Alicante News

Up to date information on IP and EUIPO-related matters

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Decmeber 2016

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The revised Guidelines for Examination of EU Trade Marks and Registered Community Designs

On 12 December 2016, the Executive Director of the EUIPO signed the Decision adopting the first part of the revised Office Guidelines, corresponding to the so-called 'Work Package 1/2017', which received a favourable opinion from the EUIPO's Management Board in November.

The Guidelines will enter into force on 01 February 2017.

The new Guidelines will be published on the EUIPO website on the Current trade mark practice and Current design practice pages.

The Guidelines have been once more fully updated with case law from the Court of Justice of the European Union and from the EUIPO's Boards of Appeal.

The EUIPO Guidelines are the main point of reference for users of the European Union trade mark and design systems, as well as professional advisors who want to make sure they have the latest information on the Office's examination processes.

They are revised on a yearly basis, in a cyclical and open process which incorporates our stakeholders' feedback, and constitute the single document of reference for EUIPO's practice.

The process of revision of the Guidelines began in 2013, under the Office's Strategic Plan 2011-2016.

With input from EU national and regional IP offices and users, the Guidelines were thoroughly updated and revised. The first set of Guidelines was put into use in the Office in February 2014, alongside the former Manual of Trade Mark Practice.

On 1 August 2014, the Manual was phased out, with one single set of Guidelines made available to users.

This new set of the revised Guidelines will further increase consistency and predictability for users, and are thus aligned with the goals of the EUIPO's Strategic Plan. They are accessible in English, French, German, Italian and Spanish.

The Guidelines have been drawn up to reflect Office practice in the most frequent scenarios. They contain only general instructions, which have to be adapted to the particularities of a case.

This edition of Alicante News also features articles highlighting the main changes in the Guidelines.

These changes will also be discussed during a webinar, available to all internal and external users, which will take place on 10 January 2017. EUIPO experts will discuss the revisions to the Guidelines across each area, and take questions from participants. The webinar starts at 10:00 CET and runs until 12:00.

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The James Nurton Interview

Robin Edman, Chief Executive, SVID and Chairman of the DesignEuropa Awards Jury

What is your background?

I realised at the age of about 15 that I wanted to become a designer. My first design job was in a design consultancy in Stockholm after high school and before doing my military service. Once that was completed I went to the US to get my degree in industrial design at the Rhode Island School of Design.

Four years later, I was back in Sweden again. I joined Electrolux as a designer, and in parallel, I started my own design consultancy, which I ran for nine years. Electrolux quickly grew as a group and as a worldwide brand, and in 1989 I moved back to the US to create and head up the company's North American design department. And in the fall of 2001, after nine years in the US, and 20 years with Electrolux, I joined the Swedish Industrial Design Foundation (SVID) as chief executive.

Robin Edman

If we look back 30 years, to the start of the Foundation's history, we can see that its aim back then was to match designers with companies that needed development, so that their businesses and their designs could blossom. That still holds true; but today the scope is so much broader. And our intention today remains the same as it always has been: to support the buying side in the market. We are a research foundation, rather than a member organisation, and we promote the use of design methodology to help private companies, as well as the public sector, to renew and grow. We work with every type of enterprise and organisation; from big to small companies, municipalities and government authorities, to integrate design into their processes so that they will have new and better tools to be innovative.

As well as running the Foundation, I am president of BEDA, which is a member organisation for professional and promotional design associations all over Europe.

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How has design changed in that time?

Design has become more understood and people are more aware of it. The spectrum of design has broadened as well – 30 years ago no-one talked about service design, for example. But today, it is a crucial discipline in terms of meeting the needs of the end user.

Design has also changed in that it is now used across the board; whether you're developing an insurance agency, a bank service or doing the interior of a jetliner. Another recent development in the marketplace is that big companies like McKinsey and Accenture are acquiring design agencies and design/architecture firms – they grasp that there is something in design that is changing their routes to market, and they want to be able to have that tool at their disposal to help their clients innovate.

Today, design is also a lot more interactive with a lot more people involved. Designers may be the spider at the centre of the web, but what would have been considered traditional design tasks are now performed by a lot more people in different professions.

One great example of the type of change that has occurred is the iPhone, which was introduced in 2007 – less than 10 years ago. Now, our attention span when using smartphones, tablets and laptops has been reduced to a few seconds, which is the absolute maximum amount of time that you are prepared to give to see if something works for you. If it's well designed and everything works, you will stay with it and explore it further: But if it isn't, then you go off to something new, because now everything revolves around touch points and user experiences – things need to be designed so that people want to use them. Of course, there is an aesthetic element involved, just as there has always been, but nowadays there is a much stronger cognitive and analytical process that underpins the development of a product. To use design methodology is to have a user-centric focus and to be prepared to test numerous prototypes as you refine the design. That's the moment in which you get it right!

Lifestyle has also become more important, to the extent that products must now satisfy your functional, social and emotional needs. Do they work, you ask yourself? Do you enjoy using them? Are these products socially acceptable, wherever you are, and however you want to live your life? A good example of that philosophy is running shoes. Some years ago, you didn't have that big of a choice but today there are thousands of shoes to choose from that will suit your own personal preferences.

Is the way that designs are protected in Europe adequate given these changes?

There are two ways of looking at this issue. I hear some companies say: of course, we need to protect

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what we do. Others say: you've just got to be faster and better, because whatever you do people will copy you anyway. So, I think there needs to be a raised awareness – and it can always be increased – in terms of what protection can do for businesses and designers and how easy it is to achieve it.

One of the biggest challenges for the local IP offices in Europe is to educate and inform people about the different means of protection available, what those means of protection cover, and how easy it is to file. In a new, disruptive and changing businesses topography, SMEs and start-ups need to be aware of the options available and how the protection that's on offer can make them more competitive.

What kind of work does the Foundation do?

Our main processes are education, advice and development. The projects and activities we have been involved in are often situations in which, once the companies or the public administration in question started using design, they quickly realised they would never have entered the market or improved what they had to offer in quite the same way, or with the same success, without the benefit of design and user focus.

There are many examples. Take digital solutions for government authorities as one case study. Preparing for the move of an entire mining town in Swedish Lapland as another. Or there's design integration into young med-tech companies, product innovation in SMEs, place innovation for destinations or educating design innovation coaches to increase creativity in Sweden's municipalities. All in all, there's a broad spectrum of opportunities.

We work to prepare our clients for a better future. Often organisations have a pre-conceived idea of what they want, and they work to get it through the system without prototyping it and testing it with their users. When did you last hear about anyone prototyping a new tax system? There's a huge potential to test your services before you launch, iterate, improve and try again - just like you would with a new piece of machinery or a coffee cup.

How did you approach the DesignEuropa Awards?

There were about 450 applications and nominations in total. The EUIPO had shortlisted 10 candidates for industry, 10 small companies and five for lifetime achievement. Before the jury deliberations started I had a lot of conversations with the office in Alicante about how the process could work.

There are many ways of approaching a challenge like this, and a very common way to do it is for all the judges is to select and rank their favourites. But we inverted that process to give all the candidates

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a better chance; we actually eliminated candidates from the bottom. When the jury was asked which candidate they would like to take off the list first, nobody wanted to remove anyone. The pressure was very much on at that stage! Then, someone suddenly said: "I think I can take X off, does anyone object?" From that point on it was easier, and we got down to four finalists fairly quickly, which was our first goal.

Then you have to follow the same process – working from the bottom up – to find the winner, and that's when the discussions start in earnest, and the jury members really have to defend their choices. As a juror, you are defending the finalists you want to keep. Eventually, depending on how the process goes, you might get to a vote at the very end.

The intention was to be in total agreement, on time and deliver a great set of finalists and winners.

Everybody was happy with the result, and for me it was a great success.

Is there anything you would do differently?

It would have been good to have had the physical objects in the judging room, where possible. We had a full dossier on each of the candidates including economic and market performance of the designs, IP and design management, as well as boards and PowerPoint presentations, but not the physical objects. That affects the outcome – sometimes when you see the products in real life, you can see they look really good, or sometimes the opposite. The videos at the award ceremony were great and gave a lot of information; of course we did not have them when we were judging but that gives you an idea of how complex the judging process is!

Have you been involved in judging many awards?

Yes, for many years – the two big design awards in Sweden, the world famous Red Dot award out of Germany, and others in Australia, the US, Slovenia, Spain, France and elsewhere.

Some design consultancies apply for lots of awards as a way to win more clients. For companies, or even for public organisations, it shows you did something right, and you get recognition for your efforts which will improve your market share or user satisfaction. Also, consumers tend to view products and services that have won awards in a different way.

But it's even better if awards can inspire companies and designers to become more innovative and to create new or improved products and services. For example, if you start giving awards to non-fossil fuel cars, that will, over time, lead to a shift in the market, and an eventual environmental benefit for all.

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If it's done the right way, the media attention can be enormous and can have a huge impact on the organisation. But it needs to be something interesting that people want to read or hear about. If you go to the press with an article about patents, it may not be high on the list. If you talk about market shift, increased profits or – for example – some great improvements in a school being given an award, then it touches you somehow, and resonates with you. You've got to take it out of the library, so to speak, apply it to real life, and make it meaningful. Products, processes, strategies and services can all be designed – you just have to make sure people see the benefits and understand how design makes a difference in their lives.

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WP1 2017 review and changes of practice

The EUIPO's practices are reflected in the Guidelines on Trade Mark Practice and the Guidelines on Designs practice. The Guidelines are revised annually in an open and cyclical process, which is split into two separate 'work packages' (WP1 and WP2).

The WP1 2017 review process has now been completed by the Knowledge Circles, in consultation with the internal and external stakeholders, and adopted by the President in Decision EX-16-7. **They will enter into force on 01/02/2017.**

Parts of the Guidelines contained in WP1 2017

EUROPEAN UNION TRADE MARK:

Editor's note and general introduction

WP1

Part A: General Rules
Section 3, Payment of Fees, Costs and Charges
Section 5, Professional Representation

Part B: Examination
Section 2, Formalities
Section 4, Absolute Grounds for Refusal
- Chapter 1, General Principles
- Chapter 2, EUTM Definition (Article 7(1)(a) EUTMR)
- Chapter 3, Non-distinctive Trade Marks (Article 7(1)(b) EUTMR)
- Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR)
- Chapter 5, Customary Signs or Indications (Article 7(1)(d) EUTMR)
- Chapter 6, Shapes or other Characteristics with an Essentially Technical Function, Substantial Value or Resulting from the Nature of the Goods (Article 7(1)(e) EUTMR)
- Chapter 7, Trade Marks Contrary to Public Policy and Acceptable Principles of Morality (Article 7(1)(f) EUTMR)
- Chapter 9, Trade Marks in Conflict with Flags and other Symbols (Article 7(1)(h) and (i) EUTMR)
- Chapter 14, Acquired Distinctiveness Through Use (Article 7(3) EUTMR)

Part C: Opposition
Section 0, Introduction
Section 1, Procedural Matters
Section 2, Double Identity and Likelihood of Confusion
- Chapter 1, General Principles
- Chapter 2, Comparison of Goods and Services
- Chapter 3, Relevant Public and Degree of Attention

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Chapter 4, Comparison of Signs
Chapter 5, Distinctiveness of the Earlier Mark
Chapter 6, Other Factors
Chapter 7, Global Assessment
Section 6, Proof of Use

Part D: Cancellation
Section 1, Cancellation Proceedings

Part E: Register Operations
Section 2, Conversion
Section 4, Renewal
Section 5, Inspection of Files
Section 6, Other Entries in the Register
Chapter 1, Counterclaims

REGISTERED COMMUNITY DESIGN
Examination of Design Invalidity Applications

Scope of the Revision

All the changes implemented appear in track changes so that users can easily see what has been updated. Furthermore, we are now, under the Project 'New Generation Guidelines', working towards offering a more user-friendly way of identifying changes in the future.

In general, the changes concern modifications to the format and structure, updates to case-law and cross references, corrections of errors and clarifications of wording. There are also a few changes of practice, which are described below.

Part A, General Rules, Section 3, Payment of Fees, Costs and Charges

Throughout the whole document, legal references to RCDs have been inserted where they were missing.

Paragraph 2.1.2, Details that must accompany the payment
A reference has been added to the payment identifier code in applications or renewals by electronic means.

Paragraph 4.3, Payment by current account
The text has been amended to clarify that the account holder can ask for an immediate debit of the payment.

Paragraph 5, Refund of fees
A general clarification of practice has been inserted. Where an action is subject to a fee, the refund of the fee following the withdrawal of the request should be dealt with in the same way in all cases, unless specifically mentioned otherwise in the Regulations. Refunds should not be at the Office's discretion or depend on whether the Office has started working on the request or not.

New text has been inserted. As a general rule, if a declaration that is subject to the payment of a fee is withdrawn before or on the day the payment is deemed to have been made, the fee will be refunded.

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Part A, General Rules, Section 5, Professional Representation

Throughout the whole document, legal references to RCDs have been inserted where they were missing.

Two paragraphs have been inserted to clarify that the content of Annex 1 and Annex 2 is based on information provided by the national industrial property offices.

Paragraph 2.4.1 (page 13), Employees acting for their employer
Clarification on authorisation (for employees). The fact that authorisation is mandatory for RCDs, but merely optional for EUTMs, has been clearly highlighted.

Paragraph 2.5 (page 15), Legal representation and signature
Clarification has been inserted that a signature must be accompanied by the name of the signatory and an indication of their role or position in the company.

Paragraph 4 (page 21), Communication with representatives
Clarification of the practice for appointing a common representative: the Office will consider not merely the first representative named in the form, but the first one named in the form that is **in the EEA**.

Annexes
The information on terminology or entitlements for some of the countries has been updated on request.

Part B: Examination, Section 2: Examination of formalities

CHANGE OF PRACTICE

Paragraph 7.5, Restriction of goods and services
In order to align the practices of dealing with limitations and withdrawals during pre-registration proceedings, the part on the restriction of goods and services has been deleted from the section on Formalities. Instead, a cross reference has been added to 'Part B, Examination, Section 1, Proceedings', paragraph 5.2 of which states that restrictions should follow the same rules as withdrawals and paragraph 5.1 of which states that a declaration of withdrawal can be made in the first or second language. Previously, the Office only accepted limitations during examination if they were in one of the five Office languages, whereas withdrawals are accepted in the first and second language (as during opposition proceedings).

Paragraph 10.3, Three-dimensional marks
The practice for three-dimensional marks received by e-filing and those received on paper has been aligned. The Guidelines have been modified to reflect that, in both cases, where more than six perspectives are submitted on one single sheet of

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A4 or JPEG (paper filing and e-filing, respectively), a deficiency will be raised, and the user will be invited to remove some of the perspectives in order to overcome the objection, provided that this does not substantially change the trade mark as filed. The applicants cannot, therefore, take such action to overcome a deficiency where one of the representations depicts a different object or a manipulated view of the mark. Previously, if an e-filing of a three-dimensional mark contained more perspectives than was allowed, the mark was refused in its entirety.

In addition, new examples have been included in the lists of acceptable and non-acceptable representations of three-dimensional marks (for formalities' purposes).

CLARIFICATION OF PRACTICE

Paragraph 4.1, Filing date requirements
The last paragraph of this section has been deleted as it concerned the examination of formalities of three-dimensional marks, which is explained later in paragraph 10.3 and does not affect the filing date.

Paragraph 4.1.2, Request
Although the Office strongly recommends that EUTM applications are filed using the e-filing form, clarification has been added that forms in PDF format are also available on request.

Paragraph 5.2, Specific formality deficiency for e-filing
New text has been added to explain the option, when filing applications electronically, of selecting pre-approved Harmonised Database terms to build the list of goods and services, and the benefits thereof One benefit is that such terms will automatically be accepted for classification purposes. Moreover, as explained in paragraph 7.1, such terms do not need to be translated into the second language.

Paragraph 10.1, Word marks
The terms 'keyboard signs' and 'punctuation marks' have been replaced by 'standard typographic characters' in order to avoid any possible misunderstanding that signs that can be inserted by using a keyboard code/combination (e.g. 'smileys') are included.

Paragraph 12, Indication of colour
An example of an acceptable colour claim has been added.

Paragraph 15.7.2, Comparison of the marks
An introductory paragraph has been inserted before the list of examples of acceptable/unacceptable priority claims. This makes clearer what is to be considered as 'identity' when examining priority claims.

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Paragraph 17.6, Examples of seniority claims
An example of an unacceptable seniority claim has been added.

Part B, Examination, Section 4, Absolute Grounds for Refusal

The overall structure of the AG Guidelines has not changed. However, the different chapters have now become individual parts of the Guidelines. During this last revision cycle, the following chapters were reviewed:

Chapter 1, General Principles
Chapter 2, EUTM Definition (Article 7(1)(a) EUTMR)
Chapter 3, Non-distinctive Trade Marks (Article 7(1)(b) EUTMR)
Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR)
Chapter 5, Customary Signs or Indications (Article 7(1)(d) EUTMR)
Chapter 6, Shapes or other Characteristics with an Essentially Technical Function, Substantial Value or Resulting from the Nature of the Goods (Article 7(1)(e) EUTMR)
Chapter 7, Trade Marks Contrary to Public Policy and Acceptable Principles of Morality (Article 7(1)(f) EUTMR)
Chapter 9, Trade Marks in Conflict with Flags and other Symbols (Article 7(1)(h) and (i) EUTMR)
Chapter 14, Acquired Distinctiveness Through Use (Article 7(3) EUTMR)

The Office has not implemented any change in Chapter 2, EUTM Definition (Article 7(1)(a) EUTMR). This section will be substantially updated in the next version of the Guidelines in the light of the entry into force on 01/10/2017 of the Implementing and Delegated Acts and the deletion of the graphical representation requirement in Article 4 EUTMR.

No drastic changes of practice have been introduced into the other parts of the Guidelines, but the overall quality of the text has been improved and new examples and case–law have been added. The following changes can be highlighted.

Chapter 3, Article 7(1)(b) EUTMR
A definition has been provided for 'commonplace figurative elements' on the basis of CP3 practice. Moreover, new examples of pictograms and accepted product shapes, product packaging, pattern marks and position marks have been added.

Chapter 4, Article 7(1)(c) EUTMR
Regarding language issues, the Guidelines, on the basis of the case-law of the Courts, elaborate on cases where the relevant public can understand foreign terms from other EU language(s). Further guidance has also been included on the assessment of names of colours and on the assessment of names of banks, newspapers and airports. Finally, the Guidelines now include real examples of Office practice applying the principles agreed within the framework of the CP3 Practice.

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The part on plant variety names has been deleted since the general rules under Article 7(1)(c) EUTMR apply to objections to non-registered PVDs (registered PVDs are objected to under Article 7(1)(m) EUTMR).

Chapter 5, Article 7(1)(d) EUTMR
The part on plant variety names has been deleted since the general rules under Article 7(1)(d) apply to objections to non-registered PVDs (registered PVDs are objected to under Article 7(1)(m) EUTMR).

Chapter 6, Article 7(1)(e) EUTMR
In addition to some hypothetical examples of 'other characteristics' and some real examples from the Boards of Appeal on shapes (R 664/2011-5 and R 3021/2014-5), minor clarifications have been added following the judgment in Hauck (18/09/2014, C-205/13, Hauck, EU:C:2014:2233).

Chapter 7, Article 7(1)(f) EUTMR
The Office has a restrictive interpretation of the public policy concept, in the sense that it considers relevant is the body of Union law applicable in a certain area. However, in the past, signs in conflict with national law or practice have been objected to for being contrary to either public policy or accepted principles of morality (or to both).

The Office has now introduced a more systematic approach to the assessment of this ground. It will consider that such signs are contrary to the accepted principles of morality of that country. The national law or practice will be taken into account not because of its normative value but as factual evidence of the perception of the public in that relevant territory.

Recent examples of trade marks accepted and refused have also been added.

Chapter 9, Article 7(1)(h)/(i) EUTMR
The structure of this section of the Guidelines has been substantially modified in order to remove repetitive and ambiguous information/instructions. There are now clearer examples, which take account of recent decisions of the Office, the Boards and the Court.

As far as Article 7(1)(h) EUTMR is concerned, the Guidelines now clarify that conflicts with a protected 'emblem' must be considered from a heraldic perspective. When examining the sign, the Office will consider the perspective of the average consumer, who, despite some differences in heraldic details, can see in the mark an imitation of a protected 'emblem'. It is now also explained that the mere fact that the emblem in question is stylised or that only part of the emblem is used in the EUTM application does not necessarily mean that there is no imitation from a heraldic point of view.

The section on Article 7(1)(i) EUTMR has also been substantially modified. The Guidelines now clearly

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indicate the objective pursued by this provision and include an updated catalogue of protected symbols.

Chapter 14, Article 7(3) EUTMR

Various issues relating to 'territorial aspects' have been clarified. Some modifications have been made regarding the extrapolation and overall assessment of evidence (including the relevant factors). Recent case-law from Court judgments (24/02/2016, T-411/14, Shape of a bottle (3D.), EU:T:2016:94; 21/05/2014, T 553/12, BATEAUX MOUCHES, EU:T:2014:264; 21/07/2016, C-363/15 P, Device of a checked pattern (maroon & beige), EU:C:2016: 595) has been included.

Finally, the section on 'language area' (identification of those Member States where the trade mark is objectionable for linguistic reasons) has been reviewed in order to align it with other parts of the Guidelines, in particular with Chapter 4, Article 7(1)(c) EUTMR.

Part C, Opposition, Section 0, Introduction

This section analyses strategic considerations regarding oppositions arising from the principle that an EUTM application is rejected when one ground of opposition is successful, and oppositions allowed on the basis of one of the earlier rights invoked. It is because of these considerations that examiners are advised to choose the 'most effective' ground of opposition or the 'most effective' earlier right.

Under WP1 2017, another important suggestion has been made with regard to Article 8(1)(b) EUTMR: since, according to the case-law, a finding of likelihood of confusion with regard to part of the public is sufficient to allow the opposition on this ground, examiners are advised to base decisions on the part of the public that is 'most prone to the confusion'. This may be due to linguistic considerations or the level of attention paid.

Part C, Opposition, Section 1, Procedural Matters

CHANGE OF PRACTICE

Paragraph 2.3, Languages and translation of the notice of opposition

The previous practice of raising an admissibility deficiency regarding an incorrect language used in the notice of opposition has been revised. The whole section has been amended to make a distinction between cases where the incorrect language used in the notice of opposition is one of the five languages of the Office but not one of the possible languages of the proceedings and cases where it is any other EU language.

It has been clarified that, in the first case, the opponent must provide a translation of the notice of opposition within one month from the expiry of the 3-month opposition period. In the second case, the opponent must provide such translation within the

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3-month opposition period. If translations are not submitted within the abovementioned time limits, the opposition will be rejected as inadmissible. Some examples reflecting different scenarios have been included.

The previous practice of issuing an admissibility deficiency for the incorrect indication of the language is no longer followed.

Paragraph 2.4.1.2, Identification of the earlier trade marks/rights (earlier well-known mark)
The text has been amended to reflect that, for oppositions based on earlier well-known marks, there is no need to indicate a filing/registration number for the earlier well-known mark. This is because registration is not a requirement for a trade mark to be identified as well known under Article 8(2)(c) EUTMR.

Paragraph 2.4.3.1, Extent of the opposition
The practice regarding interpretation of the extent of the opposition has been revised in cases where the opposition is indicated to be directed against 'part' of the goods or services, but the part is not clearly listed. Previously, an admissibility deficiency was sent to the opponent asking it to clarify the extent of opposition. If it failed to comply with the deficiency notice, the opposition was declared inadmissible.

In view of the fact that indicating the extent of the opposition is an option rather than a requirement, this section has been modified to reflect that, where the extent is not clearly indicated (including where 'part' of the goods and/or services is indicated but the list is not clear), the Office will assume that the opposition is directed against all of the goods and services of the opposed mark.

CLARIFICATION OF PRACTICE

Paragraph 4.2, Substantiation
The text has been amended to include references to case-law concerning the acceptability of evidence on CDs, DVDs and USB sticks.

Paragraph 4.2.3.2, Extracts from official databases
The list of examples of officially recognised databases has been simplified by removing the incomplete list of examples of official national databases, which was found to be redundant. The only examples not covered by the description 'official database of national office' are the TMview and ROMARIN databases, which have thereforebeen kept in the Guidelines. Finally, references to specific national databases have been replaced by general terms within the text.

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Paragraph 4.3.1, Translations of evidence of trade mark registrations and of facts, evidence and arguments submitted by the opponent to complete its file

The text has been modified to clarify what will happen when the evidence submitted is not translated, or not sufficiently translated, within the time limit, namely that such evidence will not be taken into account. This reflects current Office practice.

Paragraph 4.4.1, Documents not readable

In the section dealing with non-readable documents, a cross reference has been inserted to the Guidelines, Part A, General Rules, Section 1, Means of communication, Time limits.

Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion

Chapter 1, General Principles
Chapter 3, Relevant Public and Degree of Attention
Chapter 4, Comparison of Signs
Chapter 5, Distinctiveness of the Earlier Mark
Chapter 6, Other Factors
Chapter 7, Global Assessment

According to the methodology introduced with WP1 2016, special attention is paid to assessing the level of similarity between signs, taking into consideration their dominant and distinctive elements as well as the level of distinctiveness of the earlier mark. This should allow the global assessment of likelihood of confusion to focus on the application of the interdependence theory.

In Chapter 4, Trade mark comparison, several examples from case-law were introduced in the section on 'Conclusion on similarity', including cases where finding the level of similarity was particularly complex (apart from objective commonalities and differences, the dominant and distinctive character may play a role as may other factors, for example, the beginnings of the marks, word versus figurative elements, the lengths of the signs).

The section on 'Dissimilarity' has been amended to emphasise that finding dissimilarity between signs is reserved for clear cases and must be thoroughly reasoned; in borderline cases, the likelihood of confusion must be examined in full.

Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services

Vague terms

This most recent revision cycle addressed the following aspects.

The Knowledge Circle (KC) spent considerable time discussing and defining a proposed practice for

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dealing with vague terms in specifications of goods and services, depending on whether the vague term was to be found in the contested mark or in the earlier mark, and has elaborated its proposal in paragraphs 1.5.1 and 1.5.2. The information relating to retail in Annex II has also been updated.

The KC has made every effort to reflect the various potential scenarios, depending on whether the vague term is to be found in the contested mark or the earlier mark. The text also explains how the Office will deal with vague terms that are the result of incorrect translations and with terms that are simply vague in themselves.

Essentially, the practice defined involves **reopening the mark for classification** in the event of a vague term **in the contested application**, thus taking heed of the Court's instructions in Vogue (27/02/2014, T 229/12, Vogue, EU:T:2014:95, § 55), and not allowing the vagueness of a term contained in the earlier mark to be the sole reason for a finding of similarity. When a vague term is detected in the earlier mark, the Guidelines explain that the vague term will only be afforded its natural and usual meaning, which cannot extend to properties or qualities not expressly mentioned in relation to that vague term. Under this initial proposal, the Office will deal with the comparison of the goods and services on a case-by-case basis but the KC's intention is to develop the practice further in future iterations.

(Magnetic) data carriers
The Knowledge Circle has now included a definition of the practice in relation to magnetic data carriers in paragraph 10.7 of Annex II, where it is now clarified that magnetic data carriers are considered to be blank. Blank recording media and media that contain recorded data are very distinct products and therefore cannot be found to be similar to any recorded content they could contain.

Part C, Opposition, Section 6, Proof of Use

This section was updated with the recent case-law. New Chapter 3.7.4, Treatment of confidential information, has been introduced to address the problem that, given the public nature of decisions, the justified interest of a party in keeping certain information confidential vis-à-vis the public has to be reconciled with the Office's duty to state reasons. Providing reasons without divulging confidential business data may be problematic but can be done by referring to the data in a general manner.

Part D, Cancellation, Section 1, Cancellation Proceedings

CHANGE OF PRACTICE

Paragraph 7.3, Surrenders and withdrawals
The text in paragraph 7.3.1 has been modified to reflect that whenever a partial or total surrender affects any of the goods/services contested in

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cancellation proceedings, the latter will be treated in the same manner. Therefore, the whole section under paragraph 7.3.2., dealing with partial surrenders, has been deleted.

CLARIFICATION OF PRACTICE

Paragraph 2.2, Written applications
It has been clarified that cancellation applications may be submitted electronically as an attachment via the Office's User Area.

Paragraph 4.1.4, Identification of the applicant
The text in this section has been modified to explain that if the applicant or representative has been allocated an ID number by the Office, this number, along with their name, is sufficient for identifying the person involved.

Paragraph 6.4, Translation of evidence submitted by the EUTM proprietor in the course of the proceedings
In the section dealing with translation of evidence, a crossreference has been inserted to the Guidelines, Part A, General Rules, Section 1, Means of communication, Time limits.

Part E, Register Operations, Section 2, Conversion

Paragraph 4.2 (page 7), Ground for refusal limited to a Member State or extended to the entire EU

This paragraph now states that a conversion request will not be allowed where the contested EUTM or IR designating the EU has been rejected on the ground of Article 52(1)(b) EUTMR ('bad faith'), as this ground differs from the others that may be limited to a specific Member State(s) pursuant to Article 52(1)(a) EUTMR and Article 53 EUTMR.

Paragraph 6.2.2 (page 13), Time limit for filing a request for conversion
The text has been reworded to clarify that an application for conversion is deemed to have been filed if the fee has been paid within the time limit.

Part E, Register Operations, Section 4, Renewals

Text relating to RCDs has been fully incorporated into the Renewal section, which had hitherto only addressed EUTMs. The main reasons for doing this were that a number of elements are the same for both processes, and that the Renewal section needed to be brough into line with other sections of the Guidelines (where both EUTMs and RCDs are addressed). This new set of Guidelines,combining both EUTMs and RCDs is designed to be more user-friendly, while still highlighting the differences between the two processes.

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Paragraph 7, Fees and other formal requirements for the request for renewal
The reference to a 'fee reduction' has been removed to avoid confusion for RCD holders (as it only applied to EUTM proprietors).A new paragraph has also been inserted to clarify that a single application for renewal may be submitted for two or more EUTMs/ RCDs.

Paragraph 7.1, Persons who may submit a request for renewal
A sentence has been added to clarify that the renewal applicant, if not the proprietor/holder itself, must be authorised to submit the renewal request.

Paragraph 8.1.1.1, Payment during the basic period or the grace period
The final two paragraphs have been added to clarify that if a renewal payment is incomplete, instead of paying the missing amount, the renewal may be restricted to fewer classes/multiple designs.

Paragraph 8.1.1.2, Payment after the expiry of the grace period
The last phrase of each of the first three paragraphs has been deleted. It had erroneously stated that the Office would also inform third parties recorded in the Register as having rights in the mark of the loss of rights. This text has been removed as it is neither carried out in practice nor included as a requirement in the Regulations.

Paragraph 9, Partial renewals of EUTMs
A new section has been inserted to explain how the Office deals with partial requests for renewal. The new practice follows from the reasoning of the Court's judgment in CVTC (22/06/2016, C 207/15 P, CVTC, EU:C:2016:465). It is confirmed that a partial renewal is not an implicit partial surrender (as partial surrenders have to be explicit), and that a partial renewal in the basic period can be followed by a later partial renewal of the remaining goods/ services in the grace period.

Paragraph 13, Renewal of international design registrations designating the EU
The text has been simplified. The specific fees have been removed (aligning it with the text of international trade mark registrations).

Part E, Register Operations, Section 5, Inspection of Files

Paragraph 4.2 (page 6), Documents that constitute the files
A paragraph has been inserted to clarify that where original documents are submitted they will become part of the file and will not be returned. Copies can be submitted instead of originals.

Paragraph 6.11.4 (page 19), Refund of fees
There has been clarification and a change of practice. A paragraph mentioning that, if a request for inspection was withdrawn before the Office had

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dealt with it, the fee would be refunded, has been deleted. However, the refund should not be at the Office's discretion. New text has been inserted to reflect the general rule that, if a declaration that is subject to the payment of a fee is withdrawn before or on the day the payment is deemed to have been made, the fee will be refunded. The change of practice is intended to deal with these requests as with all others. A general statement has also been included in Part A, General Rules, Section 3, Payment of fees, costs and charges.

Part E, Register Operations, Section 6, Other Entries in the Register, Chapter 1, Counterclaims

Paragraph 2 (page 4), Application to Register the Filing of a Counterclaim Before an EUTM or a CD Court

Clarification has been given concerning the evidence to be submitted where a counterclaim has been raised before an EUTM or CD Court. Additionally, text has been inserted to clarify that, in the absence of this evidence, a deficiency letter will be issued.

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Registered Community Design

Examination of Design Invalidity Applications

On a general note, the revision includes new references to recent case-law, updates of the design examples given, and some changes in wording to reflect the terminology used in the Community Design Regulation. Moreover, some parts addressing legal issues (e.g. duty to state reasons, right to be heard) that are also regulated for trade mark proceedings and addressed in the Office's general or trade mark guidelines have been eliminated, in order to avoid overlap when the practices for the different proceedings are in fact the same. None of these improvements entails a change of practice.

The remainder of the changes, listed below, serve to clarify Office practice and follow suggestions from users.

With regard to language regime, new paragraph 3.3 has been added to guide users in relation to international registrations designating the European Union.

Paragraph 5.2, addressing the lack of entitlement to a design as an invalidity ground under Article 25(1)(c) CDR, has been restructured to avoid the frequent misperception that the Office has jurisdiction to decide on the entitlement; such jurisdiction rests exclusively with the Courts.

The guidance given under paragraph 5.5.1, concerning disclosure of an earlier design, has been restructured and revised with the main aim of making a clearer distinction between, on the one hand, general principles applicable to all types of disclosures and, on the other hand, specific matters arising in relation to certain types of disclosure, such as those taking place at trade fairs or on the internet. Furthermore, the apportionment of the onus of proof between the parties has been clarified in accordance with recent case-law.

Paragraph 5.8, on the unauthorised use of a work protected under the copyright law of a Member State, has been reworded, and the former wording that this ground of invalidity is applicable only 'in the clearest of cases' removed.

New paragraph 5.9 has been included to address the invalidity ground under Article 25(1)(g) CDR on the improper use of flags and other symbols. Such symbols are understood to correspond to those covered by Article 7(1)(h) EUTMR and thus the Office's trade mark guidelines on eligible symbols are declared to be applicable by way of reference. The meaning of the term 'improper use' will be subject to future revisions.

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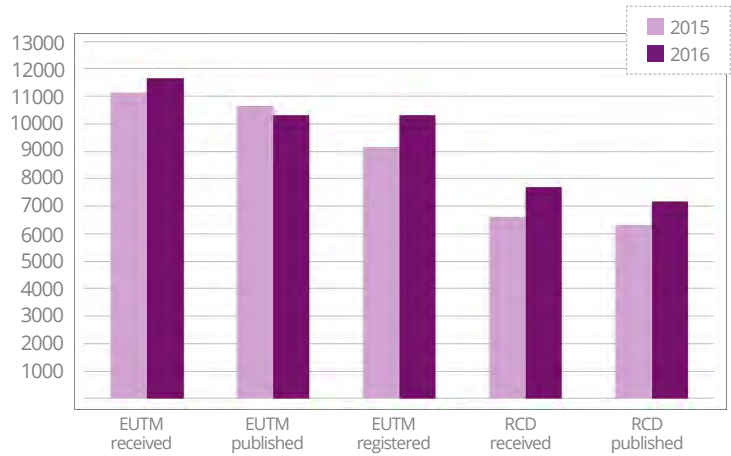
Statistical Highlights

Monthly statistical highlights November*	2015	2016
European Union Trade Mark applications received	11 121	11 645
European Union Trade Mark applications published	10 642	10 301
European Union Trade Mark registered (certificates issued)	9 166	10 310
Registered Community Designs received	6 616	7 675
Registered Community Designs published	6 307	7 174

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



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ETMDN Updates

Malaysia joins TMview and TMclass

As of 12 December 2016 The Intellectual Property Corporation of Malaysia (MyIPO) has made its trade mark data available to the TMview search tool.

MyIPO first joined ASEAN TMview which was developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II) administered by EUIPO.

This latest integration brings the total number of offices participating in TMview to 56 and with the addition of almost 750,000 trade marks from Malaysia TMview now provides information and access to more than 41 million trade marks in total.

Since the introduction of TMview on 13 April 2010 the tool has served close to 26 million searches from 155 different countries, with visitors from Spain, Germany and Italy among the most frequent users.

In addition, on 5 December, MyIPO joined TMclass, bringing to 62 the total number of IP offices sharing their goods and services through this international classification tool.

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More News

Key national enforcement judgements available in eSearch Case Law

A new version of the EUIPO's eSearch Case Law now makes key national case law in the area of IP enforcement available.

The newly available key enforcement judgments relate to the application of enforcement-related measures or procedures in IP rights infringement cases that set a new trend in case law. The case law collected includes all types of IP rights, covering both civil and criminal proceedings

In total, more than 700 key enforcement judgments from 16 EU Member States are now available online.

Users will be able to read the full text of the judgments in their original language as well as a summary in English (and, in some cases, also a summary in the original language). Judgments can be accessed using the advanced search function of the 'National Court Judgments' tab by selecting the radio button 'Only Key Enforcement decisions'.

The case law was gathered within the framework of a project on the collection and analysis of national enforcement case law.

This project, which is implemented in cooperation with national IP offices, is based on Article 5(1) of Regulation (EU) No 386/2012 (European Observatory on Infringements of Intellectual Property Rights), which sets out that '[...] Member States shall, at the request of the Office or on their own initiative: [...] (c) inform the Office of important case-law'.

Starting with a pilot covering eight participating national IP offices in 2014, the project has grown over the 2015-2016 period as more Member States have joined. In addition, the Community Plant Variety Office has made a contribution relating to Community Plant Variety Rights. The cases collected currently span the years 2006 to 2015 and the information is updated every year.

For more information on the enforcement case-law collection project, please contact: observatory.nationalcaselaw@euipo.europa.eu.

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Case law

Luxembourg trade mark and design news

A: Court of Justice: Orders, Judgments and Preliminary Rulings.

Case C-537/14P; Debonair Trading International Lda v EUIPO; Judgment of 27 October; Language of the case: EN

RESULT: Action upheld (BoA and GC judgment annulled)

KEYWORDS: Lack of reasoning, Laudatory mark, Distinctive element, Similarity of the signs

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for inter alia goods in Classes 3 and 25. An opposition based inter alia on the Community and UK earlier word marks SO...?, registered for goods in Classes 3 and 25, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) partly upheld the opponent's appeal. It found that that there was a likelihood of confusion for the identical and similar goods and for the dissimilar goods, there was risk of the contested trade mark being detrimental to the reputation of the earlier marks. The applicant filed an action before the General Court (GC) relying on, inter alia, the alleged infringement of Articles 8(1)(b) and 8(5) EUTMR. The GC upheld the appeal. It found that the element 'SO', common to both signs, was laudatory. It found that the BoA erred in finding that that element was dominant in both signs. The GC concluded that the signs at issue were not similar (para. 91 of the Judgment of the GC). The opponent filed an action before the Court of Justice of the European Union (CJ) seeking the annulment of the GC judgment. The Office filed a cross-appeal seeking the same relief. The CJ upheld the appeal and the cross-appeal and annulled the judgment of the GC.

EUTMA

Earlier marks

So...?

SUBSTANCE: Duty to state reasons: In paragraph 87 of the judgment under appeal the GC stated that a laudatory function of the word 'so' exists when it is accompanied by another word, whereas it might be understood, out of context, as meaning 'then', 'thus' or 'therefore' (implying that it would be not laudatory in such a case). On the other hand, in paragraph 73 of the judgment under appeal, the GC

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Case law

stated that the word 'so' has a laudatory function in the earlier trade marks 'SO...?' (where it is obviously not accompanied by any other word). The CJ found a contradiction in the reasoning of the GC; the parties and the CJ are unable to ascertain whether, in the GC's analysis, the word element 'so' has a laudatory function only when it is used with another word or also when it is used on its own (paras. 32-37). The GC did not comply with its obligation to state reasons, the GC judgment is set aside.

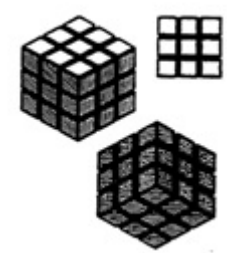
Case C-30/15P; Simba Toys GmbH & Co. KG v EUIPO; Judgment of 10 November 2016; Language of the case: EN

RESULT: Appeal upheld (Both the GC judgment and the BoA decision are annulled)

KEYWORDS: Three dimensional mark, Technical result

FACTS: The 3D EUTM was registered in respect of three-dimensional puzzles in Class 28. A cancellation action was based inter alia on Article 7(1)(e)(ii) EUTMR. The action was dismissed by Board of Appeal (BoA), which was confirmed by General Court (GC) (T-450/09). GC found that the essential characteristics of the shape were the cube and the grid structure (para. 45, T-450/09). GC dismissed the action as it found that the grid structure was not necessary to obtain a technical result. As a result, one of the essential characteristics of the contested mark was not caught by Article 7(1)(e)(ii) EUTMR, which sufficed to rule out this ground for cancellation (para. 61, T-450/09). First, GC considered irrelevant the fact that the grid structure might be the consequence of a rotating capability, because functional characteristics are those which perform a function rather than those which are the result of that function (para. 53-54, T-450/09). Second, GC found that the rotatable capability could not be inferred from the representation itself. Such characteristic "is essentially based on knowledge of the rotating capability of the vertical and horizontal lattices of the Rubik's Cube" and must for that reason be ignored (para. 56-59, T-450/09

EUTM



SUBSTANCE: The Court of Justice of the European Union (CJ) annuls the GC judgment on the second pillar on its reasoning. It considers that GC should have based its examination of the functionality

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of the grid structure in the light of the rotatable capability which is illustrated by the actual product: "Thus, and since it is not disputed that the sign at issue consists of the shape of actual goods and not of an abstract shape, the General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle, and it should have taken this into account when assessing the functionality of the essential characteristics of that sign" (para. 47).

Drawing an analogy with its previous judgment in C-337/12P to C-340/12P (shape of a knife handle), CJ goes on to say that the identification of the essential characteristics must be made on the basis of the graphic representation and "additional information on the actual goods" (para. 49-50).

GC should have examined the functionality of the grid structure in the light of the rotating capability of individual elements in a three-dimensional "Rubik's Cube'-type puzzle" (para. 51).

CJ also criticises GC for having found that this rotatable capability could not be inferred from the general category of three-dimensional puzzles. It is enough that some puzzles have such characteristic (para. 52).

CJ makes use of Article 61 of its Statute and adopts a final ruling on the merits of the case. It concludes that the BoA decision, the reasoning of which was endorsed by GC, is vitiated by the same error as the GC judgment and must therefore be quashed for the same reasons.

Case C-482/15P; Westermann Lernspielverlarge GmbH v EUIPO; Judgment of 26 October 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, New submission on appeal, Right to be heard, Right of defence, Similarity of the signs

FACTS: The EUTM applicant sought to register the figurative sign bambinoLÜK for goods in Classes 9, 16 and 28. An opposition based on an earlier figurative EUTM BAMBINO, covering goods and services in Classes 16, 28 and 41, was filed on the grounds of Article 8 (1)(b) EUTMR. The Opposition Division upheld the opposition in respect of some goods and services. The Board of Appeal (BoA) partially upheld the appeal. The opponent brought an action before the General Court (GC), alleging infringement of Article 8(1)(b) EUTMR because of (i) the lack of distinctive character of the word element "bambino" of the earlier EUTM, (ii) the lack of similarity between the signs at issue and (iii) the absence of a likelihood of confusion. The GC dismissed the action. The applicant filed an appeal before the Court of Justice of the European Union (CJ) on the basis of two grounds: breach of the right to be heard and the right to a fair trial and the infringement of Article 8(1)(b) EUTMR.

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EUTM

bambino LÜK

Earlier mark

BAMBINO

SUBSTANCE: The CJ dismissed the appeal. The GC did not err in law in reviewing the BoA's decision because the earlier mark on which the opposition is based was producing its effects at that time, since the date of its revocation is subsequent to the BoA's decision. Furthermore, the applicant's argument related to the assessment of the similarity between the signs seeks to contest the GC's factual assessment and is therefore inadmissible. As to the alleged breach of the right of property, the CJ found it inadmissible because it was raised for the first time at the reply stage. Furthermore, the CJ found ineffective the applicant's arguments related to the breach of the right to be heard and the right to a fair trial because the GC was not required, in its review of the legality of the decision, to take in consideration the Office decision revoking an earlier mark, as the revocation took effect after the adoption of the BoA's decision and could not affect its legality.

Case C-43/15P; BSH Bosch und Siemens Hausgeräte GmbH v EUIPO; Judgement of 8 November 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Ancillary appeal, Distinctive element, Likelihood of confusion

FACTS: The EUTM applicant sought to register the mark represented below for goods and in Classes 7, 9 and 11. An opposition based on the earlier mark represented below, registered for similar and identical goods in Classes 7, 9 and 11, was filed on the grounds of Article 8(1)(b) EUTMR.
The Opposition Division (OD) upheld the opposition for the goods found to be similar and identical. The EUTMR applicant appealed the decision; the owner of the earlier trade marks, it its observations, stated that the EUTM application should have been refused for even more goods. The Board of Appeal (BoA), which qualified these observations as "ancillary appeal" (Article 8(3) RP/BoA), dismissed the applicant's appeal and rejected the EUTM application for more goods than OD. The applicant filed an action before the General Court (GC).
The appeal - based solely on Article 8(1)(b) EUTMR - was dismissed by the GC. It emphasized that a certain degree of distinctiveness has to be attributed to national marks and that the distinctiveness of the earlier mark(s) is just one element of the assessment of likelihood of confusion. In light of the decorative

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figurative element and the secondary position of the element "technology" within the EUTMA the BoA was right in its assessment that the differences in the first letters "C/K" are not sufficient to compensate for the similarity of the word elements "KOMPRESSOR"/"compressor".

The EUTM applicant lodged an application before the Court of Justice, relying on two pleas in law:

First, the GC violated Article 60 EUTMR by giving its approval, without the slightest examination, to the BoA´s qualification of the observations of the owner of the earlier marks as "ancillary appeal" and by giving its approval to the BoA´s rejection of the EUTMA for even more goods than OD.

Second, the GC violated Article 8(1)(b) EUTMR by relying on an erroneous concept of likelihood of confusion, with the effect that, if two trade marks coincide as regard a purely descriptive element, it is deemed sufficient to give rise to such a likelihood of confusion, thereby leading to a monopolisation of a purely descriptive indication. The Court of Justice (CJ) dismissed the appeal.

SUBSTANCE: With regard to the claimed violation of Article 60 EUTMR, the CJ noted that the applicant - undisputedly - did not claim at any stage of the proceedings before the GC that the BoA´s interpretation ("ancillary appeal") was incompatible with Article 60 EUTMR or any other provision of EU law. In an appeal, the jurisdiction of the CJ is confined to review of the findings of law on the pleas and arguments debated before the GC. While

EUTMA

compressor technology

Earlier marks

1.) KOMPRESSOR PLUS (EUTM)
2.) KOMPRESSOR (FR)
3.) KOMPRESSOR (ES)
4.) KOMPRESSOR (UK)

the BoA infringed the adversarial principle (Article 63, Article 75 S. 2 EUTMR) by not giving the applicant an opportunity to comment on the "ancillary appeal", the fact remains that, in the absence of any challenge by the applicant relating to that matter before the GC and in the absence of the slightest criticism on its part of the analysis which led the BoA to uphold the "ancillary" appeal, the GC cannot be criticized for having failed to raise that infringement on its own motion (paras. 42-45).

Accordingly, the CJ dismissed the first plea as

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inadmissible.
With regard to the second plea in law (Article 8(1)(b) EUTMR) the CJ reiterated its long standing case law, according to which the distinctive character of an earlier mark is only one factor among others involved in the assessment of a likelihood of confusion. A likelihood of confusion cannot be precluded only because the distinctive character of the earlier mark is weak (paras. 61-62). As regards the applicant´s argument that the case-law is wrong given that it allegedly leads to the monopolisation of a purely descriptive indication, it must be stated that it is not Article 8(1)(b) EUTMR, but Articles 7(1)(b), (c) and Article 51 EUTMR, which are intended to avoid such monopolisation. Furthermore, with regard to earlier national marks a certain degree of distinctiveness has to be acknowledged (paras. 65-68).
Finally, it cannot be ruled out in advance and in any event that, where a trade mark application reproduces a weakly distinctive earlier national mark, consumers may suppose that those differences reflect a variation in the nature of the products or stem from marketing considerations and do not denote goods from different traders, and that a likelihood of confusion may therefore exist (para. 70). Accordingly, the CJ dismissed the second plea in law as unfounded.

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

Case T-777/14; Fon Wireless Ltd v EUIPO; Judgment of 26 April 2016; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The intervener sought to register the word mark Neofon as a EUTM for goods within Classes 9 and 18. The CTM application was rejected upon the opposition on the basis of an earlier UK word mark FON protected for goods and services in classes 9, 38, 42. The Board of Appeal (BoA) annulled the decision of the Opposition Division and rejected the opposition. The BoA excluded the likelihood of confusion even for identical goods on the basis of the limited distinctive character of the earlier marks. It reasoned that 'fon' is a common misspelling or a reference to the word 'PHONE' whilst all the protected goods are phones or parts of it and the services are related thereto. The opponent filed an action before the General Court (GC) relying on Article 8(1)(b) EUTMR.

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Case law

EUTMA
Neofon
Earlier mark
FON

SUBSTANCE: The GC affirmed a likelihood of confusion. With regard to the comparison of the signs, it emphasized that the EUTM application contains the earlier mark with an addition of the prefix "Neo", which results in a visual and phonetic similarity (para. 38). The addition of that prefix is not capable of sufficiently differentiating the signs, as the relevant public will perceive it with relation to the word 'fon' as its clarification (para. 43). Also phonetically there is a similarity because of the coincidence in the syllable 'fon' (para. 44). The visual and phonetic similarity is average (para. 45). There is also an average conceptual similarity (para. 50). The distinctiveness of the earlier mark is low because it refers to 'telephones' and is therefore connected with the protected goods in class 9 and services in class 38 and 42. Nevertheless, given the average similarity between the signs and the identity of the products the likelihood of confusion must be confirmed (paras. 61 and 62).

Case T-449/15; Satkirit Holdings Ltd v EUIPO; Judgment of 27 September 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Nature of goods and services, Similarity of the goods and services, Identity of the signs

FACTS: The applicant sought to register the word mark Iuvo as an EUTM for goods in Class 9. The EU trade mark application was published in Community Trade Marks Bulletin No 215/2912 of 12 November 2012. An opposition based on the earlier word mark Iuvo, registered for services in Class 35 and 42, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and rejected the trade mark application in respect of all goods in Class 9. A notice of appeal against the decision of the Opposition Division was filed pursuant to Articles 58 to 64 EUTMR solely in so far as the OD had upheld the opposition in respect of the following goods in Class 9: mobile phone; tablets; portable communication devices. It did not dispute that decision as regards compute". The Board of Appeal (BoA) dismissed the appeal, examining the opposition only based on the earlier EU word mark with regard the services design and development of computer hardware and software in Class 42. It found that for the goods covered by the mark applied for and the services design and development

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of computer software the relevant public was the general public and the professionals with a level of attention between a normal level of attention and a higher than normal level of attention. Considering the services design and development of computer hardware covered by the earlier mark, the relevant public was the professional public with a high level of attention. The two signs were identical. The earlier mark had a normal distinctive character for the services. The goods and services were similar and there was a likelihood of confusion. The applicant filed an action before the General Court (GC) relying on the infringement of Article 8(1)(b) of Regulation No 207/2009. The GC dismissed the appeal. It found that there was a likelihood of confusion between the signs.

EUTMA
luvo
Earlier mark
luvo

SUBSTANCE: Firstly, the GC stated that there was not an obligation on the opponent, in opposition proceedings, to adduce evidence on the similarity of the goods and services (para. 35). Secondly, rejecting the applicant's submission, the GC stated that BoA identified correctly the relevant public and then it examined the nature of the goods and services, their intended purpose, method of use, their distribution channels and whether they were complementary (para. 39). Thirdly, the goods and services were complementary but this was not enough to conclude they were similar (para 46). Fourthly, the distribution channels were the same for the marks (para. 50). As a consequence, the contested goods and the earlier services were similar (para. 51). Regarding the comparison of the signs, the marks were identical (para 52). In the light of all the above arguments, there was a likelihood of confusion between the signs (para. 55).

Case T-450/15; Satkirit Holdings Ltd v EUIPO; Judgment of 27 September 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Nature of the goods and services, Similarity of the goods and services, Identity of the signs

FACTS: The applicant sought to register the word mark Iuvoworld as an EUTM for goods and services in Classes 9 and 38. The EU trade mark application was published in Community Trade Marks Bulletin No 215/2012 of 12 November 2012. An opposition based on the earlier word mark Iuvo, registered for services in Classes 35 and 42, was filed pursuant

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to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and rejected the trade mark application in respect of all goods and services in Class 9 and 38. A notice of appeal against the decision of the (OD) was filed pursuant to Articles 58 to 64 EUTMR. The Board of Appeal (BoA) dismissed the appeal, examining the opposition only based on the earlier EU word mark with regard the services design and development of computer hardware and software in Class 42. It found that for the goods covered by the mark applied for and the services design and development of computer software the relevant public was the general public and the professionals with a level of attention between a normal level of attention and a higher than normal level of attention. Considering the services design and development of computer hardware covered by the earlier mark, the relevant public was the professional public with a high level of attention. The goods and services covered by the mark applied for and the services covered by the earlier mark were similar. The earlier mark had a normal distinctive character for the services. Regarding the comparison of the signs the signs were highly similar. As a consequence, the BoA found a likelihood of confusion. The applicant filed an action before the General Court (GC) relying on the infringement of Article 8(1)(b) of Regulation No 207/2009. The GC dismissed the appeal. It found that there was a likelihood of confusion between the signs.

EUTMA
luvoworld
Earlier mark
luvo

SUBSTANCE: Firstly, the GC stated that there was not an obligation on the opponent, in opposition proceedings, to adduce evidence on the similarity of the goods and services (para. 33). Secondly, rejecting the applicant's submission, the GC stated that BoA identified correctly the relevant public and then it examined the nature of the goods and services, their intended purpose, method of use, their distribution channels and whether they were complementary (para. 37). Thirdly, the goods and services were complementary but this was not enough to conclude they were similar (para. 44). Fourthly, the distribution channels were the same for the marks (para. 48). As a consequence, the contested goods and the earlier services were similar (para. 49). Regarding the comparison of the signs, the marks were highly similar (para. 50). In the light of all the above arguments, there was a likelihood of confusion between the signs (para. 53).

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Case T-453/15; Trinity Haircare AG v EUIPO; Judgment of 18 September 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Minimum degree of distinctiveness, Laudatory mark, Bad faith

FACTS: The EUTM proprietor was granted the registration of the figurative mark represented below as an EUTM for goods in Class 3. The Office refused to invalidate the registration of the EUTM pursuant to Article 52(1)(a) EUTMR in connection with Article 7(1)(b) or (c) EUTMR, as it was found distinctive, non-descriptive or laudatory for the goods. It also found that no act of bad faith within the meaning of Article 52(1)(b) of Regulation No 207/2009 had been proved. The Invalidity applicant appealed reiterating his arguments that the term 'vogue' was used as a synonym for 'fashion' or as a shortened form of the expression 'en vogue' and thus was descriptive of the goods. The Board of Appeal (BoA) dismissed the invalidity applicant's appeal. The BoA confirmed that, as in French, 'vogue' in English had the meaning 'popularity, use or general acceptance; popularity with the audience' according to well-known dictionaries. It also asserted that there were expressions such as 'en vogue' (in French) or 'in vogue' (in English), which mean 'fashionable, tendency'. However, the BoA stated that the applicant had not demonstrated that the word 'vogue' was used as a synonym for those expressions (contested decision, paragraph 16). Likewise, it held that nothing indicated that the word 'vogue' was descriptive of the goods at issue. The invalidity applicant filed an action before the General Court (GC) relying on three pleas in law: The GC dismissed the appeal.

EUTM

VOGUE

SUBSTANCE: The GC found that there is nothing in the definition of the word 'vogue' which indicates that that word has a sufficiently direct concrete link to the goods in question to enable the public concerned immediately, and without further thought, to perceive a description of an essential characteristic of the goods in question or of one of their characteristics. In respect of 'beauty products and baby care' products, it is hard to see how the word 'vogue' is descriptive of those products whose characteristic function is care or beauty care, which does not fall within the area of fashion. In that regard, the Office, supported by Vogue's owner, is entitled to state that beauty and care products are not fashion products, given that consumers buy them for their 'result', that is to say, the fact that the product moisturises well, deodorises well or produces a pleasant scent. In that connection, the Office rightly notes that the notion of fashion is connected with the permanent change linked to

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every season and every year. That is not the case with the goods at issue, in respect of which change is rarely linked to the change of season or year but rather to innovation, that is to say, the appearance of a new product in a position to satisfy the consumers' unmet needs. Therefore, fashion is not concerned with care and beauty products. Regarding the list of the results of internet searches submitted as proof by the applicant during the administrative procedure, that list does not prove that the word 'vogue' is descriptive of the goods at issue. The results of the searches submitted demonstrate, rather, that there is a reference to the commercial origin of certain services, such as those provided in a beauty salon, or to the intervener's magazine. The fact that the invalidity applicant's search displays around 850 million results does not prove by itself that 'vogue' is descriptive of the goods at issue. Besides, the applicant does not propose any analysis in support of this. Likewise, as regards the decisions by which the competent German and Swiss authorities refused to register trade marks similar to the contested mark on the grounds that those marks were descriptive, that argument should be dismissed as ineffective, inasmuch as the EU trade mark system is an independent system. Regarding the bad faith arguments, the contested mark was allegedly submitted in bad faith, given that the intervener had repeatedly submitted, between 1962 and 2003, that is to say, before the contested mark was filed, the mark VOGUE in numerous Member States for goods included in Class 3, without having the intention of using them but with the sole aim of avoiding consequences of non-use. The GC rejected the evidence submitted, namely that, the withdrawal of the opposition before the Spanish Patent and Trademark Office does not constitute evidence of non-use of the contested mark, which would at all events be insufficient in itself to adduce evidence of the intervener's bad faith.

Case T-693/15; Clover Canyon, Inc. v EUIPO; Judgment of 20 October 2016; Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant filed an application for an international registration designating the EU for the word mark represented below in respect of the goods in Class 25. An opposition based on the earlier German trade mark represented below registered for goods in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and refused the application in respect of all the goods applied for. The Board of Appeal (BoA) dismissed the applicant's appeal. It endorsed the findings of the OD concerning the identity between

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the goods and the similarity between marks and found that there was a likelihood of confusion between them. The applicant filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal

EUTMA
CLOVER CANYON
Earlier mark
CANYON

SUBSTANCE: The GC endorsed the OD's findings that the goods of the conflicting trade marks are identical (para 22) and that they are targeted at the general public in Germany who would show an average level of attention (para 19). The signs were found to be visually, aurally and conceptually similar to an average degree since they have the element 'CANYON' in common (para 41). Moreover, the GC considered that the earlier mark had an average degree of distinctiveness because the applicant did not prove that the relevant public would perceive it as descriptive of the nature of the goods concerned (para 50). Therefore, the GC concluded that considering the identity between the goods, the existing similarities between the signs and the averaged degree of distinctiveness of the earlier mark, there is a likelihood of confusion between the trade marks concerned (para 57).

Case T-77/15; Tronios Group International BV v EUIPO; Judgment of 20 April 2016; Language of the case: NL

RESULT: Action dismissed

KEYWORDS: Acquiescence, Likelihood of confusion

FACTS: The EUTM proprietor was granted the registration of the word mark SkyTec as an EUTM for goods in Classes 9 and 11. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Articles 8(1)(b) and 8(5) EUTMR and Article 53(1)(c) in conjunction with Article 8(4) EUTMR with respect to the goods in Class 9. The Cancellation Division (CD) upheld the application for invalidity and dismissed the EUTM proprietor's defence based on Article 54(2) EUTMR (limitation in consequence of acquiescence). The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It confirmed that the exception of Article 54(2) EUTMR was unfounded. The EUTM proprietor did not proof that the invalidity applicant on the date of the invalidity application had acquiesced, for a period of five successive years, in the use of the contested EUTM while being aware of such use. The BoA also stated that there exists a likelihood

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of confusion between the contested EUTM and the invalidity applicant's earlier UK trade mark. The EUTM proprietor filed an action before the General Court (GC) relying on two pleas in law: (i) violation of Article 54(2) EUTMR and (ii) wrong assessment of the likelihood of confusion according to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that the evidence of acquiescence submitted by the EUTM proprietor was correctly assessed by the BoA and that it was not proven whether the invalidity applicant was 'actually', and not only potentially, aware of the use of the contested EUTM. Furthermore, the GC confirmed the existene of a likelihood of confusion.

EUTM
SkyTec
Earlier marks
SKY

SUBSTANCE: The GC emphasized that it is established case-law that the period of limitation in consequence of acquiescence starts running when four conditions are fulfilled (para. 30). The invalidity applicant must have 'knowingly' tolerated the use of the subsequent EUTM, the onus is on the EUTM proprietor (para. 33). Consequently, it is not sufficient that 'potential' knowledge of use of the subsequent mark is proven, it has to be proven whether there was 'actual' knowledge of such use (paras. 34-35). The goods in issue are in part identical, in part similar (not disputed). The relevant public is the average consumer and the professional public in the United Kingdom, the level of attention will vary from average to higher than average (not disputed). The marks are visually, phonetically and conceptually similar to an average degree (not disputed). The GC confirmed that the distinctiveness of the earlier UK trade mark SKY is not affected by the co-existence of this mark with many other marks that contain the element 'sky', the earlier mark has an inherent average degree of distinctiveness and an enhanced degree of distinctiveness in relation to some of the goods (paras. 56-59). The element 'Tec' in the contested EUTM is descriptive and plays a subordinate role within the mark (para. 59). There is likelihood of confusion.

Case T-545/15; Pi-Design AG v EUIPO; Judgement of 29 November 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The appellant - owner of the International Registration (IR) PRESSO in Classes 7, 11 and 21 - sought to extend the protection of its mark to

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the territory of the European Union. The owner of the earlier Swedish trade mark PRESSO for coffee products in class 30 filed an opposition based on Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the appellant's appeal. It found the goods similar to a certain degree and the sings identical and, thus, a likelihood of confusion between the signs at issue. The appellant filed an action before the General Court (GC).

EUTMA
PRESSO
Earlier mark
PRESSO

SUBSTANCE: The GC confirmed the BoA´s finding that the relevant public consists of both highly attentive professionals (Restaurant/Coffeehouse owners) as well as the general public with an average degree of attentiveness (para. 22).

As regards the comparison of goods, they share the same purpose, namely the preparation and adequate serving of coffee-based drinks. The goods are also complementary as coffee machines are important in the preparation of coffee drinks (paras. 30-33). As can be seen from publicly accessible sources (such as the internet hits submitted by the Office before the GC) it is a well-known fact that the producers of coffee also sell and distribute coffee machines, -filters,-mills. This finding is not altered by the appellant's unsubstantiated claim that those goods can be (and in the relevant territory Sweden actually are) also marketed by different companies. In light of the same purpose and their complementary character the BoA was right to find a certain degree of similarity between the goods at issue (paras. 35-38).

Even if it was assumed that the earlier mark only has a weakly distinctive character, it needs to be recalled that the distinctiveness of the earlier mark is just one factor in the overall assessment of a likelihood of confusion (para. 47). The appellant's claim of coexistence cannot be proven by merely submitting register excerpts of identical or similar registrations without further information about their actual market presence and concrete information on why a likelihood of confusion between these coexisting marks and the younger mark does not exist (paras. 48-50).

In light of the similarity of goods and the identity of the signs a likelihood of confusion exists, even if the earlier mark possessed only a low degree of distinctiveness.

Based on the foregoing, the appeal was dismissed.

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Case T-345/15; Modas Cristal, S.L. v EUIPO; Judgment of 14 July 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Abbreviation, Complex mark, Conceptual similarity, Dissimilarity of signs, Dominant element, Evidence of use, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Proof of use, Sales figures, Visual dissimilarity, Weak element

FACTS: The EUTM applicant sought to register the figurative mark KRISTAL (as depicted below) for goods and services in Classes 24, 26 and 35. An opposition based on the earlier word mark MODA CRISTAL, registered for services in Class 35 and the figurative mark HOME CRISTAL (as depicted below), registered for goods in Class 24, was filed on the grounds of Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition. It found that the use of the earlier word mark was not proven and there was no likelihood of confusion between the contested sign and the earlier figurative mark. The Board of Appeal (BoA) dismissed the opponent's appeal. The opponent filed an action before the General Court (GC) raising two pleas in law: (i) breach of Article 42(2) and (3) EUTMR and (ii) breach of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

KRISTAL

Earlier marks

1. MODA CRISTAL

2. home CRISTAL

SUBSTANCE: The GC found that the documents produced by the opponent as proof of use (PoU) of the earlier mark submitted for the first time before the GC are inadmissible. It confirmed the BoA assessment on PoU. Affidavits are admissible means of PoU, however as they have a limited probative value, further evidence is necessary to establish use. The evidence filed shows the use of the denomination Modas Cristal S.L. as a business name, which identifies a company with activity in the textile industry, but not as a trade mark. From the documents submitted it is impossible to confirm that the opponent renders services in Class 35

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under the earlier trade mark. With regard to the second plea, the CG dismissed the claim regarding the breach of Article 8(1)(b) EUTMR in relation to the earlier word mark. The issue of genuine use is specific and preliminary to the opposition proceedings, since it leads to a determination whether, for the purposes of the examination of the opposition, the earlier trade mark can be deemed to be registered in respect of the goods or services in question. As regards the earlier figurative mark and the contested sign, the goods and services were assumed to be identical (not disputed). Despite the bigger size of the element 'HOME', the word element 'Cristal' in the contested mark is legible and therefore, the former is not dominant but predominant in the overall impression given by the marks. Only if all the other components of the mark are negligible, the assessment of the similarity can be carried out solely on the basis of the dominant element. (Paras 66 - 68). The fact that the marks at issue contain similar word elements is not in itself sufficient to justify the conclusion that the signs at issue are visually similar. The presence in the signs of figurative elements of a particular configuration is likely to lead to the overall impression conveyed by each sign being different (Para. 73). The marks are visually similar to a very low degree. From the aural and conceptual perspective the signs are similar to certain extent. The element 'HOME' is, because of its bigger size, colour, typography and position at the beginning of the sign, the most important element. In particular, in relation to the relevant goods in Class 24, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (Para. 100). There is no likelihood of confusion.

Case T-563/15; Paglieri Sell System Sp.A v EUIPO; Judgment of 13 September 2016; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, Figurative trade mark

FACTS: The EUTM applicant sought to register the figurative mark represented below for an extensive range of goods in Classes 3, 5, 29 and 30. The examiner refused the registration of the EUTM application (EUTMA) and the Board of Appeal (BoA) confirmed the refusal for all of the goods. The applicant filed an action before the General Court (GC) relying on three pleas in law: infringement of Article 75 EUTMR, Article 7(1)(c) and 7(1)(b) EUTMR.

EUTMA

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SUBSTANCE: The GC dismissed the appeal and found that the decision of the BoA was sufficiently reasoned in accordance with the requirements set out under Article 75 (para. 14). The GC recalled the case-law according to which the Office has in principle to motivate the refusal in relation to each of the relevant goods. However, a global reasoning is permitted when it refers to goods that show a sufficiently direct and objective link to the extent that they form a homogeneous category or group (para. 15). The GC emphasized that the BoA indicated the nature of the connection between the goods and the mark in a precise manner and gave explicit reasons for its findings in relation to all of the specified goods (paras. 18 and 19). The GC further endorsed the finding of the BoA that the relevant public is made up average consumers and professionals (para. 28) who speak German, Danish and Croatian given the similarity between the word 'APOTEKE' and its equivalent words in those languages (para. 36).The word 'APOTEKE' will be perceived by this public as a misspelling (para. 38), and will immediately be understood as referring to the concept of a pharmacy (para. 44). The GC found that the figurative elements are not capable of diverting the consumer´s attention from the descriptive content of the verbal element, as both the colour green and the image of a red cross are used to indicate pharmacies. (Para. 46) These figurative elements reinforce the descriptive meaning of the mark as affirmed by the BoA (para 47). The BoA was correct in finding that the relevant public would see the mark as designating a place (pharmacy or parapharmacy) where all of the goods specified may be purchased (para. 49), either actually or potentially within the meaning of Article 7(1)(c) EUTMR (paras. 50-57). The application was fully examined and rightly found to be concretely descriptive. Therefore, the GC found that the applicant cannot rely on previous decisions of the Office in order to challenge the findings of the present case (para .62). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR.(paras. 63-66).

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R0426/2016-2 DEVICE OF FOUR COLOURED STRIPES (fig.)

RESULT: Revocation allowed.

KEYWORDS: Evidence of use, Figurative trade mark, Revocation grounds, Use not as registered

NORMS: Rule 22(3) CTMIR, Article 51(1)(a) EUTMR

FACTS: A request for a declaration of invalidity was filed against the figurative mark

registered for, among others, goods in Classes 9, 14, 16, 18, 19 and 20. The revocation request was based on the ground that the contested trade mark had not been put to use for a continuous five-year period. The Cancellation Division revoked the EUTM in its entirety (§ 4). The EUTM proprietor clearly failed to prove genuine use, since it did not submit sufficient evidence on the nature of use (§5).

SUBSTANCE: The mark is figurative, and not a colour-combination per se, it follows that use of the mark must correspond, without significant variation, to the colours green, red, yellow and blue, in that order as indicated, and conforming to a rectangular frame which, although not delimited by any explicit border, is approximate to the ratio of 2.5:1. (§ 20). In the case at stake, there is a fundamental contradiction between the representation of the mark as registered and as put to use (see representative sample of the alleged use of the mark (§ 23).

The mark as registered and the mark as used are incompatible: they belong to two radically different categories of marks (§ 26). The mark as used is not figurative, but rather a colour mark per se that is to say, in this case, a particular order of coloured stripes which can be applied to any product, or any surface without exception, whatever shape that particular product happens to take. The use is in inherent contradiction as concerns the true nature of the mark as registered. Indeed, it is by no means certain that the mark would have been granted registration if the EUTM proprietor had elected to define its mark as 'colour per se' or a colour combination (§ 29). The Board confirms the Cancellation Division's assessment, i.e. that the mark has not been used in the form in which it was

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registered, the contested decision, which upheld the revocation request pursuant to Article 51(1)(a) EUTMR must be upheld and the appeal dismissed (§30-31).

R2085/2015-5 meebox / MEEBOX

RESULT: EUTM cancelled

KEYWORDS: Company name, Competence of the Boards, Complementary evidence, Evidence of use, Identity of the signs, Legal certainty, Likelihood of confusion, New submission on appeal, Non-registered trade mark, Sales figures, Sign of mere local significance, Similarity between the goods and services, Used in the course of trade

NORMS: Rule 50(1) CTMIR, Article 8(4) EUTMR, Article 76(2) EUTMR

FACTS: A request for a declaration of invalidity of the EUTM 'meebox' was filed with respect to contested goods and services in Classes 9 and 42. The request was based on Article 8(4) EUTMR and, as earlier rights, the non-registered trade mark 'MEEBOX' used in Denmark, Germany, Spain, Sweden and the UK and the company name 'MEEBOX' registered in Denmark and Germany. The Cancellation Division rejected the request for a declaration of invalidity in its entirety on the ground that use of the earlier signs had not been shown.

SUBSTANCE: On the basis of the evidence filed by the cancellation applicant, the Board concludes that the earlier sign has been used in Denmark since 2010 through to 2015 (§ 32). The use shown is more than of merely local significance and appears to be regular (§ 30, 32). An unregistered trade mark has the same protection as a registered trade mark (§ 36). The proprietor of an unregistered mark is entitled, under Danish law, to prohibit the use and oppose the registration of a sign if based on the existence of a likelihood of confusion on part of the public in the territory where the earlier mark is protected (§ 37). There is a likelihood of confusion with respect to all the contested goods and services (§ 51). Under Danish law, in particular its provisions granting unregistered trade marks protection identical to registered marks, the cancellation applicant is entitled to prohibit the use of the contested mark in the relevant territory (§ 52). Consequently, the contested decision has to be annulled and the challenged EU trade mark declared invalid in its entirety (§ 53).

The request was based on Article 8(1)(a) and 8(1)

(b) EUTMR. The Opposition Division rejected the opposition as unsubstantiated as the opponent failed to submit a registration certificate of the earlier mark or an equivalent document proving the existence, validity and scope of protection of the earlier right (§ 9).

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SUBSTANCE: The opponent was requested by the Office to remedy the deficiency in parallel proceedings and, as a result of this request, it did submit the registration certificate in due time in those proceedings. A party to the proceedings can make reference to the evidence filed in a different case, provided that such a reference is made in due time and clearly identifies the documents to which the party refers (§ 21). In the present case, the opponent has made no specific reference to the evidence in the parallel case before the expiry of the time-limit to substantiate the earlier mark. It is not for the Office to consider evidence filed in a parallel case ex officio, even if the parties are the same (§ 22). The opponent filed no evidence of the earlier right before the first-instance department. Consequently, the evidence filed before the Board, cannot be considered 'additional' or 'supplementary'. Therefore, it cannot be admitted at this stage and the appeal is dismissed (§ 28-29).

R0741/2016-2

RESULT: Revocation allowed

KEYWORDS: Competence of the Boards, Filing date, New submission on appeal, Proof of use

NORMS: Rule 40(5) CTMIR, Rule 50(1) CTMIR, Rule 79(a) CTMIR, Rule 91 CTMIR, Article 51(1)(a) EUTMR, Article 74 EUTMR, Article 76(2) EUTMR

FACTS: A request for revocation was filed by the cancellation applicant, based on Article 51(1)(a) EUTMR. The Cancellation Division revoked the contested EUTM. The Cancellation Division duly notified the EUTM proprietors of the application for revocation and gave them a three-month time-limit to submit evidence of the EUTM's use.

SUBSTANCE: The EUTM proprietors did not submit any documents within the time-limit and submitted the evidence after the time-limit had expired. Further evidence was submitted for the first time before the Board. Article 76(2) EUTMR, Rule 50(1) CTMIR and Article 74(2) EUTMR do not constitute a free rein, enabling a party to be given a second chance systematically and automatically in order to complete its file and to establish any factual elements necessary for its cause of action. On the contrary, as to the situation when no evidence at all has been provided before the first-instance department, the Court has clarified that the new evidence must be rejected when the party has not submitted any proof of use within the time-limit set (18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 28). Therefore, in the case at hand, the Board has no discretionary competence to accept the evidence filed belatedly (§ 27). The appeal must be dismissed (§ 28).

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R779/2016-5

CARRERA PANAMERICANA (fig.) /

CARRERA (fig.) et al.

RESULT: Restitutio in integrum rejected / Appeal deemed not filed

KEYWORDS: Restitutio in integrum

NORMS: Article 81(1) EUTMR

FACTS: The applicant sought to register the figurative mark

for goods in Classes 3, 18 and 25.
The Office in its decision upheld the opposition, on the basis of earlier word trade mark No 9 504 961, and refused the trade mark applied for, for all the contested goods on the grounds that it was confusingly similar. No appeal was received by the Office. The applicant filed, however, a request for restitutio in integrum pursuant to Article 81 EUTMR, asking for the right to file an appeal against the Opposition Division's decision to be re-established. On the same date, it also filed the notice of appeal along with the corresponding statement of grounds of appeal.

SUBSTANCE: The applicant essentially argues that the notice of appeal was not filed due to a single and unparalleled 'blackout' of the professional representative's paralegal assistant, entrusted with the deadlines for the particular week in question. He also argues that what occurred was an exceptional mistake not imputable to the firm's organization and/or structure. The arguments that the professional representative's paralegal assistant, although well instructed, had a 'blackout' when she deleted the internal deadline for filing the notice of appeal does not constitute an unforeseeable error or event which could not have been predicted. On the contrary, it seems rather to be an event which, due to the numerous deadlines with which a firm deals, can be predicted and avoided, for example, by adopting a system of double checks. In addition, it is not usual for a professional representative to inform his or her client, in that case the applicant, about the fact that the submission has been correctly made by attaching a copy of the fax report (§ 20). Moreover, the Board observes that the notice of appeal along with the statement of ground were received almost two months after the deadline for filing an appeal had expired. The professional

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representative's attorney at law does not explain why the request and the notice of appeal along with the statement of grounds were received almost one month after the failure to submit the notice of appeal was claimed to have been discovered by the professional representative (§ 26). The circumstances relied upon by the applicant's professional representative cannot be regarded as exceptional within the meaning of Article 81(1) EUTMR and it has not been shown that 'all due care required by the circumstances' was taken (§ 27-28). It follows that the request for restitutio in integrum is dismissed and the appeal is deemed not to have been filed (§ 29-30).

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