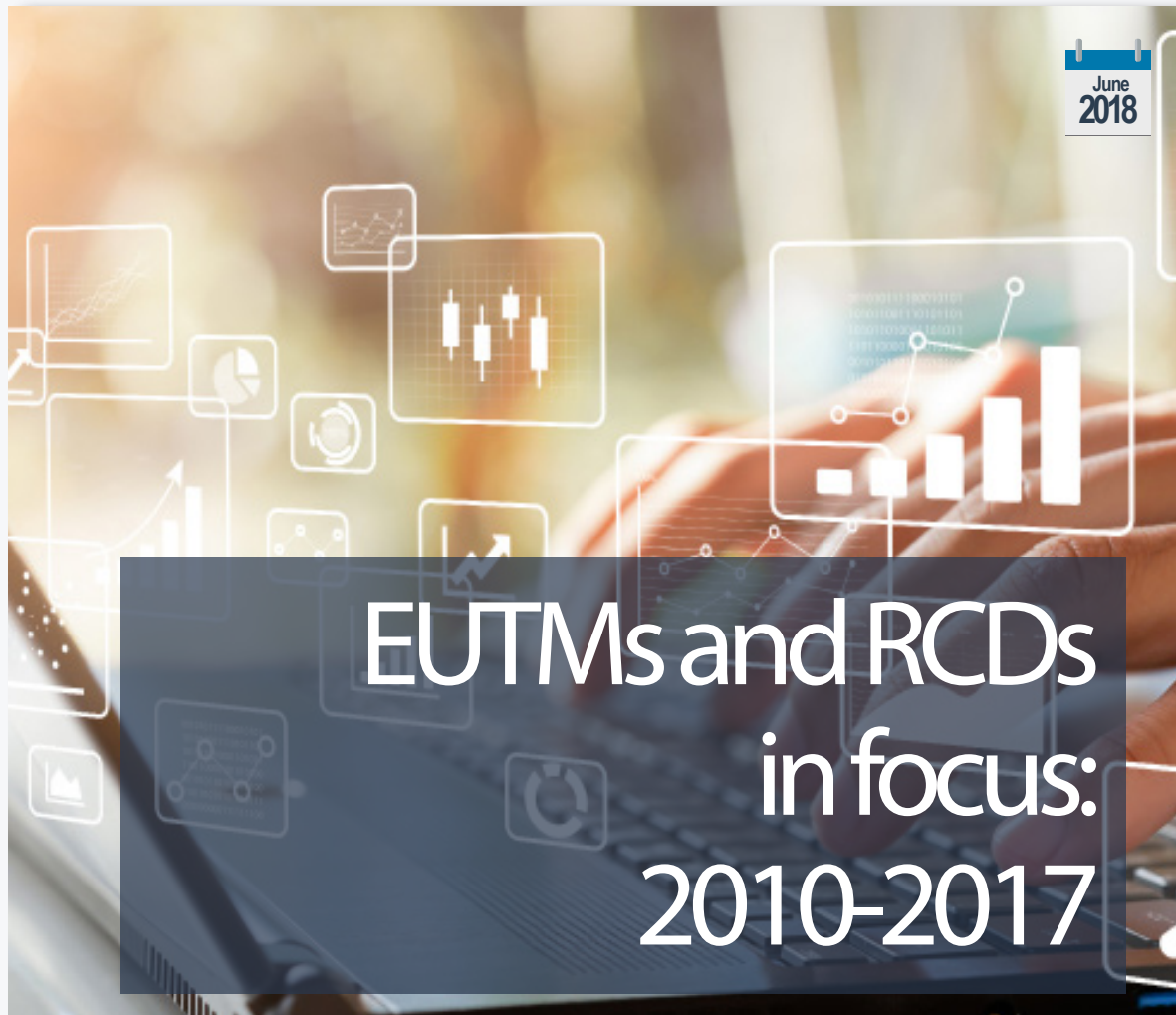


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## EUTMs and RCDs in focus: 2010-2017

For the first time, EUIPO has commissioned two reports, one on trade marks and the other on designs, showing the full evolution of growth of both unitary intellectual property rights since the start of the decade.

The reports provide an overview of the demand for both the EU trade mark and the Registered Community Design, in terms of growth of filings and registrations, as well as associated procedures such as oppositions, cancellations/invalidities and renewals.

Detailed information regarding volumes and rates per countries, applicants/owners and classes are included for analysis.

When comparing the 2017 and 2010 filing volumes, EUTM filings grew by 48.8% overall, while RCD filings increased by 33.8%.

More than 956,000 EUTM applications, including over 2,635,000 goods and services classes, were filed, with an average annual growth rate of 5.9%, and an overall growth rate of almost 49%. The forecasted volume for applications in 2018 will take the overall number of EUTM filings since the beginning of 2010 past the 1.1 million mark.

RCD filings experienced an average annual growth rate of 4.3% between 2010 and 2017, and an overall growth rate of 33.8%.

Over 203,000 applications, containing on average 3.8 designs per application, were received during this period, amounting to almost 770,000 individual design filings. The forecasted filing volumes for 2018 provide an accumulated volume of approximately 885,000 RCD filings since the beginning of 2010.

The reports clearly show that the EU's vast internal market has strong commercial appeal for the world's largest economies. The United States of America and the Peoples' Republic of China both appear in the top 10 trade mark and design rankings, with China showing exceptional growth over the past decade (39.4% average annual growth rate in EUTM application filings and 32.1% average annual growth rate in RCD filings).

Overall Germany leads the country of filing origin rankings of both EUTMs and RCDs. Germany is responsible for nearly 17% of EUTM filings since the start of the decade, with other large European Union economies such as Italy, Spain, France and the Netherlands collectively accounting for slightly over 25% of total EUTM filings.

In terms of direct RCD filings, Germany leads the Top 10 ranking of countries with the most cumulative filings, accounting for 22.2% of the total, while the five largest EU economies (Germany, United Kingdom, France, Italy and Spain) collectively represent almost 53% of total direct filings.

Top applicants/owners of both EUTMs and RCDs include global enterprises such as LG, L'Oréal, Novartis,

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Samsung, Nike, Robert Bosch, Huawei and Apple.

EUIPO has effectively dealt with increasing workloads while achieving noteworthy reductions in the timeliness of key EUTM activities such as the publication of applications (-69.2%), registrations (-35.5%), decisions on oppositions (-23.9%) and decisions on cancellations (-17.8%).

In terms of RCDs, straight-through direct filings (without examination deficiencies) improved their timeliness by 58.3% by lowering their average filing to registration time from 12 working days in 2010 to 5 working days in 2017. The timeliness of RCD invalidity decisions evolved in a very positive manner from 2010 to 2017, decreasing at an average rate of 2.2% per annum while reaching an overall reduction of 21.5% (3.2 months) when comparing the 2017 and 2010 timeliness figures.

[Read the EUTM Focus report](#)

[Read the RCD Focus report](#)

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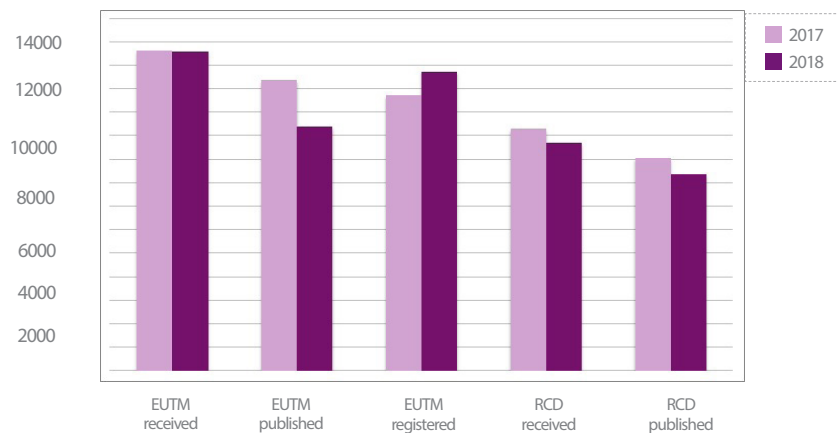


## Statistical Highlights



Monthly statistical highlights April	2018	2017
European Union Trade Mark applications received	12 943	12 384
European Union Trade Mark applications published	12 288	12 714
European Union Trade Marks registered (certificates issued)	12 834	11 933
Registered Community Designs received	7 110	8 594
Registered Community Designs published	7 407	9 335

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



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## Montenegro joins Designview

As of 28 May the Intellectual Property Office of Montenegro (IPOM) has made its design data available to the Designview search tool.

With IPOM on board Designview now contains data from 65 participating offices.

With the addition of more than 270 designs from IPOM Designview provides information and access to more than 13.6 million designs.

Since the introduction of Designview on 19 November 2012 the tool has served more than 3.6 million searches from 159 different countries, with users from Germany, the UK and Spain among the most frequent users.

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### Publication of the 'Synthesis Report' on IPR infringement 2018

New research from the European Union Intellectual Property Office (EUIPO) shows that EUR 60 billion is lost every year due to counterfeiting in 13 economic sectors.

These figures emerge from a cycle of research work carried out by the EUIPO over the last 5 years and released in one single report for the first time. The Synthesis Report, released today, brings together research on the contribution of intellectual property to the EU economy and the cost of counterfeiting and piracy to international trade. It also synthesises actions being undertaken by national, regional and international bodies to combat intellectual property right infringements.

The 13 sectors studied are: cosmetics and personal care; clothing, footwear and accessories; sports goods; toys and games; jewellery and watches; handbags and luggage, recorded music; spirits and wine; pharmaceuticals; pesticides; smartphones; batteries and tyres.

The full Synthesis Report and the executive summaries can be found [here](#)

### Closure of the Swedish Criminal Case related to Scamming

On 4 April 2018, the Supreme Court of Sweden (Högsta domstolen) refused leave to appeal against the Svea Court of Appeal's judgment dated 20 December 2017 in case B 6403-16.

Accordingly, the appeal judgment became final and irrevocable.

Following this development, the criminal litigation proceedings against senders of misleading invoices are now concluded and the judgment sentencing several individuals for completed gross fraud became final.

EUIPO's previous update reporting on the appeal judgment can be read [here](#).

### User Satisfaction Survey: results

In the first quarter of this year, the Office launched its 2017 User Satisfaction Survey, as part of its commitment to providing the highest quality standards of service to its users, and to learn from their feedback.

The survey was carried out online, with all users of EUIPO's services invited to give their views. This year, the participation rate was 10.5% (an increase from 7.8% in the last exercise).



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Overall, users indicated a high rate of satisfaction with EUIPO's services, online tools and harmonisation efforts.

More details on the results of the survey can be [accessed here](#)

The results will be used to help the Office improve its service to users in the framework of its quality management system.

The EUIPO would like to thank its users for participating and providing feedback during the survey exercise.

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

C-478/16 P; EUIPO GROUP; EUIPO v Group ODD; Judgment of 19 April 2018; EU:C:2018:268; Language of the case: BG

RESULT: Action dismissed

KEYWORDS: Complementary evidence, Essential element to be translated, Language of the proceedings, Non registered trade mark, Scope of proceedings, Translation of evidence

FACTS: : the applicant sought to register the figurative mark shown below as an EUTM for services in Classes 35, 39 and 43. An opposition was filed based on the earlier non-registered figurative sign shown below, used in Bulgaria, Czech Republic, Hungary, Poland and Slovakia as a company name for transportation services. The Opposition Division (OD) dismissed the opposition insofar as the opponent had not specified or provided any evidence about the applicable national law on which it was relying and under which the use of the mark sought might have been prohibited in the Member States concerned. The opponent filed an appeal and submitted references to Bulgarian law. The Board of Appeal (BoA) dismissed the appeal, as it found that the

documents produced by the applicant before the OD did not contain any reference to Bulgarian law. The BoA found that the references to three legal provisions in the statement of grounds of appeal had been submitted late. According to the BoA, the required reference to the legal bases must be made within the time limits granted during opposition proceedings. It also found that the applicant had referred only to the text of Article 12(1) of the Bulgarian Law on trade marks and geographical indications, without providing the original Bulgarian version or proving that that text originated from an official and reliable source. The opponent filed an action before the General Court (GC) relying on three pleas in law: (i) infringement of Article 76(1) of Regulation (EC) No 207/2009, (ii) infringement of Article 76(2) of Regulation (EC) No 207/2009, and (iii) infringement of Article 8(4) of Regulation (EC) No 207/2009. The GC upheld the action insofar as it found that the particulars of the national legislation supplemented the initial evidence, which concerned the use in the course of trade of an unregistered sign, both sets of evidence being regarded altogether as 'one piece of evidence proving the acquisition, permanence and the scope of the protection of an earlier right'. Therefore, the BoA could not rule out the admissibility of the content of the national law, submitted for the first time before it, without exercising its discretion under Article

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76(2) of Regulation (EC) No 207/2009. Also, the BoA could not require the opponent to produce an extract from the Darzhaven vestnik or the official Bulgarian text. If the BoA had doubts about the faithful reproduction, applicability or interpretation of the Bulgarian law relied on by the applicant, it was required to exercise its powers of verification. The Office filed an action before the Court of Justice of the European Union (CJEU) relying on two pleas in law: (i) infringement of Article 76(2) of Regulation (EC) No 207/2009 in conjunction with Rule 50(1) of Regulation (EC) No 2868/95 and (ii) infringement of Article 8(4) of Regulation (EC) No 207/2009 in conjunction with Rule 19(2)(d) of Regulation (EC) No 2868/95.



SUBSTANCE: (i) Regarding the first plea concerning the alleged infringement of Article 76(2) of Regulation (EC) No 207/2009 in conjunction with Rule 50(1) of Regulation (EC) No 2868/95, the Court of Justice (CJ) recalled that, when evidence is produced within the time limit set by the Office, the presentation of

supplementary evidence remains possible (para. 37). In the present case, the additional elements must be regarded as complementary rather than 'new', since altogether they form part of the evidence used to prove the acquisition, permanence and the scope of protection of the non-registered Bulgarian mark (para. 38). Moreover, the additional evidence was related to evidence previously submitted before the OD, since the Bulgarian law was indispensable for the assessment of the proof of use of the earlier non-registered sign, and vice versa (paras 42-43). (ii) Regarding the second plea concerning the alleged infringement of Article 8(4) of Regulation (EC) No 207/2009 in conjunction with Rule 19(2)(d) of Regulation (EC) No 2868/95, the CJ held that the opponent is free to choose the evidence it considers useful to submit to the Office in support of its opposition regarding a non-registered right (para. 58). Moreover, the Office is obliged to examine all the evidence submitted in order to determine whether it proves that the earlier mark was registered or filed, and cannot reject out of hand a particular type of evidence on the sole account of the form it takes (para. 58). No specific formalism is needed for the substantiation of a non-registered right (para. 56). It is clear that neither EU trade mark legislation nor the case-law identifies the manner in which the content of national legislation must be proven. Therefore, the BoA could not require the opponent to produce an extract from the Darzhaven vestnik

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or the official Bulgarian text (para. 59). The text of the legislation originating from an official source is not indispensable in order to enable the applicant to exercise his rights of defence (para. 60). It suffices that the elements of national law must enable the Office to identify correctly and unequivocally the applicable law (para. 61).

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

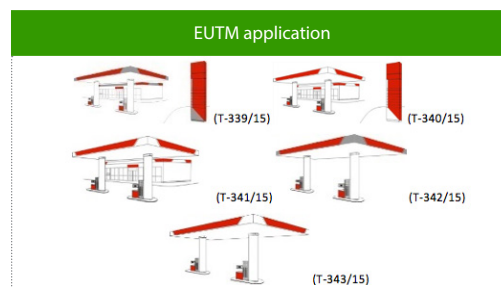
T-339/15 to T-343/15 (joined cases); STACJA BENZYNOWA; Polski Koncern Naftowy Orlen SA v EUIPO; Judgment of 16 April 2018; EU:T:2018:192; Language of the case: PL

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Admissibility, Lack of reasoning, Nature of goods and services

FACTS: the EUTM applicant sought to register five three-dimensional trade marks depicted below for the goods and services in Classes 4, 35, 37, 39 and 43. The examiner informed the EUTM applicant of the grounds for refusal of registration of the marks and rejected the applications for registration pursuant to Article 7(1)(b) EUTMR. The applicant

filed appeals against the examiner's decisions. The Board of Appeal (BoA) found that the marks were devoid of any distinctive character for some goods and services but it appeared that the examiner's justification for the lack of distinctiveness of the marks applied for was not sufficient for all the goods and services at issue. The BoA annulled the examiner's decision and remitted the case for renewed assessment. The EUTM applicant filed an action before the General Court (GC) relying on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of the principle of equal treatment and of the principle of sound administration and (iii) infringement of Article 7(1)(b) EUTMR. The Office argued that the action was not admissible because the decisions of the BoA annulled the decisions of the first instance, and the BoA did not rule on the distinctive character of the marks applied for and, consequently, the applicant was not adversely affected.



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**SUBSTANCE:** the BoA justified its annulment decision on the following grounds. It considered that the respective mark applied for was devoid of any distinctive character, 'in particular as regards fuel, retail sales of fuels, but also in relation to the typical services offered at service stations, such as the sale of beverage and magazine retailers, loyalty management programs and food services'. However, it added that the examiner's justification for the lack of distinctiveness of the marks applied for was not sufficient for all the goods and services in question. Moreover, the BoA considered that the application also included products and services, which would not be part of the usual range of goods and services offered at petrol stations (aviation fuel, petroleum coke, xylenes and wholesale of fuel) and that the examiner should have examined and substantiated in detail why the marks applied for could not fulfil the function of indicating the commercial origin of those goods and services (para. 41).

The GC found that for those goods and services the BoA did not rule on the distinctive character of the marks applied for and, consequently, did not rule on that point in a negative way for the applicant (para. 43). For those goods and services the application was inadmissible (para. 44).

However, for the goods and services, which are typically offered in the petrol stations, the GC considered that the BoA, in the reasoning behind its decision, did rule on the distinctiveness of the signs. This is because from the reasoning of the BoA's decisions it can be understood that BoA had found that at least for some goods and services

the justification of the refusal provided by the first instance was sufficient. However, the BoA did not reject the applicant's appeal with regard to those goods and services, because the BoA annulled the decisions of the first instance without making any distinction between the goods and services (paras 48-49). The GC found that neither the operative part of the BoA decisions nor their reasoning allowed for a clear understanding as to for which of the goods and services normally supplied at the petrol stations the BoA ruled on the distinctiveness of the applications (para. 50), and for which of them the reasoning of the first instance has been found to be sufficient (para. 51). The BoA did refer to the goods and services supplied at the service stations, which might suggest that the lack of justification covered all those goods and services (para. 52). But it specifically mentioned only certain services and such reasoning does not make it possible to understand whether the insufficiency of justification concerns only these services or also other typical products or services offered at the service stations (para. 53). The GC observed that there was a partial discrepancy between the reasoning of the BoA decisions and their operative parts, as well as a lack of clearness as to the BoA's position on distinctiveness of the signs (para. 54). Given that the contested decisions are not clear as to whether the BoA has ruled on the question of the distinctive character of the marks applied for the goods and services other than those that are not part of the

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usual goods and services offered in service stations, the grounds of inadmissibility of the appeal relied on by the Office cannot be retained. The contested decisions must therefore be annulled in that they contain a discrepancy between their operative parts and their reasoning and that there is insufficient reasoning for those goods and services other than those that are not part of the usual goods and services used in service stations (paras 55-56).

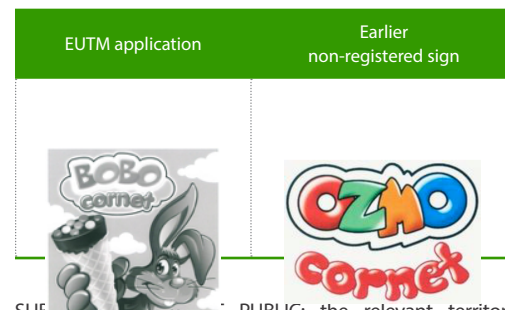
T-648/16; BOBO Cornet www.bobo-cornet.com / OZMO cornet; Şölen Çikolata Gıda Sanayi ve Ticaret AŞ v EUIPO; Judgment of 17 April 2018; EU:T:2018:194; Language of the case: EN

RESULT: Action dismissed

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

**FACTS:** The EUTM applicant sought to register the figurative sign depicted below for the goods in Classes 29, 30 and 32. An opposition based on the earlier international registration depicted below was filed pursuant to Article 8(1)(b). It was based on all the goods covered by the earlier registration, namely goods in Class 30 and directed against all

the goods covered by the EU trade mark application. The Opposition Division (OD) rejected the opposition in its entirety. The opponent filed an appeal, which was dismissed by the Board of Appeal (BoA). It found that the signs are visually dissimilar; aurally similar to a less than average degree; and conceptually void, and deduced that there was no likelihood of confusion (LOC). 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 75 EUTMR and, more particularly, breach of the duty to state reasons, and infringement of Article 76(1) EUTMR and, more particularly, breach of the duty of diligence.



**SUE PUBLIC:** the relevant territory consists of the Member States designated by that international registration, namely Belgium, Bulgaria, the Czech Republic, Denmark, Germany, Spain, France, Croatia, Italy, Luxembourg, the Netherlands, Austria,

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Poland, Portugal, Romania, Slovenia, Slovakia and the United Kingdom. The goods in question are everyday consumer goods directed at the public at large, who will display an average level of attention (para. 27). COMPARISON OF THE SIGNS: VISUAL COMPARISON: the representation of the rabbit holding an ice cream cornet occupies two thirds of the mark applied for and that constitutes a particularly striking feature of that sign (para. 36). The verbal elements 'bobo' and 'cornet' of the mark occupy a less prominent position than the representation of the rabbit. Among those verbal elements 'bobo' has more of a visual impact than the final element 'cornet', given the larger size of its letters (para. 37). The element 'ozmo' in the earlier mark is likely to have a greater visual impact than the element 'cornet' as it is written in larger letters and it is framed by a thin black line (para. 38). The mark applied for can be distinguished by the representation of the rabbit holding an ice cream cornet, which dominates its visual representation. Furthermore, the words 'bobo' and 'ozmo', which will be regarded as being visually more important than the common word 'cornet', will be perceived by the relevant public as being visually different. The signs are visually dissimilar (para. 39). PHONETIC COMPARISON: the words 'bobo' and 'ozmo' have a greater phonetic impact than the word 'cornet' as it is likely that, due to the fact that the marks constitute a relatively long combination, the relevant public will

pronounce only the first word. That will be the case in particular for the part of the relevant public that will understand the word 'cornet' and perceive it as having a descriptive character (para. 57). The words 'bobo' and 'ozmo' are pronounced very differently. The degree of phonetic similarity of the marks is below average (para. 63). CONCEPTUAL COMPARISON: in view of the descriptive and, therefore, non-distinctive character of the common word 'cornet', having regard to the absence of any concept conveyed by the words 'bobo' and 'ozmo' and the presence of a dominant figurative element in the mark applied for, the coincidence in the verbal element 'cornet' cannot introduce even a low degree of conceptual similarity (para. 80). NO LOC: given the dominant character of the rabbit holding the cornet, the visual and phonetic difference between the marks with regard to the words 'bobo' and 'ozmo', and the secondary character of the word 'cornet', the BoA was correct to find that there is no LOC between those marks (para. 95). REGARDING THE SECOND PLEA IN LAW: the BoA did not fail to fulfil its duty of diligence as the statement of reasons for the contested decision, as regards the phonetic and conceptual comparison of the signs, enabled the applicant to substantiate its case before the Court and enabled the Court to understand the reasoning of the BoA (para. 102). The BoA did not breach its duty of diligence as given that the BoA excluded LOC even if the goods were identical, the

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lack of the detailed analysis of the goods in question had no consequence in this case (para. 104).

T-439/16; holyGhost / HOLY; holyGhost GmbH v EUIPO; Judgment of 20 April 2018; EU:T:2018:197; Language of the case: DE

RESULT: Action dismissed

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

FACTS: the EUTM applicant sought to register the word sign holyGhost for the goods in Classes 18 and 25. An opposition based on the earlier trade mark HOLY was filed pursuant to Article 8(1)(b) EUTMR for all the abovementioned goods. The Opposition Division (OD) upheld the opposition in its entirety and the applicant appealed against the OD's decision. The Board of Appeal (BoA) dismissed the appeal as it found that there was a likelihood of confusion (LOC) pursuant to Article 8(1)(b) EUTMR. The EUTM applicant filed an action before the General Court (GC) relying on one plea in law: (i) infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: RELEVANT PUBLIC AND TERRITORY: the relevant public is both the EU general public

and the specialised public composed of a level of attention above average for the latter (paras 27-28). COMPARISON OF THE SIGNS: VISUAL COMPARISON: the mark applied for wholly contains the earlier mark (HOLY) at the beginning of the mark (para. 33). The letter 'g', written in capital letters, has no significant impact on the visual perception of the two words forming the mark (para. 38). The element 'Ghost' cannot be seen as dominant (para. 41). A significant part of the relevant English-speaking public would understand the term 'holy ghost' as a reference to the Holy Ghost (para. 47). Therefore, the BoA was right in finding that the two words had the same degree of distinctiveness and that the earlier mark had also a normal degree of distinctiveness (para. 49). The signs at issue are of average visual similarity (para. 52). PHONETIC COMPARISON: the presence of the word 'ghost' in the second part of the mark applied for is not sufficient to decisively differentiate the overall impression of the marks in question since the first syllables of the two marks are the same (para. 56). The BoA was right in finding that the signs are phonetically similar to an average degree (para. 58). CONCEPTUAL SIMILARITY: the word 'holy' has the same meaning as the word composing the earlier mark, namely 'saint' (para. 62). The concepts that will be perceived in the marks are very close to each other, being related to religious, immaterial and

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provided for the earlier mark for goods in Class 29. It observed that those goods could fall within Class 29 only if they were added to a milk beverage or to a beverage with milk predominating before being marketed, but the evidence did not show that those goods were marketed in that form. The earlier mark PROTI had to be deemed to have been registered for protein preparations in powder form for beverages supplemented with vitamins or minerals as well as with carbohydrates in Class 32 (paras 38-39). (ii) the BoA did not err in finding that genuine use of the earlier mark PROTI had been proven solely for preparations, particularly proteins, also supplemented with vitamins and or mineral salts, as well as carbohydrates, each particularly in powder form, for beverage preparation in Class 32 (para. 68). (iii) RELEVANT PUBLIC: the relevant public consisted of consumers in Germany presumed to be reasonably well informed (para. 78). COMPARISON OF THE GOODS: the main purpose of the goods in Class 32 covered by the earlier mark (dietary supplements in the field of sport and fitness) is different from that of the goods in Class 5 covered by the contested mark (medical use) and therefore, they are different (paras 91, 98, 101). Moreover, there is only a remote similarity between the goods in Class 29 (milk powders, milk beverages, with milk predominating), covered by the contested mark and the goods in Class 32 covered by the earlier mark (paras 106). COMPARISON OF THE SIGNS: visually

and aurally, the signs are similar to a medium degree, as the word sign 'PROTI' is found entirely at the beginning of the word sign 'PROTICURD' and consumers normally attach more importance to the beginnings of words. However, the English term 'curd' or 'curds' (curdled milk) is not part of the usual English vocabulary of the German-speaking public. Moreover, there is no similarity between the English term 'curd' and its counterpart in German, 'quark' (paras 109-110). NO LOC: since the term 'curd' is not part of the usual vocabulary of the relevant public, it will not be construed as descriptive and 'PROTICURD' will not be perceived as belonging to a family of marks comprising the word component 'proti' (para. 123). Despite the medium degree of similarity of the signs, there is no likelihood of confusion between the goods concerned (para. 124)..

T-15/17; YAMAS / LLAMA; Dimitrios Mitrakos v EUIPO; Judgment of 20 April 2018; EU:T:2018:198; Language of the case: EN

RESULT: Action dismissed

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

FACTS: the applicant sought to register the figurative mark shown below as an EUTM for goods in Classes

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32 and 33. An opposition based on the earlier word mark LLAMA, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and the applicant appealed. The Board of Appeal (BoA) dismissed it, insofar as it found likelihood of confusion, given the identity of the goods concerned, the existing low visual similarities, the very high aural similarities for the Spanish-speaking public of the EU and that the relevant public's degree of attention is no more than average. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade mark
	<p>LLAMA</p>

**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is composed of the general public and of professionals in the EU, with a focus on the Spanish-speaking part, and with an average degree of attention (paras 24, 27) **COMPARISON OF THE GOODS:** the goods concerned are identical (para. 31). **COMPARISON OF THE SIGNS:** (i) the signs have a low degree of visual similarity: they have the same length (five letters) and they both contain the

sequence of letters 'ama'. They differ visually in their first letters, namely, 'll' in the earlier sign and 'y' in the contested sign (paras 37, 40). (ii) The signs have a very high degree of phonetic similarity for the Spanish-speaking public of the EU: the greater part of that public will pronounce the sequence of letters 'll' of the sign LLAMA in the same way as the sound 'y' of the sign YAMAS ('ya-ma' and 'ya-mas', respectively) in most regions of Spain (para. 44). The additional letter at the end of the second syllable of the contested mark will not have a significant impact on the overall phonetic impression. The pronunciation of the letters 'll' in Latin American countries is not relevant (para. 45). (iii) The signs are conceptually different: it is unlikely that the average Spanish consumer of alcoholic drinks will know the Greek term 'yamas' (corresponding to the expression 'cheers') as claimed by the applicant. Evidence should have been provided to prove the contrary, since it cannot be regarded as a well-known fact (para. 49). In any event, regardless of whether the Greek term 'yamas' is known by the relevant public or not, there would still be conceptual dissimilarity (para. 50). **LOC:** the phonetic similarity is particularly important in this context as the drinks covered are ordered orally after their names have been seen on the menu or the wine list (paras 61-62). Furthermore, the relevant public will attribute a meaning to the word 'llama' when they see the bottle, not when they hear that name in a noisy bar or discotheque. The conceptual

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difference between the marks could therefore escape the notice of the greater part of the relevant public, and therefore, cannot counteract the visual and phonetic similarities (para. 63). Therefore, given the above, as well as the identity of the goods and the average level of attention of the relevant public, there is likelihood of confusion.

T-34/17; SKYLEADER; Skyleader a.s. v EUIPO; Judgment of 4 May 2018; EU:T:2018:256; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Evidence of use, Extension of the time limit, Fax, Request for proof of use

FACTS: the applicant registered the figurative mark depicted below as an EUTM for goods in Classes 12 and 14. An application for revocation was filed pursuant to Article 58 EUTMR. The Cancellation Division (CD) set the applicant a time limit of 3 months to submit proof of genuine use of the mark. Within the set time limit, the applicant submitted a two-page fax in which it listed, via annexes, proof of genuine use of the mark that was to be sent to the Office by courier. The listed documents were sent by mail within the time limit, however, the Office received them after the time limit. The CD informed the parties that the proof of use would not be taken into

account since it was received outside the time limit set, and it upheld the application for revocation. The applicant appealed and the Board of Appeal (BoA) dismissed the appeal, as it found that the original documents containing the proof of use were received outside the time limit set. Moreover, the applicant did not take up the opportunity it was given of requesting an extension of the time limit or the continuation of proceedings, or of filing a request for restitutio in integrum. The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 19(1) EUTMDR in conjunction with Article 95(2) EUTMR, and (ii) infringement of the principle of sound administration.

EUTM



SUBSTANCE: (i) In revocation proceedings, where no proof of use is submitted within the time limit, the mark should be revoked of its own motion, as it is for the proprietor to establish genuine use of the mark. Therefore, the Office must revoke a mark where no proof of use has been provided within the time limit set (paras 32, 34). Only the letter sent

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by fax was provided to the CD within the time limit (para. 35). It is apparent from that letter that proof of use, listed as annexes, was to be sent to the Office by post (para. 39). (ii) There is no provision requiring the Office to inform a party of the procedures available to it, nor is it incumbent on it to advise that party to pursue any particular legal remedy. In any event, information for the parties is contained in the Guidelines for Examination in the Office, particularly in the event of expiry of a time limit. Therefore, the Office had no obligation of informing the applicant of the means for rectifying the late submission of proof of use (para. 43).

T-234/17; DIAMOND ICE / DIAMOND CUT; Siberian Vodka AG v EUIPO; Order of 3 May 2018; EU:T:2018:259; Language of the case: DE

RESULT: Action dismissed

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

FACTS: the international registration holder (IR holder) registered the international registration designating the EU, DIAMOND ICE, for goods in Class 33. An opposition based on the earlier EU word mark DIAMOND CUT, registered for goods in Class

33, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition insofar as it found likelihood of confusion. The IR holder appealed and the Board of Appeal (BoA) dismissed the appeal, since it also found likelihood of confusion, given the identity of the goods, the average phonetic and visual similarity, as well as the average inherent distinctiveness. The IR holder filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: SCOPE OF PROCEEDINGS: no specific reference is made to the elements that the BoA failed to take into account. The generic reference to the documents and evidence adduced during the opposition proceedings is not sufficient and it is not for the Court to find in the file of the proceedings before the Office arguments to which the applicant might be referring or to examine them (paras 45-47). RELEVANT PUBLIC: the relevant public is the general public of the EU, with an average (medium) level of attention, since alcoholic beverages are usually widely consumed, and they are sold in shopping centres, supermarkets, cafes and restaurants (paras 22, 25). COMPARISON OF GOODS: the goods are identical (alcoholic beverages) (para. 27). COMPARISON OF SIGNS: even though the word element 'diamond' may convey certain laudatory allusions and therefore may have a weak distinctive character, this does not mean that it will not be taken into account in the

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comparison of the signs, since it is only one of the many factors to be considered for the assessment of similarity (paras 41-42). Regarding the argument that the common word 'diamond' refers to the diamond distillation of vodka, that would refer only to vodka and it could not be deemed to be descriptive of the production process of all alcoholic beverages. Moreover, the previous BoA decision regarding the descriptiveness of the sign DIAMOND FILTRATED cannot be applied for the word element 'DIAMOND' in the present case (para. 49). (i) The signs are visually similar to an average degree: the beginnings of the signs are identical and they differ only in the last three letters of the ten letters in total. They are identical in terms of structure and length, and they are also each composed of two words, with the longer word being at the beginning and the shorter word at the end (paras 58, 62). (ii) The signs are phonetically similar to an average degree: they have the same first three syllables, comprised in the common word element 'diamond' (para. 63). (iii) It cannot be discarded that the sign 'diamond ice' would have no meaning for the relevant public, which could just perceive them as the mere juxtaposition of two words. Moreover, even if a part of the public would perceive it as a reference to a diamond made of ice, that would not exclude the possibility of an existing conceptual similarity with the previous mark, being perceived in both marks as a reference to the shape of a diamond (para. 66). LOC: given the average level of attention

of the relevant public, the identity of the goods and the average visual and phonetic similarity of the signs, as well as the inherent distinctiveness of the earlier mark, there is likelihood of confusion (para. 77). SCOPE OF PROCEEDINGS: the descriptiveness of a mark cannot be raised within the context of opposition proceedings, since this absolute ground of refusal does not fall to be examined as part of the opposition procedure, as it refers to the validity of registrations on behalf of the Office or a national office (para. 75).

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[19/4/2018, R2336/2010-5, Innocenti / iINNOCENTI \(fig\)](#)

EUTM applied for	Earlier EUTM
Innocenti	

RESULT: Decision confirmed.

KEYWORDS: Substantiation of earlier right.

NORMS: Article 8(2)(a) EUTMR, Rule 19(1) CTMIR, Rule 19(2)(a)(ii) CTMIR, Rule 20(1) CTMIR.

Facts: The Opposition Division upheld the opposition filed against the EUTM applied for and

refused the application for the goods in question on the basis of Article 8(1)(b) EUTMR. The applicant requested a suspension of the proceedings – for the second time after it had been granted a suspension of more than five years on a similar ground in the same appeal proceedings – reasoning that a parallel case, initiated by the applicant, was pending before the Court of Turin regarding the invalidity of the earlier right. However, despite the Board's request, the applicant failed to submit appropriate documentation to prove the procedure before the national court (§ 14-17).

SUBSTANCE: As regards the likelihood of confusion the Board confirms that the conflicting goods are identical and the signs are similar overall, therefore there is a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR (§ 54-55).

As regards the request for a suspension of the appeal proceedings, the Board finds that the suspension cannot be granted. The Board relies on Article 71 EUTMDR, i.e. the Board's wide discretion regarding suspensions. The Board refers to established case-law, namely that while taking the decision to suspend the appeal proceedings a balance of all the interests at stake should be taken into account. In the present case, the Board finds that granting the suspension again would unduly prejudice the opponent's interests, therefore it rejects the request (§ 58-62).

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[25/05/2018, R 44/2018-4, Colina piatra alba](#)

RESULT: Decision confirmed.

KEYWORDS: Distinctive element, Geographical origin, Restriction of the list of goods and services.

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

FACTS: The examiner issued an objection on the grounds that the mark did not appear to be eligible for registration under Article 7(1)(j) EUTMR invoking the designation 'ALBA', which is a protected geographical indication for wines. Reference was made to Articles 102(1) and 103(2) of Council Regulation No 1308/2013.

SUBSTANCE: The Board concludes that the mark applied for contains the protected geographical indication for wine 'ALBA' as a separate distinctive element which is enough for Article 7(1)(j) EUTMR to be applicable (§ 8-9, 11).

The applicant could only have overcome the objection by limiting the 'wines' to those from the respective geographic region in Italy and, moreover, to those which comply with the relevant product specification. However, the list of goods has not been limited by the applicant,

rather the applicant indirectly dismisses such a limitation by pointing out that it wishes to use (or even actually uses) the mark for wines produced in Romania. Under such circumstances, the essential function of the PDO to designate wine with a specific geographic origin from Italy, would clearly be infringed (§ 14). As is apparent from the very wording of Article 103(1) of Regulation No 1308/2013 the essential function of the PDO is to secure that no wine is marketed which does not come from the protected zone. The protection for the PDO has been granted in respect of wines with a particular geographic origin notwithstanding the fact that the word 'ALBA' has a dictionary meaning (§ 15-16).

[PDO-IT-A1063 Italy Alba](#)

[PDO-RO-A0368 Romania Alba Iulia](#)

[02/05/2018, R 643/2017-5, COREYSA / CORESA \(fig.\)](#)

EUTM applied for	Earlier EUTM
COREYSA	 

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RESULT: Decision partially annulled.

KEYWORDS: Figurative trade mark, Non-registered trade mark, Proof of use.


NORMS: Article 8(1)(b) EUTMR, Article 8(4) EUTMR, Article 15 EUTMR, Article 47(2) EUTMR, Article 95(2) EUTMR.

FACTS: An opposition was filed against the EUTM applied for on the basis of Portuguese earlier rights (registered trade mark, registered logo and company name). The opponent furnished proof of use regarding the earlier mark as requested by the applicant. The Opposition Division rejected the opposition in its entirety stating that the evidence was insufficient.

SUBSTANCE: As regards Article 8(1)(b) EUTMR the Board finds that the opposition does not fully succeed, because the evidence filed by the opponent does not show use of the mark for the services for which it is registered, therefore the opposition should be rejected on this basis (§ 49-50, 56-57). As regards Article 8(4) EUTMR the Board finds that the Opposition Division should have researched the applicable Portuguese law and should have come to the conclusion that the admissibility conditions for the application of Article 8(4) EUTMR were fulfilled (§ 91).

As regards Article 8(4) EUTMR the Board considers that because some of the services of the contested mark are similar to the services of the earlier logo, it concludes that the conditions of a likelihood of confusion as regards the national law are at least partially met and therefore the other conditions for the application of Article 8(4) EUTMR must be examined (§ 111). As a final conclusion it must be held that the opponent's earlier logo constitutes a valid right in the sense of Article 8(4) EUTMR and it is grounded so as to be able to reject the contested mark for certain services in Class 35 (§ 131).

[18/04/2018, R 972/2017-2, mc dreams hotels Träumen zum kleinen Preis! \(fig.\) / McDONALD'S et al.](#)

EUTM applied for	Earlier EUTM
	<p>McDONALD'S</p>

RESULT: Decision annulled.

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**KEYWORDS:** Figurative trade mark, Common element, Descriptive element, Enhanced distinctiveness, Reputation, Similarity of the goods and services, Unfair advantage.

**NORMS:** Article 8(1)(b) EUTMR, Article 8(5) EUTMR.

**FACTS:** An opposition was filed against the above EUTM applied for based on Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division rejected the opposition in its entirety.

**SUBSTANCE:** The Board finds that, taking into account the low level of similarity existing between the services and the signs, the Opposition Division was right to find that no likelihood of confusion existed between the marks. However, the Board finds that in the contested decision the opponent's family of marks and the reputation of the earlier mark 'McDONALD'S' was not taken into account sufficiently, and therefore it has continued with the revision of the contested decision in that respect (§ 40-41).

After analysing the case under Article 8(5) EUTMR the Board finds that it is highly plausible that the contested mark will 'ride on the coat-tails of the earlier mark' with a reputation in order to benefit from its power of attraction, reputation and prestige. The economic advantage gained

would give the applicant a commercial advantage over its competitors' businesses. That economic advantage would consist of exploiting the efforts expended by the opponent in order to establish the reputation and the image of its earlier mark, without paying any compensation in exchange. That equates to unfair advantage taken by the applicant of the earlier mark's repute (§ 61). The appeal succeeds as regards all the services applied for in Class 43 (§ 63).

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