

# Alicante News

Up to date information on IP and EUIPO-related matters

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# TMview

*the international expansion*

May  
2017



The James Nurton Interview

**Luis-Alfonso Durán**



## TMview: the international expansion

With a database that stretches across the globe, and more than 44 million trade marks, TMview is now the world's largest, free, online trade mark search engine.

It contains data from every single one of the EU Member States, and thanks to the international cooperation work carried out by EUIPO in conjunction with its international partners, it has grown in leaps and bounds over the past seven years. Its focus is now a global one.

TMview launched on 12 April 2010 with trade marks from EUIPO, WIPO and six EU IP national and regional offices: the Benelux; the Czech Republic; Denmark; the UK; Italy; and Portugal.

By the end of its first year of operations, as it expanded across the EU, it had close to five million trade marks in its database; trade mark information that was updated daily and available online, 24/7, at no cost whatsoever to users.

But in June 2013, TMview took its first steps outside the EU, with Norway and Mexico joining the tool. Turkey soon followed, along with Morocco, and at the end of 2013, Russia and the U.S.A.

After that, international integrations of data came thick and fast. Korea. Tunisia. Iceland. Serbia. The former Yugoslav Republic of Macedonia. Canada. Switzerland. Japan (marking the fourth TM5 partner to join, along with EUIPO, Korea and the U.S.A.).

TMview's reach spread to South East Asia, encompassing all ASEAN Member States in ASEAN TMview, a standalone search tool with over three million ASEAN trade marks available in regional languages. The Cambodian and Malaysian intellectual property offices first integrated into ASEAN TMview, and then shared their data with the main tool – ASEAN TMview served as a springboard for global reach.

Brazil and India's incorporation meant two fast-growing world economies shared their trade mark data with the tool. When ARIPO, the African Regional Intellectual Property Organisation, joined TMview, it brought with it trade marks from 19 sub-Saharan African member states.

Today, TMview covers nearly every continent in the world, with 57 offices inside the tool, and a host of concrete benefits. It is linked to WIPO's Global Brand Database, speeding up search possibilities for users; a search can be replicated inside WIPO's system without having to be redone.

The expansion of TMview saves money for users too. Since the tool was first launched, it has served

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nearly 30 million trade mark searches from 155 countries and regions. A cost-benefit analysis carried out in 2014, for example, showed the tool passing on a benefit to users of EUR 28 million that year alone.

And TMview's expansion continues, underpinned and supported by a robust, user-focused international cooperation strategy. The integrations of Russia and India, for example, both took place in the context of EU-funded projects implemented by EUIPO, in line with the goals of the Office's Strategic Plan 2020, adopted by the Management Board in June 2016.

Under this umbrella too comes the close cooperation between EUIPO and the Trade Mark Office of the Peoples' Republic of China. The two offices are working together to complete the technical feasibility process enabling Chinese trade mark data to be accessed via TMview.

Every trade mark office in the world – including those with which EUIPO does not currently cooperate – can express an intent to join TMview. If no formal ties exist at the time of application, a prior consultation takes place with the European Commission in line with the requirements of the Strategic Plan 2020 of the Office.

Normally, the process of integration requires that a feasibility study be carried out, assessing what data

can be made available from a legal and technical point of view, as well as the set-up of a timetable and, finally, the implementation of the actual extraction process enabling the “go-live” of the integration itself.

All the international integrations that take place are measured via key performance indicators, which are in turn linked to actions undertaken in the context of the execution of the Office's Strategic Plan. The entire process is part of a seamless cycle of strategic planning, action and measurement, to ensure that users receive the maximum benefit from this key facet of EUIPO's international cooperation.

TMview continues to grow and develop both at a functional level and in terms of its scope. In May 2017, a new image search facility (in beta version) was rolled out within the tool; initially for three offices (EUIPO, the UK Intellectual Property Office and the French Intellectual Property Office – a total of five million trade marks), but with the possibility of extension to other offices' trade mark data in the fullness of time, including that of the TM5 partners.

Synergies between EUIPO's European and international cooperation activities are expected to bring improvements both in terms of an improved TMview interface as well as improved data content quality.

Looking to the near future, the intellectual property



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offices of Colombia and Peru have both expressed an interest in joining TMview, which would further expand the tool's Latin American base to cover over 60% of the region's population.

Cooperation work is underway with the regional intellectual property office that represents Francophone sub-Saharan Africa, the Organisation Africaine de la Propriété Intellectuelle (OAPI), with 17 member countries.

The intellectual property offices of Israel, Moldova and Argentina, as well as those of the European micro-states of San Marino, Monaco and Lichtenstein are have also expressed interest in integrating their trade mark data into the tool.

TMview has made huge strides over the past seven years. It is now a truly global database, and one which is growing every year - not just in terms of content but also in terms of use. The tool now averages nearly 900,000 searches per month, a 20% growth on 2016.

At the heart of EUIPO's oldest flagship tool is a commitment to collaboration and shared working between international trade mark offices; a commitment which puts the needs of users front and centre.



*TMview's new image search facility is quick and user-friendly, across trade mark data from three major IP offices*

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## The James Nurton Interview



### Luis-Alfonso Durán, Durán-Corretjer, Barcelona

#### What is your background?

I belong to a firm of patent and trade mark attorneys that was founded 115 years ago by my great-grandfather; my grandfather and my father also worked for the firm. I didn't always want to work in IP but I studied engineering at the Polytechnical University of Barcelona and then looked at the



Luis-Alfonso Durán

options. I learned a bit more about patents, trade marks and designs and found it really interesting, especially as you could work with many different projects. So then I studied law and became a patent and trade mark attorney.

When I was growing up, I didn't know much about what my father did – except that it was quite unusual and that he worked long hours!

I started working at the firm in about 1975 when I was studying at the same time, and worked full-time from about 1980. The work has changed dramatically since – technology was practically absent apart from a telephone and a photography machine back then. Things have completely changed now and we do nearly everything electronically which means we have a huge IT department.

As an engineer, I am a strong believer in using technology: we should not invest people's time in things that machines can do better.

#### Has the firm always been in Barcelona?

Yes, but we have moved offices five or six times since the firm was founded: our last move was in 2001 which was the firm's centenary. The foundation of the firm actually came with the first IP law in Spain in 1902, which was probably the most important development ever for IP in Spain.

Barcelona has always been an important business centre for industries such as chemicals, textiles, car manufacturing, pharmaceuticals and telecoms. All

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these industries create IP and so domestic clients are a very important part of our business.

We now have 15 attorneys and around 70 people in total. Since my father retired, I have been co-chairing the firm with one of my brothers. I do both patent and trade mark work and I was president of ECTA from 1998 to 2000.

### How has trade mark work changed?

The growth of the Madrid Protocol and the launch of the EUTM changed things a lot. They have diminished the amount of work we receive from overseas, and we are now competing with firms from 27 other countries. There is increasing competition on fees, but we believe we should always focus on quality and not work for very low fees. The growth of the Madrid System makes it more important to have domestic clients, and we can manage their cases throughout the world.

Overall, I think Madrid and the EU trade mark system have brought many improvements and it is good that you can protect your marks around the world with lower costs, but they also have their drawbacks. In particular, there is a tendency to over-protect trade marks in many fields, which has created an artificial growth in registrations and the creation of overlaps and conflicts. All trade mark owners now have to deal with these problems, and it creates great legal uncertainty for applicants and owners. It used to be the case that once you had a registration you had legal certainty, but now that is

not the case.

In summary, filing has become easier but clearing has become much more complicated.

The old systems in the UK and Spain, where you had substantive examination, as well as the systems in the US, Japan and elsewhere have advantages. But when the EUTM was launched it was a political decision to have a simple system with as much automation as possible, and that has consequences. Maybe in the future we will have to adjust the system.

### What do you think of EUIPO?

I have known all the leaders of the office including the first president, Jean-Claude Combaldieu, his successor Wubbo de Boer who sadly died very recently and the current Executive-Director António Campinos, who has worked hard on solving the labour problem and promoting harmonisation of the system. Overall, they have done an excellent job but of course everything can be improved.

My concern is that the Office has become too powerful – we saw this in the recent changes to the EU trade mark system, which I think benefit the Office more than the users. And I think the influence of the Office is too powerful compared to the national offices in Europe.

For example, the new Directive says that national offices will have to implement administrative cancellation systems, but not all offices have the

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resources to do that well. If everyone had access to the same standards as EUIPO, it would be ideal but how do you achieve that in much smaller offices, where there are not many staff and only very few cases each year?

The Spanish office is a very good office but they do not have experience of assessing proof of use, for example, so they will need to be educated on that. And we may see more people filing EUTMs rather than national marks because the fees are favourable – we have already seen that with design rights.

What's the most interesting case you've worked on?

I had one case involving the packaging of bottles of sparkling wine. The criteria on registering such trade marks are very restrictive and the Office has a tendency to require acquired distinctiveness. We filed the application in 1996 on the first day the EUIPO (then OHIM) opened, and it took 15 years to get the registration. We went three times to the Board of Appeal, twice to the General Court and once to the CJEU. In the end we were successful and it was a very significant decision, which was important for the client as a competitor was trying to copy the packaging. I was involved from the beginning to the end, preparing the briefs and arguing.

That case was also important in establishing the principle that the Office could not object to the application without good reasons. In this case, they had argued that consumers would look at the label

and other information rather than at the shape of bottle. But the Court said that the Regulation talks about signs that relate to the packaging of goods so you have to be able to protect those signs.

Another area I am particularly interested in, given my technical background, is distinctiveness of trade marks in complicated new technology products. If you don't have a technical background, it can be difficult to know what it means and you end up over-protecting, and having protection over different goods which are not really similar. Private IP firms have people with a technical background but EUIPO does not have this kind of support so they will need to have support and adapt to give fair decisions.

How do you feel about INTA holding the 2017 Annual Meeting in Barcelona?

We are very happy to welcome trade mark practitioners from all over the world to Barcelona! Not many people know that EUIPO would have been based here in Barcelona but it was moved to Alicante for political reasons. The mayor of Barcelona hoped to host the pharmaceutical agency instead, but that went to London – though with Brexit maybe we will get it after all?

I think Barcelona is a great place to host the INTA Annual Meeting, as we have nice weather, lots of lovely restaurants and bars, spectacular places

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to visit such as the Sagrada Familia and lots of shopping. The only difficulty is finding time to do the work while it is on!

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

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## European Union Trade Mark



### Temporal scope of the application of the new grounds for refusal of EUTMR

The new EU Trade Mark Regulation No 2015/2424 ('EUTMR'), which entered into force on the 23 March 2016, has amended Articles 7, 8 and 53, introducing a number of additional grounds for refusal and invalidity in absolute and relative grounds which did not exist in the former CTMR.

Those additional grounds are not only applied when dealing with the examinations of incoming EUTM applications and oppositions: they could in principle also be claimed in a request for invalidity filed after the entry into force of the EUTMR against a trade mark validly registered under the previous regime.

The EUTMR does not contain transitory provisions or specific rules on the relevant point in time for the application of those new grounds and this fact has given rise to a number of questions which need clarification.

The Note which is published in attachment seeks to provide further guidance on the application of the grounds for refusal after the entry into force of the new EUTMR.

[Annex: Note](#)

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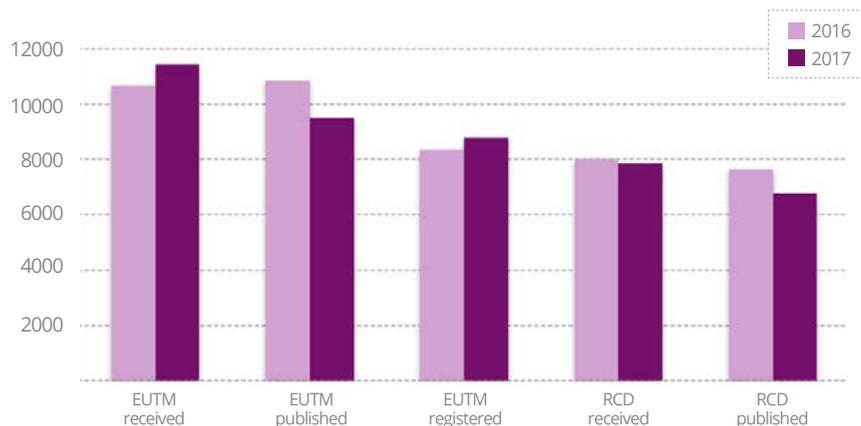


## Statistical Highlights



Monthly statistical highlights April*	2016	2017
European Union Trade Mark applications received	10676	11430
European Union Trade Mark applications published	10847	9506
European Union Trade Marks registered (certificates issued)	8355	8777
Registered Community Designs received	8016	7848
Registered Community Designs published	7636	6773

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



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## TM5 Mid-Term Meeting

The European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Administration for Industry & Commerce of the People's Republic of China (SAIC), and the United States Patent and Trademark Office (USPTO) (hereinafter referred to as the "Partners") gathered in Barcelona, Spain, on 22 May 2017 for the TM5 Mid Term meeting.

The World Intellectual Property Organization (WIPO) was present at the meeting as an observer.

The main objective of the Mid Term meeting is to take stock of progress of all projects and to prepare for the Annual Meeting which will take place on 30 Nov-1 Dec 2017 at the EUIPO in Alicante.

The Partners discussed the advancement of the current collaborative projects and agreed on the most important deliverables.

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### Trade mark reform – texts of Implementing and Delegated regulations available

The Implementing Regulation laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark (Commission reference C(2007) 3224) was adopted on 18 May 2017 by the European Commission, together with the Commission Delegated Regulation supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96.

Please note that the official publication of these two acts in the Official Journal of the EU and their subsequent entry into force are still subject to the European Parliament and the Council of the European Union not raising an objection during the period laid down in Article 163a(5) of Council Regulation (EC) No 207/2009.

The provisions in both texts are due to enter into force on 1 October 2017.

Both texts, in all language versions, are publicly available at the Commission's Better Regulation Portal using the following links:

<https://ec.europa.eu/info/law/better-regulation/>

[initiatives/c-2017-3224](#) (Implementing Regulation)

<https://ec.europa.eu/info/law/better-regulation/initiatives/c-2017-3212> (Delegated Regulation).

### New online form for international applications

EUIPO has launched a new online form, through which users can file a request for an international trade mark application through the Madrid Protocol system administered by the World Intellectual Property Office (WIPO).

The European Union ratified the Madrid Protocol in 2004, allowing the EUIPO to accept international registrations of trade marks and to forward international applications from its users to the WIPO.

Up until now, the only way to file an international application based on an EU trade mark application was to send the application using a paper form, which tended to produce more formality deficiencies.

This new release is another step in the EUIPO's commitment to becoming a paperless office by providing high-quality electronic services to its users.

The new form has been designed so as to reduce formality deficiencies in this type of application.

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The form can be accessed in various ways on the EUIPO's website:

- Through the Dashboard in your User Area
- Via the Online Services hub
- From the Forms and Filings page
- Via eSearch plus in the 'Actions and communications' section

Applications can be based on one or more EU trade marks or EU trade mark applications. Like the other electronic forms of the Office, users can save their work as a draft at any time in the process, and return to it later.

## Open data platform at EUIPO

The EUIPO has launched an open data platform, which allows users to download an XML file of the full or partial datasets in the following categories: trade marks; representatives; international registrations; designs; and applicants.

In order to protect the identities of EU trade mark and registered Community design owners, part of the data contained in the Register has been anonymised for representatives and applicants.

Data files do not contain any personal data of applicants and representatives who are physical persons (name, address, phone/fax number and

email are removed from the XML file containing the EUTM/RCD information) in compliance with the legislation regarding the protection of personal data ([Directive 95/46/EC](#)). Data from companies and organisations is fully available.

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### Luxembourg trade mark and design news

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

**Case T 473/15; Capella EOOD v EUIPO; Judgment of 16 March 2017;**

**Language of the case: DE**

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

**Keywords: Competence of the Board, Right to be heard, Restriction of the list of goods and services, Substantial procedural violation**

**Facts:** In the course of the appeal proceedings, the applicant declared two subsequent restrictions concerning the goods vehicles and their parts in Class 12 of its EUTM application. The first restriction read: vehicles for use on land; [...], the second: automotive vehicles for use on land, namely passenger vehicles; tyres; wheel trims; [...]. In the contested decision, the Board of Appeal (BoA) accepted the first restriction but rejected the second in its entirety, reasoning that tyres; and wheel trims were not previously contained in the specification. On the merits, the BoA upheld the opposition for vehicles for use on land on the basis of Article 8(1)

(b) EUTMR and rejected it for the remaining goods.

Before the General Court (GC), the applicant claimed that the BoA lacked competence to decide on restrictions, which instead was within the competence of the Opposition Division, and that the BoA had infringed its right to be heard, because it was not informed about the refusal of its second application for restriction before the contested decision was taken.

**Substance:** The GC confirmed the BoA's competence to process restrictions declared during the course of appeals. By virtue of Article 64(1) EUTMR (para. 29), and regarding the principle of continuation of proceedings (para. 38), this competence was based on and shaped by that of the Opposition Division. Restrictions might have an effect a) on the continuation of the opposition proceedings, and b) on the assessment of likelihood of confusion (para. 34). Thus, there was a close nexus between restrictions and opposition procedures that was relevant for the parties' right to be heard.

The GC found an infringement of the general legal principle of the right to be heard as enshrined in Article 75 EUTMR, since the BoA had decided on the opposition based on the first restriction without informing the applicant beforehand that the second restriction was ineffective (paras 41-61). Furthermore, the BoA also committed a procedural error by not applying Rule 13(3) EUTMR, 13

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which establishes the right to be heard (paras 62-67). This provision sets out that the Office is to communicate to the applicant the deficiencies regarding a restriction under Article 43 EUTMR for formal and all other requirements. Given that these errors concerned the goods to be compared, they may have had an impact on the assessment of a likelihood of confusion and therefore have led to the annulment of the contested decision (paras 68-69).

**Case T 638/15; Alcohol Countermeasure Systems (International) Inc. v EUIPO; Judgment of 29 March 2017;**

**Language of the case:** EN

**Result:** Action dismissed

**Keywords:** Proof of use, Proprietor consent, Extent of use

**Facts:** The Board of Appeal (BoA) confirmed the Cancellation Division's finding that the earlier UK mark had been put to genuine use, and that the contested mark was to be declared invalid on the basis of Article 53(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR.

EUTM	Earlier trade mark
ALCOLOCK	ALCOLOCK

**Substance:** The GC confirmed the BoA's findings that the invalidity applicant had proven genuine use of the earlier UK mark, by way of presenting evidence of use from its licensee of another mark, consisting of an identical sign registered for identical goods. The GC chiefly relied on the case-law, a fortiori, according to which genuine use included use of the earlier mark in a form differing in elements that did not alter the distinctive character of that mark in the form under which it was registered, even though that different form was itself registered as a trade mark (paras 17-35). Furthermore, the use by the licensee was with the invalidity applicant's consent, which was not affected by possible infringements of the terms of the licensing agreement by the licensee (paras 42-44). Article 19(2) TRIPS, as any provision of the TRIPS Agreement, had no direct effect but Article 15(2) EUTMR must be interpreted in the light thereof. However, the applicant before the GC did not put forward any specific argument and this plea therefore had to be rejected (paras 47-51). Genuine use was proven by means of the licensing agreement; a selection of invoices, accompanied by purchase orders and email requests; a selection of press articles and advertisements, together with

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invoices for placing them. As regards a press article that was published in Ireland, that is to say, outside the relevant territory of the UK, it nevertheless contained information on the use of the earlier mark in the UK and could thus be taken into account. Furthermore, the presence of the earlier mark on invoices and in articles and advertisements relating to the goods at issue could suffice to constitute the required link to them. As to the extent of use, the sale of 350 breathalyser devices during the relevant periods to different persons constituted a relatively low but sufficient number to create or preserve an outlet for the goods concerned. Genuine use was thus proven, as correctly found by the BoA (paras 52-96).

**Case T 594/15; Metabolic Balance Holding GmbH v EUIPO; Judgment of 6 April 2017;**

**Language of the case: DE**

**Result: Action dismissed**

**Keywords: Descriptive element, Distinctive element, Figurative element, Principle of legality**

**Facts:** The applicant sought to register the figurative mark **Metabolic Balance** (represented below) as an EUTM for services in Classes 35, 41, 42 and 44.

The Office refused the registration of the EUTM

application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the EUTM application was descriptive and devoid of distinctive character.

The applicant filed an action before the General Court (GC), relying on two pleas in law: Article 7(1) (b) and (c) EUTMR. The GC dismissed the appeal. It found that the mark had a descriptive character. It was sufficient that one of the absolute grounds for refusal listed in Article 7(1) EUTMR was given. The second plea (distinctive character) therefore also had to be dismissed.

### EUTM application



**Substance:** The GC confirmed that the relevant public was composed of professionals and reasonably well-informed consumers (para. 24). Taking into consideration English grammar rules, the mark had a clear meaning for English-speaking consumers; the combination of the words was not a neologism and was not unusual (para. 28). The GC confirmed that the figurative element did

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not convey a message to the consumers and the colour of the sign was not unusual either (para. 31). The graphic element could be recognised as a decorative element or a design feature around the word elements. The figurative elements were not dominant or striking; they did not change the descriptive character of the expression (para. 35). The term conveyed direct information regarding all the services in question; it referred to, or could refer to, a diet and nutrition programme, in order to maintain a balanced metabolism (paras 38 and 40). The argument that the expression was used only by the applicant was irrelevant; the examination could not depend on the result of any internet searches or on the fact that other competitors did not use it (paras 42-43). The argument that the Office had already registered similar signs was also irrelevant. The BoA found on the basis of Article 7(1)(c) EUTMR that the mark was descriptive for the services at issue; the previous decisions could not change this conclusion (para. 46). The argument that the identical sign had been registered in other countries was irrelevant in this case. The European Union trade mark regime is an autonomous system, independent of any national system and is not bound by decisions adopted in any Member State or indeed a third country. There is no provision to come to the same conclusions as those arrived at by national authorities in similar circumstances (para. 48). To the argument that the Office carried out a more stringent examination, the GC set out that the BoA was not bound by the previous practice of the

Office or the Office's Guidelines; the application was refused on the basis of the EUTMR and the relevant case-law (para 51).

**Case T 336/15; Windrush Aka LLP v EUIPO;**  
**Judgment of 22 March 2017;**

**Language of the case: EN**

**Result: Action dismissed**

**Keywords: Burden of proof, Proof of use**

**Facts:** The EUTM proprietor was granted the registration of the word mark **The Specials** for goods and services in Classes 9, 16, 25 and 41. An application for revocation on the grounds of lack of genuine use of that mark was filed pursuant to Article 51(1)(a) EUTMR. The Cancellation Division (CD) partly upheld the application for revocation. The applicant filed a notice of appeal with the Office pursuant to Articles 58 to 64 EUTMR. The Board of Appeal (BoA) partly upheld the appeal and found that the EUTM had been used only in respect of compact discs (audio-video) in Class 9. The applicant filed an action before the General Court (GC), alleging infringement of Article 15(2) EUTMR. The GC dismissed the action.

**Substance:** The applicant put forward a single plea in law, alleging infringement of Article 15(2) EUTMR, as the BoA had erred in finding that the intervener had validly consented to the use of the contested

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mark by a third party in relation to compact discs (audio-video) in Class 9. In this regard, the GC denied that the BoA placed on the applicant the burden of proving that there was no consent on the part of the intervener to the use of the contested mark by a third party (para. 39). Furthermore, the GC found it irrelevant whether the contested mark was put to genuine use by the intervener or with the intervener's consent (para. 50). Finally, the GC quoted the case-law, according to which, where the EUTM proprietor claims that use of that mark by a third party constitutes genuine use of such mark, he or she is claiming implicitly that that use was made with his or her consent. Furthermore, it seems unlikely that the intervener could have had the relevant documents and submitted them as proof of use of the contested mark if such use had taken place against his or her wishes (para 56).

**Case T 387/15; J & Joy SA v EUIPO; Judgment of 29 March 2017;**

**Language of the case:** EN

**Result:** Action dismissed

**Keywords:** Admissibility, Conceptual similarity, Distinctive element, Dominant element, Likelihood of confusion, Phonetic similarity, Relevant territory, Similarity of the goods and services, Visual similarity

**Facts:** The applicant sought to register the

word mark **J AND JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25.

An opposition based on an earlier German figurative mark, registered for goods and services in Class 25, was filed pursuant to Article 8(1) (b) EUTMR. The Opposition Division partly upheld the opposition, considering that there was a likelihood of confusion (LOC) for some of the contested goods in Classes 18 and 25.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark.

The applicant filed an action before the General Court (GC), relying on several plea(s) in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of goods, (iv) the comparison of the marks including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, finding that the BoA did not err in finding a LOC for the goods within the scope of the appeal.

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EUTM application	Earlier trade mark
J AND JOY	

**Substance:** Admissibility of the heads of claim — The GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible' (emphasis added). The Office had objected to this head of claim.

In the context of a measure of organisation of procedure, the GC requested the applicant to state precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim for the GC to annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision.

The GC concluded that the application was for the annulment of the contested decision.

LOC: The GC began the examination of LOC by clarifying that the relevant public was made up of German consumers, given that the earlier mark

on which the contested decision was based was a German trade mark (paras 17-21). Next, the GC dismissed the applicant's argument that the degree of attention paid to the goods was higher than average because the goods concerned were aimed at 'young and trendy' consumers. In so doing, the GC confirmed that the commercial strategy of the trade mark applicant was not determinative of the degree of attention; rather, the assessment must to be based on the perception of the average consumer of the category of the goods concerned (paras 22-29). On the comparison of the goods, the GC upheld the BoA's conclusions and confirmed that the comparison must be made between the goods listed in the specifications of the relevant marks, **not** between the goods on which the marks were used (paras 30-35).

Turning to the comparison of the marks, the GC supported the findings of the BoA that the element 'JOY' was of average distinctive character for the German public. 'JOY' was not necessarily understood by the relevant German consumers. Furthermore, even if they knew English, it was probable that such German consumers would make an association with the female first name 'Joy', rather than an idea of happiness (paras 39-47). The GC considered that 'JOY' dominated the earlier mark due to its relative size and position (paras 48-51). The GC agreed with the BoA's assessment of an average degree of visual similarity and phonetic similarity. In so doing, it referred to the dominant

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position of 'JOY' in the earlier mark, the secondary nature of 'j' and 'and' in the contested mark and the secondary role of 'sportswear' in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73).

On the conceptual comparison, the applicant contended that there was a conceptual difference between the marks because 'joy' in the earlier mark highlighted the idea of happiness, and 'sportswear' described sports clothing. Whereas the contested mark **J AND JOY** alluded to a young couple enjoying life because of the association with the male first name 'Jay' and the female first name 'Joy', and because of wordplay on the English term 'enjoy'. The GC rejected this and concluded that the German consumer would attribute significance only to the term 'joy' in the contested mark (paras 74-81).

When assessing the LOC, the GC first clarified that an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the **contested** mark was not relevant to the analysis of LOC (paras 84-95). It went on to conclude that the BoA did not err in finding that there was a LOC between the signs at issue for the relevant goods.

**Case T 388/15; J & Joy SA v EUIPO; Judgment of 29 March 2017;**

**Language of the case: EN**  
**Result: Action dismissed**

**Keywords: Admissibility, Conceptual similarity, Distinctive element, Dominant element, Likelihood of confusion, Phonetic similarity, Relevant territory, Similarity of the goods and services, Visual similarity**

**Facts:** The applicant sought to register the word mark **JN-JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25.

An opposition based on an earlier German figurative mark registered for goods and services in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division partly upheld the opposition, considering that there was a likelihood of confusion (LOC) between some of the contested goods in Classes 18 and 25.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that there was a likelihood of confusion given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark.

The applicant filed an action before the General 19

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Court (GC) relying on several plea(s) in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of goods, (iv) the comparison of the marks including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal finding that the BoA did not err in finding a LOC for the goods within the scope of the appeal.

EUTM application	Earlier trade mark
JN-JOY	

**Substance:** Admissibility of the heads of claim — The GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible' (emphasis added). The Office had objected to this head of claim.

In the context of a measure of organisation of procedure, the GC requested the applicant to state

precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim for the GC to annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision.

The GC concluded that the application was for annulment of the contested decision.

LOC: The GC began the examination of LOC by clarifying that the relevant public to be taken into consideration was made up of German consumers, given that the earlier mark, on which the contested decision was based, was a German trade mark (paras 17-21). Next, the GC dismissed the argument that the degree of attention paid to the goods was higher than average, because the goods concerned were aimed at 'young and trendy' consumers. In so doing, the GC confirmed that the commercial strategy of the trade mark applicant was not determinative; rather, the assessment must be based on the perception of the average consumer of the category of the goods concerned (paras 22-29). On the comparison of the goods, the GC upheld the BoA's conclusions and confirmed that the comparison must be made between the goods listed in the specifications of the relevant marks, **not** between the goods on which the marks were used (paras 30-35).

Turning to the comparison of the marks, the GC supported the findings of the BoA that the element

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'JOY' was of average distinctive character for the German public. 'JOY' was not necessarily understood by the relevant German consumer. Furthermore, even if they knew English, it was probable that such German consumers would make an association with the female first name 'Joy', rather than an idea of happiness (paras 39-47). The GC considered that 'JOY' dominated the earlier mark due to its relative size and position (paras 48-51). The GC agreed with the BoA's assessment of an average degree of visual similarity and phonetic similarity. In doing so, it referred to the dominant position of 'JOY' in the earlier mark, the secondary nature of the set of letters 'jn' and the hyphen in the contested mark and the secondary role of 'sportswear' in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73).

On the conceptual comparison, the applicant contended that there was a conceptual difference between the marks, because 'joy' in the earlier mark highlighted the idea of happiness, and 'sportswear' described sports clothing. Whereas the contested mark **JN-JOY** alluded to a young couple enjoying life. This was because of the association with the male first name 'Jay', the female first name 'Joy' and because of wordplay on the English term 'enjoy'. The GC rejected this and concluded that the German consumer would attribute significance only to the term 'joy' in the contested mark (paras 74-81).

When assessing the LOC, the GC first clarified that

an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the contested mark was not relevant to the analysis of LOC (paras 84-95). It went on to conclude that the BoA did not err in finding that there was a LOC between the signs at issue for the relevant goods.

**Case T 389/15; J & Joy SA v EUIPO; Judgment of 29 March 2017;**

**Language of the case: EN**

**Result: Action dismissed**

**Keywords: Admissibility, Conceptual similarity, Distinctive element, Dominant element, Likelihood of confusion, Phonetic similarity, Relevant territory, Similarity of the goods and services, Visual similarity**

**Facts:** The applicant sought to register the figurative mark represented below as an EUTM for goods and services in, inter alia, Classes 18 and 25.

An opposition based on an earlier German figurative mark, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division partly upheld the opposition, considering that there was a likelihood of confusion (LOC) between some

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of the contested goods in Classes 18 and 25.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue, and the average distinctive character of the earlier trade mark.

The applicant filed an action before the General Court (GC), relying on several plea(s) in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of goods, (iv) the comparison of the marks including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, finding that the BoA did not err in finding a LOC for the goods within the scope of the appeal.

**Substance:** Admissibility of the heads of claim — The GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible' (emphasis added). The Office had objected to this head of claim.

In the context of a measure of organisation of procedure, the GC requested the applicant to state precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim for the GC to annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision.

The GC concluded that the application was for the annulment of the contested decision.

LOC: The GC began the examination of likelihood of confusion by clarifying that the relevant public to be taken into consideration was made up of German consumers, given that the earlier mark on which the contested decision was based was a German trade mark (paras 17-21). Next, the GC dismissed the argument that the degree of attention paid to the goods was higher than average, because the goods concerned were aimed at 'young and trendy' consumers. In so doing, the GC confirmed that the commercial strategy of the trade mark applicant



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was not determinative; rather, the assessment must be based on the perception of the average consumer of the category of the goods concerned (paras 22-29). On the comparison of the goods, the GC found that the comparison must be made between the goods listed in the specifications of the relevant marks, not between the goods on which the marks were used (paras 30-35).

Turning to the comparison of the marks, the GC supported the findings of the BoA that the element 'JOY' was of average distinctive character for the German public. 'JOY' was not necessarily understood by the relevant German consumers. Furthermore, even if they knew English, it was probable that such German consumers would make an association with the female first name 'Joy', rather than an idea of happiness (paras 39-47). The GC considered that 'JOY' dominated the earlier mark due to its relative size and position (paras 48-51). The GC agreed with the BoA's assessment of an average degree of visual similarity and phonetic similarity. In doing so, it referred to the dominant position of 'JOY' in the earlier mark, the secondary nature of the separate letter 'j' and the ampersand (&) in the contested mark, and the secondary role of 'sportswear' in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73).

On the conceptual comparison, the applicant contended that there was a conceptual difference between the marks, because 'joy' in the earlier mark

highlighted the idea of happiness and 'sportswear' described sports clothing. However, the contested mark **J&JOY** alluded to a young couple enjoying life. This was because of the association with the male first name 'Jay' and the female first name 'Joy' and was due to wordplay on the English term 'enjoy'. The GC rejected this argument and concluded that the German consumer would attribute significance only to the term 'joy' in the contested mark (paras 74-81).

When assessing the LOC, the GC first clarified that an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the contested mark was not relevant to the analysis of LOC (paras 84-95). It went on to conclude that the BoA did not err in finding that there was a LOC between the signs at issue for the relevant goods.

**Case T 15/16; Georgios Pandalis v EUIPO; Judgment of 14 February 2017;**

**Language of the case: DE**

**Result: Action dismissed**

**Keywords: Evidence of use, Nature of use, Proof of use**

**Facts:** The Cancellation Division partially revoked the contested EUTM **Cystus** for *non-medical food supplements* in Class 30, on account of its lack of

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genuine use. The Board of Appeal (BoA) rejected the appeal, holding that the EUTM proprietor made a descriptive use of the EUTM only and that the marketed goods, such as lozenges, could not be qualified, on the basis of the evidence provided, as *non-medical food supplements* in Class 30. The EUTM proprietor filed an action before the General Court (GC). The GC rejected the action.

### EUTM

#### Cystus

**Substance:** In holding that the contested EUTM was used in a descriptive manner only, the BoA did not give any findings on Article 7 EUTMR but examined whether it was used in accordance with its main function, as required for a genuine nature of use. The BoA thus did not infringe Article 64(1) EUTMR (paras 14-18). The goods in question contained an extract from a plant with the scientific name *Cistus Incanus L.*, in Latin: *Cistus*, as a main active ingredient. On the product packaging, 'Cystus' appeared to describe that ingredient, in particular as it formed part of the expression 'Cystus®-Extrakt' and as it featured in the list of ingredients. In view of this, the multiple use of 'Cystus' on the packaging and its prominent display did not give rise to its perception as a trade mark. The use of the ®-symbol was not sufficient either, given also that it

did not always appear and was also combined with other elements. Furthermore, the writing with the letter 'y' was insufficient for a genuine nature of use, since such variations generally did not render a sign distinctive. In the case in question, the BoA was right to consider the letter 'y' and 'l' as interchangeable for words of Latin origin, and aurally identical in German (Germany being the territory to which the evidence related). The addition of the figures '052' and '52' did not endow the sign with distinctive character for the purpose of a genuine nature of use (paras 42-47). As to the lack of use in relation to the goods in question, the GC also confirmed the BoA's findings. With regard to the legal requirements for products to be marketed as supplements as laid down by Directive 2002/46/EC of 10 June 2002 on the approximation of the laws of the Member States relating to food supplements, the EUTM proprietor did not establish that the goods could be qualified as such. Furthermore, the allocation of a drug code used for distribution in pharmacies and the claimed properties to protect against colds and flu indicated that the goods were not *non-medical food supplements* in Class 30 (paras 57-59).

**Case T 16/16; Mast-Jägermeister SE v EUIPO;  
Judgment of 9 February 2017;**

**Language of the case: DE**

**Result: Action dismissed**

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### **Keywords: Deficiencies in RCD application, Representation of a design**

**Facts:** The two RCD applications each showed a beaker and a bottle; they indicated 'beaker' as the relevant product. According to the examiner, it resulted from the examination that the applicant was not seeking protection for the bottles. The applicant did not remedy the defects raised in this respect and the applications were therefore not be dealt with as applications for RCDs pursuant to Article 46(2) CDR.

The Board of Appeal (BoA) confirmed that it was not possible to determine whether protection was being sought for the beaker, for the bottle, or for a combination of the two. According to the BoA, the representation to be filed with the application pursuant to Article 36(1)(c) CDR served to identify the design for which protection was sought and was the condition for the attribution of a date of filing, which was relevant for its novelty and individual character. Under Article 4(1)(e) CDIR, the representations had to permit all the details for which protection was sought to be distinguished clearly.

**Substance:** A representation of the design suitable for reproduction for the purpose of attributing a filing date in accordance with Article 36(1)(c) CDR must be of a 'quality permitting all the details of the matter for which protection is sought to be clearly distinguished', as follows from Article 4(1)(e) CDIR in conjunction with Article 10 CDIR and Article 36(5)

CDR (paras 31-34). The quoted phrase refers to the requirement inherent in any registration, that is to say, to enable third parties to determine with clarity and precision all the details of the design for which protection is sought (para. 45). Moreover, clarification is necessary for accounting purposes, insofar as the amount of fees collected by the Office varies according to the number of classes of goods to which the design concerned relates (para. 47). The BoA properly applied Article 46(2) CDR in not attributing a filing date, rather than refusing the application under Article 46(3) CDR (paras 50-51).

### **Case T 308/16; Marsh GmbH v EUIPO; Judgment of 9 March 2017;**

#### **Language of the case: DE**

#### **Result: Action dismissed**

### **Keywords: Descriptive element, Laudatory mark, Quality of the goods and services**

**Facts:** The applicant sought to register the word sign **ClaimsExcellence** for insurance-related services in Class 36 of the Nice Classification. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and therefore devoid of distinctive character, primarily and therefore devoid of distinctive character, primarily for the English-speaking public within the European Union. The Board of Appeal (BoA) dismissed the

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applicant's appeal. It found that the application was descriptive of the services applied for in either meaning, namely: 'he/she claims excellence' or 'Claims – Excellence'. The applicant filed an action before the General Court (GC) claiming that (i) the sign was not directly descriptive for the services applied for, and that (ii) the Office had erroneously considered all the services to be 'underwriting services', while 'insurance brokerage' and 'consulting concerning insurance' were not covered by this general term. The GC dismissed the appeal.

### EUTM appliation

ClaimsExcellence

**Substance:** The GC agreed that **ClaimsExcellence** could either be understood as the short form of the sentence 'he/she/Marsh claims excellence' or as the joining of two buzzwords (paras 25-31). 'Claims' was a technical term in the relevant area of insurance services, as was also shown by the extensive use made of that term by the applicant itself, and was therefore descriptive for the services applied for (para. 37). 'Excellence' describes the quality of the services to be delivered (paras 38-40). The joining of these terms results in a descriptive combination (paras 41-43). It follows from Article 2(3) of Directive 2002/92/EC on insurance mediation that

'insurance brokerage' and 'consulting concerning insurance' are encompassed by 'insurance mediation'. This provides for a sufficiently close link with claims that are dealt with by insurance companies, so that the BoA's global reasoning correctly also covered these services (paras 44-47).

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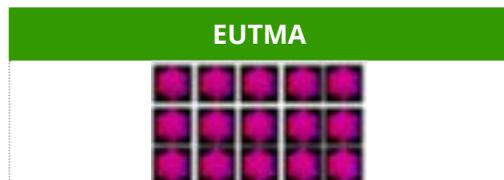
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#### R1439/2016-2 MOVEMENT MARK



**Result:** Decision confirmed

**Keywords:** Graphical representation

**Norms:** Article 4 EUTMR, Article 7(1)(a) EUTMR.

**Facts:** The applicant sought to register a movement mark, as represented above. The examiner rejected the application claiming that the graphic depiction submitted was not clear and unambiguous.

**Substance:** A trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented

graphically, particularly by means of images, lines or characters and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective (27/11/2003, [C-283/01](#), Musical notation, EU:C:2003:641, § 56; 12/12/2002, [C 273/00](#), Sieckmann, EU:C:2002:748, § 55). The Board agrees with the examiner that it is not possible to grasp the movement described in the description of the mark from the sequence of images shown. The contrast from image to image is not sufficiently sharp and the design looks the same in each image (§ 18). The appeal is dismissed and the trade mark application is rejected pursuant to Article 4 and Article 7(1)(a) EUTMR.

**Case citation:** 03/03/2017, R 1439/2016-2, [Bevægelsesmærke \(al.\)](#)

#### R0955/2016-5 Szatmári (fig.)



**Result:** Decision annulled.

**Keywords:** Descriptive element, Distinctive element, Figurative element, Nature of the goods and services.

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**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(2) EUTMR.

**Facts:** The applicant sought to register the figurative mark above. The examiner rejected the application on the basis of Article 7(1)(b) and (c) claiming that ‘SZATMÁR(l)’ referred to a historical and geographical region of Hungary and Romania.

**Substance:** The figurative elements of the mark applied for endow the mark with a certain level of distinctiveness; it is not a mere word mark (§ 17). The sign applied for ‘hides’ the name of a geographical area in Hungary, ‘SZATMÁR’, famous for its plums, plum jam, and plum spirit (*pálinka*). Other fruits, such as apples are also characteristic of the region, which is also rather small. However, as regards wheat, grain, bread products and oils the goods applied for, there is no real tradition to protect, so the mark is registrable. The first-instance decision lacks reasoning in this respect (§ 19-20). The appeal is upheld.

**Case citation:** [05/04/2017, R 955/2016-5, Szatmári \(fig.\)](#)

**R0976/2016-4 Aldi / Aldo (fig.)**

EUTMA	Earlier trade mark
Aldi	

**Result:** Decision annulled.

**Keywords:** Admissibility, Nature of use, Proof of use, Substantiation of earlier right.

**Norms:** Rule 15(2)(e) CTMIR, Rule 19(1) CTMIR, Rule 19(1)(a)(ii) CTMIR, Rule 19(2)(a) CTMIR, Rule 20(1) CTMIR, Article 42(2) EUTMR, Article 42(3) EUTMR

**Facts:** An opposition was filed against the EUTM applied for, for the word mark ‘Aldi’. The opposition was based on a Bulgarian trade mark as represented above. The opponent submitted a copy of the registration certificate of the Bulgarian trade mark in black and white. In reply to the applicant’s comments the opponent filed, inter alia, a document showing the earlier mark in colour. The Opposition Division upheld the opposition in part and rejected the application for certain services.

**Substance:** Since the notice of opposition showed a representation of the earlier mark in colour,

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the Opposition Division rightly considered the opposition to be admissible (§ 18). However, in the absence of a colour representation of the earlier mark in an official document, the existence and validity of the earlier Bulgarian trade mark has not been sufficiently substantiated (§ 24-25).

In addition, the opponent failed to prove genuine use of the earlier mark for the services for which it is registered. The earlier mark is not registered for 'retail services' but for 'procurement services for others [purchasing goods and services for other businesses]' (§ 33-35).

The opposition is rejected in its entirety.

**Case citation:** [29/03/2017, R 976/2016-4, ALDI / ALDO \(fig.\)](#)

**R1511/2016-4 Vidal sweet cakes (fig.) / Sweet (fig.)**



**Result:** Decision annulled.

**Keywords:** Function of trade mark, Request for proof of use, Visual dissimilarity, Weak trade mark.

**Norms:** Article 8(1)(b) EUTMR.

**Facts:** The applicant sought to register the figurative mark above for goods and services in Classes 29, 30 and 35. The opponent filed an opposition on the basis of the EUTM above. The Opposition Division partially refused the EUTM applied for claiming that a likelihood of confusion existed with respect to Bulgaria and Hungary.

**Substance:** It would be against the rationale of the EUTMR to give too much importance in the assessment of a likelihood of confusion to non-distinctive elements. It cannot be that a proprietor of a trade mark composed of figurative and word elements, where each of them taken alone or in combination are non-distinctive, were in the position to successfully claim a likelihood of confusion based on the presence of one of these elements in the other sign. This would result in unduly broad protection for descriptive and non-distinctive elements ([18/09/2013, R 1462/2012-G, ULTIMATE GREENS / ULTIMATE NUTRITION, § 62](#)) (§ 34). Consequently, no likelihood of confusion can arise, not even for identical goods (§ 36). The opposition is rejected in its entirety.

Case citation: [29/03/2017, R 1511/2016-4, VIDAL SWEET CAKES \(fig.\) / Sweet \(fig.\)](#)

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**R0888/2016-2 Authentic herbal tea wellucky since 1828 (fig.) / Wang lao ji et al.**

EUTMA	Earlier trade mark
	Wang lao ji

**Result:** Decision confirmed.

**Keywords:** Dissimilarity of signs, Dominant element, Figurative element, Figurative trade mark.

**Norms:** Article 8(1)(b) EUTMR.

**Facts:** An opposition was filed against the EUTM applied for, for the figurative mark above. The opposition was based on several earlier rights and on the grounds laid down in Article 8(1)(b) EUTMR. The Opposition Division rejected the opposition.

**Substance:** The respective lists of goods do not support the conclusion that generally the products concerned are sold in special Asian stores with clients that mostly have a Chinese or Asian background (§ 30). The Asian script as a whole is illegible for the relevant public in the European Union and consumers will not and cannot try to pronounce it or link it to a definite meaning; they may only establish some vague conceptual link with Asia or Asian medicine (§ 59). When seen in

an isolated manner, the characters composing the earlier marks can be considered to be included in the contested sign (§ 65), but consumers normally perceive a mark as a whole. The Board considers the distinctiveness of the earlier marks to be normal. Since no enhanced distinctiveness is claimed and the earlier marks are not particularly well-known, the very low level of conceptual similarity described above is not sufficient to give rise to a likelihood of confusion between the signs at hand. (§ 97). The appeal is dismissed.

**Case citation:** 21/03/2017, R 888/2016-2, AUTHENTIC HERBAL TEA WELLUCKY SINCE 1828 (fig.) / WANG LAO JI et al.

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