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Anti-Scam Network meeting at EUIPO

Misleading invoices have long been a problem for intellectual property offices worldwide, and their users. They also represent a financial problem that is very difficult to quantify and monitor.

EUIPO has had a strategy in place to combat misleading invoices for some years now. Its customer service department receives samples of this type of correspondence sent to users, and publishes them on the Office's [searchable database](#).

Samples of those invoices are also published on EUIPO's social media channels, as part of an EU-wide awareness campaign to warn users that these invoices are circulating, and to familiarise them with the different types of misleading invoices that are being sent.

From a legal perspective, EUIPO supports, as appropriate, law enforcement authorities and prosecutors in investigative actions against scammers; one such example was a [recent judgment](#) in the Court of Appeal in Stockholm taken against fraudsters who had sent misleading invoices to EUTM owners under the misleading letterhead "OMIH."

EUIPO analyses all samples of misleading invoices sent to it by its users, to put together a picture of where these invoices are coming from, and to identify ways of tackling them.

But all these activities are not taken in a vacuum. The



Anti-Scam Network, comprising representatives from National IP Offices of the EU Member States, EFTA Countries, the European Patent Office (EPO), the World Intellectual Property Organization (WIPO), the European Union Agency for Law Enforcement (Europol) and several user associations, represents a coordinated effort to fight against misleading invoices, for the benefit of all users.

With the publication of a [Joint Statement on an Expert Cooperation Charter in the area of Anti-Scam](#), the Network sets out a framework for cooperation, as well as objectives which include information-sharing, mutual assistance with a view to undertaking legal actions, where appropriate, defining common warnings and actions and the coordination of IT security measures and dissemination policies.

The Network gathered for the third time at EUIPO on 19 April 2018, for an intensive meeting which covered a variety of topics common to all offices. Highlighted were communication actions, IT security measures, legal issues and other areas of mutual concern. The common goal is to build together on the on-going work carried out by offices across the EU, seeking synergies where appropriate and tackling this issue together for the benefit of users.

EUIPO is committed to working closely with the Network members to enhance information sharing in anti-scam matters, as well as to strengthen cooperation contributing to the Network's joint endeavour in the fight against scammers.

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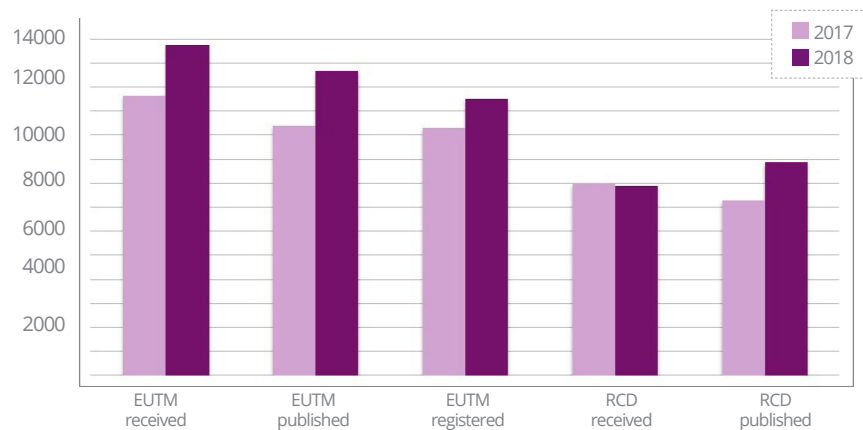


Statistical Highlights



Monthly statistical highlights November*	2017	2018
European Union Trade Mark applications received	11 434	13 236
European Union Trade Mark applications published	9 502	11 706
European Union Trade Marks registered (certificates issued)	8 775	8 902
Registered Community Designs received	7 951	7 994
Registered Community Designs published	6 894	7 965

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



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EUIPN Updates



Moldova and Peru to use the list of terms from the harmonised database in TMclass

On 07 May 2018 the State Agency on Intellectual Property of the Republic of Moldova (AGEPI) and the National Institute for the Defense of Free Competition and the Protection of Intellectual Property of Peru (INDECOP) began to use the list of goods and services from the harmonised database (HDB) in TMclass.

As a result, these are the two first non-EU IP offices to use terms from HDB, one of the expected outcomes of the strategic project “Extension of tools” within EUIPO’s international cooperation projects. This project aims at extending the reach of the EUIPN’s tools beyond the EU for the benefit of global users.

With the extension of the reach of HDB to AGEPI and INDECOP through TMclass, this tool now offers users the opportunity to search and translate more than 58,000 harmonised concepts among 29 IP offices.

Israel joins TMview

On 14 May 2018, the Israel Patent Office (ILPO) made its trade mark data available to the TMview search tool.

With ILPO on board TMview now contains data from 66 participating offices.

With the addition of more than 270,000 trade marks from ILPO, TMview provides information and access to more than 50.2 million trade marks in total.

Since the introduction of TMview on 13 April 2010 the tool has served more than 42.2 million searches from 160 different countries, with Spain, Germany and Italy among the most frequent users.

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Trade mark reform – Entry into force of ‘replacement’ Delegated and Implementing regulations

On 14 May 2018, Delegated Regulation (EU) 2018/625 and Implementing Regulation (EU) 2018/626 enter into force. Both acts are the same as the legislation that they repeal (EU 2017/1430 and EU 2017/1431, respectively) but the new acts cross-refer to the new codified EUTMR (EU) 2017/1001 and they contain some stylistic changes.

Both texts are available in all EU language versions below:

[Delegated Regulation \(EU\) 2018/625](#)
[Implementing Regulation \(EU\) 2018/626](#)

ETMD Education Centre

The EUIPO is launching a new training programme specially designed in-house for intellectual property (IP) practitioners. This practical course will focus on the interaction between the EUIPO and IP practitioners in trade mark and design registration and prosecution. The course will be delivered by EUIPO staff, leading IP professionals and academics. The programme will be held in English and will run from September 2018 to June 2019 with a total of 150 hours of courses combining e-learning, webinars, and two 3 day face-to-face sessions at the EUIPO, Alicante, Spain.

The course will be concluded with an exam taking place at the EUIPO and successful candidates will be awarded an EUIPO certificate.

For more information about the curriculum, the calendar and the tuition fees, [visit the programme's website](#).

Applications will be open from 15 May 2018.

Case-Law Collection on the Balance between the Right to Information and Fundamental Rights in the European Union

Within the framework of its various activities, the EUIPO Knowledge Circle Enforcement has for the first time prepared a case-law collection. The collection focuses on the balance between the right to information and fundamental rights, and aims to provide an overview of relevant decisions of the Court of Justice of the European Union as well as of national courts within eight selected EU Member States. It does not analyse the decisions collected, but provides a summary of them. A full report can be found [here](#).

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

Case C-412/16P and C-413/16P (joined cases); ocean beach club Ibiza / OC ocean club Ibiza et al.; Ice Mountain Ibiza, S.L. v EUIPO; Judgment of 1 March 2018; EU:C:2018:140; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Distortion of facts or evidence, Distinctive element, Dominant element, Figurative element, Identity of the goods and services, Lack of reasoning, Likelihood of confusion, Phonetic similarity, Visual similarity, Conceptual similarity, Legal certainty, Matters of fact appealed to CJ, Common element

FACTS: The applicant sought to register the figurative marks represented below as EUTMs for, inter alia, services in Class 41. Two oppositions based on the earlier Spanish figurative marks represented below registered for services in Class 41 were filed respectively pursuant to Article 8(1) (b) EUTMR. The Opposition Division (OD) upheld the oppositions respectively and the applicant appealed the OD's decisions. The Board of Appeal (BoA) dismissed both appeals as it found likelihood of confusion. The applicant filed two actions before the General Court (GC) relying on a single plea in law, infringement of Article 8(1)(b) EUTMR, which was dismissed, insofar the GC found likelihood

of confusion, given the identity or similarity of the services and the similarity of the signs. The applicant filed two actions before the Court of Justice of the European Union (CJ) relying on four pleas in law: (i) the incorrect assessment of the distinctiveness of the element 'OCEAN', (ii) the incorrect assessment of the dominant character of the various elements, (iii) the GC ignored relevant jurisprudence in its assessment of the similarity of the signs, and (iv) the GC erred in concluding that there was a likelihood of confusion.



SUBSTANCE: (i) The GC did not distort the evidence when it determined that the association with the sea was not a necessary characteristic of the services (paras 39-40). The GC did not err in not applying the judgment in Case C-479/12, which interpreted Regulation No 6/2002 on Community Designs, (para. 42). The GC correctly applied the jurisprudence of the burden of proof, without

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infringing the Right of Defence. The GC duly took into account the perception of the public when assessing the distinctive character of the word 'ocean' and it did not demand an excessive or too rigorous level of evidence (paras 44, 49 and 50). (ii) The GC did not apply automatically the principle that verbal elements are in general more important than figurative elements, but concluded that the word elements were at least as dominant as the figurative elements, after examining the position and the dimensions of the word element in the mark (paras 63 to 69). The CJ clarifies the content of judgment in Case T-134/06, namely that although the position and the dimensions of a weak element should be taken into account when assessing the dominant character of that element, these are not the only criteria to be considered (paras 80-81). The CJ confirms that the alleged case-law on invalidity proceedings under Regulation No 6/2002 is not applicable to the present case because the criteria are different (para. 83); (iii) Since the arguments only question the GC's assessment of facts concerning the similarity of the signs, in the absence of claiming a distortion of facts, this plea in law is inadmissible (paras 90-97); (iv) The GC duly considered the argument on coexistence. It identified the criteria correctly and pointed out that the applicant had the possibility of submitting evidence in order to prove that peaceful coexistence was due to the lack of likelihood of confusion, the evidence that the relevant public would already be familiarised with each one of the marks before the application

for registration of the contested marks being of particular pertinence to that effect (paras 103-105).

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

T-806/16; CLOS DE LA TORRE; Agricola J.M., SL v EUIPO; Judgment of 22 March 2018; EU:T:2018:163; Language of the case: ES

RESULT: Action dismissed

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

FACTS: The EUTM applicant sought to register the word sign CLOS DE LA TORRE for goods in Class 29 edible oils and fats; jellies, jams, compotes, fruit and vegetable spreads and Class 33 Alcoholic beverages except beers. An opposition based on the earlier trade marks TORRES and LA TORRE was filed pursuant to Article 8(1)(b) for the goods in Class 33. The OD upheld the opposition and the applicant lodged an appeal, which was dismissed by the BoA as it found that there was a likelihood of confusion (LOC) pursuant to Article 8(1)(b) EUTMR. It limited the examination of the opposition to the earlier word sign TORRES and found that the relevant public was composed of Belgian, French and Luxembourgish adult general public who consume alcohol; that the goods in question were identical and that the signs

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were visually and phonetically similar; that, for the French-speaking public, the element 'clos' had a lower than the average distinctive character as it means 'vineyard' in French; that the signs at issue had more similarities than differences as they shared the most distinctive part of the sign, namely the element 'torre'. The EUTM applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: RELEVANT PUBLIC AND TERRITORY: the relevant public is the general public composed of moderately attentive and informed consumers (para. 20). For the purposes of this case, only the French-speaking consumers of the Kingdom of Belgium, the French Republic and the Grand Duchy of Luxembourg were taken into account (para. 24). COMPARISON OF THE GOODS: the goods are identical (para. 26). COMPARISON OF THE SIGNS: VISUAL COMPARISON: the two signs share the element 'torre' and are visually similar (para. 32). PHONETIC COMPARISON: the pronunciation of the signs coincides in the element 'torre' so the overall impression of the signs is that they are similar to each other (para. 38). The BoA was right in finding that the final 's' in 'TORRES' will not be pronounced, since according to the rules of the French language, the final 's' indicating 'plural' is never pronounced (para. 39). So the signs at issue are phonetically and visually similar, but they are conceptually dissimilar (para. 43). LOC: The element 'clos' means 'vineyard' in French and has a lower distinctive character than the element 'torre' (para.

48), which has no meaning for the French public (para. 49). The differences between the signs, being mainly conceptual, are not sufficient to neutralise the visual and phonetic similarities (para. 55). The BoA was right in concluding that it is likely that the public would consider that the goods covered by the signs at issue come from the same company (para. 56).

T-272/17; Dating Bracelet; Webgarden Szolgáltató és Kereskedelmi Kft v EUIPO; Judgment of 20 March 2018; EU:T:2018:158; Language of the case: HU

RESULT: Action dismissed

KEYWORDS: Admissibility, Descriptive element, Legal certainty, Principle of legality

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 9, 41, 42 and 45. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The EUTM applicant appealed and the BoA dismissed the appeal. It found that the mark was descriptive and non-distinctive. The EUTM applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 4 EUTMR, (ii) infringement of Article 7(1)(b) and (c) EUTMR and (iii) infringement of the principles of equal treatment and legal certainty.

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EUTM application

Dating Bracelet

SUBSTANCE: ADMISSIBILITY: The plea under Article 4 EUTMR is inadmissible as it was not supported by any argument, in breach of Article 177(1)(d) of the Rules of Procedure of the GC (para. 16). **RELEVANT PUBLIC:** Since the word elements of the trade mark form an English expression, the relevant public consists of the English-speaking public of the EU (Ireland, Malta and United Kingdom) (para. 31). Irrespective of the fact that some of the goods and services are directed at a specialised public, there is nothing to indicate that the specialised public would have a different perception of the mark than the general public (para. 36). **MEANING OF THE MARK:** The composition 'Dating Bracelet' refers to a 'bracelet for dating' or a 'bracelet used for arranging dates' (para. 39). In particular, it has been proven that it designates in trade an existing electronic device worn around the wrist that runs software purported to assist in finding a partner (paras 43-45). **DESCRIPTIVENESS:** For goods in Class 9, 'Dating Bracelet' indicates that it is a connected device worn around the wrist that contains IT and electronic components that through emitting and receiving

radio signals facilitate dating (para. 48). For services in Class 41, it indicates that the services in night clubs, discotheques and online fora are targeted at consumers wearing the dating bracelet (para. 49). For services in Class 42, it indicates that the services are closely connected to the operation of the IT components of the device, through which it enables its wearer to arrange dates or update information stored in the bracelets (para. 50). For services in Class 45, it indicates online social networking services and personal introduction services through use of the dating bracelet (para. 51). The figurative element depicting two intertwined hearts merely reinforces the meaning of the word elements (para. 57). **PRINCIPLES OF EQUAL TREATMENT AND LEGAL CERTAINTY:** The principle of equal treatment has to be reconciled with the principle of legality. Each trade mark application must be subject of a full assessment on its own merits and not on the basis of the Office's previous decision-making practice (paras 71 and 73). The principle of legal certainty has also not been breached (para. 74).

T-205/17; SECURE DATA SPACE; SSP Europe GmbH v EUIPO; Judgment of 15 March 2018; EU:T:2018:150; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Figurative trade mark, Laudatory mark, Nature of the goods and services

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FACTS: The EUTM applicant sought to register the figurative sign represented below for services in Classes 38 (Providing internet access for others; Email services; Data exchange services) and 42 (Providing of memory space on the internet; providing of online storage; computer security services for secure internet access; computer system design; providing of an internet platform for exchanging data). The examiner refused to register the mark and the applicant appealed the examiner's decision. The BoA dismissed the appeal because it considered that the services covered were aimed at both the general public and the professional public, and noted that the level of attention varied from medium to high. It also considered that the word elements of the mark applied for, being literally 'secure data space', would describe the purpose of the services concerned. It added that the figurative element of the mark applied for would only reinforce the descriptive character of its word elements and concluded that the mark applied for was descriptive and devoid of distinctive character. The EUTM applicant filed an action before the 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: REGARDING THE FIRST PLEA IN LAW: the relevant public was the general public and a professional public, both English-speaking, with a level of attention that varied from medium to high (para. 15). The expression describes the intended purpose of the services offered, namely computer, internet, email and data exchange services, so it is descriptive of the services provided (para. 16). The combination of the three words 'space', 'data' and 'secure' can be understood as 'secure data space' (para. 27). So the word mark was descriptive of the services in question (para. 28). The sign indicates that the services provide a secure, virtual data space in which the consumer can store, save or retrieve data in a secure manner. The figurative element only further reinforces the descriptive character of the words, as the cloud and the two arrows pointing in opposite directions are typical symbols for data exchange and cloud computing. There is nothing unusual in the expression or the figurative elements. The connection between the services and the meaning of the sign is direct; no further reflection is needed to perceive this meaning (paras 33-36). REGARDING THE SECOND PLEA IN LAW: Since one ground of refusal is sufficient, there is no need to go into this plea in law (paras 38-40).

T-235/17; MOBILE LIVING MADE EASY; Dometic Sweden AB v EUIPO; Judgment of 22 March 2018; EU:T:2018:162; Language of the case: EN

EUTM application



SECURE DATA SPACE

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RESULT: Action dismissed

KEYWORDS: Distinctive element, Lack of reasoning, Laudatory mark, Quality of the goods and services, Slogan mark

FACTS: The applicant sought to register the word mark MOBILE LIVING MADE EASY as an EUTM for goods and services in Classes 5 to 7, 9, 11, 12, 19 to 22 and 27. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The applicant appealed and the BoA dismissed the appeal. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 94 EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

SUBSTANCE: (i) The statement of reasons for the contested decision enabled the applicant to understand how the BoA defined a homogenous category of goods and services in relation to which it used general reasoning (para. 20). By stating that the link between all the goods and services is that they 'facilitate mobile life', it found that they all had a characteristic relevant to the examination of the absolute ground for refusal regarding lack of distinctiveness and that they were all part of a homogenous category (para. 16). (ii) RELEVANT PUBLIC: The relevant public is the English-speaking public (para. 49). MEANING OF THE MARK: The relevant public will recognise in the contested mark

the mere juxtaposition of the expressions 'mobile living' and 'made easy', therefore it will perceive the meaning 'which facilitates mobile life' (para. 49). PERCEPTION OF THE MARK: That meaning has a promotional content, which communicates a laudatory message as regards quality. It merely serves to highlight positive aspects of the goods and services, namely that they make it easy to have a mobile, travelling life. The contested mark will not therefore be perceived by the relevant public as an indication of the origin of the goods and services, but as an advertising slogan (para. 50). HOMOGENEITY OF GOODS AND SERVICES: Despite their possible different characteristics, the goods and services belong to a homogenous category in the light of a common characteristic defined by reference to the meaning of the sign, namely 'which facilitates mobile life' (para. 32). It is sufficient that the goods are capable of being installed or used in vehicles serving as accommodation, such as caravans, motorhomes and boats and, as a result, facilitate mobile life (para. 43). The BoA was right in finding that the goods and services in question form a homogenous category, in that they facilitate mobile life in one way or another (para. 44).

T-60/17; TSA LOCK; Safe Skies LLC v EUIPO; Judgment of 22 March 2018; EU:T:2018:164; Language of the case: EN

RESULT: Action dismissed

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KEYWORDS: Acronym, Deceptive element, Descriptive element, Distinctive element

FACTS: The applicant sought to register the word mark TSA LOCK as an EUTM for goods and services in Classes 6, 18 and 20. An application for invalidity was filed pursuant to Article 59 in conjunction with Article 7(1)(b), (c), (d), (g) and (i) EUTMR. The Cancellation Division (CD) dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal. It found, inter alia, that the invalidity applicant had failed to establish that the sign was descriptive or devoid of any distinctive character. In that respect, it held that the relevant date for the purposes of assessing the case was that on which the application for registration of the contested EU trade mark was filed and that none of the evidence was sufficient to prove that, on the relevant date, the sign was perceived by the relevant public as descriptive or devoid of any distinctive character. The invalidity applicant filed an action before the GC relying on a single plea in law: infringement of Article 52(1)(a) in conjunction with Article 7(1)(b), (c) and (g) EUTMR.

SUBSTANCE: ARTICLE 7(1)(b) EUTMR: Since the contested mark contains a word with an English meaning, the relevant public consists of the English-speaking consumers in the EU. The relevant goods are directed both to the public at large in these Member States and to business professionals, for example manufacturers and retailers in the field of travel luggage (para. 29). The BoA was correct to hold that the relevant date was that on which

the application for registration was filed (para. 25). However, all the evidence is dated after the filing of the application for registration and/or contains material which does not relate to the situation at the date of the filing of the application for the contested mark (paras 26-27). Admittedly, the word sign 'lock', which is generally understood to mean a 'locking mechanism' or 'padlock', is not apt to distinguish such goods from those of other undertakings and therefore cannot confer on the contested mark a distinctive character (para. 34). Furthermore, there is no proof that the relevant public associates the abbreviation TSA with the 'Transport Security Administration'. Since that abbreviation lacks a meaning that could be immediately perceptible by the relevant public, the contested mark could not be understood by that public as a reference to the Transportation Security Administration (para. 39). It is in no way apparent from an overall examination of the word sign TSA LOCK that the trade mark was perceived by the relevant public at the date of filing of the application for registration as being devoid of distinctive character (para. 49). ARTICLE 7(1)(c) EUTMR: Although the word 'lock' can be regarded as descriptive of some goods and services for which this trade mark is registered, it has not been demonstrated that the general public or the relevant specialist public would understand 'TSA' as an abbreviation for Transportation Security Administration or as a reference to that American agency (paras 49-50). The use by the applicant on its own website of the expressions 'tsa luggage locks'

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and 'tsa patented locks' would only demonstrate its descriptiveness if the public understood the abbreviation TSA, which was not proven to be true (para. 51). Moreover, the adduced discussion threads did not conclusively indicate where the contributors are from. Admittedly, only one of those discussion threads pre-dates the relevant date and is written by an author identified as present in the EU. The use of the expression 'tsa lock' in that item of evidence is not sufficient to make a generalisation as to the understanding of that expression by a significant part of the relevant public (para. 52). The decisions from other trade mark offices cannot be taken into account, in part because of their dates but also because they give no indication as to the relevant public of the EU (para. 53). The BoA also referred explicitly to all evidence provided (para. 55). ARTICLE 7(1)(g) EUTMR: It cannot be held that the public will be misled as to the origin of the goods bearing the contested mark, since the sign will have no association in the public consciousness with a particular origin. It has not been proven that 'tsa lock' will be understood in the relevant territory as a reference to the American Transportation Security Administration (para. 64).

T-364/17; HOUSE OF CARS; Marcin Bielawski v EUIPO; Judgment of 17 April 2018; EU:T:2018:193; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Distinctive element, Legal certainty, Legitimate expectations, Scope of proceedings

FACTS: The applicant sought to register the word mark HOUSE OF CARS as an EUTM for goods and services in Classes 25, 35, 37 and 39. The Office refused the registration of the EUTMA pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character regarding certain services in Classes 35, 37 and 39. The applicant's appeal was dismissed by the BoA which considered it not distinctive. It found that the level of attention of the public was average or high. It also found that the sign was directly related to the contested services (which directly concern or may concern vehicles) to such an extent that the relevant public, immediately and without further reflection, would see in it the definition of the company's activity and its specialisation (the car industry). Therefore, the sign will not be perceived by the relevant public as an indication of the commercial origin of the service but just an indication of the services, industry or specialisation. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of the principles of legal certainty and legitimate expectations.

SUBSTANCE: (i) RELEVANT PUBLIC: The services concerned include both consumer services for the average consumer and services to be provided to professionals. Due to the nature of the services, 12

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the degree of attention of the relevant public will be high or at the level of an average consumer who is reasonably well informed and reasonably observant and circumspect (paras 24-25). The contested mark consists of elements that have a meaning in English and, therefore, the assessment of the nature of the mark must be carried out from the point of view of English-speaking consumers in the EU (para. 25). MEANING AND PERCEPTION OF THE MARK: The word 'house' means a house (building) but also a building having specific purpose, a company or institution. The word 'of' is a preposition or link that expresses belonging, and the word 'cars' means 'cars'. The word mark as a whole will be understood as a 'company running the vehicle-related business' or a 'car company' (para. 27). All services relate to vehicles: therefore, they share a common characteristic and they form part of a homogenous category of services. For instance, the services in Class 35 may all relate to vehicles insofar as vehicles may all be the object of auction sales, whereas services in Class 39 include all types of vehicles, namely cars (para. 38). LACK OF DISTINCTIVENESS: The sign will be perceived as an indication of the services, industry or specialisation, rather than an indication of the commercial origin of the service (para. 37). (ii) The way in which the principles of equal treatment and sound administration are applied must be consistent with respect to legality. Moreover, for reasons of legal certainty and of sound administration, the examination of any trade mark application must be undertaken in each individual

case. In the present case, the BoA duly found that the mark was devoid of distinctive character, regardless of the previous Office decisions that accepted the registration of marks containing the word element 'house of' (paras 44-45).

New decisions from the Boards of Appeal:

EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). For best results, please use either the Mozilla Firefox or Google Chrome browsers

[10/04/2018, R 2004/2017-4, EkoVital \(fig.\) / eoVital](#)

EUTM application	Earlier International Registrations
 EkoVital	eoVital

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RESULT: Decision confirmed.

KEYWORDS: Substantiation of earlier right.

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

FACTS: The opposition was based on an international registration designating the EU. No substantiation evidence was filed at first instance.

SUBSTANCE: At the appeal stage the opponent filed an extract from the EUIPO database. Apart from being belated, this evidence does not suffice to substantiate the earlier right pursuant to Rule 19 CTMIR (T-240/13, Alifoods, EU:T:2014:994, § 28-32) (§ 19, 21). The opposition shall be rejected as unfounded according to Rule 20(1) CTMIR.

05/03/2018, R 1759/2017-4, DARSTELLUNG EINES SCHWIMMERS IN STARTPOSITION (fig.)

EUTM application



RESULT: Decision annulled.

KEYWORDS: Figurative trade mark.

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

FACTS: The sign depicted a highly stylized human being in a starting position. The goods were related to swimming but the sign did not denote the act of swimming, the suitability of the goods to be worn in water, nor was it geometrically simple. The figurative sign was applied for in relation to goods in Classes 6, 9, 14, 16, 24, 25 (in particular swimming trunks, bathing suits and swimming caps; Swim gear; Footwear; Headgear; Wetsuits and drysuits for water sports), 26 and 28.

SUBSTANCE: The depiction is strongly abstracted and not naturalistic. This stylized swimmer is not yet swimming. He or she still has to jump into the water. Thus the sign can be associated much more with the competitive practice of swimming than with swimming as a type of human movement in the water.

One conceivable interpretation of the sign would be that one can jump into the water at the designated point or, conversely, that this is forbidden. In any case 'a swimmer in a start position' has nothing to do with the goods specified in the application which do not cover sporting events or the operation of swimming pools, but clothing and sporting goods. If the mark is affixed to such products, it could be

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argued that this would be perceived as an indication that the product is suitable for bathing. But such a statement remains too abstract as it only symbolizes a human person and not a commodity and therefore 'a swimmer in a start position' does not describe any characteristic of the specified goods (§ 20). The appeal is upheld.

[22/03/2018, R 307/2017-1, ebi \(fig.\)](#)

EUTM



RESULT: Decision confirmed.

KEYWORDS: Complex mark, Specialised public, Descriptive.

NORMS: Article 7(1)(c) EUTMR, Article 59(1)(a) EUTMR.

FACTS: A request for a declaration of invalidity, based on absolute grounds, of the registered mark for all the specified goods and services (in Classes 29 and 39) was filed; the cancellation applicant argued

that 'ebi' was an internationally known Japanese food term which could be translated as 'shrimp' or 'prawn'. The mark, including a common image of a shrimp, was descriptive, and had no distinctive character. In addition the term 'ebi' had become customary in the current language. The Cancellation Division upheld the application for a declaration of invalidity declaring the contested EUTM entirely invalid on the grounds of Article 7(1)(c) EUTMR.

SUBSTANCE: It is undisputed that 'ebi' is the Japanese word for 'shrimp' or 'prawn' (§ 24). This is reinforced by the graphic representation of a shrimp next to the word. The cancellation applicant has proven that at the time of the trade mark's filing, the term 'ebi' was already used to describe 'shrimps' or 'prawns' in food dictionaries, websites dedicated to cooking, Japanese food and restaurants and seafood suppliers. The relevant public, especially professionals in the field of seafood (restaurants, food wholesale and retail businesses), will establish a direct connection to the goods (fish, seafood and molluscs) and services (food delivery services) covered by the registration, and immediately understand the nature and content of those goods and services. (§ 26-28)

The Cancellation Division correctly considered that the trade mark at issue was descriptive for all its goods and services and should therefore be cancelled in its entirety (§ 33).

[23/03/2018, R 26/2018-5, MATPRAT \(fig.\)](#)

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RESULT: Decision confirmed.

KEYWORDS: Distinctive element, Geographical origin.

NORMS: Article 7(1)(j) EUTM, Article 40(1) EUTMR.

FACTS: The application was rejected on the basis of Article 7(1)(j) EUTMR, after receiving observations from the Spanish Ministry of Agriculture, Food and Environment, with regard to the goods ‘meat; poultry’ in Class 29.

Substance: It is not questioned that the PGI ‘Pollo y Capón del Prat’ covers ‘chicken and capon’ originating in Prat in the Catalan region of Spain (§ 17).

The concept of ‘evocation’ mentioned in Article 13(1) (b) of Regulation (EC) No 1151/2012 covers a situation where the term is used to designate a product which incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his or her mind is that of the product whose designation is protected

(04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 25; 26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 44) (§ 22). Contrary to the applicant’s argument, the presence of the word ‘MAT’ and the figurative elements cannot overcome the application of the concept of ‘evocation’. The presence of the word ‘PRAT’ is sufficient to evoke in the minds of a significant proportion of the Spanish-speaking public, the PGI ‘Pollo y Capón del Prat’, in particular in relation to ‘meat and poultry’ products (§ 30-31). The appeal is dismissed.

[Pollo y Capón del Prat \(PGI\)](#)

[26/03/2018, R 487/2017-2, Mclight / McDONALD’S et al.](#)

EUTM	Earlier trade marks
Mclight	McDONALD’S

RESULT: Decision annulled.

KEYWORDS: Common element, Conceptual similarity, Descriptive element, Distinctive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Reputation, Visual similarity, Weak element, Word mark.

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

FACTS: An opposition against the trade mark application was filed on the basis of Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division rejected the opposition in its entirety. Some of the goods were identical or highly similar (§ 31-36) and the signs were similar to a certain degree (§ 37-41).

SUBSTANCE: As regard Article 8(1)(b) EUTMR, the Board concludes that insofar as the earlier mark has a normal degree of distinctiveness per se and in addition to that, both the claim of reputation and that of the family of marks is upheld, in the circumstances of the present case, the identity and very high similarity between the goods at issue are such as to offset the lower degree of similarity between the signs, and, according to the principle of interdependence, there is a likelihood of confusion with respect to the goods applied for in Classes 29, and 30 (§ 47). However, since the goods in Class 5 were found dissimilar, there can be no likelihood of confusion as regards those goods (§ 48).

In relation to Article 8(5) EUTMR, the Board notes that the contested mark is likely to take unfair advantage of the distinctive character or the repute of the earlier mark and that, on this basis, the opposition would be well founded for the remaining goods in Class 5. As the applicant did not submit any comments or arguments about the existence of due cause for the use of the mark applied for, the Board

concludes that all the conditions for the application of Article 8(5) EUTMR are met and the opposition is successful (§ 73-77).

The appeal is upheld in its entirety and the contested decision must be annulled inasmuch as it rejected the opposition and allowed the contested application with respect to all the goods applied for, in Classes 5, 29 and 30 (§ 78).

See also [21/03/2018, R 620/2017-2, McSlim / McDONALD'S et al.](#)

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