

Alicante News

Up to date information on IP and EUIPO-related matters

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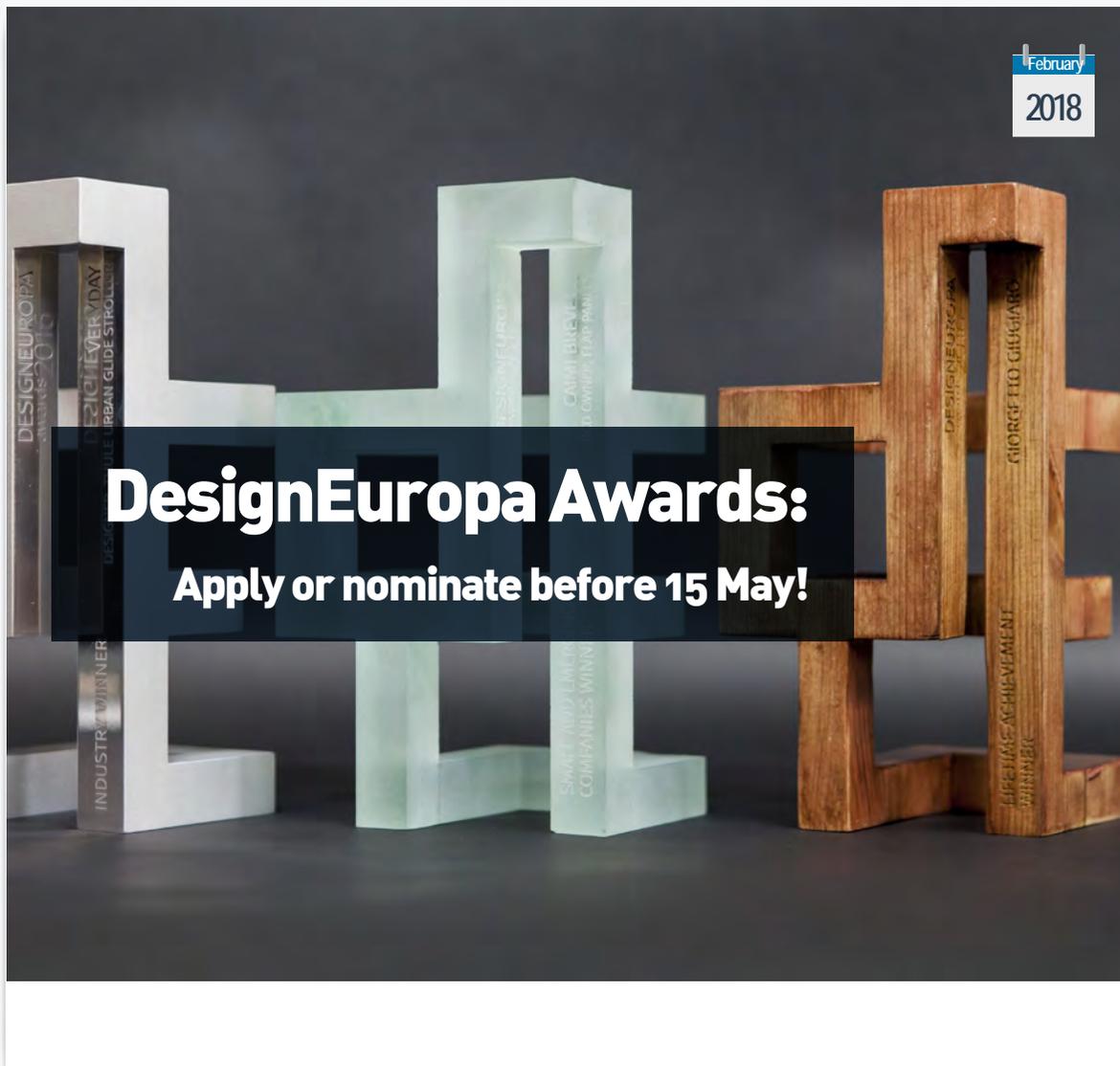
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February
2018

DesignEuropa Awards:
Apply or nominate before 15 May!

DESIGNEUROPA AWARDS 2018

DESIGN EVER/DAY
JULE URBAN GLIDE STROLLER

SMART AND LINEAR
COMPANIES WINNER

DESIGNEUROPA AWARDS 2018

GEORGE TEO GIUGIARO

DESIGNEUROPA AWARDS 2018

LIFETIME ACHIEVEMENT WINNER

INDUSTRY WINNER

The image shows three award trophies: a silver one on the left, a translucent green one in the middle, and a wooden one on the right. A calendar icon in the top right corner indicates the month of February and the year 2018. A dark blue banner with white text is overlaid across the trophies, reading 'DesignEuropa Awards: Apply or nominate before 15 May!'. The trophies have various inscriptions, including 'DESIGNEUROPA AWARDS 2018', 'DESIGN EVER/DAY JULE URBAN GLIDE STROLLER', 'SMART AND LINEAR COMPANIES WINNER', 'GEORGE TEO GIUGIARO', and 'LIFETIME ACHIEVEMENT WINNER'. The silver trophy also has 'INDUSTRY WINNER' written on it.

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DesignEuropa Awards:

Apply or nominate before 15 May!

Building on the success of the first edition held in Milan in 2016, the call for entries for the second edition of the DesignEuropa Awards is well underway.

The Awards seek to recognise companies and designers that have brought outstanding design to the market with the protection of the **Registered Community Design (RCD)**.

The ultimate goal of the Awards is to **raise awareness on the importance design and its protection** to foster innovation and growth.

EUIPO's users and stakeholders are encouraged to support the initiative by helping to disseminate the Awards among RCD holders, industry and designers.

There are two ways to participate. RCD holders can apply directly by submitting their registered designs. Alternatively, anyone can propose their favourite designs as candidates in either category through the nomination form. Applying and nominating is free of charge and easy to do using the [online forms](#).

The application and nomination period is open until 15 May.

The DesignEuropa Awards have three categories:

The Industry Award: This category is for RCDs owned by companies which have more than 50 employees and over €10 million in turnover/€10 million balance sheet total.

The Small and Emerging Companies Award: This category is for RCDs owned by companies which comply with one of the following conditions:

- Fewer than 50 employees and less than €10 million turnover/€10 million balance sheet total
- Companies established after January 1 2014, regardless of their size

The Lifetime Achievement Award (nomination only): This category is reserved for individual designers with a significant body of work of aesthetic value, created over the course of a career, which has also had a demonstrable impact on the marketplace. Nominees in this category must currently use or have used the RCD system during their professional careers.

The rules of the competition are available [here](#).

The finalists and winners will be chosen by the DesignEuropa Awards jury, which is composed of members drawn from the fields of design, business and intellectual property rights.

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The jury members will base their selection on: the aesthetic value and visual appeal of the designs submitted; the demonstrable impact in the market of the submitted designs; and the sound marketing and management of design and other IP rights.

The 2016 edition of the DesignEuropa Awards set a high standard in terms of applications and nominations, which came from around the world, and encompassed a wide range of products and designs in all categories.

Four finalists in each of the company categories were chosen, along with one winner of the Lifetime Achievement Award – legendary Italian designer Giorgetto Giugiaro.

The finalists in the Small and Emerging Companies category showed the power of the Registered Community Design in supporting firms of all sizes and disciplines.

The finalists designs belonged to an established family firm specialising in high-tech soundproofing solutions, a boutique lighting design firm which collaborates as a matter of course with some of the world's leading designers, a creative start-up founded by two young German designers, and a one-woman design studio based in the United Arab Emirates.

The Industry category finalists featured world leaders in design and innovation, with rich histories and global recognition in their fields. Again, all had used the RCD to protect their design excellence as part of their business strategies.

This year's DesignEuropa Awards ceremony will take place in Warsaw on 27 November. It will be held in collaboration with the [Polish Patent Office](#), which is celebrating its centenary in 2018.

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Design filing - Tips & best practices for minimizing objections

Filing a Community design before the EUIPO is simple and fast: with the new Fast Track eFiling form and new tools now integrated to the application form, it can take as little as 10 minutes and in most of the cases, the design will be registered in two days or even less.

Nevertheless, the average rate of deficiencies detected during the examination procedure before the Office still remains high: in 2017, the EUIPO received 26,017 Community design applications, 23% of them with deficiencies (5,984 applications) to be remedied by the applicant to comply with the legal requirements established by the RCD regulation.

The most common mistake concerns the representation of the design, the wrong specification of the indication of the product, missing priority documents and the indication of the deferment of the publication not properly claimed when filing. Generally arising due to a lack of information of the legal requirements, these mistakes could be avoided before filing. Very few corrections are possible after filing and the registration may be adversely affected or refused by the Office.

Representation of the design:

Once filed, in principle, the design representation cannot be altered. Therefore filing of a correct design representation is extremely important. It will directly affect the design's subject matter of protection once registered.

One and the same design

The representation of the views must consist of a graphic or photographic reproduction, for one and the same design, and on a neutral background and in good quality. It is recommended to avoid any alteration (colour, features, shape, etc) of the design in the different views provided in the application and exclude external elements to the design which do not permit to clearly determine for which the applicant seeks protection. Variations are considered different designs. The relevant legal provisions do not allow the inclusion of any other matter.

Disclaimer for external elements in the views

When the representation requires including external elements visible in the views but not intended to be protected, the representation should contain clear graphical disclaimer to enable the examiner and third parties to determine unequivocally the matter to be protected by the design.

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Visual disclaimers to exclude features from protection are detailed in the Guidelines for Examination (Chapter 5.3) at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_2_2017/examination_of_applications_for_registered_community_designs_en.pdf

Minimum 1 view, maximum 7 views, plus 3 extra non protected views

The design should be represented by at least one view and the maximum number of protected views is 7 per design. Additionally 3 unprotected and not published views may be submitted. The same applies to multiple applications.

Product indication of the design:

The indication of the product often affects the examination procedure before registration: this indication will help third parties to identify the product which the design is intended to be applied to or incorporated in. The applicant must provide an indication of the product for every design submitted. The typical mistake is an unclear specification of the indication of the product or an indication that does not correspond with the representation of the design itself.

DesignClass to avoid errors

To avoid unfortunate errors when filing, the Office has integrated to the application form a new tool DesignClass from which the applicant can browse and find terms accepted by the EUIPO, valid in all EU IP Offices. It is highly recommended to use DesignClass and choose the terms which fit better with the product concerned. DesignClass has also been integrated into other search systems that have a design component, such as DesignView and eSearch Case Law.

On 7th March 2017, the EUIPO proposed a specific webinar available online on DesignClass that can be attended freely at: <https://euipo.europa.eu/knowledge/course/view.php?id=2822>

Priority & missing documents:

A person who has filed a national, international or Community design application enjoys for the purpose of filing a Community design application a right of priority for a period of six months from the date of filing the first application. The application must concern the same design to confer to the proprietor the right to claim for priority. The same rule applies for the applicant of the Community design: the person (legal or physical entity) must be the same person of the previous application. In order to avoid a deficiency notification on this matter and a possible loss of priority right, a complete copy of the previous application (issued by the authority

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that received the previous application) must be submitted no later than three months from the date of submitting the priority claim.

If the language of the previous application is not one of the EU languages, the Office requires translation of the information that allows the examiner to check the nature of the right (design or utility model), the country of filing, the file number, the filing date, the applicant's name and the information regarding earlier filing rights.

Missed indication of a request of deferment of the publication:

When filing a Community design application, the owner can request its publication to be delayed for a period of up to 30 months. The design can, therefore, be kept confidential until the applicant is ready to disclose it.

The request for deferment must be made on the initial application form; later requests (even on the same date) will not be accepted. Where no deferment request is indicated within the application, the Community design will be registered and published.

Deferment & fees calculation

A useful tip is to check, when completing the eFiling form online, the fees to be paid. The eFiling system provides directly the applicant with the exact calculation of fees to be paid, taking exclusively into

account the registration and deferment fees, where a request of deferment is included. The publication fees will not appear in the final amount as it will have to be paid at later stage, with the request of publication (at the latest three months before the 30-month period of deferment expires).

When applying for designs with deferment, the applicant has to pay the registration and the deferment fees. Optionally the applicant can pay also the publication fees at the time of the filing. Depending on the decision of the applicant, the system will provide the exact amount.

More tips and best practices online:

- A series of tips to avoid deficiencies when filing for a registered Community design <https://euipo.europa.eu/ohimportal/en/design-filing-tips-best-practices#t9>.
- "Designs" – "Route to registration" available online, the applicant can find a check list to comply with before filing: <https://euipo.europa.eu/ohimportal/en/rcd-route-to-registration>
- Practice of the Office regarding the Community design examination [link](#) to [guidelines](#)
- Online courses and webinars: <https://euipo.europa.eu/knowledge/>

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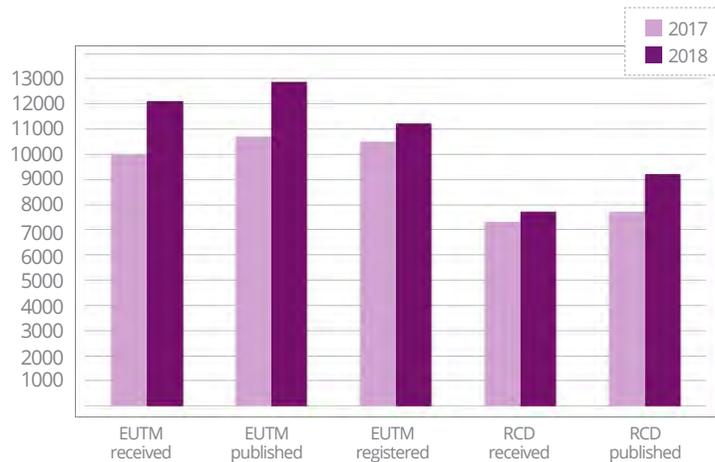


Statistical Highlights



Monthly statistical highlights January*	2017	2018
European Union Trade Mark applications received	9 958	12 105
European Union Trade Mark applications published	10 708	12 861
European Union Trade Marks registered (certificates issued)	10 484	11 211
Registered Community Designs received	7 312	7 721
Registered Community Designs published	7 713	9 195

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



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The Economic Cost of IPR Infringement in the Tyres and Batteries Sectors

The latest report in the quantification of infringement study series, released today by the EUIPO, through the European Observatory on Infringements of Intellectual Property Rights, shows that EUR 2.4 billion is lost each year through counterfeiting in the tyre and battery sectors in the EU.

The findings of this study show that:

- EUR 2.2 billion — corresponding to 7.5 % of all sales in tyres for cars, trucks and two-wheeled vehicles — is lost each year due to counterfeiting across the EU.
- The presence of counterfeit batteries in the EU market costs legitimate industry EUR 180 million each year, which is equivalent to 1.8 % of the sector's sales.
- These lost sales translate into the loss of approximately 8 400 jobs across the sector, as legitimate manufacturers employ fewer people than they would have done in the absence of counterfeiting.

- In terms of lost taxes, the total loss of government revenue as a result of counterfeit tyres and batteries amounts to EUR 340 million.

The full study in English and the Executive Summaries in 23 languages can be found [here](#)

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Change of EUIPO bank account for payment of fees

On 17 February 2018, one of the two bank accounts used by EUIPO to which users may transfer fees, current account replenishments and charges changed.

The BBVA bank account previously used by the Office was replaced by one with Banco Santander.

This change does not affect the bank account held by the Office at CaixaBank, which remains unchanged.

[Find out more.](#)

EUIPO performance update: Q4 2017

The Office [has published its 2017-Q4 results](#) for timeliness, quality and accessibility.

EUIPO is committed to continuously improving the quality and timeliness of its decisions.

As a result, the Office set more demanding targets for the relevant indicators in 2017, and put in place a series of actions to ensure the targets were complied with, including daily monitoring of cases which aligned processing time with planning.

These actions have already improved several key performance indicators, including those of timeliness for EUTM Fast Track Publication and Opposition decisions, which achieved their compliance targets after some months in action needed.

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

Case T-249/15; JT v EUIPO; Judgment of 11 December 2017; EU:T:2017:885, Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Figurative trade mark, Non-registered trade mark, Ownership of IP right, Statement of grounds, Well-known trade mark

FACTS: Registration as an EUTM was sought for the figurative sign represented below for goods and services in Classes 9, 16 and 41. An opposition based on the earlier well-known figurative mark, French trade mark and international trade mark represented below, registered for goods and services in Class 41, was filed pursuant to Article 8(1) (a) and (b) and Article 46 EUTMR. The Opposition Division (OD) partly upheld the opposition insofar as it found likelihood of confusion, given the identity of the signs and the similarity or identity of the goods and services covered (Class 9: magnetic data carriers, recording discs and Class 41: providing of training; entertainment; sporting and cultural



activities). An appeal was filed before the Board of Appeal (BoA), which was upheld and the BoA annulled the OD's decision. It also found that the opponent had not submitted evidence of being the 'real proprietor' of the previous well-known mark, whereas proprietorship was also claimed by the other parties to the proceedings. Finally, it concluded that it had no competence to decide who met the conditions of being the proprietor of the unregistered well-known mark, but that it was up to the national court to decide. The opponent filed an action before the General Court (GC), relying on a single plea in law: (i) erroneous interpretation and application of Article 8(2)(c) EUTMR, in conjunction with Article 6bis of the Paris Convention.

EUTM application



Earlier trade mark



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SUBSTANCE: The BoA erred in law insofar as it required evidence that the opponent was the exclusive owner of the previous mark, without assessing whether co-ownership was sufficient entitlement to file the opposition (para. 50). Article 2(1) EUTMDR does not rule out that the earlier mark can have various proprietors. Should exclusive co-ownership be necessary, then neither of the co-proprietors of the trade mark could individually oppose the registration of the contested sign on behalf of a third party, unless they were to do so jointly (paras 47-48). The opponent did not sustain for the first time before the GC that it was the co-proprietor of the previous mark; it had not denied that the previous well-known mark could have various proprietors, as it had stated that, in the absence of any express resolution regarding co-ownership, two different musical groups had been created, both claiming the contested sign (para. 51). As for the request for refusal of registration on behalf of the GC, it suffices to remark that the GC has no competence to make an assessment on an issue that the BoA has not examined. The power of the GC to alter decisions does not have the effect of conferring on the GC the power to substitute its own reasoning for that of a BoA, nor to carry out an assessment on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the GC, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as

established, what decision the BoA was required to take. Therefore, it is not up to the GC to examine the argumentation regarding the acquisition of the rights over the previous unregistered mark on behalf of the proprietor (para. 52).

Case T-771/15; Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO; Judgment of 12 December 2017; EU:T:2017:887; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complementary evidence, Declaration, Domain names, Evidence of use, Extent of use, Fax, Legal certainty, New submission on appeal, Place of use, Proof of use, Representative, Revocation grounds, Right to be heard, Suspension of the proceedings

FACTS: The applicant was the proprietor of the EUTM registration for the word mark bittorrent for Classes 35, 38 and 42. The intervener, BitTorrent Inc., filed an application for revocation of the mark at issue, based on Article 58(1)(a) EUTMR, on the ground that that mark had not been put to genuine use in the European Union in connection with the services concerned within a continuous period of five years. The Office notified the applicant that it had three months within which to submit evidence of use of the mark at issue. Following a request

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from the applicant, the Office extended this time limit (expiring on 19 October 2011) by one month (i.e. to 21 November 2011, since 19 November 2011 was a Saturday). On 21 November 2011, the last day of the time limit for establishing genuine use of the mark at issue, the applicant transmitted a five-page letter by fax, which referred to attached documents that, however, were not attached to the fax. By fax of 23 November 2011, the applicant's representative informed the Office that it had not sent all of the documents due to a fax machine failure. On 24 November 2011, the Office received by post the 69 pages of items of evidence referred to in the five-page letter sent by fax on 21 November 2011. The Board of Appeal (BoA) held that the applicant had submitted no relevant proof before the Cancellation Division (CD) within the time limit specified so the evidence submitted before the BoA could not be taken into account. The BoA therefore concluded that genuine use of the mark at issue had not been proven, and held that the mark must be revoked. For the sake of completeness, the BoA nonetheless assessed the evidence submitted late before the CD and that submitted before the BoA at the appeal stage, and held that it did not prove use of the mark at issue.

The applicant raised two pleas: (i) infringement of Article 95(1) and (2) EUTMR and (ii) infringement of Article 58(1)(a) EUTMR.

SUBSTANCE: REGARDING THE ADMISSIBILITY OF THE ANNEXES: The evidence filed for the first

time before the GC is inadmissible (paras 16-21). REGARDING THE FIRST PLEA IN LAW: In proceedings for revocation of an EUTM, it is for the EUTM proprietor, and not the Office of its own motion to establish genuine use of that mark (paras 28-30). The rule that the Office is to examine the facts of its own motion, as laid down in Article 95(1) EUTMR, does not apply to the question of proof of genuine use of the EUTM in revocation proceedings brought before the Office (para. 31). Regarding the evidence submitted late before the CD, the Office may disregard facts or evidence that are not submitted in due time by the parties concerned and has broad discretion to decide whether or not to take such information into account (paras 33, 36). Where the Office is called upon to rule on an application for revocation, taking belated evidence into account is particularly likely to be justified where the material is complementary to evidence submitted within that time limit and the Office considers that the belated material is likely to be relevant to the outcome of the application for revocation and that the stage of the proceedings and the circumstances surrounding it do not argue against such matters being taken into account (para. 40). In this case, only the letter sent by fax on 21 November 2011 was produced by the applicant before the CD within the period specified (para. 41). The letter submitted within the time limit is a five-page document, but it clearly contains only statements that are not substantiated by any supporting evidence capable of adducing proof of the place, time, extent and nature of use of the

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mark at issue, since the evidence was submitted three days after the time limit expired. The BoA was thus correct in finding and concluding that no proof was submitted in due time before the CD (para. 45). The reason behind the failure to respect the deadline shows inexcusable negligence and cannot be attributable to exceptional circumstances that could not be predicted from experience (paras 49-51). The BoA duly took into account all the relevant circumstances concerning the belated evidence (para. 52). With regard to the items produced before the Landgericht Berlin in 2010, the contested mark in those proceedings was not the EUTM at issue but a German mark registration, bittorrent, and the territory was Germany and not the European Union, as in the present case (para. 56). With regard to the items produced in May 2008 in opposition proceedings against the intervener, the applicant referred to these items only before the BoA. In addition, they were insufficient to prove genuine use of the EUTM as those documents are a very brief description of the website 'bittorrent.net' and three extracts from that website (para. 57). As to the evidence submitted for the first time before the BoA, since no proof of use of the EUTM was filed before the CD within the time limit and since the evidence filed at the appeal stage was not complementary to the evidence produced within that period, the applicant could not argue that the evidence submitted before the BoA was additional evidence that should have been taken in account (para. 63). In addition, the applicant did not file a

request for the continuation of proceedings under Article 105 EUTMR or for restitutio in integrum under Article 104 EUTMR (para. 65). REGARDING THE SECOND PLEA IN LAW: With regard to the arguments presented in the context of the first plea in law, no genuine use of the mark at issue had been proven by the applicant (para. 67).

Case T-622/16; Sheepworld AG v EUIPO; Judgment of 7 December 2017; EU:T:2017:878; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element

FACTS: The applicant sought to register the word mark Alles wird gut as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28 and 33. The examiner refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the EUTM application would not be perceived by the relevant public as an indication of the commercial origin of the goods applied for. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

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SUBSTANCE: 'Alles wird gut' is a German expression meaning 'everything will be fine', which is used in everyday language to express, in particular, affection or consolation in the face of certain events in life. The German-speaking public will understand this phrase only in the sense that, by buying a gift or using the goods covered by the EUTM application, including those received as gifts, 'everything will be fine', and thus perceive it as a reassuring message, creating a positive feeling (para. 34). Consumers will not need to perform an interpretive effort or successive intellectual associations to understand the phrase as a laudatory expression that encourages the purchase or use of the goods and highlights their attractiveness. Therefore, the EUTM application will not be understood as an indication of the commercial origin of the goods (para. 37). The BoA correctly assessed how the EUTM application might be perceived in the future and was not required to establish that the EUTM application was usually used in advertisements (para. 44). Overall, the BoA was right to find that the EUTM application was devoid of distinctive character (para. 49).

Case T-332/16; Colgate-Palmolive Co. v EUIPO; Judgment of 7 December 2017; EU:T:2017:876; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Distinctiveness acquired by use, Evidence of use, Extent of use

FACTS: The applicant sought to register the word mark 360° for toothbrushes in Class 21. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner's decision. The Board of Appeal (BoA) dismissed the appeal and confirmed that the word mark is descriptive and non-distinctive. Distinctiveness acquired by use was not proven. The applicant raised four pleas: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) infringement of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR.

SUBSTANCE: RELEVANT CONSUMER: The relevant public consisted of average, reasonably well-informed and reasonably observant and circumspect consumers of toothbrushes in the European Union (para. 18). **DESCRIPTIVENESS:** The sign applied for has at least: i) a possible meaning of the mathematical concept of 360°, and ii) it is

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connected with a circle, in the sense of 'all round', designating a characteristic of the goods concerned, namely that of allowing profound brushing and complete, quality dental cleaning (para. 20). The sign is therefore not ambiguous and describes a profound brushing all around the tooth (para. 21). **DISTINCTIVENESS ACQUIRED BY USE:** The word mark never appears on its own but is always associated with the trade mark Colgate, and with other descriptive terms (para. 51). The BoA was right to find that the territory in which the mark applied for did not have any distinctive character ab initio was the European Union as a whole, so the acquisition of distinctive character by that mark had to be established in relation to each of the Member States (para. 56). As the evidence does not in any way demonstrate the relevant public's perception of the mark applied for on its own, the applicant has not proven that the mark applied for, taken purely on its own, has acquired distinctive character throughout the European Union (paras 62-63).

Case T-333/16; Colgate-Palmolive Co. v EUIPO; Judgment of 7 December 2017; EU:T:2017:875; Language of the case: EN

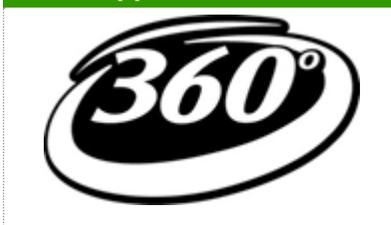
RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Distinctiveness acquired by use, Dominant element, Evidence of use, Extent of use, Figurative

element, Figurative trade mark

FACTS: The applicant sought to register the figurative sign represented below for toothbrushes in Class 21. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner's decision. The Board of Appeal (BoA) dismissed the appeal and confirmed that the word mark was descriptive and non-distinctive. Distinctiveness acquired by use was not proven. The applicant raised four pleas: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) infringement of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR.

EUTM application



SUBSTANCE: RELEVANT CONSUMER: The relevant public is mainly the general public of the European Union who are consumers of toothbrushes, informed and reasonably attentive (para. 18). **DESCRIPTIVENESS:** The sign applied for has at least: i) a possible meaning of the mathematical concept of 360°, and ii) it is connected with a circle, in the sense of 'all round', designating a characteristic

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of the goods concerned, namely that of allowing profound brushing and complete, quality dental cleaning (para. 20). The sign is therefore not ambiguous and describes a profound brushing all around the tooth (para. 21). The figurative elements around the number reinforce that descriptive message by evoking a characteristic of the goods in question, namely their ability to clean 'all around' a tooth (para. 28). **DISTINCTIVENESS:** Since one ground for refusal is sufficient, there is no need to examine Article 7(1)(b) EUTMR (paras 35-38). **DISTINCTIVENESS ACQUIRED BY USE:** The sign is always used in combination with the applicant's trade name and other descriptive elements (para. 56). As the evidence does not in any way demonstrate the relevant public's perception of the mark applied for on its own, the applicant has not proven that the mark applied for, taken purely on its own, has acquired distinctive character throughout the European Union (paras 67-68).

Case T-893/16; Xiaomi, Inc. v EUIPO; Judgment of 5 December 2017; EU:T:2017:868; Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant sought to register the word mark MI PAD for goods and services in Classes 9 and 38. The intervener filed an opposition against all the goods and services of the contested mark based on the earlier word mark IPAD covering goods and services in the same classes. The Opposition Division (OD) upheld the opposition on the basis of Article 8(1)(b) EUTMR and rejected the application for registration for all the goods and services covered. The applicant filed an appeal against the OD's decision. The Board of Appeal (BoA) dismissed the appeal because it considered that the marks were highly similar visually and phonetically, and were very similar conceptually in the English-speaking part of the European Union. Moreover, it considered that the marks at issue were both weakly distinctive, at least for the English-speaking part of the public. The applicant raised a single plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: RELEVANT PUBLIC: The average consumer's level of attention ranged from average to high for the goods and services in Classes 9 and 38, depending on their complexity and their price (para. 25). **COMPARISON OF THE SIGNS:** (i) the marks at issue do not contain any dominant elements and the common element 'pad' cannot be regarded as negligible (para. 41); (ii) visual similarity: the marks are highly similar visually despite the presence of the additional letter 'm' at the beginning of the mark for which protection is sought (para. 45); (iii) phonetic similarity: the marks display an average degree of

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phonetic similarity for the English-speaking part of the relevant public of the European Union and a high degree of phonetic similarity for the non-English-speaking part of the relevant public (para. 48); (iv) conceptual similarity: the marks at issue display an average degree of conceptual similarity for the English-speaking part of the relevant public because of the meaning attributed to the common element 'pad'. As regards the non-English-speaking part of the relevant public, the conceptual comparison of the marks at issue remains neutral (paras 54-55). As the relevant territory is the European Union, the existence of a likelihood of confusion for the non-English-speaking part of the relevant public, because of the high degree of visual and phonetic similarity between the marks at issue and the identity or the similarity of the goods and services in question, is sufficient to prevent the registration of the mark applied for (para. 65).

Case T-304/16; bet365 Group Ltd v EUIPO; Judgment of 14 December 2017; EU:T:2017:912; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Distinctiveness acquired by use, Evidence of use, Extent of use, Sales figures

FACTS: The EUTM proprietor registered the word

mark BET 365 as an EUTM for goods and services in Classes 9, 28, 35, 36, 38, 41 and 42 on account of acquired distinctiveness of Article 7(3) EUTMR. An application for invalidity was filed pursuant to Article 7(1)(b) and (c) EUTMR. The Cancellation Division (CD) dismissed the application for invalidity insofar as it found that the EUTM had acquired distinctive character through use. The Board of Appeal (BoA) upheld the appeal. It held that the EUTM had not acquired distinctiveness through use in Denmark, Ireland, the Netherlands, Finland, Sweden and the United Kingdom on the EUTM's filing date. The EUTM proprietor did not establish the link between the demonstrated commercial success and its advertising activities and the public's perception of the EUTM due to insufficient direct evidence. The press articles mainly relied on did not relate to the relevant territory and the figurative and colour signs shown therein did not correspond to the EUTM. Furthermore, the evidence relates to use of the element 'bet365' to designate either the applicant itself or its website, but not to its use as a mark. In addition, the commercial data provided was not apportioned among all the goods and services. There were no opinion polls, assessments from chambers of commerce, consumer organisations or competitors to provide information in that regard and the evidence submitted only concerned the services in Class 41 relating to betting and gambling per se. The EUTM proprietor filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 7(3) EUTMR.

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SUBSTANCE: (i) Even though the EUTM proprietor expressly refers only to an infringement of Article 7(3) EUTMR, its plea in law also concerns an infringement of Article 59(2) EUTMR. The invalidity proceedings based on absolute grounds for refusal directly refer to the absolute grounds for refusal set out in Article 7 EUTMR, and to the exception of the acquisition of distinctive character through use that moderates them, the only potential substantive difference between the two procedures being the time at which the acquisition of such distinctive character must be assessed. Therefore, it is sufficient to give a ruling concerning the date of filing of the invalidity request (paras 23-24). (ii) The examination was correctly limited to the said EU Member States and does not expand to others with a public that has at least passive knowledge of English. However, Cyprus and Malta should also have been taken into account, since they were already Member States on the date on which the proprietor sought to register the EUTM. Distinctive character acquired through use must be proven only for the states that were EU Member States at the time of filing the application for registration of the EUTM (paras 32-35). (iii) The proprietor only submitted evidence for betting and gambling services in Class 41. For the other goods and services, the decision of the BoA cannot be annulled (para 36). The BoA erred in excluding figurative marks or marks composed of several word elements containing the EUTM (with different typography and colours) (para. 39). (iii) The use of the EUTM as a website name could constitute use 'as a

trade mark' because: (a) only the applicant uses the element 'bet365' for the marketing of gambling and betting services; (b) that element is found in all the marks used to identify its services; (c) its website is its main gambling and betting sales channel; (d) in that sector, most of the marks used by online operators are inherently descriptive; and (e) betters and gamblers are, in the vast majority of cases, regular customers (paras 43-44). (iv) Consequently, the number of connections to the applicant's website, its ranking in terms of the number of visits in various countries or the number of times the contested mark or its derived marks were the subject of a search using internet search engines is an indication of acquired distinctiveness by use. The same applies to extracts of pages from the proprietor's website or other websites, in various languages, on which the contested mark or its derived marks appear (para. 46). (v) The use of the EUTM in press articles, in particular in association with betting odds and the comparison of services illustrate the use of the EUTM as a trade mark and not exclusively as a company name (paras 49-52). (vi) The stake figures, advertising investment, particularly that concerning sponsorship, or the sums paid to affiliate websites directing players and betters to the applicant's website relate either completely or essentially to gambling and betting services marketed by the applicant under the EUTM or its derived marks. Therefore, this evidence cannot be dismissed with the argument that it cannot be apportioned among the goods and services (para. 54).

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Case T-815/16; For Tune sp. z o.o. v EUIPO; Judgment of 12 December 2017; EU:T:2017:888; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Distinctive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Scope of proceedings, Similarity of the goods and services, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark below for Classes 9, 16, 35, 40 and 41, describing the mark as follows: 'A figurative mark consisting of two words, in colour. The word "opus" is in blue (Pantone Cyan C) and the letter "o" is in white inside a rhombus in blue (Pantone Cyan C). The word "AETERNATUM" is in black, bold letters.' Simplicity trade GmbH filed an opposition against the goods and services in Classes 16, 35 and 41 based, inter alia, on the earlier EU word mark OPUS, pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partially upheld the opposition, refusing the application for the following goods in Class 16: paper, cardboard and goods made from these materials, not included in other classes, printed matter; book-binding material, photographs, plastic materials for packaging (not included in other classes); the following services in Class 35: advertising; business management; business administration; office functions and the

following services in Class 41: education; providing of training; entertainment; sporting and cultural activities. The applicant filed a notice of appeal against the OD's decision. The Board of Appeal (BoA) dismissed the appeal and held that there was a likelihood of confusion (LOC) between the marks. The applicant raised a unique plea: infringement of Article 8(1)(b) EUTMR.

EUTM application



Earlier trade mark

OPUS

SUBSTANCE: RELEVANT PUBLIC: The goods and services in Class 16 and 35 target the general public and also a professional public with a level of attention that may vary from average (Class 16) to high (Class 35); for Class 41, the services are rather varied and target both the general public and professionals, the level of attention was normal (para. 29). COMPARISON OF THE GOODS AND SERVICES: The goods in Class 16 and the services in Class 35 and 41 are identical to those covered by

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the earlier mark (para. 34). COMPARISON OF THE SIGNS: the two marks are visually similar as they both have the word 'OPUS' (para. 39). Moreover, the word element 'OPUS' is dominant as it is the largest element and it is placed above the smaller element 'AETERNATUM' (paras 44-46). The graphic elements are weakly distinctive because they will be perceived as decorative and meaningless elements and the stylised typeface has no effect on the overall impression of the mark (paras 47-50). Phonetically, the signs are similar if not identical, as the pronunciation of the marks coincides in the syllables 'o' and 'pus' and it is likely that a significant part of the relevant public will not pronounce the element 'aeternatum' (para. 58). Conceptually, the signs have the concept of 'opus' in common, while the word 'AETERNATUM' and the figurative elements have no meaning for a significant part of the public in the relevant territory (para. 63). **DISTINCTIVE CHARACTER:** The earlier mark has a normal degree of inherent distinctiveness arising out of the fact that it is not, as a whole, descriptive, allusive or laudatory (paras 69-72). **LOC:** Taking into account that the goods and services concerned are either identical or similar to a normal degree, and the distinctive word element, which is not only common to both of the marks but is also dominant in the mark for which protection is sought, which means that the two marks are visually and conceptually similar and phonetically similar to an average degree, there is LOC (para. 79).

Case T-61/16; The Coca-Cola Company v EUIPO; Judgment of 7 December 2017; EU:T:2017:877; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Figurative trade mark, Evidence of use, Use in third country, Packaging, Relevant territory, Reputation, Scope of proceedings, Unfair advantage, Well-known trade mark

FACTS: An application was filed to register the figurative mark



as an EUTM for goods in Classes 29, 39 and 32. An opposition based on the earlier EU figurative trade marks (i)



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(ii)



(iii)



and (iv)



registered for goods and services in (i) Classes 30, 32 and 33; (ii) Class 32; (iii) Classes 32 and 43; and (iv) Classes 32 and 33, as well as on the earlier United Kingdom figurative mark



goods in Class 32) was filed pursuant to Article 8(1) (b) and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition. The opponent appealed against the OD's decision and the Board

of Appeal (BoA) dismissed the appeal. It found that the signs were not at all similar and there was no likelihood of confusion despite the identity of goods. Furthermore, it disregarded the evidence submitted by the opponent, since it claimed that only the use of the mark for which protection was sought could be taken into account. The applicant filed an action before the GC relying on the grounds of Article 8(5) EUTMR. The GC annulled the BoA's first decision and requested the BoA to take into consideration the evidence regarding commercial use of the contested mark. It referred the case to the BoA for examination, which again dismissed the opponent's appeal. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(5) EUTMR and (ii) infringement of Article 72(6) EUTMR.

SUBSTANCE: USE OF A SIGN IN THE COMPOSITE MARK 'MASTER COLA': Since the term 'master' is the distinctive and dominant element of the 'Master Cola' mark used on 'www.mastercola.com', in particular for drinks, the element 'master' continues to be perceived as an indication of the origin of the goods. Therefore, the use of that term within the composite trade mark 'Master Cola' is indeed a use of the trade mark Master as such, and the evidence regarding its commercial use was correctly taken into account (para. 76). TERRITORIALITY AND USE IN THIRD COUNTRIES: There is no derogation from the principle of territoriality, since the applicant relies on EUTMs, namely the four earlier Coca-Cola

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EUTM application



Earlier trade marks



marks, and not on well-known marks in third states that are not registered in the EU (para. 85) The principle of territoriality does not preclude taking into consideration evidence relating to the actual commercial use of the contested mark Master (in combination with the term 'cola') in Syria and the Middle East, such as excerpts from the website 'www.mastercola.com', which is written mainly in Arabic. They may serve for the purpose of establishing a risk that the use of that mark in the European Union would take unfair advantage of the reputation of

the four earlier Coca-Cola EUTMs (para. 89). RISK OF FREE RIDING : The actual use of the mark applied for occurring anywhere in the world may lead to a logical inference that there is a serious risk that the contested mark will be used in the same way within the European Union as in the third countries (para. 104). The fact that presentational features (namely the red label on which the term 'Master Cola' is written in white, the characteristic shape of the container and the red cap, as well as the Spencerian script) are already used on the website in its current state may reinforce the logical inference that there is a risk of free riding and that an amended form thereof could be used in the future on that website in order to target consumers in the EU (para. 105). The applicant referred at length to the concrete image of the four earlier Coca-Cola marks. The evidence submitted, in particular the excerpts from the Superbrands study, made it possible to establish clearly what Coca-Cola stood for, and therefore, the concrete image that was liable to be transferred from the earlier marks to the contested mark (paras 114, 119).

Case T-114/16; Delfin Wellness GmbH v EUIPO; Judgment of 13 December 2017; EU:T:2017:899; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Disclosure within the EU

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FACTS: The intervener is the proprietor of the three contested Community designs below, all registered on 17 December 2008 for infrared cabins, saunas in Class 23.02 of the Locarno Classification. The applicant filed an application for invalidity on the grounds that, as she had been selling these designs since at least 2007, the RCDs did not meet the condition of novelty. The Invalidity Division (ID) upheld the application for invalidity pursuant to Article 25(1)(b) CDR on the grounds that the evidence submitted by the applicant demonstrated the disclosure of the contested designs. The intervener filed three appeals against the ID's decisions. The Board of Appeal (BoA) considered that the applicant did not prove an event of disclosure outside the grace period and, therefore, rejected the invalidity application. The applicant raised two pleas in law: (i) incorrect assessment of the evidence for the purpose of Article 7 CDR, and (ii) infringement of the right to be heard.

SUBSTANCE: REGARDING THE ADMISSIBILITY OF THE ANNEXES: The evidence filed for the first time before the General Court (GC) is inadmissible (paras 28-29). REGARDING THE FIRST PLEA IN LAW: The intervener is the creator of the contested designs. The applicant and the intervener used to work together (para. 42). In view of their commercial relationship, the disclosure by the applicant during the grace period cannot be taken into account as it was based on information given by the intervener

RCDs



Earlier designs



(para. 44). The evidence submitted is not sufficient to prove the disclosure of the design (DMC No 1) (para. 56). The date mentioned in the catalogue does not establish exactly when the catalogue was made available to the relevant public (para. 58). The order for a TM1 Elegance cabin does not contain any picture of the cabin and, therefore, does not prove that it is the same design as the DMC No 1 cabin (para. 59). The trade name and article number of the DMC and TM1 cabins do not prove disclosure of the design, as the order was placed before the publication of the said catalogue and may, therefore,

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have referred to a previous model (para. 62). The same argumentation is put forward for DMC No 2 and DMC No 3. REGARDING THE SECOND PLEA IN LAW: The applicant had the opportunity to present her observations and submit evidence in each of the three proceedings (para. 113).

Case T-35/16; Sony Computer Entertainment Europe Ltd v EUIPO; Judgment of 12 December 2017; EU:T:2017:886; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Lack of reasoning, Evidence of use

FACTS: The word mark VITA was registered as an EUTM for goods in, inter alia, Class 9 by Vitakraft-Werke Wührmann & Sohn GmbH & Co KG. Following that, Forrester Ketley Ltd informed the Office that the abovementioned company had transferred to it its rights in the abovementioned trade mark for the goods in Class 3. Later on, it informed the EUIPO that it had transferred the contested mark to the current EUTM proprietor. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The Cancellation Division (CD) upheld the application for revocation and revoked the contested mark. Upon the EUTM proprietor's appeal, the Board of Appeal (BoA) dismissed the appeal as it found, inter alia, that all of the evidence submitted by the applicant demonstrated evidence of use in respect of goods



in Class 28 and not for the goods covered by the contested mark. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 58(1)(a) EUTMR.

SUBSTANCE: The BoA's decision does not make it possible to determine with sufficient clarity the reasons why the applicant had not proven genuine use of the contested mark for the various types of goods: (i) The BoA does not in any way explain why the reproductions of memory cards bearing the sign PSVita cannot establish genuine use of the contested mark for data carriers containing programs, even though, first, it expressly lists those reproductions among the evidence relating to the relevant period and, second, it also expressly refers to memory cards as an example of such data carriers (para. 51). (ii) The BoA does not state in a sufficiently clear and unequivocal manner the reasons why it found that genuine use of the contested mark had not been established for audio and/or image carriers (not of paper), in particular magnetic tape cassettes, audio tapes, audio compact discs, DAT (digital audio tape) cassettes, videodiscs, videotapes, exposed films, lithographs. Although the same part of the BoA's decision refers to the expression 'data carrier' several times it cannot, however, be established with certainty whether the expression covers only 'data carriers containing programs' or whether it also includes the abovementioned category (para. 53). (iii) The BoA does not explain why it did not accept the applicant's evidence establishing the

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presence of the sign PSVita on the video games to be played on the PlayStation Vita console (para. 55). The Office's argument that the photographs of video game boxes bearing the sign PSVita did not contain information relating to the use cannot be regarded as supplementing a statement of reasons that is already self-sufficient. Statements of reasons for a decision may not be made by means of subsequent explanations provided by the Office, save in exceptional circumstances of emergency (paras 56-58). The BoA infringed its obligation to state reasons with respect to the elements of reasoning that are essential to support its final conclusion (para. 59).

Case T-68/16; Deichmann SE v EUIPO; Judgment of 17 January 2018; EU:T:2018:7; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Catalogue, Evidence of use, Extent of use, Graphical representation, Nature of use, Place of use, Proof of use, Used in the course of trade, Sales figures, Figurative trade mark

FACTS: The figurative mark below was registered as an EUTM for goods in Class 25 (sports footwear). An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The Cancellation Division (CD) upheld the application for revocation insofar as it found that the evidence submitted demonstrated

use of the mark in a form that altered the distinctive character of the mark as registered. Upon appeal, the Board of Appeal (BoA) annulled the CD's decision and rejected the application for revocation. It held that the evidence adduced showed genuine use of the mark and that the differences between the mark as used and the contested mark were negligible. The revocation applicant filed an action before the General Court (GC) relying on three pleas in law: (i) infringement of Article 58(1)(a) EUTMR, inasmuch as the BoA wrongly assessed the subject matter of the contested mark, by holding that it was irrelevant whether the mark was a figurative mark or a position mark; (ii) infringement of Articles 58(1) and 18(1) EUTMR, inasmuch as, in order to determine whether the mark was used in its registered form or in a form that did not alter its distinctive character, the BoA merely compared a part of the mark, namely two intersecting stripes, with the two intersecting stripes placed on the sports shoes marketed by the EUTM proprietor; and (iii) infringement of Article 58(1) EUTMR, inasmuch as the contested decision was based on models of shoes whose marketing had not been proven

SUBSTANCE: Regarding the three pleas in law: (i) It may be inferred directly from the graphic representation of the mark at issue, and with sufficient precision, that the protection sought covered only a cross consisting of two black intersecting lines, represented in solid lines, as well its position on the side of a sports shoe. The dotted lines, forming the

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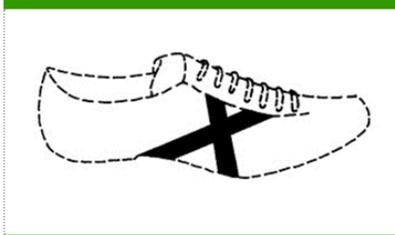
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EUTM



outline of the sports shoe and its laces, are used, as is customary in similar situations, to permit a clearer delimitation of the mark (para. 40) (ii) It is clear from the evidence that the cross used on the various shoes is clearly discernible independently from the possible presence of the other details, which do not counteract its distinctiveness (para. 69). Evidence concerning sales of sport shoes in the MARCELO, MUNDIAL REVOLUTION, and GALES models (which are similar, even if the proportions and the colour used for the cross may vary) demonstrate use of the mark related to a sufficiently large and diverse territory in the EU. Moreover, the invoices relating to those models cover several years of the relevant period and they show actual, constant and uninterrupted use (paras 58-60). The figures from the invoices in conjunction with the relevant catalogues demonstrate marketing of numerous sports shoes with crosses on the side, which are identical or similar to the contested mark (para. 62). The distinctiveness of the contested mark has already been confirmed, and, in any event, the

actual use of the registered mark can be proven even if its distinctive character proves to be rather weak (paras 74-75). (iii) The catalogues submitted as evidence regarding the REAGEE, TECNO and AVANT models, although they are not decisive evidence, may be assessed as an additional indication of the genuine use of a mark, insofar as this is a public and outward use of the mark or, at the very least, preparation for such use (para. 71).

Case T-765/16; Grupo Ganaderos de Fuerteventura, S.L. v EUIPO; Judgment of 25 January 2018; EU:T:2018:31; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the figurative mark represented below for a list of goods in Class 29, inter alia, milk, cheese and milk products; edible fats. The examiner refused to register the mark as an EUTM in its entirety on the grounds of Article 7(1)(c) EUTMR. 'TOFIO', a bowl linked to the 'majorera' culture used to collect goat's milk, would immediately inform consumers that these 'milk products' originated from goats from the Canary Islands. The sign was also refused on the grounds that it infringed Article 7(1)(j) and (k) EUTMR. The applicant appealed against the examiner's decision

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and requested a limitation of the relevant goods to cheese. The Board of Appeal (BoA) dismissed the applicant's appeal because it found that the mark was descriptive — it is considered a well-known fact that Fuerteventura has a native race of goats (cabra majorera) used to elaborate Queso Majorero (PDO). 'Tofio' appears in the database of the Academia Canaria de la Lengua, as well as on social networks and in the Gran Enciclopedia Virtual Islas Canarias (GEVIC) database in the sense indicated in the examiner's decision. Therefore, the sign would be seen as descriptive of the kind of cheese protected. Registration in Spain is not binding and there is no need to evaluate as to Article 7(1)(j) EUTMR because refusal under one ground is sufficient.

EUTM application



SUBSTANCE: ADMISSIBILITY: The applicant's request to limit the relevant goods to goat cheese originating from the Canary Islands must not be taken into consideration because this would modify the subject matter of the case as evaluated before the BoA (paras 11-23). The admissibility

of the appellant's claims as to the modification of a contested decision must be evaluated in the light of the competences attributed to the BoA, and this organism is not competent to declare the registration of an EUTM application. Consequently this claim is inadmissible (paras 24-28).

The signs covered by Article 7(1)(c) EUTMR, descriptive, are only those that serve to designate a characteristic easily recognisable by the relevant section of the public of the goods or services in respect of which registration is sought (para. 38). The relevant public is the Spanish-speaking part of the general public located in the European Union (para. 40). As regards 'EL TOFIO', the dominant part of the EUTM application, the fact that it does not appear in a dictionary — as it is a simple term and does not constitute any verbal combination or an abbreviation — must be seen as a clue and a hint that the average consumer does not know this term (para. 44). The internet sites quoted in the contested decision on which the BoA based its decision are glossaries of terms specially linked to the culture of the Canary Islands. From these elements it cannot be deduced that 'Tofio', originating from Lanzarote and Fuerteventura, has a 'clear' meaning for the Spanish average consumer of goods for mass consumption (para. 45). This is equally applicable to the other hits located that appear in the contested decision. The circumstance that one particular term is no longer in use can have an impact on the relevance of the knowledge of the public (para. 46). Even if some consumers might associate 'Tofio'

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with a traditional bowl forming part of the culture of some of the Canary Islands, the BoA has not produced any element that would enable the breadth of the knowledge of the function of the bowl on the part of the relevant public to be determined and, as a consequence, of its possible relationship with the goods in question (para. 47). Therefore, 'Tofio' does not provide a sufficiently clear and direct meaning for Spanish-speaking consumers to see it as descriptive. In order to apply Article 7(1)(c) EUTMR, it is sufficient that the grounds of refusal exist only with regard to a non-negligible part of the public. However, the evidence submitted does not enable such a conclusion to be reached in this case (para. 48). In the absence of a descriptive character in one of the elements, even if the other were to be descriptive, this absolute ground does not apply (para. 49).

Case T-804/16; LG Electronics, Inc. v EUIPO; Judgment of 18 January 2018; EU:T:2018:8; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The applicant sought to register the word mark Dual Edge for Class 9 (smart phones; portable communications apparatus; monitors for

computers; monitors for commercial purposes; audio components; apparatus for recording, transmission or reproduction of sound and images; application software; software for mobile phones; television receivers (TV sets); wearable smart phones; cases for mobile phones; stands for mobile phones; stylus for smart phones; portable mobile phone chargers; headphones; earphones; wireless headphones). The examiner rejected the application for registration in part on the basis of Article 7(1) (b) and (c) and Article 7(2) EUTMR for the following goods: smart phones; portable communications apparatus; monitors for computers; monitors for commercial purposes; apparatus for recording, transmission or reproduction of sound and images; television receivers (TV sets); wearable smart phones; cases for mobile phones; stands for mobile phones; stylus for smart phones. The applicant filed a notice of appeal, which was dismissed by the Board of Appeal (BoA) because it held that the mark was descriptive and consequently non-distinctive. The applicant raised two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR.

SUBSTANCE: Regarding the second plea in law; the products covered by the mark are intended for average English-speaking consumers, who are reasonably well informed, observant and circumspect (para. 23). The mark is the combination of two English words, 'dual', which means 'relating to two, double' and 'edge', which is 'the border,

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brim or margin of a surface, object' according to the Collins English Dictionary (para. 27). The BoA did not expressly attribute a meaning to the expression 'dual edge', it analysed the descriptiveness of the expression and noted that no analysis was required in order to ascertain the possible meaning of that expression since it was merely a combination of two words (para. 28). The expression 'dual edge' will be immediately perceived by the relevant public as meaning that the goods are mobile phones and display apparatus with dual displays incorporated along the rims of the telephones or apparatus or goods used in connection with those devices and this is confirmed by examples of actual use in the market of expressions similar to the mark applied for, used for similar or identical goods (para. 31). A direct link would be made by the relevant public between the mark and the characteristics of the goods (para. 34). According to the examiner, Dual Edge was used at the time of the application for registration to designate an innovative characteristic of screens and of mobile phone screens (para. 36). Therefore there is a link between the mark applied for and the goods covered as it refers directly and specifically to a characteristic of some of the goods covered (namely, mobile phones, portable communications apparatus, apparatus for recording, transmission or reproduction of sound and images, monitors for computers, monitors for commercial purposes and television receivers) (para. 38). The expression 'dual edge' will likely be recognised by the relevant public as a description of one of their characteristics,

namely the fact that they have an integrated screen on two sides of the device (para. 39). Moreover, the examples of EUTMs referred to in the application are irrelevant since they contain only one of the two words: 'dual' or 'edge', together with another word element (para. 44). Regarding the first plea in law; since one ground of refusal is sufficient there is no need to take into account this plea in law (para. 47).

Case T-398/16; Starbucks Corp v EUIPO; Judgment of 16 January 2018; EU:T:2018:4; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Ending of mark, Visual similarity, Phonetic similarity, Conceptual similarity, Identity of the goods and services, Likelihood of confusion, Reputation, Figurative trade mark, Figurative element

FACTS: Registration as an EUTM was sought for the figurative mark represented below for services in Class 43. An opposition was filed based, inter alia, on earlier EUTMs consisting of the figurative mark represented below, the United Kingdom earlier figurative mark represented below, and the Spanish figurative mark represented below, registered, inter alia, for services in Class 43, pursuant to Article 8(1) (b) and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition in its entirety and

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EUTM application



Earlier trade marks



the opponent filed an appeal. The Board of Appeal (BoA) confirmed the OD's decision and dismissed the opponent's appeal. The opponent filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR.

SUBSTANCE: i) ARTICLE 8(1)(b) EUTMR: RELEVANT PUBLIC: The relevant public is the general public of the European Union, including the United Kingdom and Spain (para. 18), which was not disputed by the parties. COMPARISON OF SERVICES: The services covered by the contested mark were identical to the services covered by the earlier marks: café, cafeteria, snack bar, coffee bar and coffee house (para. 22), which was not disputed by the parties before the Court. COMPARISON OF SIGNS: (i) As a whole, the signs are visually similar in three aspects: (a) circular devices consisting of a figurative element placed in the centre and a surrounding broad band with word elements of identical structures and two smaller white figurative elements (para. 51); (b) use of the same colours (black and white) and use of the same font for the word elements 'starbucks coffee' and 'coffee rocks' (para. 52); (c) the common word 'coffee', which, despite its descriptive character, is an important similarity factor, especially when some of the earlier marks have a reputation (para. 55). (ii) The signs are phonetically similar due to the common word 'coffee' and the similar endings of the words 'rocks' and 'starbucks': the ending 'rocks' may be regarded as phonetically similar to the

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ending 'bucks' on account of the relevant English-speaking public's pronunciation of the letters 'o' and 'u' (para. 62). (iii) From a conceptual standpoint, on account of the general appearance of the marks and the presence of the word 'coffee' in both marks, the relevant public will associate the earlier marks and the contested mark with the concept of a 'coffee house' (para. 64). LOC: Following an overall assessment of the likelihood of confusion, namely the identity of the services, the reputation of the earlier marks, as well as the proven similarity of the signs and taking into account the rules of interdependence, there is a likelihood of confusion (paras 67-69). The BoA erred in ruling out any similarity, even a low degree of similarity, between the marks (para. 71). ASSESSMENT OF LOC IN OPPOSITION PROCEEDINGS: The likelihood of confusion should have been assessed globally, since the protection in favour of marks with a reputation may apply even if there is a lower degree of similarity between the signs. The BoA should not have refused to assess LOC globally on the sole grounds that the marks were dissimilar (para. 82). ii) ARTICLE 8(5) EUTMR: The similarity between the signs has to be capable of leading the relevant public to establish a link between the signs, but does not require that similarity to be capable of leading that public to confuse those signs (paras 78-79). The BoA erred in ruling out any similarity between the signs and should not have refused to assess the grounds set out in Article 8(5) EUTMR because the marks were dissimilar (para. 83).

Case T-367/16; Brunner v EUIPO; Judgment of 25 January 2018; EU:T:2018:28; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Identity of the goods and services, Common element, Figurative element, Weak element, Descriptive element, Similarity of the signs

FACTS: The applicant sought to register the figurative EUTM represented below for goods and services in Classes 3, 18, 25 and 35. An opposition based on the earlier trade mark HOLY, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that there was a likelihood of confusion. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

EUTM application



Earlier trade mark

HOLY

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SUBSTANCE: RELEVANT PUBLIC: All the goods and services at issue are partly aimed at the general public having an average degree of attention. The services in Class 35 are also aimed at a specialised public having a degree of attention that is higher than average (para. 27). The BoA correctly focused on the German-speaking part of the relevant public (para. 31). COMPARISON OF GOODS AND SERVICES: Perfume is similar to a low degree to retail services, also through websites and teleshopping, in relation to perfumery (para. 43). Wholesale and/or retail services in relation to clothing, shoes and textile goods and retail services in relation to clothing and footwear are similar (para. 47). Hosiery and clothing are identical (para. 50). DISTINCTIVE ELEMENTS: The word 'Holy' does not belong to English basic vocabulary and must be regarded as a fanciful term (para. 56). 'Haferl' is a German word used in Austria designating a traditional type of shoe. 'Shoe' and 'Couture' will be understood by the relevant public as an indication of a link between the EUTM application and the traditional shoe fashion. Therefore, the elements 'haferl', 'shoe' and 'couture' have a weak distinctive character, not only with regard to shoes but also for all the other goods and services at issue that are related to traditional fashion (paras 63-70). The figurative element is not particularly distinctive either, since it will be perceived as the letter 'H', the first letter of the words 'holy' and 'haferl', and the heart referring to the concept of love in general is a commonly used symbol in the field of folklore and traditional culture (para. 75). COMPARISON OF THE

SIGNS: The signs at issue are visually similar to a low degree and phonetically similar to an average degree (paras 80-85). As regards the conceptual comparison, the earlier mark does not convey any meaning and the EUTM application refers to the folk domain. The conceptual dissimilarity is not high and will be even weaker for the part of the public able to understand the meaning of 'holy' (paras 90-91). Therefore, the BoA did not err in finding a likelihood of confusion, even as regards the goods at issue that are purchased following a visual inspection (para. 101).

Case T-250/17; Avanti v EUIPO; Judgment of 23 January 2018; EU:T:2018:24; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Minimum degree of distinctiveness, Slogan mark, Typographical element

FACTS: The applicant sought to register the figurative EUTM represented below for goods and services in Classes 9, 35, 41 and 42. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the EUTM application would be perceived as a laudatory indication devoid of distinctive character

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for the goods and services at issue. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 7(1)(b) EUTMR. The GC dismissed the action.

EUTM application



SUBSTANCE: RELEVANT PUBLIC: The relevant public is composed of professionals and employers displaying a high degree of attention (para. 19). **PERCEPTION OF THE SIGN:** The element between 'a' and 'anti' will be perceived by the relevant Italian- and German-speaking public as the letter 'v'. The EUTM application as a whole will be perceived immediately and without further thought as a representation of the word 'avanti' (paras 20-23). **NON-DISTINCTIVE CHARACTER:** The term 'avanti' will be seen as a slogan stating that the goods and services provided will enable the customer to move forward and make progress. The stylised letter 'v' evokes the symbol 'OK', conveying the positive idea that the goods and services are 'OK' (i.e. tested, approved or verified). Therefore, the EUTM application as a whole will be perceived as a promotional and incentive message and not as an indication of commercial origin (paras 24-25).

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New Decisions from the Boards of Appeal

23/01/2018, R 200/2017-2, GREY AND ORANGE (col.)

EUTM application



Result: Decision annulled

Keywords: Colour mark, Combination of colours, Graphical representation, Representation of a mark

Norms: Article 4 EUTMR, Article 7(1)(a) EUTMR, Article 59(1)(a) EUTMR

Facts: The cancellation applicant filed a request for a declaration of invalidity of the trade mark, registered in Class 7 for chainsaw, as regards it being not distinctive, not eligible to be registered because of its representation and filed in bad faith. The Cancellation Division rejected the request once the EUTM proprietor had successfully demonstrated that at the filing date of the EUTM, it had already acquired distinctiveness in the EU within the meaning of Article 7(3) EUTMR.

Substance: The first-instance decision is annulled. The contested mark consists of the horizontal positioning of two colours, orange and grey, one on top of the other, accompanied by a description which specifies that ‘the colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw’.

Applying relevant case-law that sets specific rules about the representation of colour trade marks (12/12/2002, C-273/00, Sieckmann, EU:C:2002:748, § 49-52, 54), the Board finds that the sign was not described properly (§ 24). A simple combination of colours (with no reference, for example, to their lengths), even with reference to the EUTM proprietor’s previous international registration (§ 34), is not sufficient to identify the sign, whose appearance and proportions are likely to change from time to time (§ 30). This may finally result in the consumer’s impossibility of recognizing it as an indication of the origin of the goods (§ 39).

19/12/2017 R 1311/2017-5 Ромашка (fig.)

EUTM application

Ромашка

Result: Decision partially annulled

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Keywords: Distinctive element, Descriptive, Distinctiveness acquired by use, Non-distinctive, Nature of the goods and services, Survey

Norms: Article 7(1)(c) EUTMR

Facts: The application for goods in Class 30 (mainly confectionery, chocolate, flakes and tea) and consisting of the word 'Ромашка' (Russian for 'chamomile, camomile, or daisy'), was refused for being descriptive and non-distinctive in relation to the goods at issue.

Substance: The Board states that the relevant public at issue consists of Russian-speaking consumers in the Baltic area of Lithuania, Latvia and Estonia (§ 18). The word 'Ромашка' does not have an identical or similar equivalent in any other language of the European Union and therefore it cannot be understood by those consumers who do not speak Russian. Taking this into account, and also considering a linguistic opinion and a market survey conducted amongst Russian speakers in Latvia presented by the applicant as elements of proof (§ 30 - 32), the Board considers that the sign is not descriptive in relation to goods such as chocolate and bonbons.

It also refuses to take into consideration the practice of the National Patent Offices in the Baltic states, where the designation 'Ромашка' is not considered descriptive, as the assessment for the legality of the registration is made only on the basis of the EUTMR (§ 34). The existence of similar registered signs can only be considered as a further indication that the sign at issue is not descriptive for certain other

goods.

Against this background, the Board confirms the contested decision's findings which considered the sign descriptive in relation to 'tea and related products', but dismisses the appeal for the rest and allows the trade mark to be registered for the other contested goods (such as chocolate and bonbons).

30/01/2018, R 1477/2017-2, VANILLA PERSIMON

Keywords: Descriptive element, Descriptiveness, Non distinctive, Deceptive element

Norms: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(1)(d) EUTMR, Article 7(1)(g) EUTMR, Article 7(2) EUTMR

Facts: The IR holder appealed the examiner's decision to refuse the registration of the word sign 'Vanilla Persimon' in Class 31 (namely for fresh fruit, and specifically caqui of the variety Rojo Brillante, protected by the DPO Kaki Ribera del Xúquer) pursuant Article 7(1)(b) and (c) EUTMR, considering the sign descriptive and not distinctive for the goods designated.

Substance: The appeal is dismissed. 'VANILLA PERSIMON' will immediately be perceived by the English-speaking public as a reference to a persimmon or a caqui, having the flavour or smell of vanilla, notwithstanding the omission of the letter 'm' (§ 26). The relevant public would perceive it as descriptive of the goods, since it calls to the consumer's mind a plant variety commonly used in

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the relevant sector, not registered according to EU law, whose customary indication is 'Vaniglia' (§ 31-32). As a consequence of its descriptiveness, the trade mark is considered non-distinctive (§ 43). The trade mark is also considered deceptive, pursuant Article 7(1)(g) EUTMR because the sign would be applied to goods explicitly described as belonging to the 'Rojo Brillante' variety, notwithstanding the fact that its name refers to the persimmon variety 'VANILLA' (§ 65).

08/01/2018, R 940/2017-2, DEVICE OF A BLACK SQUARE CONTAINING SEVEN CONCENTRIC BLUE CIRCLES (fig.)

EUTM application



Keywords: Technical result

Norms: Article 7(1)(e)(ii) EUTMR, Article 52(1) CTMIR

Facts: The Cancellation Division dismissed the cancellation applicant's application for a declaration of invalidity related to the registered trade mark (for 'cable and pipe penetration seals, made from plastic or rubber' in Class 17), on the basis of bad faith, that it had the same appearance as the goods and would not be perceived as an indication of origin, also being a customary element in the sector, in violation of



Article 7(1)(b), (d) and (e) EUTMR.

Substance: The Board annuls the first-instance decision and upholds the application for a declaration of invalidity.

It assesses that, notwithstanding the classification of the trade mark as figurative (§ 44), the sign exactly represents the good it is supposed to be applied to: the figure as a whole depicts the end view of a sealing module, with removable layers lining the cavity of the module, which are removed to achieve the required diameter.

The Board also reviews whether or not the sign consists of a technical feature of the product. The fact that the EUTM proprietor not only owned a lapsed patent corresponding to the mark, but also admits that the trade mark is intended to prevent other traders using its 'design features', shows that the EUTM proprietor seeks to preserve its monopoly on a technical solution, through trade mark protection, that should be kept free for other traders (§ 52).

Thus, the registration of the mark runs counter to Article 7(1)(e)(ii) EUTMR.

14/12/2017 R 1320/2017-2 BLANC DE BLANCS CENTINELA CONO SUR

Result: Decision annulled

Keywords: Geographical origin, Similarity of the signs

Norms: Article 7(1)(j) EUTMR

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Facts: The examiner refused the trade mark application 'BLANC DE BLANCS CENTINELA CONO SUR', in Class 33 (wines and sparkling wines), on the grounds that the word 'SUR' was protected as a geographical indication under Appendix II of the Association Agreement on wine trade between Chile and the EU (OJ L 352, 30/12/2002), and was also protected as a PGI by Chilean decree No 464/2004. The examiner suggested that the ground for refusal could be overcome by limiting the goods by adding the following: 'complying with the specifications of the protected geographical indication Sur'. As the applicant did not modify its application, it was finally refused.

Substance: The appeal is allowed.

The mere fact that a PDO/PGI from a third country is protected by [a bilateral agreement] does not automatically imply that an EUTM that contains, or consists of, the GI must be refused: this will depend on the content and scope of the agreement's relevant provisions (§ 12). The Board interprets the Association Agreement's substantive provisions concerning the refusal of a trade mark covering wine when in conflict with a GI protected under the Agreement. The Board also refers to Article 22 of the TRIPs Agreement (§ 13 - 15).

The prohibition on the registration of trade marks is enshrined in Article 7 of Annex V on trade in wines of the TRIPs Agreement and it provides that the 'registration of a trademark for wine [...] which is identical with, or similar to, or contains a geographical indication [...] shall be refused' (§ 19). The Board also finds that the relevant part of the sign that has to be taken in account in this case is

the entire GI 'REGION DEL SUR', instead of only the word 'SUR' (§ 22).

The trade mark applied for 'BLANC DE BLANCS CENTINELA CONO SUR' is neither identical nor contains the protected GI, 'REGION DEL SUR'. Taking into consideration the visual, aural and conceptual impressions caused by the sign, the Board is of the view that the presence of the common element 'SUR' is insufficient reason to consider the GI and the contested mark similar (§ 37). Therefore, the contested sign does not fall within the scope of refusal foreseen in the Agreement.

The contested decision is annulled and the objection under Article 7(1)(j) EUTMR is waived.

[23/01/2018, R 237/2017-2, Lande \(fig.\) / LAND ROVER et al.](#)

EUTM application



Earlier EUTM

LAND ROVER

Keywords: Common element, Enhanced distinctiveness, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services

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Norms: Article 8(1)(b) EUTMR

Facts: The opposition against the sign applied for in Classes 6 and 9, claiming a likelihood of confusion and reputation, was just partially upheld. The opponent appealed the first-instance decision whereas it allowed the trade mark to proceed for the following goods: 'devices for treatment using electricity; diving equipment; magnets, magnetizers and demagnetizers; measuring, detecting and monitoring instruments, indicators and controllers; targeting and map making devices; optical devices, enhancers and correctors; recorded content; safety, security, protection and signalling devices; scientific research and laboratory apparatus, educational apparatus and simulators'.

Substance: The decision is annulled.

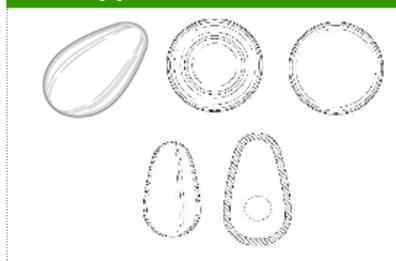
The Board fully reassesses the likelihood of confusion, based on the opponent's earlier, reputed EUTM. The relevant public comprises both the general public and professional customers and, according to settled case-law, the Board takes into consideration the public with the lowest level of attention (§ 16).

As regards the comparison of the goods, the contested ones are found identical to those in Class 9 of the earlier EUTM and similar to different degrees to those in Class 12, taking into account the reputation of the 'LAND ROVER' trade mark in relation to 'land vehicles' (§ 31).

Applying the principle of interdependence and the enhanced degree of distinctiveness possessed by the earlier mark, the Board finds that a likelihood of confusion exists (§ 33).

10/01/2018, R 591/2017-3, Pharmaceutical capsule

RCD application



Result: Decision annulled

Keywords: Priority

Norms: Article 41 CDR, Article 42 CDR

Facts: The applicant sought to register the RCD as represented above for Class 28.01 of the Locarno Classification: capsules, pharmaceutical and claimed priority for a US design. The examiner rejected the priority claim stating that the prior design application was a 'continuation of a prior utility patent application and according to the USPTO an application that is a 'continuation of a previous application contained the same subject matter and, therefore, was not considered a first filing.

Substance: The appeal is upheld.

The Board finds that the documentation provided establishes that new features have been added in respect of the initial drawings of the US patent, the

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basis of the continuation. The US priority application was the first application to disclose the entirety of all the relevant features of the RCD (the five figures) by adding four new views to the earlier US patent. As the design of the capsule has not been fully disclosed in the original patent application, the benefit of the earlier filing date cannot be claimed for the US design application. Therefore, as the US priority application has been given a new filing date, it is a first filing (§ 39).

Article 41(4) CDR does not apply to the present case (§ 40).

As a result, the design holder is entitled to claim the priority of the RCD on the basis of the US design application (§ 44).

04/12/2017, R 413/2017-4, Shape of a Bottle (3D)

EUTM application



Result: Decision confirmed

Keywords: Distinctive element, Three-dimensional mark, Geographical origin, Non-distinctive, Geographical indication

Norms: Article 7(1)(b) EUTMR, Article 74(2) EUTMR, Article 75(2) EUTMR, Regulation No 1308/2013.

Facts: The applicant sought to register the form of a round-shaped bottle for goods in Classes 21 (bottles), 32 and 33 (wine, beer and other alcoholic and non-alcoholic beverages). The application was refused in its entirety.

Substance: The applicant argues that the overall shape of the bottle (the so-called 'Bocksbeutel') is typical for wine produced in the German region of Franconia and should therefore be protected under Article 93(1) of Regulation No 1308/2013 as a geographical indication.

However, the Board states that this provision only applies to wines whose names refer to the area of origin. As the shape of a bottle is not the name of a region, it cannot be protected as such. Besides, the shape of the bottle applied for is typical not only for Franconia, but also for certain regions of Italy, Greece, Portugal and Baden. The shape of the bottle presented by the applicant does not possess any distinctive character and would not, therefore, allow consumers to distinguish this bottle from the bottles of other entrepreneurs.

The application is, therefore, refused in its entirety. The Board's decision is under appeal before the GC (T-68/18).

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