

# Alicante News

Up to date information on IP and EUIPO-related matters

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The banner features a background image of a desk with a calendar showing March 2018, a wooden pen holder with pens, and a document with the DesignEuropa Awards logo and the text 'CELEBRATE DESIGN EXCELLENCE' and 'APPLY OR NOMINATE UNTIL 15th'. The main text 'DesignEuropa Awards: Apply today!' is overlaid in large, bold, blue letters.

## DesignEuropa Awards: Apply today!

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### DesignEuropa Awards: apply today!

Applications and nominations for the second edition of the DesignEuropa Awards (organised by EUIPO), can be submitted until 15 May.

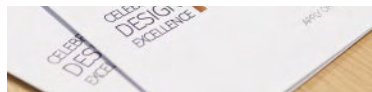
The DesignEuropa Awards are unique among design award ceremonies, in that they focus on the Registered Community Design itself.

They were conceived by EUIPO as a way to honour and celebrate the hundreds of thousands of businesses and individual designers who bring their great designs to market with the protection of the RCD – as well as raising awareness about the RCD among businesses, particularly SMEs.

Anyone can apply or nominate through the DesignEuropa Awards web page ([www.designeuropaawards.eu](http://www.designeuropaawards.eu)) before 15 May 2018. It's completely free to apply or nominate, and the entire process only takes a couple of minutes.

There are three categories:

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



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

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

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

The first edition of the Awards took place in 2016 (the DesignEuropa Awards are held every two years). At the ceremony in Milan, the Small and Emerging Companies Award went to the Flap soundproofing panel owned by Italian firm Caimi Brevetti, and designed by Alberto and Francesco Meda (RCD Number: 001367262-0019 (-0004 to -0021)).

The Industry Award went to the Thule Urban Glide jogging stroller, owned by Thule A.G. and designed by Thule's in-house design team with support from VeryDay (RCD Number: 002394130 (-0002, -0004, -0006)).

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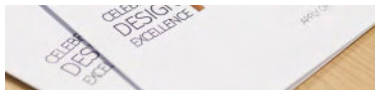
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The Lifetime Achievement Award was presented to legendary Italian designer Giorgetto Giugiaro, the creator of some of the most iconic car designs of the 20th and 21st century (the Volkswagen Golf, Passat, and Scirocco; the Audi '80; the Seat Ibiza, Toledo and Malaga; the Fiat Panda, Uno, the Croma and the new Croma, the Grande Punto and the Fiat Sedici; the Lotus Elite, and even the "Back to the Future" DeLorean car).

The prestigious [DesignEuropa Awards jury](#) is chaired this year by the President of the World Design Organisation, Luisa Bocchietto. The jury is made up of recognised leaders in the fields of design, business and intellectual property rights.

The DesignEuropa Awards 2018 ceremony will take place at the POLIN Conference Centre in Warsaw on 27 November 2018, and registration to attend the ceremony will open in July.

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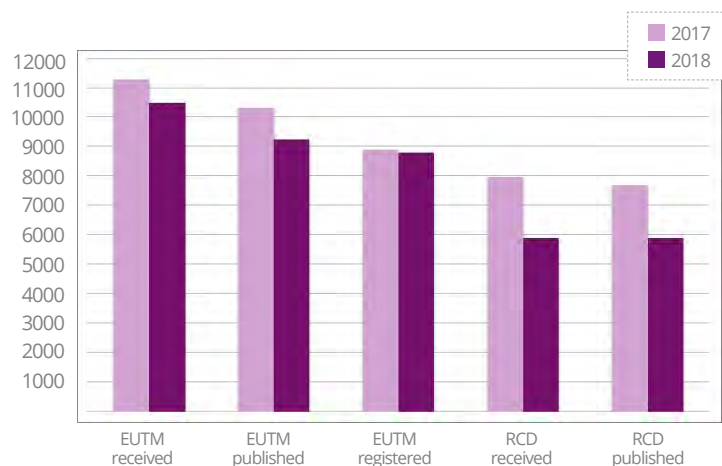


## Statistical Highlights



Monthly statistical highlights February*	2017	2018
European Union Trade Mark applications received	11 273	10 468
European Union Trade Mark applications published	10 316	9 238
European Union Trade Marks registered (certificates issued)	8 879	8 799
Registered Community Designs received	7 957	5 897
Registered Community Designs published	7 672	5 880

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



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## EUIPN Updates



### Montenegro joins TMview

As of 12 March 2018 the Intellectual Property Office of Montenegro (IPOM) has made its trade mark data available to the TMview search tool.

With IPOM on board, TMview now contains data from 63 participating offices.

With the addition of more than 15,000 trade marks from IPOM, TMview provides information and access to more than 48.4 million trade marks in total.

### Georgia joins the Quality Standards tool

Quality standards is an online search tool which provides easily accessible information on services and related quality standards (i.e., performance indicators) offered by each participating IP office.

Sakpatenti is the first IP office outside the EU to join the Quality standards tool. Sakpatenti joined Quality Standards on 19 March 2018.

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### Guidelines HTML Pilot

After offering the EUIPO's Guidelines in PDF format, the Office is currently in the process of creating a more user-friendly version, containing features the PDF output does not support.

Please find [here](#) a link to a pilot showcasing a subset of the EUIPO's trade mark Guidelines in HTML format. This pilot provides an idea of what the final product will look like.

The objective of this project is to offer a more open, agile and inclusive environment for consulting the EUIPO's Guidelines. Some of the features included in the pilot are:

- easy navigation through the Guidelines
- a central search function
- an on-off switch to show modifications for comparing two editions

It also contains cross-referencing between different parts of the Guidelines and links to external databases. Please see the [basic tutorial](#) for instructions on how to use the pilot.

The pilot is still considered work in progress, therefore no rights are reserved and not all envisaged functionalities are available yet. Please also see the disclaimer located in the menu at the top right-hand corner of the pilot web page. To

reference the EUIPO's Guidelines content, please solely refer to the PDF versions on the [website](#).

For any queries or to provide feedback, please use the "Feedback" tab at the top of the pilot webpage, or contact the New Generation Guidelines team directly: [NGGL\\_info@euipo.europa.eu](mailto:NGGL_info@euipo.europa.eu).

### EUIPO achieves new ISO certification after annual audit of activities

The EUIPO has successfully passed an external audit for the renewal of the ISO 9001 (quality), ISO 27001 (information security), OHSAS 18001 (health and safety), UNE 170001 (universal accessibility) certifications and for the follow-up of the EMAS (environment) management system. In addition, the Office achieved a new certification: ISO 10002 standard (complaints handling).

The auditors noted the significant work done by the Office to resolve all the issues raised in the previous audit and remarked on the maturity of all Management Systems implemented at the EUIPO.

They also highlighted the effort of the Office in achieving high-level timeliness standards when dealing with users' interactions (as shown in the Service Charter) and the robustness of the process for the management of complaints, which is now certified to the ISO 10002 standard.

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The EUIPO obtained its first certification (ISO 27001) in 2004 and since then has been following a process of continual improvement of its activities. This has led to the achievement of international certifications in quality management, environmental performance, universal accessibility, occupational health and safety and, from 2018, complaints handling.

For more information about the EUIPO certified management systems, please visit the [EUIPO quality page](#).

## IP Course for Paralegals

As in previous years, the EUIPO will be hosting a new edition of the 'IP Course for Paralegals' from 18 to 20 April 2018 in Alicante.

Online registration will be open from 16/03/2018, on a first come, first served basis. A link to the registration page will be published on the EUIPO Website and in the EUIPO Academy Learning Portal.

The programme has been especially designed to give participants in-depth knowledge of the updates in the EUIPO's practice: A review of the changes brought about by the Legislative Reform; EU trade mark and registered Community design procedures (through practical workshops); actions and initiatives ensuring the quality of procedures and decisions; as well as other subjects that may be of interest to you



that are in the programme.

Please note that all presentations will be given in English.

You can find the programme and register online [here](#).

## eSearch Case Law automatic translation services will bring savings

As part of its commitment to customer-driven, multilingual quality services, EUIPO is rolling out a machine translation service of its decisions available through the eSearch Case Law application.

Here, the translation service provides automatic translations for selected decisions accessible through the language acronym of interest (e.g. EN, FR, IT...) listed under "machine translation."

The automatic translations are provided for information purposes only so that users have an immediate and general understanding of the content and meaning of case law documents. Afterwards, users can decide whether they still need to invest in a human translation of a decision.

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The new automatic translation service is powered by [eTranslation](#) from the European Commission. The initially available languages have been selected on the basis of quality criteria. Further language combinations and decision types will be available in the future when they meet the quality criteria.

This initiative is part of the [Multilingual Communication Management project](#) which forms part of EUIPO's Strategic Plan 2020.

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### Luxembourg trade mark and design news

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

**C-634/16 P; FITNESS; EUIPO v European Food; Judgment of 24 January 2018; EU:C:2018:30; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** New submission on appeal, Competence of the Boards, Complementary evidence, Substantial procedural violation

**FACTS:** The EUTM proprietor was granted the registration of the word mark FITNESS as an EUTM for goods and services in Classes 29, 30 and 32. An application for invalidity was filed pursuant to Article 52(1)(a) of Regulation (EC) No 207/2009 in conjunction with Article 7(1)(b) and (c) EUTMR. The Cancellation Division dismissed the application for invalidity, since the applicant failed to prove the descriptive and non-distinctive character of the mark at the relevant point in time. The Board of Appeal (BoA) dismissed the invalidity applicant's appeal and disregarded the evidence filed for the first time before the BoA, since it was

belated and new, applying by analogy the third subparagraph of Rule 50(1) of Regulation (EC) No 2868/95 in conjunction with Rule 37(b)(iv) of that Regulation. The invalidity applicant filed an action before the General Court (GC), relying on, inter alia, infringement of Article 76 of Regulation (EC) No 207/2009 in conjunction with Rule 37(b)(iv) and Rule 50(1) of Regulation (EC) No 2868/95. The GC upheld the action; it found that Article 76 of Regulation (EC) No 207/2009 in conjunction with Rule 37(b)(iv) of Regulation (EC) No 2868/95 does not imply that evidence submitted for the first time before the BoA must be regarded as belated in invalidity proceedings based on an absolute ground for refusal and that Rule 50(1) of Regulation (EC) No 2868/95 should not be applied by analogy. The Office filed an appeal before the Court of Justice (CJ), 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) imbalance in the parties' procedural rights and infringement of the principles of procedural economy and sound administration. The CJ dismissed the appeal.

**SUBSTANCE:** TIME LIMIT FOR THE SUBMISSION OF

**EVIDENCE:** in the context of invalidity proceedings based on absolute grounds for invalidity, even

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if no time limit is set by which to apply for the cancellation of the registration of a mark, a time limit is nevertheless set for the submission of evidence in the context of the application for a declaration of invalidity or may be set by the Office, by virtue of its competence to organise the procedure (para. 32). The GC erred in stating that Regulation (EC) No 207/2009 contains no provision fixing a time limit for the submission of evidence (para. 33). BELATED EVIDENCE: Article 76(2) of Regulation (EC) No 207/2009 does not imply that evidence submitted for the first time before the BoA must be considered to be out of time in all circumstances (paras 35-45). SCOPE OF APPLICATION OF THIRD SUBPARAGRAPH OF RULE 50(1) OF REGULATION (EC) No 2868/95: the third subparagraph of Rule 50(1) of Regulation (EC) No 2868/95 constitutes a special rule derogating from the principle according to which the provisions relating to proceedings before the department that has made the decision against which the appeal is brought are to be applicable to the appeal proceedings mutatis mutandis. That special rule is specific to appeal proceedings brought against the decisions of the Opposition Division and is not applicable in the context of invalidity proceedings based on absolute grounds for invalidity (paras 48-49). DISCRETIONARY POWER: the discretion conferred on the Office by Article 76(2) of Regulation (EC) No 207/2009, according to which

it may decide to disregard or take into account facts and evidence submitted out of time, is in no way a favour granted to one party, but must result from an objective, reasoned exercise of that discretionary power (paras 56-58).

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

**T-869/16; SWISSGEAR; Wenger SA v EUIPO; Judgment of 23 January 2018; EU:T:2018:23; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Distinctive element

**FACTS:** The applicant sought to register the word mark SWISSGEAR for Classes 9, 12, 14, 16, 18, 20, 22 and 25. The intervener filed an application for a declaration that the contested mark was invalid in respect of all the goods covered by that mark. The Cancellation Division (CD) rejected the application, except for the goods in Class 14 (watches of Swiss origin). The intervener filed a notice of appeal seeking the annulment of the CD's decision insofar as it had rejected the application for a declaration of invalidity. The applicant also brought an appeal against the decision insofar as it had upheld the application for a declaration of invalidity. The Board of Appeal

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(BoA) upheld the intervener's appeal and dismissed that of the applicant. The BoA focused its analysis on the general public in the Member States where English is an official language, who were considered to be well informed and reasonably observant and circumspect consumers for all the goods in question, except for the vehicles and apparatus for locomotion by land, air or water in Class 12, where consumers would display a higher degree of attention. In accordance with Article 7(1)(c) EUTMR, the BoA found that the word 'gear' was descriptive for all of the goods in question and that the word 'swiss' constituted an indication of geographical origin and of quality in light of the reputation of goods or services that come from Switzerland, and an evocation of that country's nature and tourist attractions and of the tourism-related activities that take place there. It was established that there was a link between the geographical indication and all of the goods in question. Moreover, in respect of Article 7(1)(b) EUTMR, the BoA found that the lack of distinctive character of the mark SWISSGEAR arose out of its semantic content, the information that the mark conveyed as regards the geographical characteristic of the goods in question and the overlap between the respective scopes of the Article mentioned previously. The applicant raised two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

**SUBSTANCE:** WHETHER ANNEXES 8, 9 AND 10 ARE ADMISSIBLE: Annex 9, which relates to the results

of an internet image search carried out on the basis of the term 'swissgear', must be excluded, as the results were not produced in the course of the administrative proceedings; Annex 8, which relates to the results of an internet image search carried out on the basis of the term 'gear', should not be excluded, as the results were produced in the course of the proceedings; Annex 10, which consists of five extracts from the Office's EUTM Register that relate to trade marks containing the term 'swiss', should not be excluded (paras 19-27). REGARDING THE FIRST PLEA IN LAW: the contested mark consists of two English terms, namely 'swiss' and 'gear', both of which are, according to the contested decision, descriptive and the combination of which is itself regarded as descriptive (para. 38). At the time when registration of the contested mark was sought, the relevant public perceived the element 'swiss' in that mark as an indication relating to the origin of the goods in question (para. 43). In addition, the word 'swiss' was associated with notions of quality and robustness connected with the purpose of the goods in Classes 20 and 22 (para. 45). The element 'swiss' in the contested mark is descriptive for all of the goods in question. The element 'gear' has a number of meanings, namely those of a toothed wheel that engages with another toothed wheel or with a rack in order to change the speed or direction of transmitted motion, personal equipment and accoutrements, belongings, equipment and supplies for a particular operation such as a sport, and up-to-date clothes and accessories, especially

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those bought by young people (para. 53). Moreover, all the categories of goods in question may be linked directly and specifically with one of the possible meanings of the word 'gear'; namely, 'equipment' for the goods in question in Classes 9, 16 and 18; 'gear' as an 'engine part' or 'cogwheel' for the goods in Class 12; 'accessory' for the other goods in question in Class 12 and the goods in question in Classes 20 and 22, which correspond to accessories necessary for camping, and lastly that of 'clothing' for the goods at issue in Class 25 (para. 56). The fact that a word has a number of meanings does not make it vague. Moreover, the fact that the meaning of a word is broad does not have the effect of eliminating its descriptiveness, but, on the contrary, of increasing it (paras 58-59). Therefore, the element 'gear' is descriptive (para. 60). The word mark SWISSGEAR is descriptive, as each element is descriptive of characteristics of the goods in question (para. 62). REGARDING THE SECOND PLEA IN LAW: as the mark applied for was descriptive and did not enable the consumer to determine the origin of the goods it was therefore devoid of any distinctive character (paras 73-77).

**T-113/16; DEVICE OF A PANTHER (fig.) / DEVICE OF A PANTHER (fig.) et al.; Arctic Cat Inc. v EUIPO; Judgment of 30 January 2018; EU:T:2018:43; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant designated the EU in the context of its application for protection of an international registration for the figurative sign represented below for goods in Classes 12 and 25. The intervener filed a notice of opposition for the goods in Class 25. The opposition was based on the earlier figurative EU trade mark and the UK figurative mark represented below, pursuant to Article 8(1)(b), (4) and (5) EUTMR. The Opposition Division (OD) upheld the opposition for the goods in Class 12 and 25. The applicant appealed against the OD's decision and the Board of Appeal (BoA) upheld the appeal only for the goods in Class 12. Regarding Class 25, the BoA found that there was a likelihood of confusion (LOC), essentially based on the fact that (i) the relevant public is composed of the general public, whose degree of attention is not above average, and of power sport vehicle professionals, whose degree of attention is above average, (ii) the goods are identical, (iii) the signs are similar, given their visual similarity and their obvious conceptual similarity, and (iv) the earlier mark has an average degree of distinctiveness. The applicant raised a single plea in law: (i) infringement of Article 8(1)(b) EUTMR.

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### IR designating the EU



### Earlier trade marks



**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is made up of consumers likely to use both the goods designated by the earlier mark and those designated by the applicant's mark and includes average consumers with an average degree of attention and power sport vehicle professionals, whose degree of attention is above average. **COMPARISON OF THE SIGNS:** in both of the signs concerned, the overall visual impression is dominated by the black silhouette of a member of the cat family, conveying an impression of movement, characterised by the position of the forelegs and hind legs, which are extending from the central part of the body and not supporting it (para. 37). Therefore, the signs are similar visually. As the concept conveyed by the signs in the present case includes the stance of the animals of the cat family, the jumping position, which conveys an

impression of movement, in which they are both represented, confirms the conceptual identity of the signs (para. 46). LOC: there is LOC between the marks at issue in the light of the average degree of attention of the relevant public, the identity of the goods in question, the visual similarity of the signs concerned, their obvious conceptual similarity and the irrelevance of a phonetic comparison, the earlier mark's distinctive character being regarded as average (para. 60).

**T-105/16; Raquel Superior Quality Cigarettes FILTER CIGARETTES (fig.) / FILTER CIGARETTES PM Marlboro 20 CLASS A CIGARETTES (fig.) et al.; Philip Morris Brands Sàrl v EUIPO; Judgment of 1 February 2018; EU:T:2018:51; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Likelihood of confusion, Reputation, Evidence of use

**FACTS:** The intervener registered the EU figurative trade mark represented below for goods in Class 34 (tobacco pouches; tobacco; smoking tobacco; tobacco, cigars and cigarettes; manufactured tobacco). The applicant filed an application for a declaration of invalidity of the mark at issue based on 13 earlier figurative marks. The Cancellation Division (CD) rejected the application for a declaration of

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invalidity, having first compared the contested trade mark and the following earlier international trade mark represented below, and found that the low similarity between the signs did not lead to a likelihood of confusion (LOC) under Article 8(1)(b) and (5) EUTMR. Furthermore, the applicant had not submitted any evidence to establish the reputation of the earlier mark. The applicant filed a notice of appeal against the CD's decision and submitted evidence to prove the reputation of the earlier mark. The Board of Appeal (BoA) dismissed the appeal and rejected the applicant's arguments on the grounds that: (i) the dominant elements of the figurative signs at issue were the word elements 'Marlboro' and 'Raquel'; (ii) it could not take into account evidence submitted for the first time before it; (iii) the applicant's arguments alleging infringement of Article 8(5) EUTMR, as the evidence of the reputation of the earlier mark had been adduced for the first time before the BoA and, therefore, not being supplementary or additional to evidence submitted in time could not be taken into account. The applicant raised three pleas in law: (i) infringement of Article 76(2) EUTMR; (ii) infringement of Article 8(1) (b) and Article 76(1) EUTMR; (iii) infringement of Article 8(5) EUTMR.

**SUBSTANCE:** The General Court (GC) quoted the case-law regarding the discretionary power of the BoA to take into account belated evidence, including that it only extends to evidence that is additional or supplementary to relevant evidence lodged



### EUTM



### Earlier trade mark



within the original time limit. The GC confirmed that the evidence in the present case was not additional or supplementary but completely new. In those circumstances, the BoA was, in principle, not required to take that evidence into account (para. 48). However, the BoA had knowledge of a previous decision in which the earlier mark was found to have reputation. This decision is not in itself sufficient to demonstrate the reputation of the earlier mark automatically. However, this decision was a clear indication that the mark might have a reputation (para. 65). The Office is under a duty to exercise its powers in accordance with the

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general principles of EU law, such as the principle of sound administration. It is in the interests of the sound administration of justice that the BoA is able to make a fully informed decision when ruling in proceedings brought before it. Therefore, it is for the BoA to examine with care and impartiality all the factual and legal information necessary for the exercise of its discretion (para. 63). The evidence was likely to be genuinely relevant to the outcome of the proceedings and by refusing to examine the evidence on the ground that it was submitted out of time, the BoA failed to examine a potentially relevant factor in the application of that provision. Notwithstanding the interpretation of Rule 50 of Regulation (EC) No 2868/95 and Article 76(2) of Regulation (EC) No 207/2009, the broad discretion enjoyed by the Office in the performance of its duties cannot exempt it from its duty to assemble all the elements of fact and law necessary for the exercise of its discretion in cases where the refusal to take account of certain evidence submitted late would breach the principle of sound administration (para. 67). Consequently, the BoA should have taken the new evidence into account. This would not have resulted in the breach of the principle of equality of arms because the other party had the chance to comment on the evidence in the proceedings before the BoA (and it also did comment on it).

This error of the BoA cannot be corrected by its conclusion that, in any event, even if the reputation had been proven, the outcome of the decision would not be different as the degree of similarity

between the marks was not sufficient for the successful application of Article 8(5) EUTMR. As the existence of the link for the purposes of Article 8(5) EUTMR must be assessed globally, the similarity of the marks being only one of the factors and another being the strength of the earlier mark's reputation, the application of Article 8(5) EUTMR should not have been excluded by the BoA.

**T-808/16; HISPANITAS JOY IS A CHOICE (fig.) / JOY; Jean Patou Worldwide Ltd v EUIPO; Judgment of 30 January 2018; EU:T:2018:45; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Similarity of the signs, Dominant element, Identity of the goods and services, Enhanced distinctiveness, Common element, Weak element, Slogan mark

**FACTS:** Registration was sought for the figurative mark represented below as an EUTM for goods in Classes 3, 14, 16, 18 and 25. An opposition based on the earlier word mark JOY, registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition insofar as it found a likelihood of confusion. The Board of Appeal (BoA) upheld the opponent's appeal, as it found there was no likelihood of confusion, given the lack of any similarity between

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the signs. The opponent filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

### EUTM application

HISPANITAS  
JOY IS A CHOICE

### Earlier trade mark

JOY

**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is the EU general public with an average to high degree of attention, given that the goods may be ordinary goods or luxury goods (para. 12). COMPARISON OF GOODS: the goods are identical, since perfumes in Class 3 are included in the broader category of perfumery of the earlier mark (para. 13). COMPARISON OF SIGNS: the dominant element of the contested mark is the word 'hispanitas', due to its prominent position in the first line and its considerably larger and darker print. As part of a whole sentence, the word 'joy' is combined with other words in such a way that the independent distinctive role of the earlier mark is removed in the contested sign, where it is perceived as an inseparable part of a slogan, merely illustrating the

dominant word 'hispanitas'. The signs are similar only to a very low degree, because of their clearly different length and composition (para. 53). NO LOC: Despite the identity of the goods and the presumed enhanced distinctive character of the earlier mark (which was duly taken into account), the marks produce a significantly different overall impression in the minds of the relevant public; in the contested mark, the word element 'joy' cannot be disassociated from the phrase it forms part of and it plays only a secondary role in that mark (para. 54). Even assuming the combination of a 'house mark' with 'product marks' in the contested mark, it could not be inferred from this that such a usage is common to the entire perfumery sector and could be presumed to be known by the average consumer of perfumes (para. 34).

**T-44/16; DEVICE OF A SQUARE (fig.); Novartis AG v EUIPO; Judgment of 31 January 2018; EU:T:2018:48; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Functional element, Graphical representation, Shape of the product, Technical result, Figurative trade mark

**FACTS:** The EUTM proprietor was granted registration of the figurative mark represented below as an EUTM for goods in Class 5. An application

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for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(a), (b) and (e) EUTMR. The Cancellation Division (CD) upheld the application for invalidity. Upon the EUTM proprietor's appeal, the Board of Appeal (BoA) dismissed the appeal. It found that the contested mark had to be declared invalid on the ground that it was composed of a sign consisting exclusively of the shape of the product necessary to obtain a technical result. The EUTM proprietor filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(e)(ii) EUTMR.

### EUTM



**SUBSTANCE:** Registration as a trade mark of a purely functional product shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same shape, but also from using similar shapes (para. 40). The function of the specific product may be examined in order to establish the link between what is visible and what could be a technical solution (para. 93). The technical functions identified are technically

causal of, and sufficient to obtain, the intended technical result, which is the administration of a medicinal product through a transdermal patch for the treatment of Alzheimer's disease (para. 38). (i) The square shape of the liner serves to package and store the patches, which are packaged in packets, which are in turn stored in rectangular cardboard boxes. The easier detachment is only an additional functionality of the square shape of the patch (paras 37 and 63). (ii) The arrangement of knobs serves to protect the patch before use: the circular configuration of the knobs merely follows the round, functional shape of the patch and cannot represent a major non-functional element (paras 37 and 89). In any event, the same technical function can be obtained with a different arrangement of the knobs: the condition of necessity does not mean that the shape at issue must be the only one capable of obtaining the technical result (para. 87). (iii) The white stripe represents the overlapping protective plastic layer, which facilitates the application of the patch (para. 37). The functionality of the plastic layer was correctly identified through examination of the function of the product, as well as by the fact that transdermal patches used in the medical field frequently have an overlapping plastic layer on the back with the same function (para. 69). (iv) The circular shape of the patch ensures that it affixes to skin: application recommendations indicate that detachment should be avoided, and the fact that there are numerous examples of rectangular patches available on the market that have rounded

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edges also suggests that a circular shape is less likely to detach (paras 37 and 78). (v) The beige colour of the circular area of the patch cannot be regarded as an essential characteristic: it is commonly used for transdermal patches and this colour on a product that affixes to the skin is not remarkable. The presence of one or more minor arbitrary elements in a sign does not alter the conclusion that the sign consists exclusively of the shape of goods that is necessary to obtain a technical result (paras 100, 102 and 104). Given that all the essential characteristics of the sign serve a technical result, there is no need for an overall assessment of the sign (para. 52). Even if a sign consisting exclusively of the shape of the product necessary to obtain a technical result has become distinctive through use, it cannot be registered as a mark (para. 57).

**T-775/16; CRABS (fig.) / DEVICE OF A CRAWFISH (fig.); Dochirnie pidpriemstvo Kondyterska korporatsiia 'Roshen' v EUIPO; Judgment of 7 February 2018; EU:T:2018:74; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the figurative mark represented below as an international registration designating the EU for goods in Class 30. An opposition based on the earlier figurative mark represented below, registered for goods and services in Class 30 (sweetmeats [candy]), was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition, as it found that the visual and phonetic differences between the signs were sufficient to offset the similarities, irrespective of the identity of the goods and the conceptual similarity of the pictures of crayfish, and that there was therefore no likelihood of confusion. Upon the opponent's appeal, the Board of Appeal (BoA) annulled the OD's decision and refused the contested international registration protection in the EU. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is the public at large, with a low to average degree of attention (average in the case of luxury confectionery). The relevant territories are Benelux, Bulgaria, Germany, Greece, Spain, France, Croatia, Italy, Cyprus, Latvia, Lithuania, Poland, Portugal, Romania, Slovakia and the United Kingdom (para. 19). COMPARISON OF THE GOODS: the goods covered are identical (confectionery and sweetmeats [candy]) (para. 21). COMPARISON OF

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### EUTM application



### Earlier trade mark



THE SIGNS: (i) The signs are visually similar to an average degree; the graphic representations of crayfish are the distinctive and dominant elements that have the most significant impact on the consumer's overall impression in both signs, due to their size and position. The representations of crayfish, situated in the centre of the contested sign, are significantly larger than the word element 'crabs' (para. 39). (ii) The signs are phonetically different for Bulgarian-speaking consumers and consumers with some knowledge of Russian, but are not phonetically comparable for consumers who are unable to pronounce the word elements of

the earlier sign written in Cyrillic letters, since they are incomprehensible and illegible for that part of the relevant public (para. 53). (iii) The signs are conceptually similar, since they both contain the dominant and distinctive representations of crayfish but their word elements are meaningless for the parts of the relevant public who do not understand Russian or Bulgarian in order to be able to grasp the meaning of the word element 'раковье шейки', or who do not understand English or French, so as to be able to understand the word element 'crabs' (para. 55). **DISTINCTIVENESS OF THE EARLIER MARK:** the evidence submitted to demonstrate the low distinctive character of the earlier mark in relation to Belarus, Russia and Ukraine did not relate to the relevant territories (para. 63). **LOC:** Given the identity of the goods, the low to average degree of attention of the consumer, in addition to the considerable importance of the graphic representations of crayfish in the overall visual impression of both signs, and of the coinciding arrangement of the crayfish in a vertical line in the centre of the signs, there is a likelihood of confusion, since the similarities outweigh the differences to a sufficient degree (para. 70).

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**T-795/16; CRABS (fig.) / RAKOVYE SHEIKI KARAMEL (fig.); Moscow Confectionery Factory 'Krasnyiy oktyabr' OAO v EUIPO; Judgment of 7 February 2018; EU:T:2018:73; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the figurative mark represented below in the EU as an international registration for goods in Class 30. An opposition based on the earlier figurative mark represented below, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition insofar as it found no likelihood of confusion, since irrespective of the identity of the goods and the conceptual similarity of the pictures of crayfish, the visual and phonetic differences between the signs, in particular as regards their word elements, were sufficient to offset the similarities. The opponent appealed against the OD's decision and the Board of Appeal (BoA) dismissed the opponent's appeal, because it found that the differences between the signs outweigh the similarities and, regardless of the identity of the goods and the low to average degree of attention of the public, there was no likelihood of

confusion. The opponent 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



**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is the public at large with a low to average degree of attention. The relevant territories are Benelux, Bulgaria, Germany, Greece, Spain, France, Croatia, Italy, Cyprus, Latvia, Lithuania, Poland, Portugal, Romania, Slovakia and the United Kingdom (para. 21). COMPARISON OF THE GOODS: the goods covered are identical (candy) (para. 23). COMPARISON OF

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THE SIGNS: the word 'crabs' is the most distinctive and dominant element of the contested mark, whereas in the earlier mark, it is the representations of crayfish that are dominant. On the contrary, the latter are perceived as serving purely decorative purposes in the contested mark (para. 37). (i) The signs are visually similar only to a low degree, since they have representations of crayfish in common (although there are differences between them), but they are different in their structure, word elements and other figurative elements (paras 52 and 55). (ii) Aurally, the signs are either different for the public able to read the Cyrillic alphabet, or incomparable insofar as the remainder of the public was unable to pronounce the word element in Cyrillic (para. 58). (iii) The signs are conceptually similar, as they both contain representations of crayfish and their word elements are meaningless for the parts of the relevant public who do not understand Russian or Bulgarian in order to be able to understand the meaning of the word element 'раковъле шейки', or who do not understand English or French in order to be able to understand the word element 'crabs' (para. 59). Therefore, the signs are similar only to a low degree. **DISTINCTIVENESS OF THE EARLIER MARK:** a mark does not have a higher degree of distinctiveness just because it has no conceptual link to the relevant goods. The evidence submitted regarding Belarus, Russia and Ukraine did not relate to the relevant territories (paras 68 and 70). **NO LOC:** The differences between the signs, especially the clearly recognisable visual differences in their



structures and their overall impressions, outweigh their similarities and therefore there is no likelihood of confusion, even for the identical goods (para. 83).

**T-879/16; VIETA (fig.); Sony Interactive Entertainment Europe Ltd v EUIPO; Judgment of 8 February 2018; EU:T:2018:77; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Scope of proceedings, Res judicata, Figurative trade mark

**FACTS:** The figurative trade mark represented below was registered as an EUTM for goods in Class 9. The trade mark was then transferred to Marpefa SL (EUTM proprietor). An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The Cancellation Division (CD) dismissed the application for revocation for the following goods: loudspeakers, loudspeaker systems, sound amplifiers and computers, video screens, apparatus for the reproduction of sound and images, television sets, and record players. The applicant appealed and the Board of Appeal (BoA) dismissed the appeal, insofar as it found that genuine use had been proven for the above goods. The applicant filed an action before the General Court (GC), which was upheld in part, since the GC found that the term apparatus for the reproduction of sound and

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images was not defined sufficiently 'precisely and narrowly'. The GC annulled the BoA decision insofar as it found that genuine use of the contested mark had been proven for apparatus for the reproduction of sound and images. The case was referred back to the BoA, which dismissed the appeal, stating that following the partial annulment of the first decision by the first judgment of the GC, it had to examine whether the contested trade mark had been put to genuine use for apparatus for the reproduction of sound and images during the relevant period. It stated that the term apparatus for the reproduction of sound and images was 'a specific term, and a synonym of "television sets", sufficiently clear and precise', and that it was not part of the heading of Class 9. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 72(6) EUTMR and (ii) breach of the principle that the applicant must identify the goods or services for which protection of the EU trade mark is sought with sufficient clarity and precision.

### EUTM



**SUBSTANCE:** Res judicata extends only to the matters of fact and law actually or necessarily settled by the judicial decision in question. The force of res

judicata attaches not only to the operative part of that decision, but also to the ratio decidendi of that decision, which is inseparable from it (para. 31). The BoA clearly disregarded the first judgment of the GC by stating, in total contradiction with the findings of the GC, which had acquired the force of res judicata, that the term apparatus for the reproduction of sound and images had a clear and specific content and covered only a single type of product, namely television sets. The BoA inferred from the above that proof of genuine use had been adduced in respect of apparatus for the reproduction of sound and images. Therefore, it is also in total contradiction with point 1 of the operative part of the first judgment (which had also acquired the force of res judicata), that the BoA rejected the appeal and reaffirmed that the first BoA decision was well founded (para. 41). Therefore, the BoA did not take the necessary measures to comply with the judgment of the GC.

**T-793/16; Boxes [packaging]; Şölen Çikolata Gıda Sanayi ve Ticaret AŞ v EUIPO; Judgment of 7 February 2018; EU:T:2018:72; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Conflict of design with prior trade mark, Similarity of the goods and services

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**FACTS:** The intervener registered the Community design represented below for Class 09-03 (boxes [packaging]). The applicant filed an application for invalidity of the figurative mark represented below on the grounds set out in (i) Article 25(1)(e) CDR, invoking international trade mark No 1 148 957 designating, among other Member States, Bulgaria, registered for goods in Class 30 (cocoa, cakes, chocolates, chocolate creams, cakes with cocoa milk, chocolate cream), and the grounds set out in (ii) Article 25(1)(f) CDR, claiming copyright protection under Bulgarian law. The Invalidity Division (ID) rejected the application for a declaration of invalidity because it found that (i) there was no likelihood of confusion on the part of the relevant public and (ii) that the existence and extent of the protection of the work claimed had not been proven under the relevant legislation, namely United Kingdom law. The applicant filed an appeal against the ID's decision. The Board of Appeal (BoA) dismissed the appeal. First, it assessed whether there was a likelihood of confusion on the part of the relevant public. The BoA found that the goods covered by the earlier mark were intended for the general public in Bulgaria, whereas the product portrayed by the contested design was directed at professional consumers in the confectionery industry. With regard to the goods, it was found that they were similar. As regards the comparison of the signs at issue, it found that the earlier mark and the contested design were visually and phonetically dissimilar, as the common element 'cornet' was descriptive and



not distinctive, and consumers would not pay any attention to it. It considered that they were similar only from the conceptual perspective, insofar as they both refer to a cornet. Finally, the BoA added that it had not been established that the earlier mark had acquired enhanced distinctive character in Bulgaria. Therefore, it was concluded that there was no likelihood of confusion (LOC) on the part of the relevant public and rejected the application for invalidity based on Article 25(1)(e) CDR. Regarding Article 25(1)(f) CDR, the BoA found that the applicant had not established that the work invoked was protected by copyright and rejected that claim. In its application before the GC, the applicant raised three pleas in law: (i) infringement of Article 25(1)(e) CDR; (ii) infringement of Article 25(1)(f) CDR; (iii) infringement of Article 62 and Article 63(1) CDR.

**SUBSTANCE:** RELEVANT PUBLIC: the goods in question target the Bulgarian general public who, given the nature of the goods, will have a reduced degree of attention (paras 29-35). COMPARISON OF GOODS: the goods are complementary and, therefore, similar, as the box portrayed by the contested design was intended for stocking and displaying edible cones and that the earlier mark had been registered in respect of various items of confectionery, inter alia, chocolate creams (para. 39). COMPARISON OF SIGNS: (i) distinctive and dominant elements: the element composed of the words 'bobo' and 'cornet' on the contested design will capture the relevant public's attention more

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### RCD application



### Earlier RCDs



than the rabbit that is also portrayed on the design, which, contrary to the intervener's assertion, plays a minor role in the overall impression conveyed by the design (para. 51). Only Bulgarian consumers with knowledge of English or any other language in which the word 'cornet' exists and has the same meaning will understand that that word designates the goods wrapped in packaging in the form of a cone. However, it has not been established that that word forms part of basic English vocabulary or in any other language that will be understood by a large part of the relevant public in Bulgaria

(para. 54). Therefore, contrary to the findings of the BoA, the word 'cornet' is not totally devoid of distinctive character (para. 56). In the signs at issue, the words 'bobo', 'ozmo' and 'cornet' are written in very visible bold letters and are of the same width (para. 58). Even though the word 'cornet' does not, in itself, dominate the overall impression conveyed by the signs at issue and is not especially distinctive, it cannot, on account, in particular, of its position in the signs at issue and its size, be regarded as playing a negligible role in the overall impression conveyed by the signs. Accordingly, due account must be taken of it when comparing the signs (para. 60). (ii) Visual comparison: the contested design and the earlier mark are both made up of two words, 'bobo' and 'cornet', and 'ozmo' and 'cornet', respectively. The word 'cornet' is therefore common to both. Moreover, the words 'bobo' and 'ozmo' are of the same length and each contains the letter 'o', which appears twice, once at the end of each word. Therefore, they have considerable similarities (paras 63-64). The contested design and the earlier mark are also different in certain respects (paras 65-68). Nevertheless, the elements that differentiate the signs at issue visually do not outweigh the considerable similarities between those signs that will be perceived by consumers. Therefore, the BoA erred in taking the view that those signs are visually different (para. 69). (iii) Phonetic comparison: the signs at issue have an average degree of phonetic similarity due to the word 'cornet' and because the contested design and the earlier mark have the

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same number of words with the same number of syllables and the same number of letters, with the letter 'o' appearing in both words: 'bobo' and 'ozmo' (paras 73-74). (iv) Conceptual comparison: the part of the relevant public that does not understand the meaning of the common word 'cornet' cannot attribute any particular meaning to the signs at issue. Accordingly, it is not possible to make a conceptual comparison of the signs in respect of this part of the public (para. 77). The representations of a rabbit, other animals and food products in the form of cones, which are present on the contested design but not on the earlier mark, cannot introduce a conceptual difference between the signs because they will play only a minor role in the overall impression of the contested design (para. 78). In conclusion, contrary to the position reached by the BoA, the signs at issue are highly similar visually, they have an average degree of phonetic similarity and are conceptually similar for the members of the relevant public who understand the meaning of the word 'cornet', but they are not for the rest of the public who does not attribute any meaning to that word (para. 79). LOC: there is a likelihood of confusion on the part of the relevant public (para. 82). There is no need to examine the second plea as the first has been upheld (para. 84).

**T-794/16; Ice cream cornets [edible] (Packagings for -); Şölen Çikolata Gıda Sanayi ve Ticaret AŞ v EUIPO; Judgment of 7 February 2018; EU:T:2018:70; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Conflict of design with prior trade mark, Similarity of the goods and services

**FACTS:** The intervener registered the Community design represented below for Class 09-05 (ice cream cornets [edible] (packagings for)). The applicant filed an application for invalidity on the grounds set out in (i) Article 25(1)(e) CDR, invoking international trade mark No 1 148 957 designating, among other Member States, Bulgaria, registered for goods in Class 30 (cocoa, cakes, chocolates, chocolate creams, cakes with cocoa milk, chocolate cream) for the figurative mark represented below as earlier right No 1, and as set out in (ii) Article 25(1)(f) CDR, claiming copyright protection under Bulgarian law in respect of earlier right No 2 as represented below. The Invalidity Division (ID) rejected the application for a declaration of invalidity because it found that (i) there was no likelihood of confusion on the part of the relevant public and (ii) that the existence and extent of the protection of the work claimed had not been proven under the relevant legislation, namely United Kingdom law. The applicant filed an appeal against the ID's decision. The Board of Appeal (BoA) dismissed the appeal. First, it assessed whether

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there was a likelihood of confusion on the part of the relevant public. The BoA found that the goods covered by the earlier mark were intended for the general public in Bulgaria, whereas the product portrayed by the contested design was directed at professional consumers in the confectionery industry. With regard to the goods, it was found that they were similar. As regards the comparison of the signs at issue, it found that the earlier mark and the contested design were visually and phonetically dissimilar, as the common element 'cornet' was descriptive and not distinctive and consumers would not pay any attention to it. It considered that they were similar only from the conceptual perspective, insofar as they both refer to a cornet. Finally, BoA added that it had not been established that the earlier mark had acquired enhanced distinctive character in Bulgaria. Therefore, it was concluded that there was no likelihood of confusion (LOC) on the part of the relevant public and rejected the application for invalidity based on Article 25(1) (e) CDR. Regarding Article 25(1)(f) CDR, the BoA found that the applicant had not established that the work invoked was protected by copyright and rejected the claim. In its application before the GC the applicant raised three pleas in law: (i) infringement of Article 25(1)(e) CDR; (ii) infringement of Article 25(1)(f) CDR; (iii) infringement of Article 62 and Article 63(1) CDR.



### RCD



### Earlier RCDs



**SUBSTANCE:** RELEVANT PUBLIC: the goods in question target the Bulgarian general public who, given the nature of these goods, will have a reduced degree of attention (paras 29-35). **COMPARISON OF GOODS:** the goods are complementary and, therefore, similar, as the packaging in the form of a cone portrayed by the contested design was intended as packaging for edible cones filled with ice cream and that the earlier mark had been registered for various items of confectionery, inter alia, chocolate creams (para. 39). **COMPARISON OF SIGNS:** (i) distinctive and dominant elements: the

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element composed of the words 'bobo' and 'cornet' on the contested design will capture the relevant public's attention more than the rabbit portrayed on the design, which, contrary to the intervener's assertion, plays a minor role in the overall impression conveyed by the design (para. 50). Only Bulgarian consumers with knowledge of English, or any other language in which the word 'cornet' exists and has the same meaning, will understand that that word designates the goods wrapped in packaging in the form of a cone portrayed by the contested design and the goods covered by the earlier mark. However, it has not been established that that word forms part of basic English vocabulary or of any other language that will be understood by a large part of the relevant public in Bulgaria (para. 53). Therefore, contrary to the findings of the BoA, the word 'cornet' is not totally devoid of distinctive character (para. 55). In the signs at issue, the words 'bobo', 'ozmo' and 'cornet' are written in very visible bold letters and are of the same width (para. 57). Even though the word 'cornet' does not in itself dominate the overall impression conveyed by the signs at issue and is not especially distinctive, it cannot, particularly on account of its position in the signs at issue and its size, be regarded as playing a negligible role in the overall impression conveyed by the signs at issue. Accordingly, due account must be taken of it when comparing the signs (para. 59). (ii) Visual comparison: the contested design and the earlier mark are both made up of two words: 'bobo' and 'cornet' and 'ozmo' and 'cornet',

respectively. The word 'cornet' is therefore common to both. Moreover, the words 'bobo' and 'ozmo' are of the same length and each contains the letter 'o', which appears twice, once at the end of each word. Therefore, they have considerable similarities (paras 62-63). The contested design and the earlier mark are also different in certain respects (paras 64-67). Nevertheless, the elements that differentiate the signs at issue visually do not outweigh the considerable similarities between those signs that will be perceived by consumers. Therefore, the BoA erred in taking the view that the signs are visually different (para. 68) (iii) Phonetic comparison: the signs at issue have an average degree of phonetic similarity due to the word 'cornet'; the contested design and the earlier mark have the same number of words with the same number of syllables and the same number of letters, with the appearance of the letter 'o' in both words 'bobo' and 'ozmo' (paras 72-73). (iv) Conceptual comparison: the part of the relevant public that does not understand the meaning of the common word 'cornet' cannot attribute any particular meaning to the signs at issue. Accordingly, it is not possible to make a conceptual comparison of the signs in respect of this part of the public (para. 76). The representations of a rabbit, other animals and food products in the form of cones, which are present on the contested design but not on the earlier mark cannot introduce a conceptual difference between the signs, because they will play only a minor role in the overall impression of the contested design (para. 77). In

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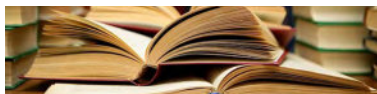
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conclusion, contrary to the position reached by the BoA, the signs at issue are highly similar visually, have an average degree of phonetic similarity and are conceptually similar for the members of the relevant public who understand the meaning of the word 'cornet' (para. 78). LOC: there is a likelihood of confusion on the part of the relevant public (para. 81). There is no need to examine the second plea as the first has been upheld (para. 83).

**T-35/17; iGrill; Weber-Stephen Products LLC v EUIPO; Judgment of 31 January 2018; EU:T:2018:46; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Nature of the goods and services, Principle of legality, Purpose of the goods and services

**FACTS:** The applicant designated the European Union for an international registration covering the word mark iGrill for goods in Class 9. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, and the applicant appealed. The Board of Appeal (BoA) dismissed the appeal insofar as it found that the contested mark was descriptive: it stated that iGrill was a neologism composed of the element 'i' and the element 'Grill'. The letter 'i', as a prefix, referred to the word 'interactive', as well as to

information technology, and the word 'grill' referred to a cooking device. Therefore, the relevant public will understand the term 'iGrill' as referring to an interactive grill or a grill that employs information technology. The applicant lodged an application for registration of the change of the proprietor of the international registration with the WIPO. The new proprietor of the international registration was Weber-Stephen Products LLC. The latter filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

**SUBSTANCE:** RELEVANT PUBLIC: the relevant public is the English-speaking general and specialised public of the EU (para. 19). MEANING OF THE MARK: the word 'grill' is a common word in English that denotes a cooking device, whereas the letter 'i' can mean 'intelligent' or refer to information technology (para. 22). The contested mark will be seen as the mere juxtaposition of the two elements 'i' and 'grill' and not as a neologism consisting of a single word that has no obvious meaning (para. 23). DIRECT LINK AND DESCRIPTIVENESS: 'iGrill' may mean a grill having the characteristic of being intelligent and of making use of information technology. In addition, the goods have the characteristic of making grills intelligent by enabling them to make use of information technology in order to assist their users (para. 33). Therefore, as its meaning serves to designate the above characteristic, it is descriptive (para. 34). EUIPO'S DECISION-MAKING PRACTICE:

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the descriptiveness of the contested mark is not counteracted by the fact that the Office interpreted the letter 'i' differently in previous decisions and allowed the registration of marks with the letter 'i' as a prefix, even though the goods and services covered by those marks are part of the information technology sector (para. 38). **DISTINCTIVENESS:** there is no need to examine distinctiveness, as there is already one ground that justifies refusal (para. 43).

**T-102/17; SANTORO / SANGRE DE TORO et al.; Cantina e oleificio sociale di San Marzano v EUIPO; Judgment of 1 February 2018; EU:T:2018:50; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the figurative sign represented below for Italian wines in Class 33. The opponent filed an opposition pursuant to Article 8(1)(b) and (5) EUTMR against all the goods in Class 33, based on, inter alia, the EU word mark SANGRE DE TORO, registered for alcoholic beverages (except beers). The Opposition Division (OD) rejected the opposition on the ground that there was no likelihood of confusion (LOC) between

the marks at issue and no link proven for Article 8(5) EUTMR. The Board of Appeal (BoA) upheld the appeal brought by the opponent and annulled the OD's decision, holding essentially that, in the light of the identical nature of the goods and the similarity of the signs, there was a LOC on the part of the relevant public. In its application for annulment, the applicant raised three pleas in law: (i) infringement of Article 8(1)(b) EUTMR on the ground that the BoA did not correctly assess the similarity of the goods; (ii) infringement of Article 8(1)(b) EUTMR on the ground that the BoA did not correctly assess the similarity of the signs; (iii) infringement of Article 8(5) EUTMR and distortion of the evidence in relation to the assessment of the reputation of the earlier mark.

### EUTM application



### Earlier trade mark

SANGRE DE TORO

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**SUBSTANCE:** REGARDING THE COMPARISON OF GOODS: as the earlier mark was not subject to the requirement of proof of use, the scope of protection conferred by that mark could not be restricted solely to Spanish wines, as wrongly claimed by the applicant. The goods protected by that mark are therefore alcoholic beverages, except beers (para. 34). That specification is sufficiently clear and precise for the purposes of judgment C-307/10 'IP Translator' (para. 39). As the alcoholic beverages, except beers covered by the earlier mark include the Italian wines covered by the mark applied for, the goods are identical (para. 37). REGARDING THE COMPARISON OF SIGNS: visually, the signs are similar to a certain degree. Notwithstanding the differences in the figurative elements and the absence of the letters 'gre' and 'de' in the contested sign, the signs coincide in the letters 'san' and 'toro' (para. 48). Phonetically, the signs are similar. The difference resulting from the two additional syllables in the earlier mark does not outweigh the phonetic similarity due to the elements in common, 'san' and 'toro' (para. 50). Conceptually, the comparison is essentially neutral from the perspective of the part of the European Union public that does not perceive any concepts in the signs at issue or that perceives only a reference to a tree or grapevine (para. 56). A substantial portion of the consumers in the European Union will not perceive the term 'SANTORO' as relating to the idea of sainthood just because of the Latin origin of the terms 'san' or 'sanct', and will not ascribe any meaning to the

word 'sangre', not even on account of its alleged proximity to the word 'sangría' (paras 53 and 55). There is a LOC between the marks at issue because of the identity of the goods, the average degree of attention of the relevant public, the phonetic and, to a lesser extent, visual similarity of the signs, the normal inherent distinctiveness of the earlier mark and because the goods at issue are generally consumed after being ordered orally (para. 57). REGARDING ARTICLE 8(5) EUTMR: as the opposition could be fully upheld under Article 8(1)(b) EUTMR, it was not necessary for the BoA to assess whether the earlier trade mark had a reputation. Therefore, the applicant's arguments that the reputation of the earlier mark was not demonstrated are ineffective (paras 62-63).

**T-69/17; Fack Ju Göthe; Constantin Film Produktion GmbH v EUIPO; Judgment of 24 January 2018; EU:T:2018:27; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Contrary to public policy or principles of morality

**FACTS:** The applicant sought to register the word mark Fack Ju Göhte as an EUTM for goods and services in Classes 3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38 and 41. The Office refused the registration

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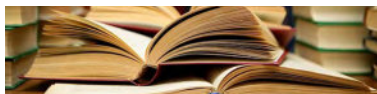
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of the EUTM application pursuant to Article 7(1)(f) EUTMR, as it was found to be contrary to accepted principles of morality. The applicant appealed and the Board of Appeal (BoA) dismissed the appeal, as it found that the pronunciation of the component 'Fack ju' was identical to that of the expression 'Fuck you', and therefore meant the same thing. It also concluded that even if the relevant public that was the subject of these proceedings were not to attribute any sexual connotation to the expression 'Fuck you', it was still an insult, and not only tasteless but also offensive and vulgar. Moreover, the fact that the respected German writer Goethe, as well as having his name misspelt, was being posthumously disparaged in such a derogatory and vulgar way might even add an additional layer to the breach of the accepted principles of morality. The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1) (f) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

**SUBSTANCE:** RELEVANT PUBLIC: German-speaking consumers within the European Union, namely consumers in Germany and Austria (para. 17). The goods and services covered primarily target general consumers, while some primarily target children and young people. However, signs caught by this ground of refusal may cause offence not only to the relevant public but also to other people who encounter the sign by chance in everyday life without being interested in the goods and services specified (para. 15). Likewise, it is not possible to refer to the perception of the part of the relevant public that is easily offended or the perception of

the part of that public that is impervious; rather the criteria of a reasonable person with an average sensitivity and tolerance threshold must be taken as a basis (para. 34). PERCEPTION OF THE SIGN: the trade mark application Fack Ju Göhte is the phonetic reproduction in German of the expression 'Fuck you Göhte/Goethe', the first part of which is easily understood by the general public and the second part of which corresponds to the renowned German writer (para. 17). Even if the first element were deemed not to have any sexual connotation, it still expresses anger, disappointment and contempt. Besides, directing the insult towards a specific person, Goethe in particular, increases rather than mitigates the vulgarity and obscenity of the sign (para. 18). Furthermore, it cannot be inferred from the broad public success of a film of the same name that the relevant public will immediately recognise the film title in the trade mark application and not be offended (para. 40). The contested mark as a whole is intrinsically vulgar and could offend the relevant public (para. 20). SCOPE OF PROCEEDINGS: as the Office's Guidelines also confirm, 'public policy' and 'accepted principles of morality' are two different concepts that often overlap. There is no need to assess separately whether the contested mark is contrary to public order, since it suffices that it was found to be contrary to the principles of morality (paras 23-24). Nor is there any need to assess the ground invoked under Article 7(1)(b) EUTMR and the distinctiveness of the mark, as the conditions for at least one absolute ground for refusal have been met (para. 46).

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### New Decisions from the Boards of Appeal

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#### A. Cases referred to the Grand Board

**15/12/2017, R 1801/2017-4, easyBank (fig.)**

#### EUTM application



On 15 December 2017, the Fourth Board of Appeal decided to refer case R 1801/2017-4 easyBank (fig.) to the Grand Board.

This case concerns the assessment of the eligibility for registration of the figurative trade mark applied for, which includes the word “easy”, pursuant to Article 7(1)(b) and (c) EUTMR.



There are numerous decisions of the Office concerning trademarks with the word element “easy”. The applicant argued in that direction, but did not mention the judgment of the General Court in case T-87/00 of 2001.

Therefore, in the light of the importance of the legal issues concerned, the Grand Board will take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the Fourth Board in the EUIPO OJ on 1 April 2018.

**08/11/2017, R 958/2017 5, BREXit (fig.)**

#### EUTM application



On 8 November 2017, the Fifth Board of Appeal decided to refer case R 958/2017-5 BREXIT (fig.) to the Grand Board.

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This case concerns the assessment of the eligibility for registration of the figurative trade mark applied for, which includes the word “BREXIT”, pursuant to Article 7(1)(b) and (f) EUTMR. On 28 June 2017, the Second Board of Appeal issued a decision on the registration of word mark ‘BREXIT’, on behalf of the same applicant, and considered that there were no grounds to refuse the registration of that trade mark under Article 7(1)(b) and (c) EUTMR.

Therefore, in the light of the importance of the legal issues concerned and taking into account that diverging decisions were taken by the Office and by the Boards of Appeal (but also by competent authorities at national offices), the Grand Board will take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the Fifth Board in the EUIPO OJ on 1 April 2018.



**06/12/2017, BoA Presidium decision (referral of case R 1814/2014-1, DEVICE OF A REPEATED GEOMETRIC DESIGN (fig.), to the Grand Board**

### EUTM application



On 6 December 2017, the Presidium of the Boards of Appeal decided to refer case R 1814/2014-1, DEVICE OF A REPEATED GEOMETRIC DESIGN (fig.), to the Grand Board, after annulment of the BoA decision taken in 2015 by judgment of 21 June 2017 in T-20/16.

This case concerns the assessment of the eligibility for registration of the figurative trade mark applied for and, within that framework, involves, inter alia, the issue whether the Boards have to take into consideration evidence showing the actual use of the sign in relation to the goods applied for.

Therefore, in the light of the importance of the legal issues concerned, the Grand Board will take a decision in order to establish a harmonised approach in similar cases.

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Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the Decision of the Presidium in the EUIPO OJ on 1 March 2018.

### B. New Decisions from the Boards of Appeal

**24/01/2018, R 853/2017-1, DARSTELLUNG VON 15 RECHTECKEN (fig.)**

#### EUTM application



**Result:** Decision confirmed

**Keywords:** Figurative trade mark, Non-distinctive

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

**Facts:** The examiner rejected the international registration designating the EU, as represented above, for goods and services in Classes 1, 5, 9, 10 and 42 in accordance with Article 7(1)(b) and Article 7(2) EUTMR.

**Substance:** The IR designating EU is rejected.

The sign is too simple and banal. It is composed of tiny rectangles: a rectangle is a simple basic geometric shape. The tiny rectangles are aligned horizontally to form a line: a horizontal line is a simple sign. The rectangles are separated by perfectly regular white intervals: regular white intervals do not produce a distinctive impact visually. The fact that a simple and banal sign is repeated 15 times, in the same size, with the same intervals, on the same (imaginary) horizontal line, with indistinguishable differences in colour shades is unlikely to be perceived as an indication of the industrial origin of the goods by reasonably observant consumers, including extremely discerning ones such as scientists who test biological samples with a microscope (§ 20-23).

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

**Result:** Decision confirmed

**Keywords:** Descriptive element, Used in the course of trade, Deceptive element

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

**Facts:** The examiner rejected the international registration designating the EU, as represented above, for goods in Class 31 on the bases of

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Article 7(1)(b), (c) and (m) EUTMR. As a result of a limitation requested by the applicant the examiner withdrew her objection on the basis of Article 7(1) (m), and upheld the rejection on the other legal grounds.

**Substance:** The IR designating EU is rejected. 'VANILLA PERSIMON' will be immediately perceived by the English-speaking public at large as information that makes reference to a persimmon having a vanilla flavour or smell (§ 26). The omission of a letter 'm' in 'PERSIMON', does not modify the descriptive character of the sign (§ 27). Furthermore, the evidence on file proves that 'VANILLA PERSIMON' is descriptive for a plant variety commonly used in the relevant sector but not registered according to EU law (§ 31). Therefore, the EUTM applied for is rejected pursuant Article 7(1)(c), (b) and (d) EUTMR. The specification of the goods indicates that they are persimmons from the plant variety 'Rojo Brillante'. However, the trade mark applied for provides different information, in particular that the goods are persimmons of the variety 'VANILLA'. Therefore, the sign must be rejected for being deceptive under Article 7(1)(g) EUTMR (§ 63).

25/01/2018, R 674/2017-1, YORKSHIRE PROVENDER

**Result:** Decision confirmed

**Keywords:** Geographical origin, Descriptive

**Norms:** Article 7(1)(c) EUTMR, Article 7(1)(j) EUTMR, Article 7(2) EUTMR, Article 7(3) EUTMR

**Facts:** The examiner rejected the word mark applied for 'YORKSHIRE PROVENDER', for all the goods in Classes 29 and 30 pursuant to Article 7(1)(b), (c) and Article 7(2) EUTMR and partially for some goods in Class 29, pursuant to Article 7(1)(j) EUTMR.

**Substance:** The application is rejected. A significant part of the public has extensive knowledge of food and of the vocabulary in the field thereof. Accordingly, they will know that 'provender' means 'food in general'. 'YORKSHIRE PROVENDER' would be understood as a reference to food from the region of Yorkshire (a geographical location in the north of England) (§ 22, 27).

'Yorkshire Wensleysale' is a protected geographical indication (PGI) for 'cheeses' and 'Yorkshire Forced Rhubarb' is a protected designation (PDI) (§ 36).

The Board recalls the case-law of the Court in relation to the concept of the evocation of a geographical indication, in particular 04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 25; 26/02/2008,

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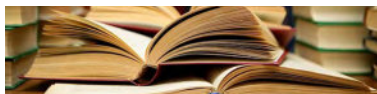
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C-132/05, Commission v Germany, EU:C:2008:117, § 44; 02/02/2017, T-510/15, TOSCORO, EU:T:2017:54, § 31, 44; 11/05/2010, T-237/08, Cuvée Palomar, EU:T:2010:185, § 125, 131. In the present case, 'Yorkshire' is the essential region from which the goods that are identical and comparable to the PGI and PDI originate (§ 46). The presence of the word 'YORKSHIRE' is sufficient to evoke, in the minds of a significant proportion of the English-speaking public, the PGI 'YORKSHIRE WENSLEYDALE' and the PDI 'YORKSHIRE FORCED RHUBARB' not only for identical but also for comparable products. The different word elements do not add to the distinctive character of the geographical indication 'YORKSHIRE'. Evocation is all the more likely since 'YORKSHIRE' is reproduced identically at the beginning of the mark applied for and since the other word element lacks distinctiveness (§ 49).

**05/02/2018, R 1108/2017-2, MATUSALEM EL ESPIRITU DE CUBA / CUBA**

**Result:** Decision confirmed

**Keywords:** Burden of proof, Sign used in the course of trade, Substantiation of earlier right, Geographical origin

**Norms:** Article 8(4) EUTMR

**Facts:** An opposition was filed against the registration of the published trade mark application

'MATUSALEM EL ESPIRITU DE CUBA' for goods in Classes 32 and 33. The grounds of opposition were those laid down in Article 8(4) EUTMR. The opposition was based on the Geographical Indication for the word mark 'CUBA' granted by resolution of the Cuban Office of Intellectual Property on 2 April 2010. The opponent claimed that the sign was protected in Germany and Spain for 'rum' on the basis of the bilateral agreements signed between the countries on 23 January 1979 and 22 March 1954, respectively. The Opposition Division rejected the opposition in its entirety.

**Substance:** The appeal is dismissed.

The opposition is based on Article 8(4) EUTMR and on the use made of the geographical indication 'CUBA' for 'rum' protected under bilateral agreements signed between the Kingdom of Spain and the Republic of Cuba on 23 January 1979 and between the Federal Republic of Germany and the Republic of Cuba on 22 March 1954 (§ 14).

Despite the numerous documents filed, such as the international agreement between the Kingdom of Spain and Republic of Cuba, Spanish judgments, Spanish administrative decisions, Cuban legislation, etc., the opponent has failed to prove the norm on which the internal Spanish legislation confers the right to prohibit the use of later trade marks and the conditions under which this right can be exercised. As to the right to prohibit use in Germany, the provision pointed out by the opponent (Article 13(a) and (b)) in the agreement between the Federal Republic of Germany and the Republic of Cuba on

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the reinstatement of Industrial Property Rights and Geographical Indications of 22 March 1954 and Section 127 of the German Act on the Protection of Trademarks and Other Signs do not provide for a subjective right granted to a party who, being the owner of a Cuban GI, under specified conditions can prohibit the use of a subsequent trade mark application (§ 45-49).

In light of the above, the documents submitted by the opponent do not confirm the subject who can exercise a right to prohibit use, the scope of the right and the conditions to exercise it on the basis of the GI 'CUBA' according to German law, as is necessary for the protection of the earlier right claimed under Article 8(4) EUTMR (§ 52).

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

**Result:** Decision confirmed

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

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

**Facts:** The Office issued a communication requesting the opponent to substantiate the earlier right. No further evidence was submitted by the opponent, accordingly the Opposition Division rejected the opposition as unfounded pursuant to



Rule 20(1) CTMIR in conjunction with Rule 19(1) and (2)(a)(ii) CTMIR.

**Substance:** The appeal is rejected.

### EUTM application



### Earlier EUTM

**FLORIAN**

The opponent has failed to submit the latest renewal certificate showing that the term of protection of the earlier mark had been extended beyond the Rule 19(1) CTMIR time-limit. Therefore, the Opposition Division correctly decided that the opponent had not proven the existence, validity and scope of protection of the earlier mark and correctly rejected the opposition as unfounded pursuant to Rule 20(1) CTMIR (§ 17).

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The renewal document filed for the first time by the opponent with its statement of grounds on 12 October 2017 cannot overcome the rejection of the opposition. The renewal document filed belatedly is not supplementing evidence (§ 18-20). Moreover the opponent did not contest any of the Opposition Division's findings. No single argument was raised in its statement of grounds as to why the Opposition Division's decision to reject the opposition was incorrect (§ 21).

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