

Alicante News

Up to date information on IP and EUIPO-related matters

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DesignClass Phase II goes live



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DesignClass Phase II goes live

A year on from the publication of the first ever Common Practice on designs, the second European design convergence initiative reaches completion

The tool offers users and IP Offices a harmonised database of approximately 15,000 product indications, including the Locarno 11th Edition Classification terms. It is the result of collaboration between 24 participating EU Offices, 4 non-EU IP Offices, 2 User Associations, WIPO and EUIPO, who worked to pre-approve the harmonised product indications in 23 EU languages.

Prior to the development of DesignClass no common classification tool for designs existed in the EU. The CP7 project was therefore launched to converge practices in this area, by standardising the use of product indications within the EU and beyond.

To meet its objectives, the project was rolled out in two phases. Phase I, which went live in November 2015, delivered the Common Practice, the harmonised database of product indications and the first release of DesignClass.

With this launch, Phase II of DesignClass builds on the earlier achievements to include:

- The extended product indications classification (EPIC) – taxonomisation of the harmonised database of product indications, which divides Locarno sub-classes into groups and sub-

- groups to improve the intuitiveness of searches
- The association of images to product indications – enabling users to visualise the product indications and hence select the most appropriate to their needs
- The pairing of non-accepted with accepted product indications – ensuring that users are directed to the harmonised product indications that correspond to their design
- Validated translations of all product indications, variants and duplicates – translations have been thoroughly revised by IP Offices, EUIPO and external translation companies to minimise risk of disconformity in any EU language
- A Harmonised Workflow tool – an administrative module which allows all users of the application to propose updates to the harmonised database of product indications through a two-month long voting cycle

DesignClass: developing for the future

As participating Offices (and users via EUIPO or via the relevant national or regional Intellectual Property Office) use the Harmonised Workflow to submit terms for inclusion in the database, propose the deletion of obsolete product indications, suggest alternative translations and add images to existing product indications, DesignClass will become more streamlined and attuned to users' needs. The products for which a design can be registered will be better mapped, meaning greater accuracy and legal certainty for designers.

The harmonisation of product indications and the

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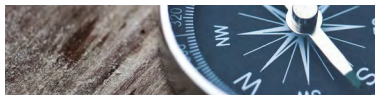
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definition of exact equivalents in all EU languages will also increase the efficiency of DesignView, with searches by product indication returning more precise results, especially for searches across multiple Offices. Not only will this facilitate priority checks for examiners, but it will afford users greater decision predictability as well, as it will be easier to determine the novelty of a given design based on its product indications.

DesignClass is freely accessible online and EU IP Offices may also implement the tool into their own e-filing systems, on a voluntary basis and according to their established procedures.

More information on DesignClass, including FAQs and tutorials, can be found on the [DesignClass](#) webpage.

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The James Nurton Interview



Frank Meixner, Head of Corporate Trademarks, Bayer, Germany

Tell me about yourself?

By training I'm an attorney-at-law. I've worked in the IP field since 1998. I didn't actively pursue a career in the IP field but after my admission to the bar I got my first job in an IP boutique in Düsseldorf, which specialised in IP litigation.

After three years I felt going in-house would be more interesting, and I also wanted to work in a less technical area than patent law. Working in patent litigation you are very dependent on patent attorneys and I found this a bit frustrating. It was



Frank Meixner

also frustrating being far from the client, and only being involved too late, often after the conflict could have been avoided.

I worked for L'Oréal in Germany very briefly and then joined Bayer in 2001, working in the trade mark field as trade mark counsel. In 2007 I became head of the department.

We have 19 people in the trade mark department in Germany and we have a satellite in Pittsburgh, USA with four people. We have about 90,000 trade mark records. The biggest part of the portfolio is pharmaceuticals. In that industry due to regulatory uncertainties most companies have a strategy to file between five and 10 names just for one project, and that inflates the portfolio. As a consequence the percentage of unused trade marks in the pharmaceutical part of the business is high.

Sometimes those trade marks can be re-activated for another product, but sometimes they may be subject to cancellation, or they may not have sufficient scope of protection in terms of territory or the list of goods, or the marketing managers want to use a new brand rather than a rejected candidate from an old project! That means our chance to recycle left-over names is often limited.

As well as pharmaceuticals, Bayer still has other businesses including consumer health, crop science, agrochemicals and animal health, so it is quite diversified. Every division has its special challenges and peculiarities.

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The James Nurton Interview



What kinds of work do you handle?

We do all soft IP, including copyright, design patents and unfair competition law as well as trade marks. Domain names are handled by IT rather than IP but of course we are involved in domain name issues when it comes to enforcing trade mark rights, suing third parties or purchasing rights from third parties.

The EU trade mark is very important to us and we also use the Madrid System very much for filings. The Madrid System offers some attractive advantages, one of which is cost. Another is that you don't have to involve local counsel unless you end up in a conflict. For administrative reasons it's very easy if you have to renew a trade mark or record a change of name or assignment – you can do 80 designations in one go, and that is a big advantage.

What is being discussed and would be attractive for us is the abolition of the five-year dependency period. It's a risk that if you lose the basic home registration then your whole Madrid trade mark may implode, so it would be nice if that were ever abolished. The other problem at the moment is that WIPO is very good at attracting new member states and promoting the System, which is wonderful – the more countries the better – but some of the new countries, for example in Africa, have joined without making sure that appropriate national legislation is implemented to ensure the same protection for Madrid registrations as national registrations.

What do you think of the EUTM?

We are very satisfied – it's a very easy-to use system for big companies like us. There's a low level of administrative burden and it's very attractive price wise – more so than anything else.

EUIPO is focusing very much on improving predictability, in particular by having rules such as taxonomy and convergence programmes. That's very interesting but I feel like a bit more training of staff might also do a good job. You need to invest in training individuals as well as having lots of rules and regulations.

Do you have a lot of trade mark enforcement?

Anti-counterfeiting work in my company is decentralised so it is the responsibility of the regions and countries, while pure trade mark work such as prosecution and enforcement against generic look-alikes is centralised. The reason is that while trade mark legislation is widely harmonised, the mechanisms for dealing with counterfeits are not. Often you're dealing with a public prosecutor, border control or the police and that's not harmonised – so the trade mark function cannot be an expert on that. Also you have to react fast when counterfeits have been discovered – and it's difficult to handle that from headquarters.

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A problem is the environment in terms of the security of the supply chain allows some gaps for counterfeits – for example with online sales. In Germany, for example, pharmacists may have an online platform which is perfectly fine. But allowing online sales opens options for counterfeiters to come up with counterfeit websites and it's very difficult to control them. The question is: do we need to sell pharmaceuticals online? Personally, I have my doubts.

The problem is that with counterfeit sites patients may not have to produce a prescription, so that is attractive for products where people might feel embarrassed – such as drugs for erectile dysfunction. But they may end up with a counterfeit that poses health risks.

What can be done?

You can shut down the websites or you could have some sort of certification scheme for legitimate sites – but that is difficult when everything is being liberalised. Sometimes liberalisation means you increase the risks!

Tell me about the ASPIRIN trade mark?

We still have ASPIRIN registered in many countries but in the US, UK and France it is now a generic term. That is largely a consequence of the world wars: ASPIRIN was one of the most effective early painkillers and the Allies were interested in making

sure it could not be monopolised by a German company. In the US we lost our rights in ASPIRIN and our company brands BAYER and BAYER-CROSS as a result of World War One when all Bayer assets were confiscated as enemy property. In the 1990s we were able to re-purchase all the US rights in the name BAYER and the BAYER-CROSS but the US trade mark ASPIRIN had been lost since in the 1920s a company had filed a cancellation action and at that time there was no one to defend it.

It was not that difficult an issue before globalisation but now a British or American company could legitimately refer to the word Aspirin in their home countries as an equivalent to an international non-proprietary name, which is fine, but if they go to another country it's a protected trade mark. That's what makes our life difficult. The same is true online.

Tell me about your role with PTMG?

I was elected chairman of PTMG last spring and have been chairing the organisation since then. The task of the chairman is to chair the two conferences each year. The educational aspect of the conferences is very important and finding good topics, presentations and speakers is key. We have a special focus on trade marks in the pharmaceutical world, so major pharmaceutical companies are represented on the committee.

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A good example of topics is the issues to do with regulatory approval and challenges in developing new pharmaceutical drug names, especially now the FDA and EMA have become so active in the drug name review process. Until 20 years ago the drug name aspect of regulatory approval was quite easy but it has become much more problematic and unfortunately highly unpredictable. We are good at dealing with trade mark availability but the very strict drug name review process is an extra hurdle just prior to launch with a high rate of unpredictability.

Other issues are special rules about similarity of goods, what pharmaceuticals are considered to be similar, what is the average level of attention – is it the perspective of a consumer or that of a healthcare professional which is relevant here?

I once went to a conference on the process of creating new brands, and I realised it is very different in our industry to other industries: On the pharmaceutical side, we can say that we often start with a list of 100 names that are usually not very emotional and if one doesn't work then we have another 99. We also always try to convince marketing that a pharmaceutical name should not contain any descriptive elements.

In other industries such as fashion, perfumes or luxury goods, the marketing person comes in and says "I have had an inspiration", and comes up with a wonderful name for a new product and then the project only flies if that name is available.

Sometimes you are lucky if the result of availability searches is a finding that there are no risks at all. But these days if you want a global name it is very rare to identify a trade mark candidate with no risks. So the question normally is: what are tolerable risks? We have a traffic light system – each candidate is classified and green is very rare!

Class 5 is very crowded because everyone has the same problem and files five to 10 names for one project, so there are a large number of unused trade marks. As long as the unpredictability of the regulatory approval at the end of the process doesn't change, then this congestion won't change. Also Class 5 is a very broad class and includes other areas such as agrochemicals. This should perhaps be addressed in one of the future editions of the Nice Classification.

The James Nurton Interview is produced monthly for Alicante News, and contains the personal views of the interviewee.

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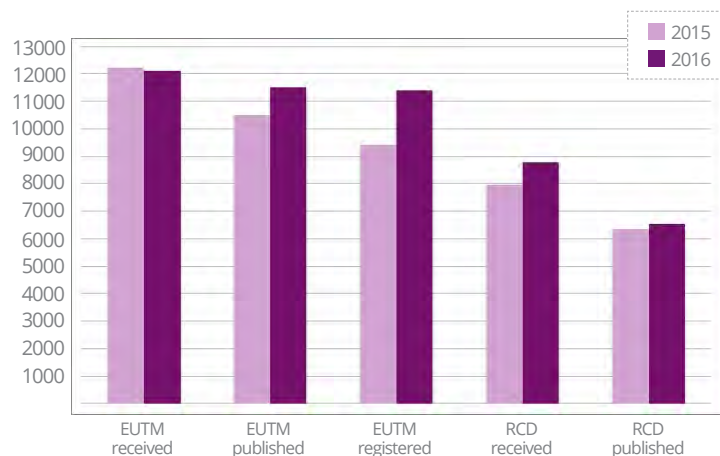


Statistical Highlights



Monthly statistical highlights December*	2015	2016
European Union Trade Mark applications received	12 223	12 095
European Union Trade Mark applications published	10 501	11 500
European Union Trade Mark registered (certificates issued)	9 401	11 391
Registered Community Designs received	7 939	8 782
Registered Community Designs published	6 362	6 529

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



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Switzerland implements CP5 Common Practice

As of 1st January 2017, the Swiss Federal Institute of Intellectual Property (IPI) became the 29th IP Office to implement the [CP5 Common Practice](#) on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components) into its guidelines.

The CP5 common principles have been incorporated into the updated version of IPI's guidelines, which came into force on 1 January 2017. Users were informed of the implementation via an explanatory note published on the IPI website, which listed all the changes in the updated guidelines, an article in the IPI Newsletter and a footnote in the guidelines themselves.

1st Implementation Workshop ECP4 Collaborative Network in Vilnius on the 26th to 27th January 2017

The first implementing group of Intellectual Property Offices (IPOs) from the ECP4 Collaborative Network (Language Check option) has held its first workshop in Vilnius.

The aim of the workshop was to provide guidance for the creation of a strong network of exchanging knowledge and expertise among the IPOs in the examination procedure of the EU trademarks, in this case, in the language check task.

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Harmonised Database (HDB) updated with latest changes to Nice Classification.

The amendments to the [Nice Classification](#) agreed by the Nice Committee of experts have been introduced in the Harmonised Database (HDB), the classification database shared among the EUIPO and the national and regional IP offices of the European Union.

The Nice Committee of Experts at the World Intellectual Property Organisation decides on the transfer, insertion, change and deletion of terms of the Nice Classification of goods and services. The latest edition of Nice (Nice 11) entered into force on 1 January, 2017.

These amendments have also been introduced into the Harmonised Database (HDB) thus making the HDB fully compliant with the latest edition of the Nice Classification.

The Taxonomy, the market-based hierarchical categorisation of classification terms, was also amended so that the structures and Group Titles comply with Nice 11.

Publication of the Summary Report: Consumers' Frequently Asked Questions (FAQs) on Copyright

EUIPO through the European Observatory on Infringements of Intellectual Property Rights has published the Summary Report: Consumers' Frequently Asked Questions (FAQs) on Copyright.

The Summary Report is part of the Observatory's project dealing with the most frequently asked questions average consumers have in relation to copyright.

28 national copyright experts, in coordination with the competent authorities in the respective Member State, provided answers to the 15 FAQs.

The Summary Report provides a horizontal synthesis of these answers, and highlights relevant differences between national laws.

The FAQs and the answers for all twenty-eight EU Member States are available on the [Observatory's website](#). The respective status date of the answers is indicated for each country.

The Summary Report can be consulted [here](#).

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

Case T-7/16; LA TARTE TROPÉZIENNE v EUIPO; Judgment of 28 October 2016; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The trade mark LA TARTE TROPEZIENNE 1955. SAINT-TROPEZ was applied for various goods in Class 30 and partially rejected by the examiner as being descriptive of the goods applied for and lacking distinctiveness for the relevant French-speaking consumer in the European Union. The Board of Appeal (BoA) partially annulled the examiner's decision (as regards goods which had no relation with cakes) and partly dismissed the appeal (as regards cakes and goods which could be used as ingredients for a cake) given that the mark designates a particular kind of cake traditionally produced in Saint-Tropez (France).

SUBSTANCE: The applicant based its action for annulment before the General Court (GC) in essence on the argument that the combination of 'LA', 'TARTE TROPEZIENNE', '1955' and 'SAINT-TROPEZ' would

EUTMA

LA TARTE TROPÉZIENNE
1955. SAINT-TROPEZ

render the sign applied for complex and fanciful. In accordance with established case-law, the GC rejected these arguments and confirmed the BoA's reasoning according to which neither the article 'LA' nor the date '1955' which would be perceived as the date on which the cake had been invented, nor the additional geographical indication 'SAINT-TROPEZ' would be capable of diverting the relevant consumer's from the clearly descriptive meaning of 'TARTE TROPEZIENNE'.

Case T-34/15; Wolf Oil Corp. v EUIPO / UAB SCT Lubricants; Judgment of 1 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Dissimilarity of signs, Conceptual dissimilarity, Examination of facts ex officio, Right of defence

FACTS: The applicant obtained the international registration designating the European Union of the word mark CHEMPIOIL for goods covering, inter

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alia, hydraulic and brake fluids (Class 1), cleaning and washing preparations for oil-soiled engines and other soiled industrial objects (Class 3), lubricants; fuels, industrial greases and industrial oils (Class 4). An opposition based on the earlier figurative mark represented below, also registered for goods in Classes 1, 3 and 4, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition. The Board of Appeal (BoA) annulled the OD's decision and upheld the appeal. It found that there was no likelihood of confusion between the marks at issue because the signs were different due, in particular, to the fact that the earlier mark had a fixed meaning for all the public in the EU, whereas the earlier mark had no meaning or different ones. The opponent filed an action before the General Court (GC) relying on three pleas in law: infringement of Articles 75 and 76 and 8(1)(b) EUTMR. The GC dismissed the appeal.

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CHEMPIOIL

Earlier mark

CHAMPION[®]

SUBSTANCE: On the likelihood of confusion: It was not disputed that the goods at issue were identical or similar. The GC confirmed the finding of the BoA that the earlier mark CHAMPION is an English and French word meaning a person who has beaten or overcome his rivals in a competition, which is part of the basic vocabulary of those languages. By contrast the CHEMPIOIL sign does not convey any clear concept. Thus, it is unlikely that a significant part of the public will associate a specific meaning to that sign (para. 42). The GC applied, as the BoA did, the case-law following which conceptual differences may counteract to a large extent visual or phonetic similarities between the signs concerned. Therefore, it concluded that consumers would differentiate the signs at issue, despite their visual and phonetic similarities. The GC therefore confirmed that since the requirement of identity or similarity of signs was not met in the present case, there was no likelihood of confusion between the marks at issue (paras. 53-54).

Regarding the infringement of Articles 75 and 76(1) EUTMR, the GC noted that, in confirming that the word 'champion' which is part of the earlier mark would be understood by a large majority of the relevant public, the BoA relied on the one hand, on the arguments submitted by the intervener during the administrative procedure which the applicant, moreover, acknowledged and, on the other, on well-known facts (paras. 63, 64). Therefore, there was no infringement of Article 75 CTMR. the BoA clearly and unequivocally set out the reasoning which led it to

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find that the word 'champion' would be understood by a large majority of the relevant public, which enabled, in particular, the applicant to ascertain the reasons for that conclusion (paras. 72-75).

Case T-250/15; Speciality Drinks Ltd v EUIPO; Judgment of 24 November 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Claim for alteration of EUIPO decision, Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity, Likelihood of confusion, Coexistence of trade marks

FACTS: The EUTM applicant sought to register the word mark CLAN for goods in Class 33. An opposition based, i.a., on the earlier word mark CLAN MACGREGOR, registered for goods in Class 33 was filed on the grounds of Article 8(1)(b) EUTMR. The Opposition Division dismissed the opposition: genuine use of the aforesaid earlier mark was proven for 'Scotch whisky' and there was likelihood of confusion between the marks at issue. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC) raising one plea in law, namely breach of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

CLAN

Earlier mark

CLAN MACGREGOR

SUBSTANCE: Insofar applicant seeks the rejection of the opposition and reversal of the order for costs made by the BoA, this aims to obtain a decision by the GC to replace the decision which the BoA should have taken. The BoA may annul the decision of the Office adjudicating body which took the contested decision and exercise any power within the competence of that body, in the present case to rule on the opposition and reject it, drawing, if it does so, the consequences of that annulment as regards the costs. Consequently, that measure is amongst those that the GC may make in the exercise of its power to alter decisions under Article 65(3) of the regulation (para. 17). Application for annulment: The relevant public is made up of the general public (para. 20) which would show an average degree of attention (paras. 23-31). The goods are identical. The signs have an average degree of conceptual similarity (paras. 34-50). Having regard to the element 'macgregor' within the earlier mark, which the BoA itself refused to classify as 'secondary' or 'marginal' and which, contains more letters and syllables than

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the element 'clan', the signs at issue only have a low degree of visual and phonetic similarity (para. 63). The identity of the goods is sufficient to overcome the differences found between the signs at issue, and justifies the conclusion of a likelihood of confusion. The applicant's 'coexistence in the register' argument is insufficient to affect the outcome (para. 69 et seq.). The earlier marks invoked by the applicant are all composite marks and, consequently, their peaceful coexistence, even if proven, could not exclude the likelihood of confusion between a mark composed of the element 'clan' only, and a composite mark. The application for annulment must be dismissed. The claim for alteration: No grounds for annulment or alteration as set out in Article 65(2) EUTMR have been found in the course of the examination of the application for annulment made by the applicant.

Case T-349/15; CG Verwaltungsgesellschaft mbH v EUIPO; Judgment of 24 November 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the goods and services, Weak element, Visual similarity, Phonetic similarity, Conceptual dissimilarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 25. An opposition based on the earlier



figurative marks represented below, registered for, inter alia, goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) upheld the applicant's appeal. It found that the marks at issue were visually similar to a very low degree and not similar phonetically and conceptually. The opponent filed an action before the General Court (GC) relying on a single plea in law: Article 8(1)(b) EUTMR. The GC dismissed the appeal.

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SUBSTANCE: It was not disputed that the goods at issue were identical or highly similar. The GC upheld the findings of the BoA as regards the meaning of the verbal elements of the contested mark (in English the word 'pro' means, inter alia, 'a person who engages in an activity on a professional rather than an amateur basis'; furthermore, according to the case-law, the word 'pro' may be laudatory; the word 'player' means, inter alia, 'a person who practises physical exercise') (paras. 37-38). The GC held that as regards some goods (jackets, shorts, socks, etc.), although they may be used for playing a sport, nothing in their description indicates that they are specifically designed for that purpose and the inherent distinctiveness of the word element 'pro player' is normal (para. 40). However, as regards some of the goods, the wording of which does indicate that they have a direct link with sporting activities (such as swimsuits) this element will be weak (para. 41). The GC confirmed that the BoA rightly took into account all elements of the marks at issue and based its comparison on the overall impression of the marks and rightfully concluded that there was a low degree of visual similarity, that the phonetic similarity would not be more than low and that there is no conceptual similarity, considering that the single letter 'p' does not convey any concept (paras. 48-64). The GC confirmed that the inherent distinctiveness of the marks was not higher than normal. There is no likelihood of confusion.

Case T-350/15; Perry Ellis International Group Holdings Ltd v EUIPO; Judgment of 11 October 2016; Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 25. An opposition based on, inter alia, the earlier figurative 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. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the signs at issue, likely to be perceived as the letter 'p', had average visual similarity, were phonetically identical if they were perceived as the letter 'p' and that there was no conceptual similarity. The applicant filed an action before the General Court (GC) relying on one plea in law: Article 8(1)(b) EUTMR. The GC dismissed the appeal.

SUBSTANCE: It was not disputed that the goods at issue were identical or highly similar. The GC confirmed the BoA's assessment that the most distinctive and dominant element of the mark applied for is the element likely to be perceived as the letter 'p' (para. 39). The GC confirmed that the

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EUTMA



Earlier mark



BoA was correct in finding the signs visually similar to an average degree (para. 46), phonetically either identical or not comparable (paras. 47-49) and that there was no conceptual similarity since, even if they were perceived as the letter 'p', a letter does not have semantic content (para. 50). Furthermore, the BoA's conclusion that, irrespective of whether the earlier mark is perceived as the letter 'p' or not, that mark has an average degree of inherent distinctive character (paras. 58-62). There is likelihood of confusion.

Case T-362/15; The Lacamanda Group Ltd, established in Manchester (United Kingdom) v EUIPO; Judgment of 28 September 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Reputation

FACTS: The EUTM proprietor registered the word mark HENLEY as an EUTM for goods in Classes 9, 11 and 18. An application for invalidity was filed pursuant to Articles 52(1)(a) and 53(1) EUTMR, read in conjunction, first, with Article 7(1)(b)(c) and (d) of EUTMR and, secondly, Article 8(5) of that regulation. The Cancellation Division (CD) dismissed the application for invalidity/revocation. The Board of Appeal (BoA) dismissed the invalidity applicant's appeal. It found that the contested mark had not been registered in breach of either Article 7(1)(b), (c), or (d) or of Article 8(5) EUTMR. The invalidity applicant filed an action before the General Court (GC) relying on 3 plea(s) in law: (i) infringement of Article 7(1)(c), (ii) Article 7(1)(b) and (iii) Article 8(5) EUTMR. The GC upheld the appeal. It found that, in excluding the application of Article 8(5) of EUTMR without examining the earlier mark's reputation, the BoA infringed that provision.

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EUTMA
HENLEY
Earlier mark
HENLEYS

SUBSTANCE: The judgment confines itself to the BoA's handling of the claim under Article 8(5) EUTMR. The BoA had excluded Article 8(5) EUTMR without considering it necessary to examine the reputation of the earlier mark. It stressed that the conditions for the application of Article 8(5) are cumulative and pointed out the following shortcomings in the invalidity applicant's case:

(i) Unfair advantage

Failure to establish that the earlier trade mark conveys any image so the BoA is unable to assess whether there would be unfair advantage of an image attributable to the earlier mark.

(ii) Detriment to distinctive character

Failure to provide the required prima facie evidence of a change in the economic behaviour of the earlier trade marks' average consumer

(iii) Detriment to the earlier trade marks' distinctive

Failure to allege that the contested goods have a characteristic or quality that may produce a negative influence on the earlier trade marks' image.

The BoA concluded that, since the contested EUTM neither takes unfair advantage of the earlier trade marks nor is it detrimental to the earlier trade marks' distinctive character or reputation, it was unnecessary to assess the earlier trade marks' reputation. The GC found that the application of Article 8(5) EUTMR "necessarily requires a 'definitive conclusion' regarding whether or not a reputation exists, which, in principle, means that no analysis regarding the possible application of that provision can be carried out on the basis of a vague hypothesis, that is to say, a hypothesis which is not based on the acknowledgement of a reputation with a specific level of strength" (para. 22).

The GC noted that the BoA neither (i) concluded that the earlier mark enjoyed a reputation nor (ii) made an assumption based on the acceptance of a reputation of a specific strength nor (iii) adopted the detailed analysis which had been carried out by the CD on the earlier mark's reputation. The GC concluded that, in excluding the application of Article 8(5) EUTMR without examining the earlier mark's reputation the BoA infringed that provision.

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Case T-400/15; Ana Isabel Pinto Eliseu Baptista Lopes Canhoto v EUIPO; Judgment of 28 September 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Translation of evidence, Substantiation of earlier right, Clarity of party submission

FACTS: The applicant sought to register the word mark CITRUS SATURDAY as an EUTM for goods in, inter alia, Class 25. An opposition based on the earlier word mark CITRUS registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition as unsubstantiated as the opponent had not submitted a translation of the certificate of registration of the earlier mark into the language of the proceedings within the period prescribed for that purpose. The translation reached the Office on 21 May 2014 although the time-limit expired on 12 May 2014. The Board of Appeal (BoA) dismissed the opponent's appeal. It found that the OD had correctly rejected the opposition as unfounded pursuant to Rule 20(1) of EUTMIR. The opponent filed an action before the General Court (GC) relying on two pleas in law, (i) infringement of Rule 19 and Rule 20 of EUTMIR and of Article 76 EUTMR and (ii) infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights of the European Union and of Article 18 TFEU.

EUTM

CITRUS SATURDAY

Earlier mark

CITRUS

SUBSTANCE: Infringement of Rule 19 and Rule 20 of EUTMIR and of Article 76 EUTMR: The opponent argued that the translations in question, that is, certificate of registration of the earlier mark should have been regarded as admissible evidence, given that (i) they had been sent before the expiry of that period, (ii) the context in which they had been submitted [a delay on the part of the postal services] justified the delay in their being received by the Office and (iii) the BoA should, in any event, have proceeded to examine those documents of its own motion pursuant to Article 76 EUTMR.

Firstly, the GC found that the fact that the translations were sent within the prescribed period, is irrelevant, given that only the receipt of those documents by the Office is to be taken into account (para. 22). The interpretation that it is the date on which a document is filed with the Office which is to be taken into account is consistent with the general scheme of the EUTMR and EUTMIR (para. 25).

Secondly, the submission of facts and evidence by the parties in relation to substantiation remains

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possible after the expiry of the relevant time limits under EUTMR and the Office is in no way prohibited from taking account of facts and evidence which are submitted late (paras. 29-30). Nevertheless, where an opposition is based on an earlier national registered trade mark, the evidence of the existence, validity and scope of protection of that mark which must be submitted during the opposition proceedings is set out precisely and exhaustively in Rule 19(2)(a)(ii) and Rule 19(3) of EUTMIR, so that an opponent is in a position to be aware of the specific documents which it must produce in support of that opposition. Consequently, the BoA must, in those circumstances, exercise its discretion restrictively and may allow the late submission of such documents only if the surrounding circumstances are likely to justify the delay that has occurred in the submission of proof (para. 33). The circumstances surrounding the late receipt of the documents in question – even considering postal delays – did not constitute a legitimate reason capable of justifying the submission of the documents after the expiry of the period prescribed for that purpose. In particular, the circumstances did not constitute exceptional circumstances capable of interrupting or disrupting the proper functioning of the Office for the purposes of Rule 72 of EUTMIR (para. 34).

Thirdly, as regards the opponent's assertion that the BoA infringed Article 76(1) EUTMR by refusing to examine the facts of its own motion. In that regard, it is sufficient to note that it is apparent from that provision that the obligation for the Office

to examine facts of its own motion is restricted to relevant facts that could lead to it applying absolute grounds for refusal to the examination of an EU trade mark application carried out by the examiners and, on appeal, by the BoA during the procedure for the registration of that mark. However, in the context of opposition proceedings, it is for the proprietor of the earlier trade mark to prove the existence, validity and scope of protection of that mark (para. 38).

Infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights and of Article 18 TFEU: The GC interpreted the opponent's submission under this plea to be, in essence, first, that the BoA disregarded her right to an effective remedy and a fair hearing and, second, that the Office infringed the principle of non-discrimination on grounds of nationality (para. 44).

First of all, the GC emphasised that the Court has excluded the possibility of relying on the right to a fair 'trial' in proceedings before the BoAs of the Office, since proceedings before the BoAs are administrative and not judicial in nature.

Next, regarding the right to an effective remedy, the OD's decision may be either revoked under the conditions laid down in Article 80 of EUTMR or annulled in the context of an appeal brought under Article 58 of that regulation. Thus, it is evident that the opponent's right to an effective remedy is protected (paras. 48-50).

Regarding discrimination on grounds of nationality, the Office rejected the opposition purely on the

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ground that the documents had been submitted late. As that fact is entirely unrelated to the opponent's nationality or her place of establishment, The Office cannot be accused of having treated the opponent differently on the basis of her nationality (para. 51). In any event, it should be borne in mind that the opponent also had the possibility of sending the Office the proof in question by personal delivery, by fax or by any other means, including electronically, so that an alleged discrimination on grounds of nationality, connected with the delivery times for communications sent by post, is excluded (para. 52).

Case T-67/15; Polo Club, established in Gassin (France) v EUIPO; Judgment of 10 November 2016 ; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity, Distinctive element, Enhanced distinctiveness, Likelihood of confusion, Weak element

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services, inter alia, in Classes 3 and 41. An opposition based on, inter alia, the earlier EU figurative marks represented below, registered for goods and services, inter alia, in Classes 3 and

41, was filed pursuant to Article 8(1)(b) EUTMR. The opponent opposed all goods and services and claimed enhanced distinctiveness for the earlier marks. The Opposition Division (OD) dismissed the opposition in its entirety finding that there was no likelihood of confusion. The OD refused to take into account additional evidence of enhanced distinctiveness filed by the opponent in reply to the request for proof of use of the earlier marks because it was filed outside the time-limit to substantiate the opposition. The OD then found insufficient evidence to demonstrate that the earlier marks had enhanced distinctive character as a result of use. In the absence of sufficient admissible evidence to establish enhanced distinctive character, the signs at issue were insufficiently similar to find that there was a likelihood of confusion, even if the goods and services concerned were identical.

The Board of Appeal (BoA) annulled the decision of the OD. It allowed the opposition insofar as it is directed against goods and services in Classes 3 and 41 and remitted the case to the OD as to the remainder. The Board of Appeal (BoA) found that the OD could not rely on the mere failure to observe the time-limit as a ground for refusing to take the additional evidence on enhanced distinctiveness into account and noted that it would be artificial and over formalistic to divide the whole body of evidence into the evidence which is admissible only for the purpose of showing genuine use of the earlier mark but is then ignored for the purpose of assessing the enhanced distinctive character of the earlier mark.

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The BoA accepted the additional evidence. The opponent filed an action before the General Court (GC) relying on two pleas in law alleging (i) an infringement of Article 8(1)(b) EUTMR and (ii) infringement of the procedural rules governing opposition proceedings relating to the BoA's acceptance of belated evidence on relating to enhanced distinctiveness of the earlier mark. The GC dismissed the appeal. It found that there was likelihood of confusion for the goods and services in Classes 3 and 41 under Article 8(1)(b) EUTMR.

EUTMA



Earlier mark



SUBSTANCE: Likelihood of confusion; As to the comparison of goods and services, the GC endorsed most of the BoA's conclusions albeit it found that arranging and conducting of conferences,

colloquiums, workshops, congresses, seminars, competitions (education)' and 'organisation of exhibitions for educational purposes covered by the mark applied for were identical and not merely similar to cultural activities, education and providing of training covered by the earlier mark.

The GC emphasized that the image of a polo player and the words 'polo club' have enhanced inherent distinctiveness with regard to the goods in Class 3 and normal inherent distinctiveness with regard to the services in Class 41 which confirmed the essence of the BoA's assessment (para. 54). It also confirmed the BoA's assessment that the signs, each considered as a whole, are visually and phonetically similar to a low degree and conceptually similar at least to an average degree (para. 78).

In assessing likelihood of confusion, the GC stated that a corollary of the fact that the goods and services are identical is that the scope of any differences between the signs in question is reduced (para. 87) and found a likelihood of confusion as regards the goods and services which were considered identical. As regards the services which are not identical, but similar, that factor, combined with the signs' similarity — above all their conceptual similarity — and with the normal distinctive character of the earlier marks, is sufficient to confirm that there is a likelihood of confusion (para. 88).

Belated evidence: The GC cited case-law establishing that Article 76(2) EUTMR grants the Office broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take

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belated evidence into account (para. 99). It held that Rule 20(1) EUTMIR does not constitute a provision to the contrary, within the meaning of said case-law, precluding the Office from using its discretion under Article 76(2) EUTMR for the purposes of taking into account facts and evidence relied on or produced late (para. 100).

The GC found that the BoA had been incorrect to find that the discretion in question stemmed from the third subparagraph of Rule 50(1) EUTMIR because the latter does not apply to the OD (para. 101). Nevertheless, considering that Rule 20(1) of EUTMIR does not constitute a 'provision to the contrary', the BoA was entitled to consider the belated evidence especially considering the following:

- The opponent had proven the existence, validity and scope of the earlier marks' protection within the substantiation period (para. 103);
- The opponent had filed evidence on the highly distinctive character of the earlier marks within the time limit initially set. Consequently, the evidence submitted outside that time limit was additional evidence that complemented evidence already filed (para. 105);
- It is apparent from the case-law that, where a party disputes evidence filed by another party within a time limit, this can justify production of additional complementary evidence (para. 106);
- The material produced late is, on the face of it, likely to be genuinely relevant to the

outcome of the opposition and the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (paras. 108-114);

- As to the lack of an explanation as to why the opponent was unable to submit the evidence in question at an earlier stage of the proceedings, even if the lack of such an explanation were relevant to the production of additional evidence concerning the enhanced distinctive character of the earlier marks — not the existence, validity and scope of their protection — it is sufficient to note that the intervener produced that evidence at the first opportunity open to it in order to respond to the applicant's criticisms of the initial evidence.

Case T-549/15; Ramón Guiral Broto v EUIPO; Judgment of 13 December 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Admissibility; Competence of the Boards, Essential element to be translated, Examination of facts ex officio, Right to be heard, Right of defence, Substantiation of earlier right, Translation of evidence

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FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 30, 35, 41, 42, 43 and 45. An opposition based on the earlier figurative marks represented below, registered variously for goods and services in Classes 9, 25, 42 and 43 was filed pursuant to Article 8(1)(a) and (b) EUTMR. The Opposition Division (OD) partly upheld the opposition in so far as it related to services for providing of food and drink, temporary accommodation, outside catering in Class 43. Only one of earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110.

The Board of Appeal (BoA) upheld the applicant's appeal. It found that the only earlier mark upon which the OD had based its decision was not substantiated because the translations provided by the opponent left out indications of colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative time or that they were not properly substantiated. Consequently, as all the earlier marks were either invalid or not substantiated, the opposition was dismissed as unfounded.

The opponent filed an action before the General Court (GC) relying on 3 plea(s) in law: (i) the contested decision is ultra petita; (ii) the documents submitted in order to prove the existence of the earlier mark were sufficiently probative and (iii) failure to respect the subordinate, instrumental and auxiliary nature of the procedural rules at issue and the possibility of

remedying procedural irregularities. The GC upheld the appeal. It found that the contested decision was adopted in infringement of the principle that the parties should be heard and that the contested decision must be annulled owing to infringement of the applicant's rights of defence.

EUTMA

Earlier marks



SUBSTANCE: The crux of the matter is that the BoA found that the earlier Spanish trade mark was not substantiated because the relevant translations left out indications of colour. The translation of the registration certificate omitted (i) 'azul' and 'blanco' (blue and white respectively) in the arrows shown above and (ii) the words 'y color azul' (and coloured blue) in the description field.

ultra petita: It was common ground that the BoA raised the absence of a translation of the colour claims of its own motion (para. 26). The opponent

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complained that, in doing so, the BoA overstepped its appellate function. The GC held that, in rejecting the opposition on that basis, the BoA did not exceed the scope of the appeal which had been brought before it (paras. 21 to 26). The GC cited the settled principle that the effect of the appeal before the BoA was that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (para. 21). Furthermore, the matters of law put forward before the BoA include any question of law which must necessarily be examined for the purpose of assessing the facts, evidence and arguments relied on by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on that question and even if the Office has omitted to rule on that aspect (para. 25).

The colour claims in respect of the earlier mark at issue are amongst the facts which were submitted to the OD for the purpose of assessing whether there was a likelihood of confusion. They could therefore be taken into account by the BoA (para. 27). In addition, the obligation to translate those claims into the language of the proceedings is a matter of law. Compliance with that obligation is necessary in order to ensure a correct application of the EUTMR in the light of the facts, evidence and arguments provided by the parties and the relief sought since those claims may affect the assessment of whether

there is a likelihood of confusion between the marks at issue. Furthermore, in the absence of a translation of those claims, the trade mark applicant may not have been able to defend itself adequately (para. 28).

Audiatur et altera pars (audi alteram partem): The second sentence of Article 75 EUTMR provides that decisions of the Office are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. It was not disputed that the BoA declared the opposition unfounded pursuant to Rule 19 and Rule 20(1) of EUTMIR without having heard the opponent on the incompleteness of the translation. The fact that the opponent was not heard on that issue constitutes a procedural irregularity (para. 31).

The latter procedural irregularity constitutes an infringement of the rights of defence only provided that the failure to take into account the view of an interested party has had a concrete effect on the ability of that party to defend himself (para. 32). In the present case, considering the BoA's discretion to admit evidence not presented within the time limits, if the opponent had been heard on the absence of a translation of the indications of colour in respect of his earlier mark, he would have submitted a translation of those indications which might have been accepted by the BoA and might therefore have led to the opposition proceedings resulting in

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a different outcome (para. 39). Consequently, the contested decision was adopted in infringement of the principle that the parties should be heard (para. 40).

As regards the other heads of claim that the GC should declare or order the opposition admissible, confirm the decision of the OD and allow the evidence submitted in the course of the administrative proceedings, in view of the BoA's infringement of the opponent's rights of defence, the GC is not 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. Consequently, those heads of claim must be rejected.

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R1250/2016-2



SHAPE OF A BISCUIT (3D)

RESULT: Decision annulled.

KEYWORDS: Distinctive element, Shape of the products, Three-dimensional mark

NORMS: Article 7(1)(b) EUTMR

FACTS: The applicant sought to register the 3D mark for goods in Class 30. The examiner rejected the application under Article 7(1)(b) EUTMR claiming that the shape in question was not so materially different from basic, common shapes of pastry/confectionery products. The face consisting of eyes and a mouth would be seen as a mere decorative element.

SUBSTANCE: The representation of the eyes (including the eyelashes) and the mouth as depicted on the sign at issue, transforms the contested mark as a whole from a naturalistic reproduction of the goods themselves into a fanciful three-dimensional cartoon-like living being. Considering that the goods objected to are 'biscuits; chocolates; pastries; crackers; wafers; cakes; tarts; desserts; ice creams; edible ices' the Board considers the representation of the mark too stylised to be taken as a naturalistic reproduction of the goods themselves. In light of the foregoing, the mark applied for has at least the minimum degree of distinctiveness necessary for it to surmount the barrier posed by Article 7(1)(b) EUTMR (§ 28-29).

It follows that the appeal must be upheld, the contested decision annulled and the mark may, therefore, be accepted for publication for all the goods applied for (§ 30).

R0579/2016-2 DEVIN

RESULT: Decision confirmed.

KEYWORDS: Descriptive element, Evidence of use, Geographical origin, Reputation, Survey

NORMS: Article 7 EUTMR, Article 7(1)(c) EUTMR, Article 52(1)(a) EUTMR

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FACTS: The cancellation applicant filed a request for the invalidity of registered mark 'DEVIN' on the basis of Article 52(1)(a) EUTMR, in conjunction with Article 7(1)(c), (f) and (g) EUTMR, claiming that the mark was the name of a mineral water deposit recognized in Bulgaria. It was a registered geographical indication and was protected under the Lisbon agreement in 27 countries. The sign indicated to consumers that the goods originated from the town of Devin and/or that these goods were prepared using mineral water with a registered GI from the Devin mineral water deposit located in the town of Devin. The Cancellation Division invalidated the registered EUTM in its entirety.

SUBSTANCE: The contested decision concurred with the cancellation applicant that the town of Devin is known by a 'considerable proportion' of consumers in neighbouring countries such as Greece and Romania, where it is 'associated with the category of goods concerned' (contested decision, p. 8, § 7). In coming to this finding, the Cancellation Division relied on several sources of tourist sector data, and the Official Tourism Portal of Bulgaria. On inspection of the evidence, it finds that the geographical name 'Devin' falls foul of Article 7(1)(c) EUTMR, since it would be 'understood by the general public in Bulgaria and by a part of the public in neighbouring countries as a description of the

geographical origin of the relevant goods' (§ 37). The Board confirms that consumers from neighbouring countries would see 'Devin' as a geographical indication. Information is found on the tourism websites. Devin has substantial tourism and is nearby to a major holiday resort. Over 5 million tourists visit Bulgaria yearly. Persons from other Member States would know of Devin. The Board concludes that Devin's reputation for water does not stop at the Bulgarian border (§ 55). Consequently the Board confirms the Cancellation Division's assessment that the mark must be declared invalid, and the appeal is dismissed (§ 57-58).

R0057/2016-2 ICLOUD

RESULT: Decision annulled.

KEYWORDS: Declaration, Distinctiveness acquired by use, Evidence of use, Nature of the goods and services, Purpose of the goods and services, Sales figures, Scope of proceedings

NORMS: Article 7(3) EUTMR

FACTS: The examiner rejected the EUTM application in part firstly under Article 7(1)(b), (c) and Article 7(2)

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EUTMR for all the services in Classes 38, 39 and 45. The Second Board of Appeal in decision 18/05/2015, R 955/2014-2, ICLOUD upheld the examiner's decision. In view of the new evidence filed on appeal, and the perceived deficiencies in the original analysis of the proof of acquired distinctiveness, the Board remitted the case to the Examination Division on the basis of Article 7(3) EUTMR. In this second examination procedure the examiner rejected the application under Article 7(1)(3) EUTMR.

SUBSTANCE: The only issue to be addressed on appeal is whether the evidence filed by applicant is sufficient to allow mark to proceed on the basis of acquired distinctiveness, Article 7(3) EUTMR (§ 14). Contrary to the contested decision, based on an overall assessment of all the evidence provided at first instance coupled with the supplementary evidence filed on appeal, third-party declarations and a survey report, and the repute of the applicant's family of 'I' prefixed marks, the Board concludes that the evidence demonstrates a very high recognition of the mark applied for amongst the relevant public for part of the contested goods and services (§ 21). Consequently the contested decision is annulled and the EUTM is allowed to proceed.

R1607/2015-5



NorthSeaGrid (fig.) /



nationalgrid (fig.) et al.

RESULT: Decision partially annulled.

KEYWORDS: Conceptual similarity, Declaration, Detriment to earlier mark, Dilution of distinctiveness, Distinctive element, Enhanced distinctiveness, Evidence of use, Figurative element, Figurative trade mark, Identity between the goods and services, Likelihood of confusion, Non-registered trade mark, Phonetic similarity, Reputation, Scope of proceedings, Unfair advantage, Visual similarity

NORMS: Article 8(1)(a) EUTMR, Article 8(1)(b) EUTMR, Article 8(4) EUTMR, Article 8(5) EUTMR

FACTS: An opposition was filed against the figurative mark above, which sought protection for goods and services in Classes 4, 35, 37, 38 and 39. The opposition was based on several earlier EUTMs and on the non-registered UK trade mark as indicated above. The grounds of the opposition were those laid down in Article 8(1)(a) and (b) and Article 8(5) EUTMR. The Opposition Division rejected the opposition in its entirety.

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SUBSTANCE: The opponent enjoys reputation in the UK which, in the context of Article 8(5) EUTMR, extends from its business customers in the UK, to a number of its equivalent 'Transmission System Operators' (TSOs) in the rest of Europe, with some awareness amongst the wider public in the UK. However, there is no convincing evidence that 'NATIONAL GRID' is more generally known throughout the European Union (§ 29).

Likelihood of confusion — As regards the relevant public, in relation to Article 8(1)(b) EUTMR the contested sign is addressed to the professional public. However, the relevant public will also consist of the general public of all the Member States, the majority of whom will not read any descriptive significance into the word 'GRID' (§ 30).

'Negotiation and settlement of commercial transactions for third parties relating to the delivery of electricity' in Class 35 are, by their nature, services for commercial enterprises (§ 37).

Given that the services in Classes 38 and 39 are not limited to the transport and distribution of electricity, it is clear that they do not exclude the general public (§ 38).

For the remaining services in Classes 35 ('administrative management of transport and distribution of electricity') and 37 ('construction and repair; installation services; all of the aforesaid services in particular relating to networks for transport and distribution of electricity'), they include ordinary consumers. For example, in some Member States such as Spain, it is not unusual for

electricity companies to require consumers in rural areas to pay for the erection of electricity pylons in order to be linked to the grid (§ 39).

As regards the descriptiveness of the word 'GRID', the Board concludes that 'GRID' will be meaningless because it is not part of a basic English vocabulary (§ 56).

The Board finds confusion to exist from the perspective of the average consumer between the signs compared for those goods and services that do not exclude the general public (§ 60).

Reputation — The opponent does not generate electricity itself in the UK, but owns the transmission and distribution network. Electricity is sold to consumers by companies that have bought it from generators, paying the opponent to transmit the same. Further afield, the opponent's other business stakeholders are grid operators (TSOs) from different countries where the opponent has been developing interconnectors. Thus, the opponent's reputation exists amongst its business customers in the UK, and amongst a number of its equivalent businesses in other European Union countries (§ 69-70).

There is no convincing evidence that 'NATIONAL GRID' has the benefit of very significant reputation amongst the general public in the UK (§ 71).

It has not been proved that use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks, thus one of the necessary conditions for the opposition to be successful, under Article

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8(5) EUTMR, has not been fulfilled. The opposition is partially rejected and the contested decision is partially annulled.

[R1881/2015-1](#)

KB KRITIKAL BILBO (fig.)



RESULT: Decision confirmed.

KEYWORDS: Abbreviation, Dominant element, Figurative element, Figurative trade mark, Nature of the goods and services, Purpose of the goods and services

NORMS: Article 7(1)(f) EUTMR

FACTS: The above figurative mark was refused by the examiner on the basis of Article 7(1)(f) and (2) EUTMR for goods in Classes 31 and 34 stipulating that the said expression was immediately recognisable to the relevant public as 'marihuana'.

SUBSTANCE: The applicants do not deny that the words 'KRITIKAL BILBO' identify a variety of plant of the 'cannabis' genus – also called 'marihuana' – which is used to make marihuana (§ 19). Cannabis with a high THC content is considered to be a narcotic which is prohibited in a large number of Member States

(19/11/2009, T-234/06, Cannabis, EU:T:2009:448) (§ 22).

The assessment of whether the ground for refusal under Article 7(1)(f) EUTMR exists cannot be based on the perception by those members of the relevant public who do not take offence at anything, nor by those who are very easily offended, but must be based on the criteria of a reasonable person with average thresholds of sensitivity and tolerance (see, in that respect, 05/10/2011, T-526/09, Paki, EU:T:2011:564) (§ 23).

The argument that the trade mark applied for does not contravene the basic moral standards of society cannot be maintained given that it is acknowledged that the misuse of marihuana can cause serious harm to the individual and poses an economic and social risk to society in general, and is therefore wholly contrary to the ethical and moral principles that are recognised not just in all the Member States of the European Union, but in all civilised countries (§ 28).

Consequently, the appeal as a whole must be dismissed and the European Union trade mark application must be refused in respect of all the goods in Classes 31 and 34 (§ 32, 44).

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R1471/2016-4



DEVICE OF A CARTOON CHARACTER (fig.)

RESULT: Decision annulled.

KEYWORDS: Distinctive element, Figurative trade mark, Graphical representation, Shape of the products, Substantial procedural violation

NORMS: Rule 51(b) CTMIR, Article 7(1)(b) EUTMR, Article 75 EUTMR

FACTS: The above figurative mark was refused by the examiner on the basis of Article 7(1)(b) EUTMR for goods in Class 28 stipulating that the mark was not markedly different from various basic action figures commonly used in trade, but simply a variation thereof.

SUBSTANCE: Toy figurines can take any (distinctive or non-distinctive) form. The examiner's reasoning means that no representation of toy figurines can be registered in Class 28. It means that non-distinctiveness is directly inferred from the definition of the goods, and not, as it should be, from the characteristics and elements of the graphic representation of the mark. A 'toy' is something to

play with. Any object can serve that purpose. In order to reason a lack of distinctiveness for 'toys' the examiner would have to establish that the representation of the mark represents a typical, already known type of toy (§ 18-19).

The examiner did not show that similar figurines or toys already exist on the market. So it cannot be said that the mark applied for is 'classic' or 'commonplace' (§ 22).

The mark applied for shows a graphic design which is endowed with sufficient distinctive character for the goods in question (§ 23).

Consequently Article 7(1)(b) EUTMR is not applicable, the contested decision is annulled and the EUTM application shall be accepted for publication.

R0001/2016-4 BERLUTI / BELUTTI

RESULT: Decision confirmed.

KEYWORDS: Identity between the goods and services, International registration, Likelihood of confusion, Restriction of the goods and services, Similarity between the goods and services, Similarity of the signs

NORMS: Article 8(1)(b) EUTMR

FACTS: The word mark 'BERLUTI' registered for goods in Classes 3, 9, 14, 18, 21 and 25 was opposed on the basis of EUTM 'BELUTTI' registered for goods

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and services in Classes 9, 35 and 44. The Opposition Division partly upheld the opposition based on certain goods and services in Class 9. The IR holder (appellant) proposed a limitation.

SUBSTANCE: The limitation proposed by the appellant is inadmissible. Any limitation of the list of goods and services of an international registration must be filed at the International Bureau of the World Intellectual Property Organisation and not at the Office. Furthermore, a limitation is not admissible as an 'accessory request'. The IR holder proposes the limitation in its statement of grounds and then continues its arguments by quoting the goods as applied for. Moreover a procedural request cannot be made under the 'condition' that the Board rules in a particular manner about another question relevant for the appeal. 'Accessory requests' for limitation are actually auxiliary requests and are not clear and unconditional. It is, overall, not a valid request for a limitation (§ 11).

The appeal is dismissed and the opposition allowed.

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