods and services in Classes 9, 35 and 42. An opposition based, inter alia,

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on the Benelux figurative trade mark represented below, registered, inter alia, for goods and services in the same classes, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition in respect of the following services: advertising; business management, business administration; office functions in Class 35 and design and development of computer software in Class 42. The proprietor of the IR appealed and the BoA dismissed the appeal as regards the above services. The proprietor of the IR filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.



**SUBSTANCE: RELEVANT PUBLIC:** The relevant public was made up of professionals, with a high degree of attention (para. 43). **COMPARISON OF THE SERVICES:** The services covered by the contested IR and the earlier Benelux trade mark were identical (para. 49). **COMPARISON OF THE SIGNS:** (i) Despite the common element, 'K', the signs are visually dissimilar. In the contested IR, the vertical line and the two diagonal lines that open towards the right are closely linked, whereas in the earlier Benelux trade mark, the vertical line constituting the left-hand part of

the capital letter 'K' is slightly set apart from the diagonal lines on the right-hand side of that letter. The ends of the capital letter 'K' in the contested IR are partially rounded, whereas those in the earlier Benelux trade mark are totally rounded. The shape of the black background in the two marks also differs (para. 59). (ii) Contrary to the findings of the BoA, the signs are phonetically identical; since the relevant public may recognise a letter 'K' in both trade marks, they are likely to be pronounced in the same way (para. 64). (iii) The signs are conceptually identical, since the element 'K' is present in both marks (paras 66-68). **DISTINCTIVENESS OF THE EARLIER MARK:** The rounded ends of the white lines in the capital letter 'K' are not banal or ordinary elements. In addition, the white vertical line and the element resembling a chevron are separate. Moreover, that letter is an unusual graphic representation. Lastly, the impression created by the earlier Benelux trade mark is dynamic and playful. Therefore, it has an average degree of inherent distinctiveness (para. 82). **LOC:** Even the public with a high degree of attention may only rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them. Given the identity of the services, the phonetic and conceptual identity and despite the visual differences between the figurative elements, the relevant public would perceive the IR as an updated and modernised version of the earlier mark, rather than as a separate trade mark with a different commercial origin (para. 74). Based on the foregoing, the GC dismissed the application.

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T-222/16; MAGELLAN; Hansen Medical, Inc. v EUIPO; Judgment of 27 February 2018; EU:T:2018:99; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Competence of the Boards, Complementary evidence, Evidence of use, Lack of reasoning, Proof of use, Right to be heard, Scope of proceedings

FACTS: The word mark MAGELLAN was registered as an EUTM for goods and services in Class 10. An application for revocation was filed pursuant to Article 58 EUTMR. The CD dismissed the application for revocation in respect of medical apparatus and instruments, namely injection devices and their components for all manner of injection, collection and transfer of tissue and fluids, and granted the application for revocation for the following goods: surgical, dental and veterinary apparatus and instruments. Both the invalidity applicant and the EUTM applicant filed an appeal before the BoA, which dismissed the invalidity applicant's appeal and upheld the EUTM applicant's appeal. It annulled the CD's decision in part insofar as it revoked the contested mark for surgical, dental and veterinary apparatus and instruments. The invalidity applicant filed an action before the GC, relying on five pleas in law: (i) infringement of Article 18 and Article 58(1)(a) EUTMR, (ii) infringement of Articles 64(1), 70(2), Articles 94 and 95 EUTMR, (iii) infringement of Article 71 EUTMR, (iv) infringement of Article 94 EUTMR, and (v) infringement of Article 96 EUTMR.

SUBSTANCE: (i) The BoA was fully entitled to find that the

contested mark did not cover surgical, medical, dental and veterinary apparatus and instruments as four separate categories, but, because of the term 'namely', was referring to a dedicated subgroup of goods consisting of injection devices and their components for all manner of injection, collection and transfer of tissue and fluids (para. 30). Evidence of genuine use of the contested mark for medical apparatus and instruments, namely, injection devices and their components for all manner of injection, collection and transfer of tissues and fluids was submitted. None of the evidence demonstrated that an injection device used in medical procedures differs from an injection device used in dental, surgical or veterinary procedures (paras 31-32). (ii) The BoA was right to find that the CD's decision would not have been different in the absence of the procedural error committed by it (by depriving the applicant of the opportunity to submit its observations on the additional evidence that it had accepted) (paras 38 and 41). (iii) Although the BoA did refer to the CD's reasons as to the proof of genuine use of the contested mark, nevertheless it conducted its own analysis. It found that the evidence submitted before the CD was sufficient to prove not only the genuine use of the contested mark for medical apparatus and instruments, namely injection devices and their components for all manner of injection, collection and transfer of tissues and fluids, but also for all the goods for which that mark had been registered (para. 45). (iv) The duty to state reasons does not require the BoA to provide an account that follows all the lines of reasoning articulated by the parties exhaustively and one by one. The BoA set out the facts and the legal considerations having decisive importance in the context

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of the decision: it explained that the injection devices for which use had been proven did not form a subgroup of goods corresponding to a single general term on a list of goods, but formed a subgroup of goods of both medical apparatus and instruments and of dental, veterinary and surgical apparatus and instruments (paras 50-51). (v) The BoA exercised its discretion by finding that it was in possession of all the information required as a basis for the operative part of the contested decision (para. 59).


T-118/16; BEPOST / ePOST (fig.) et al.; Deutsche Post AG v EUIPO; Judgment of 20 February 2018; EU:T:2018:86; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual dissimilarity, Dissimilarity of signs, Dominant element, Enhanced distinctiveness, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Non-registered trade mark, Phonetic dissimilarity, Reputation, Similarity of the goods and services, Visual dissimilarity, Weak element

FACTS: Registration was sought for the word mark BEPOST as an EUTM, covering goods and services in Classes 16, 35, 38 and 39. An opposition was filed, inter alia, on the earlier German word mark POST (services in Classes 35 and 39), the EU figurative mark represented below (goods and services in Classes 9, 35, 36, 38, 39, 40, 41 and 42) and the non-registered mark or sign used in the course of trade POST. The grounds invoked were based on infringement of Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD

dismissed the opposition and the opponent appealed. The BoA dismissed the appeal, insofar as it found that the signs showed significant visual, aural and conceptual differences that were sufficient to rule out a LOC, as required by Article 8(1) EUTMR and national law. The possibility of association or the creation of a mental link for the purposes of Article 8(5) EUTMR was rejected, taking into account that the German word 'post' was a generic term widely used to refer to postal and related services. The opponent filed an action before the GC relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(4) EUTMR and (iii) infringement of Article 8(5) EUTMR.

EUTM application	Earlier trade mark
<b>BEPOST</b>	<b>POST</b>  <b>Non-registered mark: POST</b>

SUBSTANCE: REGARDING THE EARLIER GERMAN WORD MARK POST: RELEVANT PUBLIC: The relevant public was composed of professionals and consumers in Germany with an overall average degree of attention (para. 31). COMPARISON OF SERVICES: The services covered by the contested mark are identical or 'remotely' similar to the services covered by the earlier mark (para. 33). COMPARISON OF SIGNS: The signs showed, despite their (weak) common element 'post', significant visual, aural and conceptual

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differences, because of the difference in the length of the word elements, in addition to the slightly dominant word element 'be' at the beginning of the contested mark, which does not allude to postal services (paras 43-49). Although a significant percentage of the relevant public recognises the trade mark significance of the word 'post', which does not in itself demonstrate that the term can be perceived only as that mark when it is incorporated in marks that differ in overall appearance, pronunciation and concept (para. 47). NO LOC: In order to assess a LOC, the BoA duly took into account the proof of enhanced distinctiveness of the earlier mark and correctly assessed the distinctiveness and dominance of the components of the marks, the degree of similarity of the marks and the services, as well as the fact that the element 'BE' of the contested sign was placed at the beginning of the short contested mark and was slightly dominant. No LOC was confirmed (para. 72).

REGARDING THE EU FIGURATIVE MARK :

### **ePOST**

RELEVANT PUBLIC: The relevant public was composed of consumers in the EU (para. 74). COMPARISON OF GOODS AND SERVICES: Part of the goods and services are dissimilar, partly identical or at least somewhat similar (para. 75). COMPARISON OF SIGNS: Visually the signs are similar to a low degree, inter alia, because the first word element of the earlier figurative mark is 'e', whereas the first word element of the contested mark is 'be'. There are further visual differences resulting from the different colours and typefaces used and the way in which those different elements are arranged and the distinctive character of those elements is no weaker than that of the word

element 'post' (para. 81). The 'e' in the earlier mark ePOST will be understood as meaning 'electronic, indicating the involvement of the internet', which represents a conceptual difference between it and the mark applied for (para. 83). NO LOC: The distinctive character of the two word elements 'e' and 'post' of the earlier EU figurative mark ePOST is weak (para. 88). The signs are similar to a low degree, since, despite their common element 'post', they show significant visual, aural and conceptual differences (para. 89). The common element 'post', which is not separated from the word element 'be' by a space, does not play the same role in the two marks at issue (paras 69 and 91). Even if the common element 'post' may potentially have some independent distinctiveness due to the registration of the sign POST as an earlier national word mark, it is rather likely to be seen as a mere reference to postal services in the contested mark, and, therefore, it is purely descriptive (paras 91-92). Therefore, in view of the above and given the different overall impression of the marks because of the differences between the word elements at the beginning of the signs in different graphic styles, there was no LOC (para. 90). The same applied for the non-registered mark or sign used in the course of trade POST (paras 101-102). REGARDING THE REPUTATION OF THE EARLIER NATIONAL MARK POST: In view of the significant differences between the marks and the weak distinctive character of the common element 'post', the relevant public would not make any link between the mark for which protection was sought and the earlier national word mark POST, since the term 'post' was likely to be perceived merely as a reference to postal services in the context of the mark for which protection was sought (para. 115).

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T-727/16; REPOWER; Repower AG v EUIPO; Judgment of 21 February 2018; EU:T:2018:88; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Competence of the Boards, Lack of reasoning, Legal certainty, Legitimate expectations, Revocation of decision, Substantial procedural violation

FACTS: The EUTM proprietor was granted registration of the word mark REPOWER for goods and services in Classes 4, 9, 37, 39, 40 and 42. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) of Regulation (EC) No 207/2009 for all the goods and services. The CD partly upheld the application for invalidity, as it found that the term 'REPOWER' directly informed English-speaking consumers that the services in Classes 37 and 42 were intended to repair or replace the engine or the energy source of energy installations. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC. Considering that the contested decision was vitiated by a breach of the duty to state reasons, the BoA revoked its decision in order to analyse in further detail the distinctiveness and the descriptiveness of the sign for the contested goods and services. The EUTM proprietor filed a new action before the GC contesting the BoA's revocation decision, relying on four pleas in law: (i) lack of legal basis, (ii) lack of competence of the BoA, (iii) infringement of Article 80 of Regulation (EC) No 207/2009, the EUIPO's Guidelines and principles of good administration, legal certainty and res judicata and (iv) failure to state reasons.

SUBSTANCE: (i) ON THE LACK OF LEGAL BASIS: Article 80(1) of Regulation (EC) No 207/2009, stating that the Office must revoke a decision containing an obvious procedural error, was applicable to the decisions adopted until 1 October 2017 (para. 27). (ii) ON THE LACK OF COMPETENCE OF THE BoA: According to Article 80(3) EUTMR in conjunction with Article 65 EUTMR, the BoA is entitled to revoke its decisions (paras 38 and 41). The fact that an action contesting the decision has been lodged before the GC does not prevent the BoA from revoking it (para. 44). (iii) ON THE INFRINGEMENT OF ARTICLE 80 OF REGULATION (EC) No 207/2009, THE EUIPO'S GUIDELINES AND SEVERAL GENERAL PRINCIPLES OF LAW: A procedural error is an error having procedural consequences and not an error related to substantive issues (para. 55). A failure to state reasons has an impact on the substance of the decision and cannot be qualified as a procedural error within the meaning of Article 80(1) of Regulation (EC) No 207/2009 (para. 57). Therefore, the BoA could not revoke its decision on the basis of Article 80(1) of Regulation (EC) No 207/2009 (para. 59). Withdrawal of an unlawful administrative act is a general principle of law recognised by case-law. Since the BoA are administrative in nature, they can rely on this general principle to revoke their unlawful decisions (para. 61). Relying on this general principle is possible even where the withdrawal proceedings are already regulated by specific provisions in the law (para. 65). Therefore, the regulation of revocation in Article 80(1) of Regulation (EC) No 207/2009 does not preclude the application of Article 83 of Regulation (EC) No 207/2009 referring to general principles (para. 66). Retrospective

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withdrawal of an unlawful administrative act that has created individual rights is permissible, provided that the institution that adopted the act complies with the conditions relating to reasonable time limits and the legitimate expectations of beneficiaries of the act who have been entitled to rely on its lawfulness. Since the BoA did not describe either the contested goods and services or their characteristics, it failed to state why the sign was not descriptive (para. 78). Furthermore, the EUTM proprietor could not have legitimate expectations relying on the decision's lawfulness (para. 82). Withdrawal of an unlawful decision is compatible with the principle of good administration and legal certainty (paras 83-85). This general principle cannot infringe the principle of res judicata, since administrative decisions do not have a res judicata effect (para. 86). In order to respect the principle of good administration, the fact that the BoA should have based its revocation decision on this general principle and not on Article 80(1) of Regulation (EC) No 207/2009 would not lead to the annulment of the act, since that error did not affect the content of the decision (para. 91). (iv) ON THE FAILURE TO STATE REASONS: By stating that its decision should be revoked because it was vitiated by a failure to state reasons that constituted a manifest error of procedure, the BoA provided the reasons for its revocation decision (para. 98).

T-424/16; Footwear; Gifi Diffusion v EUIPO; Judgment of 14 March 2018; EU:T:2018:136; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Competence of the Boards, Lack of reasoning, Scope of proceedings, Statement of grounds

FACTS: The RCD proprietor was granted the registration of the design represented below as an RCD for products in Class 02-04 of the Locarno Classification (footwear). An application for invalidity was filed pursuant to Article 52 in conjunction with Article 25(1)(b) CDR and the invalidity applicant claimed lack of novelty by reason, inter alia, of prior disclosure of various earlier designs. It also claimed lack of individual character because the overall impression it produced was similar to that of designs D 1, D 18a, D 18b and D 19, as well as D 20-22. The Invalidity Division upheld the application for invalidity and declared the contested design invalid due to a lack of individual character in relation to the earlier Community design represented below (D 1). The RCD proprietor appealed and the BoA upheld the appeal, stating that the application for invalidity needed to be re-examined 'in its entirety': It nevertheless restricted its examination to a comparison between the contested design and designs D 1 to D 17, without expressing a view on designs D 18 to D 22. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 6 and (ii) infringement of Article 62 and Article 63(1) CDR.

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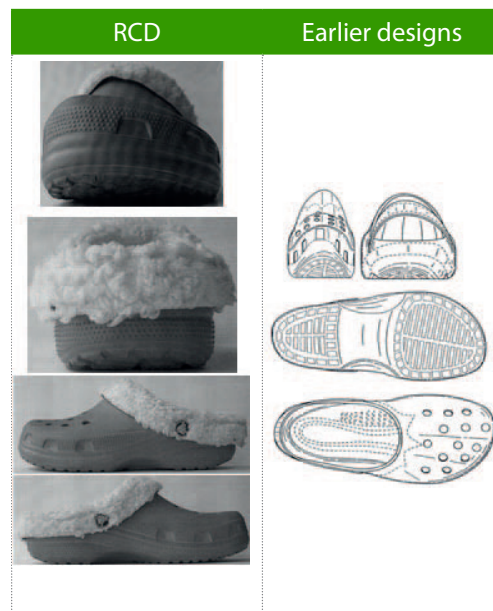
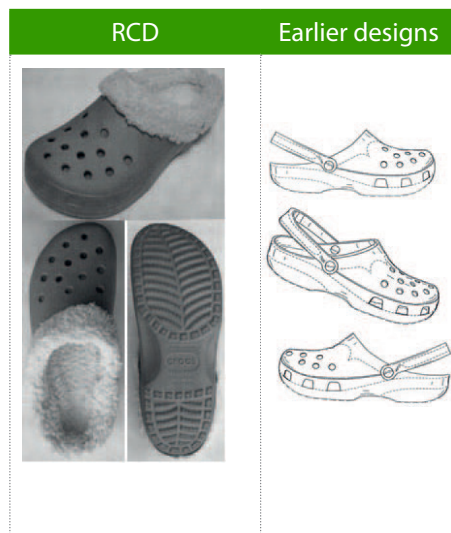
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SUBSTANCE: (i) The Office put forward two grounds for the first time: designs D 20 and D 22 were invoked at a later stage of the proceedings, and designs D 18a, D 18b and D 19 were not invoked with sufficient clarity and precision (para. 30). It is not possible, however, to give this additional statement of reasons for the first time before the Court (para. 34). In any event, assuming that the BoA considered that some designs had been invoked late it was required to give reasons for its decision in that regard (para. 38). Moreover, the application for a declaration

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of invalidity contained not only the indication and the reproduction of designs D 18a, D 18b and D 19, but also documents proving the existence of those earlier designs, in the form of screenshots and copies of journals. What is more, the invalidity applicant referred to them both in its observations and before the BoA (para. 39). (ii) The BoA was, in principle, required to examine the contested design in relation to every earlier design duly invoked, and the BoA itself recalled that it was required to re-examine the invalidity application in its entirety. In the absence of any statement of reasons in respect of designs D 18 to D 22, the BoA's decision lacked reasoning (paras 41-42). (iii) The BoA had exceeded the limits of its powers and it had gone beyond the facts, evidence and arguments submitted by the parties, since the 'party concerned' had never invoked a ground for invalidity alleging the lack of individual character of the contested design in relation to designs D 2 to D 17, but, on the contrary, had restricted that ground for invalidity to designs D 1 and D 18 to D 22 (para. 47). (iv) The ground for invalidity examined of its own motion by the BoA entailed the assessment of different legal criteria, concerning two separate grounds for invalidity. The BoA itself stated on several occasions that the [invalidity] applicant 'did not give any explanation as to why these clogs should produce the same overall impression as the contested [design]; without taking account of the fact that this absence of explanation was due precisely to the fact that the latter had not invoked that ground for invalidity (para. 48). (v) In the absence of any statement of reasons in the BoA's decision in relation to designs D 18 to D 22, the GC could not substitute its own reasoning for that of the BoA nor carry out an assessment on which

that BoA had not yet adopted a position (para. 51).

T-390/16; DONTORO dog friendship (fig.) / TORO; Grupo Osborne, SA v EUIPO; Judgment of 20 March 2018; EU:T:2018:156; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dissimilarity of the goods and services, Dominant element, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 18, 20, 25 and 35. An opposition based, inter alia, on the earlier EU word mark TORO registered for goods in Classes 18 and 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition as it found a LOC except for some of the services in Class 35. The OD's decision was appealed by the opponent and the BoA partially upheld the appeal. It found a LOC for goods covered by the contested mark in Class 25 due to their identity with the clothing, footwear, headgear; and belts covered by the earlier mark. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

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EUTM application

Earlier trade mark



TORO

**SUBSTANCE:** RELEVANT PUBLIC: The relevant public of the contested mark consisted of both the general public and professionals, with an average to high degree of attention. The relevant public of the earlier mark was the EU general public with an average degree of attention (para. 22). **COMPARISON OF THE GOODS AND SERVICES:** The goods covered by the earlier mark, namely, clothing and footwear, have a certain degree of similarity to the contested services of wholesaling, retailing and mail order sales of these goods because they are complementary, but differ in their nature, intended purpose and method of use (paras 29-33). **COMPARISON OF SIGNS:** (i) The signs have a certain degree of visual similarity since the element 'toro' is the most distinctive element of the contested mark as regards the Spanish- and Italian-speaking parts of the relevant public and it constitutes in itself the earlier mark (para. 45). (ii) The signs are phonetically similar to a low degree, since they coincide in the element 'toro', but they have a different pronunciation due to the expression 'dog friendship' in the contested mark. Moreover, the contested mark is composed of three words and six syllables, in contrast to the earlier mark, which consists of one word

and two syllables (paras 48 and 51). (iii) The signs are conceptually similar to an average or even low degree: although the common reference to the concept of a bull is evident, the figurative element representing a crown and the phrase 'dog friendship' in the contested mark convey a concept that is distant from the classic concept of a bull as an animal or as a family name (paras 55-56). **NO LOC:** The visual, phonetic and conceptual differences between the signs were sufficient for the services covered by the contested mark not to appear in the eyes of the relevant public as originating from the undertaking that was the proprietor of the earlier mark (para. 60).

T-346/17; Guidego what to do next (fig.) / GUIDIGO; Hotelbeds Spain SL v EUIPO; Judgment of 13 March 2018; EU:T:2018:134; Language of the case: EN

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Phonetic similarity, Visual similarity

**FACTS:** The EUTM applicant sought to register the figurative sign depicted below for services in Classes 39, 41 and 43. An opposition based on the earlier figurative mark GUIDIGO, depicted below, for services in Classes 39 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in its entirety, on the ground that there was a LOC. The applicant filed a notice of appeal against the OD's decision. The BoA dismissed the appeal and confirmed that there was a LOC; it confirmed the findings of the OD that the services were identical or similar; regarding the

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comparison of the signs, it found that the word element 'guidego' was the most distinctive element in the trade mark for which protection was sought; that the signs at issue were visually similar to an average degree; that, for at least the French-, Finnish- and Spanish-speaking part of the relevant public, the signs were phonetically highly similar; and that the conceptual comparison was neutral. The EUTM applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade mark
	GUIDIGO

SUBSTANCE: RELEVANT PUBLIC: the relevant public was the general public in the European Union with an average degree of attention (para. 23). COMPARISON OF THE SERVICES: the services were partly identical and partly similar (para. 24). COMPARISON OF THE SIGNS: DOMINANT AND DISTINCTIVE ELEMENT: the mark for which protection was sought consists of the word element 'guidego', which is the most distinctive element, written in green and dark blue, the word sequence 'what to do next', written below in a smaller dark blue typeface, and a figurative element placed to the left consisting of a dark blue circle in which a green shape of a water drop is placed horizontally (para. 27). The element 'guidego' is the dominant element of that sign because of its size and its position (para. 28). The dominant element of the sign applied for is a juxtaposition

of two words, and the use of different colours makes it possible to perceive them, as well as the space between the two words (para. 32). VISUAL COMPARISON: the signs are similar to the extent that they coincide in six out of seven letters and differ only in the central vowel. Similarly, the degree of stylisation of the word element and the additional elements of the mark for which protection was sought do not counteract the similarities between the signs, as a result of which they are similar to an average degree (para. 37). The degree of similarity exists regardless of whether the element 'guidego' is perceived as two separate words or as a single element (para. 38). PHONETIC COMPARISON: the elements 'guidigo' and 'guidego' are not existing words and will be pronounced almost identically by the French-, Finnish- and Spanish-speaking public, therefore they have a high degree of phonetic similarity for at least that part of the relevant public (para. 39). Regarding the words 'what to do next', they will probably not be pronounced because of the small typeface and the tendency of consumers to shorten long signs (para. 42). Even if all members of the general public of the European Union recognise the element 'guidego' as the juxtaposition of two English words, it cannot be argued that the whole of that public will pronounce that element according to the rules of English pronunciation (para. 45). The space between the two words does not affect their pronunciation (para. 47). CONCEPTUAL COMPARISON: it was neutral since neither 'guidego' nor 'guidigo' had any meaning for the relevant public. The BoA noted that the element 'guidego' consisted of the English words 'guide' and 'go', but found that, considered as a whole, it was devoid of any meaning for the non-English-speaking

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part of the relevant public (paras 48, 50-51). LOC: there was a LOC pursuant to Article 8(1)(b) EUTMR, because the obvious similarity of the signs as regards the elements 'guidigo' and 'guidego' was sufficient to induce the average consumer to believe that the respective services have the same or a related commercial origin (para. 61). Moreover, the services covered by the marks at issue are partly identical and partly similar. The signs at issue have an average degree of visual similarity, a high degree of phonetic similarity for at least part of the relevant public and conceptual differences only for the English-speaking part of the relevant public and for consumers who have a basic knowledge of English (para. 62).

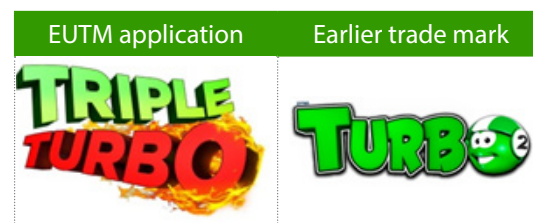
T-210/17; TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.); International Gaming Projects Ltd v EUIPO; Judgment of 22 February 2018; EU:T:2018:91; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Conceptual similarity, Likelihood of confusion, Visual dissimilarity

FACTS: The EUTM applicant sought to register the figurative sign represented below for goods in Classes 9 and 28. An opposition based on the earlier figurative mark represented below for the abovementioned goods was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition insofar as it found no LOC. The opponent appealed the OD's decision and the BoA annulled the OD's decision because it found that (i) the relevant public was the general public composed of

moderately attentive and informed consumers, as well as professionals, whose degree of attention was higher than that of the general public; (ii) the goods covered by the mark for which protection was sought and the earlier mark were identical or similar; (iii) the signs were visually, phonetically and conceptually similar. The EUTM applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.



SUBSTANCE: RELEVANT PUBLIC: the relevant public was the general public, composed of moderately attentive and informed consumers, as well as professionals, whose degree of attention is higher than that of the general public (para. 17). COMPARISON OF THE GOODS: the goods covered are identical or similar (para. 20). COMPARISON OF THE SIGNS: the word 'turbo' and the figurative element of a smiling face wearing a racing helmet is the most distinctive and dominant element of the earlier mark (para. 41) while in the contested mark the words 'triple' and 'turbo' dominate (para. 47). Even if both marks have the word 'turbo', with a weak distinctive character, it is not considered dominant. The BoA incorrectly concluded that merely the presence of the word 'turbo' could imply a visual similarity (para. 51). The signs at issue have

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differences: (i) the fonts and the colours of the word 'turbo' are different; (ii) the earlier mark has a verbal element that is well aligned, whereas the contested mark has two verbal elements that are curved; (iii) the figurative element (the face) for the earlier mark; (iv) the verbal element 'triple' in the contested mark (para. 52). The colour green is used in the word 'turbo' in the earlier mark and in the word 'triple' in the contested mark (para. 53). The BoA incorrectly found the phonetic similarity relevant, as the word 'triple' is as significant as the word 'turbo'; the number of syllables in the contested mark is twice that of the earlier mark; and the word 'triple' is the initial part of the sign, to which the consumer will pay more attention (para. 59). Finally, the BoA was right in finding a conceptual similarity, as both signs refer to the original meaning of the notion of 'turbo' and they both refer to the speed of motor vehicles (paras 63-64). As the signs at issue only coincide in the term 'TURBO', which has a low distinctive character, the graphic differences will dominate the global impression of the signs in conflict and will offset the similarity resulting from the common term 'TURBO'. There was no LOC (paras 72-76).

T-1/17; La Mafia SE SIENTA A LA MESA (fig.); La Mafia Franchises, SL v EUIPO; Judgment of 15 March 2018; EU:T:2018:146; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Contrary to public policy or principles of morality

FACTS: The EUTM proprietor was granted registration of

the figurative mark represented below as an EUTM for goods and services in Classes 25, 35 and 43. An application for invalidity was filed pursuant to Article 7(1)(f) of Regulation No 207/2009. The CD upheld the application for a declaration of invalidity and the proprietor appealed against the CD's decision. The BoA dismissed the appeal, as it confirmed that the contested mark was contrary to public policy. The proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 52(1) (a) of Regulation No 207/2009 (now Article 59(1)(a) EUTMR) in conjunction with Article 7(1)(f) of that Regulation.

### EUTM



SUBSTANCE: (i) The word element 'la Mafia' is the dominant element in the contested mark on account of its size and central position in the contested mark (paras 31-32). (ii) 'La Mafia' refers to a criminal organisation that resorts to

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intimidation, physical violence and murder in carrying out its activities. Such activities breach the values on which the EU is founded (especially respect for human dignity and freedom). Therefore, 'la Mafia' would manifestly bring to mind, for the relevant public, the name of a criminal organisation responsible for particularly serious breaches of public policy (paras 34-38). (iii) Moreover, the fact that there are many books and films (The Godfather) on the Mafia in no way alters the perception of the harm caused by that organisation (para. 43). The red rose could be perceived by a large part of the relevant public as the symbol for love or harmony, in contrast with the violence that characterises the Mafia's activities (para. 44). That contrast is accentuated by the sentence 'se sienta a la mesa' in the contested mark. That sentence means 'takes a seat at the table' in Spanish, and may be perceived by a large part of the public as referring to the idea of sharing a meal. Thus, the association of the Mafia with the ideas of conviviality and relaxation may trivialise the illicit activities of that criminal organisation (paras 45-46). Consequently, the GC concluded that the contested mark refers to a criminal organisation, conveys a globally positive image of that organisation and trivialises the serious harm caused by that organisation to the fundamental values of the EU. It was therefore likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds, and must therefore be declared invalid (para. 48).

T-6/17; BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al.; Equivalenza Manufactory, SL v EUIPO; Judgment of

7 March 2018; EU:T:2018:119; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Coexistence of trade marks, Common element, Conceptual dissimilarity, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The EUTM applicant sought to register the figurative sign represented below for the goods in Class 3 (perfumery). An opposition based on the earlier trade mark represented below was filed pursuant to Article 8(1)(b) EUTMR designating Belgium, Bulgaria, the Czech Republic, Denmark, Estonia, Greece, Croatia, Latvia, Lithuania, Luxembourg, Hungary, the Netherlands, Austria, Poland, Portugal, Romania, Slovenia and Slovakia for the abovementioned goods in Class 3 and for those with the following description: cologne, deodorants for personal use (perfume), perfumes. The OD upheld the opposition because of the existence of a LOC in the minds of the relevant public in the Czech Republic, Hungary, Poland and Slovenia. The applicant appealed against the OD's decision, which was dismissed by the BoA. It found that the relevant public was the general public with an average degree of attention; that the goods were identical; that the signs were visually and phonetically similar to an average degree and that there were conceptual differences; that the applicant had not demonstrated that other marks containing the word 'label' coexisted on the market without any risk of LOC; and concluded that there was a LOC. The EUTM applicant filed an action before the GC, relying on

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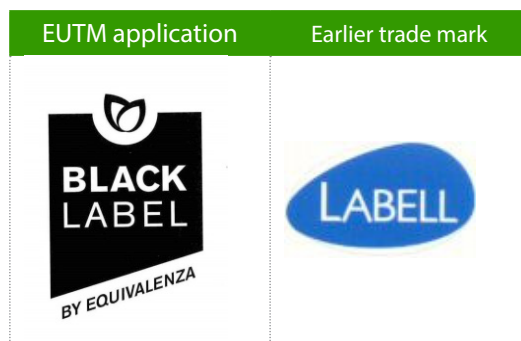
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one plea in law: (i) infringement of Article 8(1)(b) EUTMR.



**SUBSTANCE: RELEVANT PUBLIC:** the relevant territory was the Czech Republic, Hungary, Poland and Slovenia and the relevant public was composed of the general public with an average degree of attention. The parties did not challenge these findings (para. 17). **COMPARISON OF THE GOODS:** the goods are identical; the parties did not challenge this finding either (para. 18). **COMPARISON OF THE SIGNS:** the contested mark is composed of four words ('black', 'label', 'by' and 'equivalenza'), while the earlier mark has only one ('label') (para. 30). Moreover, the black quadrilateral geometric shape and the two small stylised leaves present in the mark applied for are very different from the blue oval shape shown in the earlier mark. The blue colour of the oval shape is visible and bright enough not to be confused with the black colour of the contested mark (para. 31). Therefore, the signs at issue are visually dissimilar (para. 32) and the BoA was incorrect in finding a visual similarity between the signs. The signs at issue are phonetically

similar to an average degree as the words 'label' and 'label' will be pronounced the same way (para. 36); and the other words may not be pronounced because of their position at the end of the sign (para. 38). Conceptually, the signs are dissimilar to the limited extent that the words 'black' and 'by equivalenza' are present in the contested mark. 'Black' is a basic English word understood by the public and qualifies the word 'label', which has no meaning for the relevant public, whereas the words 'by equivalenza' indicate that the goods originate from the EUTM applicant, but do not distinguish the marks because the earlier mark does not indicate a different origin (paras 40-45). The visual aspect of the signs at issue is more important than the phonetic and conceptual aspects of those signs (para. 52). The word and figurative elements of the signs have numerous and significant visual differences, therefore the BoA should have considered that the signs were visually dissimilar (para. 53). Moreover, there is a conceptual difference between the signs, due to the existence of the elements 'black' and 'by equivalenza' (para. 54). Therefore, because of the differences between the signs and notwithstanding the phonetic similarity to an average degree, the signs at issue are, in the overall assessment, not similar pursuant to Article 8(1)(b) EUTMR (para. 55). There was no LOC pursuant to Article 8(1)(b) EUTMR (para. 56).

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EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). For best results, please use either the Mozilla Firefox or Google Chrome browsers.

[13/03/2018, R 2415/2017-5, Znak pozycyjny w postaci czarnych i żółtych elementów na taśmie przenośnika](#)

#### EUTM application



Result: Decision annulled.

Keywords: Position mark, Distinctive element, Specialised public.

Norms: Article 7(1)(b) EUTMR.

Facts: The examiner refused the application owing to its lack of distinctive character because, in particular, the public targeted would perceive the colours used as only having a decorative function and/or as giving a warning. The sign applied, a position mark,



consisted of black and yellow elements on a conveyor belt. The goods (belts for conveyors; conveyor belts; belts for belt conveyors) covered by the sign applied for were intended for a limited group of specialised consumers, characterised by a high level of attention.

Substance: The goods at issue usually do not have any decorative or coloured element and the customer is not accustomed to these elements. Taking into account the specific characteristics of the goods, both are unusual. The position mark in itself is unprecedented and enjoys distinctive character, within the meaning of Article 7(1)(b) EUTMR (§ 19-20, 23, 25, 31).

[19/03/2018, R 173/2017-5, Hudson](#)

Result: Decision confirmed

Keywords: Geographical origin, Res judicata.

Norms: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(1)(g) EUTMR, Article 59(1)(a) EUTMR, Article 63(3) EUTMR.

Facts: An invalidity application was filed against the registered word mark 'Hudson'.

Substance: The invalidity applicant has failed to substantiate its claim that the term 'Hudson' would be understood by the European consumer to indicate the geographical origin of the goods, namely clothing items in respect of which the mark is registered. The BoA confirms the opinion of the

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Cancellation Division that the mark is registrable.

[21/02/2018, R 2305/2017-5, CRU CÔTES DU RHÔNE VACQUEYRAS \(fig.\)](#)

### EUTM application



Result: Decision confirmed.

Keywords: Figurative trade mark, Deceptive element, Geographical origin.

Norms: Article 7(1)(j) EUTMR.

Facts: The examiner refused the sign on the basis of Article 7(1)(j) EUTMR. New Article 7(1)(j) EUTMR (Regulation (EU) No 2017/2001) provides that 'trade marks which are excluded from registration pursuant to Union legislation or national law or international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications' shall not be registered.

Substance: The Board confirms that the EUTM applied for falls under the prohibition of Article 7(1)(j) EUTMR (§ 9-10). In addition, the Board notes that because of the presence of the words 'CÔTES DU RHÔNE' and 'VACQUEYRAS', which are two designations of origin and geographical indications protected in the EU, pursuant to Regulation (EU) No 1308/2013, the EUTM applied for cannot be accepted for registration, since the sign can create potential confusion in the minds of average European consumers who wish to buy wine with a specific protected origin, whereas this product actually complies with the specification of another designation of origin and geographical indication, even if this indication is in the geographical area of the other one (§ 11, 17).

Therefore, the EUTM applied for is rejected in accordance with Article 7(1)(j) EUTMR, in combination with Article 102(1) and Article 107 of Regulation (EU) No 1308/2013.

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15/02/2017, R 2201/2017-4, DOMAINE FLORIAN KTHMA  
ΦΛΟΡΙΑΝ (fig.) / FLORIAN

EUTM applied for	Earlier international registrations
	FLORIAN

Result: Decision confirmed.

Keywords: Admissibility, New submission on appeal, Substantiation of earlier right.



Norms: Rule 19(1) CTMIR, Rule 19(2) CTMIR, Rule 20 CTMIR, Article 27(4) EUTMDR.

Facts: An opposition was submitted against the EUTM applied for as represented above.

Substance: The earlier right on which the opposition was based expired during the time-limit for its substantiation. Despite the Office inviting the opponent to submit evidence as regards the substantiation of the

earlier right, no renewal certificate was submitted within the time-limit set by the first-instance department (§ 17). The renewal document filed for the first time before the Boards of Appeal by the opponent is not supplementary evidence and cannot be taken into account (§ 18-20). The appeal is dismissed, the contested decision is confirmed and the opposition is rejected.

06/03/2018, R 954/2017-2, O LOTTERY KENO (fig.) / KENO et al.

EUTM applied for	Earlier EUTM
	<p>KENO KUNG KENO</p> 

Result: Decision partially annulled.

Keywords: Substantial procedural violation, Reimbursement, Reputation, Proof of use.

Norms: Article 8(1)(b) EUTMR, Article 8(5) EUTMR.

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Facts: All the contested goods and services were identical to those of the earlier mark. The opposition was rejected by the Opposition Division which concluded that (i) there was no likelihood of confusion between the contested sign and Swedish registration No 339 504 and (ii) that the opponent failed to prove that its trade marks had a reputation.

Substance: A comparison between the contested sign and the other marks on which the opposition is based would lead to the same outcome. Regarding the proof of use, the Opposition Division decided that '[g]iven that the opposition is not well founded under Article 8(1) EUTMR, it is unnecessary to examine the evidence of use filed by the opponent' (§ 36).

As regards the proof of use filed by the opponent, the Board is of the opinion that, under the circumstances of the case at hand, it should have been examined prior to carrying out the final assessment on the risk of confusion. This is because the signs in conflict were found to be similar at least to a very low degree, rather than clearly dissimilar, by the Opposition Division. In such a case, the request for proof of genuine use by the applicant adds a preliminary issue to the opposition proceedings and in that sense changes their content, in so far as it constitutes a new specific claim linked to factual and legal considerations which are separate from those which gave rise to the opposition to the registration of the EUTM (§ 37).

The omission in examining the proof of use constitutes a substantial procedural violation (§ 39).

The Board remits the case back to the first instance for

the assessment of the proof of use and the likelihood of confusion (§ 40).

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