

# Alicante News

Quick Links 

Up to date information on IP and EUIPO-related matters



The banner features a dark background with three stylized, 3D-printed letters 'A', 'E', and 'U' in white, light green, and wood-grain finishes. A calendar icon in the top right corner shows 'November 2017'. A dark blue box with white text reads 'DesignEuropa Awards Apply Now!'. A small photo of Leo Longauer is in the bottom left corner.

November 2017

**DesignEuropa Awards**  
**Apply Now!**

Leo Longauer talks to James Nurton

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### EUIPO announces the second edition of the DesignEuropa Awards

Following on from the highly successful first edition, the DesignEuropa Awards are now open for nominations and applications.

Organised by the EUIPO, the DesignEuropa Awards honour outstanding design, designers and businesses that have brought their designs to the marketplace with the protection of the Registered Community Design (RCD).

The Awards take place every two years.

The nomination and application period for the DesignEuropa Awards runs until 15 May 2018, and entries can be submitted through the DesignEuropa Awards website: [www.designeuropaawards.eu](http://www.designeuropaawards.eu).

The DesignEuropa Awards categories are:

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

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

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

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

Designs submitted in both the Industry and Small and Emerging categories will be assessed by the DesignEuropa Awards jury on the following criteria:

- aesthetic value and visual appeal
- demonstrable impact on the market
- sound marketing and management of design and other intellectual property rights.

All designs submitted must be valid RCDs at the time of sending the application, with no pending invalidity proceedings. Finalist designs must retain their validity throughout the selection and award period.

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The competition is open to any person, entity or institution of any nationality, either individually or as a team, provided that they own a valid RCD that is also marketed and sold (in any country).

Full details on how to apply or nominate can be found on the DesignEuropa Awards website.

The DesignEuropa Awards celebrate great companies and designers who have taken their business ideas to the marketplace with the protection of the Registered Community Design. Unlike other design awards, the DesignEuropa Awards focus on the RCD itself.

The DesignEuropa Awards ceremony will be held in November 2018 in Warsaw, in cooperation with the Patent Office of the Republic of Poland (UPRP).

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## The James Nurton Interview



**Interview: Leo Longauer, Director Global IP Enforcement, Corporate Legal Intellectual Property, Swarovski, Liechtenstein**

### How did you become interested in IP?

It was a mixture of luck and destiny. When I received my university degree in law, there was an advert for a six-month internship at the Swiss Patent and Trade Mark Office in the envelope. I thought this could be interesting so I applied and ended up staying for six years. I started out working in trade mark examination and moved up the ranks from there.



Leo Longauer

One thing I was involved in as head of a trade mark examination section was harmonising Swiss trade mark examination practices with those at the EUIPO. That was an interesting project to work on.

After that I joined a bank – not an uncommon experience in Switzerland. I was head of IP at UBS for about nine years, which saw both the golden age for banks and the banking crisis. It was an interesting move for me, mainly because it was a very international role with IP lawyers in London, New York and Hong Kong.

In IP too, it was a very interesting time. One issue we had to deal with was the growth of internet phishing. Another was patenting – this was the golden age of business method patents in the US, many of which are probably worthless now, and we built up quite a nice patent portfolio. We also had to deal with patent trolls, as banks were a natural target, and trade secrets was interesting too as we had lots of very smart people developing trading algorithms and systems. And there was generally greater interest in the relevance of IP in finance – e.g. in providing security for loan or patent funds.

As head of IP I had to oversee all of this. We had two patent lawyers on the team and we hired a patent attorney in New York, which was quite a new thing for a European bank.

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## The James Nurton Interview



After UBS I joined Virgin's branding and IP team in Geneva where I worked for a year-and-a-half. It was a compelling company to work for and I focused mainly on licensing work. I am now director of global IP enforcement for Swarovski: we have an IP team of 13, of which six are in my enforcement team. Five of these are based in our Liechtenstein headquarters and one in Shanghai.

For an IP lawyer, working at Swarovski gives an incredible playing field: we have all the different IP rights – trade marks, designs, copyright, even patents – and we have conflicts all over the planet, including both online and offline, including Customs work. As an IP lawyer, it means you get to use all your skills on a global scale, which is very gratifying. In addition, IP enjoys a high recognition within the company, making it an attractive place to work.

### Which are the key markets for you?

A significant part of our budget is spent in China, which is one of our most important markets both commercially and in terms of IP. Europe is another big focus.

China is definitely improving. The old image that the country is just full of counterfeiters and there is nothing that can be done is not true anymore. You can deal with the problem, and the system is now extremely developed with good lawyers, courts and decisions. The challenge is that it is so

big and there are so many trade marks being filed that the problem is never-ending. Once you start investigating one counterfeit case, you find 10 new targets. Another big issue in China is bad faith trade mark applications. It takes a lot of resources to fight those and you need to develop the right tactics to mitigate this threat.

### How does Europe compare?

Europe is a very sophisticated market. I think the EU trade mark system is a fantastic tool, and the RCD system is too. All forms of harmonisation are very welcome for us as a global company, despite the challenges such as proving proof of use or secondary meaning in the EU.

Where we see more issues is to do with enforcement where harmonisation is more difficult. For example, we had a case in Hungary where we obtained a favourable judgment against a website selling fake Swarovski goods. But the infringer just moved the same website to a company in Austria, and then another one in the UK, so we had to start all over again. It would be great to have easier recognition of judgments across borders.

Another thing we have noticed is that EUIPO has become stricter in its trade mark examination practice, which in fact is now closer to the Swiss practice. That's not necessarily a bad thing though.

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## The James Nurton Interview



### What do you think about design rights?

Designs are rightly simple to obtain, in particular within the EU, and they play an increasingly important role in our enforcement actions. They have a reputation as a weak right but we have been relatively successful in enforcing them in European courts, which makes them an effective tool in our enforcement arsenal.

### How big is your IP portfolio?

We have almost 5,000 trade marks and around 3,000 design rights. We do make a number of new filings each year. We are based in Liechtenstein so we tend to file trade marks in Liechtenstein and use these as the basic mark for the Madrid Protocol. Not many people know about the Liechtenstein IP office but it does exist and has two people working there – part time...!

### What do you like about working in-house?

I like that I can be part of the brand strategy at a relatively early stage. We talk to the business and marketing teams and to a certain extent we can influence the whole process. It means we can help shape it. Of course IP has a different relevance in different companies – at UBS IP was less prominent but at Swarovski we rely on it to be able to charge a brand premium. That really shows in the attitude of employees – they are very attached to the brand

and often send in reports about fakes they have seen.

### What are the most interesting cases you have worked on?

One big trade mark case when I was at UBS involved a conflict with an international delivery company with three letters starting with a U as well – there were lots of oppositions going on worldwide after they started to offer financial services for their goods delivery. That was challenging to manage but we ultimately settled.

At Swarovski one thing that is quite unique is that we sell crystals as ingredients to third parties as well as finished products. Very few companies use the same brand for ingredients and finished goods and this brings its own set of IP challenges. We have a wall of shame showing some of the things people have put Swarovski crystals on, such as walking sticks, bikinis, holsters for horses and even sex toys.

Our business set-up leads to a lot of fair use questions: people who use our crystals sometimes try to push the limits of fair use, so a big part of our role is to educate consumers about what is correct use of our brand. This puts another interesting spin on our enforcement work.

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## The James Nurton Interview



### What do you think the future will hold?

IP will remain very relevant, no doubt. The most important current challenges are in the online field. Marketplaces are becoming increasingly important and crowded with various players (including the brands themselves) selling all sorts of products, including genuine goods, grey goods and counterfeits. I think the future will be much more about collaboration with marketplaces, not just fighting counterfeiters by sending takedown requests but also educating consumers so we can catch infringements and counterfeits early or even avoid them altogether.

For example, we have built a good relationship with Alibaba and they have agreed to send all their sellers our Proper Use Guidelines on our behalf. We have already seen a number of people correct their listings as a result of that.

A lot of people are now talking about the role artificial intelligence and big data can play. For example, Alibaba have all the data available about who buys and sells on their platforms, including all monetary transactions. All this information can be used to identify bad actors. We have started to collaborate with them to track down the bad guys, who are often in the background. As a first result, last year Alibaba sued two sellers of fake Swarovski watches using this so called On-to Offline system.

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

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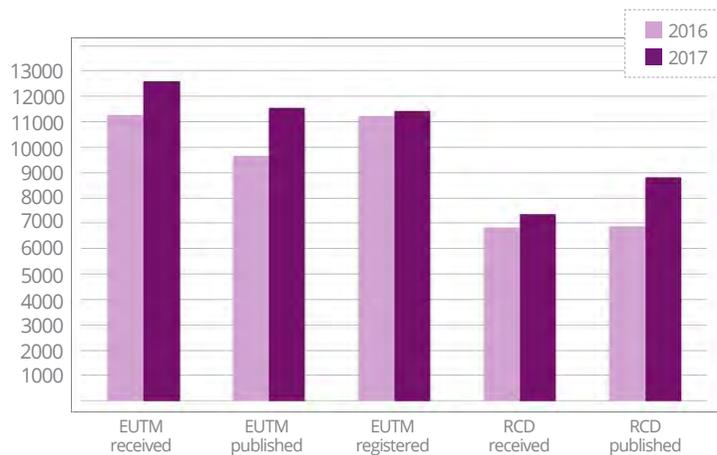


## Statistical Highlights



Monthly statistical highlights October*	2016	2017
European Union Trade Mark applications received	11 248	12 597
European Union Trade Mark applications published	9 634	11 538
European Union Trade Mark registered (certificates issued)	11 217	11 430
Registered Community Designs received	6 827	7 354
Registered Community Designs published	6 880	8 813

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



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## Argentina, Switzerland and Moldova join Designview

As of 20 November 2017, the National Institute of Industrial Property of Argentina (INPI), the Swiss Federal Institute of Intellectual Property (IPI) and the State Agency on Intellectual Property of the Republic of Moldova (AGEPI) have made their design data available to the Designview search tool.

With INPI, IPI and AGEPI on board Designview now contains data from 61 participating offices.

With the addition of more than 86,000 designs from INPI, more than 124,000 from IPI and more than 10,000 from AGEPI, Designview provides information and access to more than 12.7 million designs.

Since the introduction of Designview on 19 November 2012 the tool has served more than 3 million searches from 159 different countries, with users from Germany, the UK and Spain among the most frequent users.

## Argentina and Moldova join TMview

As of 20 November 2017 the National Institute of Industrial Property of Argentina (INPI) and the State Agency on Intellectual Property of the Republic of

Moldova (AGEPI) have made their trade mark data available to the TMview search tool.

With INPI and AGEPI on board TMview now contains data from 62 participating offices.

With the addition of more than 2.5 million trade marks from INPI and more than 40,000 from AGEPI, TMview provides information and access to more than 47.6 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 35.7 million searches from 157 different countries, with Spain, Germany and Italy among the most frequent users.

## European Cooperation: faster, more efficient Back Office for Latvian Patent Office

The Latvian Patent Office has implemented an improved version of the Back Office system, developed under the ECP2 work stream of the European Cooperation Service at EUIPO.

The Back Office system powers the processing of the complete lifecycle for trade marks and designs at national and regional IP offices.

The system was developed and implemented during the course of EUIPO's first Strategic Plan as part of the Cooperation Fund.

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The first set of improvements focused on modernising and simplifying the technology stack of the system.

The Latvian Patent Office was the first EU IP office to undertake the Back Office improvement under the new European Cooperation programme.

To implement the system, Latvian IP and IT experts worked collaboratively with the European Cooperation teams at EUIPO to ensure a seamless transition to the new system, and to deliver a better service for Latvian users.

Under the provisions of Article 151 EUTMR, EUIPO and its stakeholders are working together on five European Cooperation Projects, with a range of separate subprojects addressing different objectives.

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### DesignClass integrated in EUIPO's design e-filing

EUIPO's design e-filing is now connected to DesignClass, the online tool for harmonised product indications. This means that once users reach the product indication stage of their e-filing application, they can now browse and select terms from DesignClass.

DesignClass is the online search tool for harmonized product indications and has been designed to help users find product indications in the Harmonised Database that best match the goods to which a design applies.

DesignClass has also been integrated in other search systems with a design component, such as DesignView and eSearch Case Law.

### IP Case Law Conference 2018 – save the date!

Registration will open shortly for the second edition of the IP Case Law Conference. Like the last conference, which took place in 2016, this edition will focus on a variety of selected, essential and relevant legal trade mark and design related topics. The conference will take place on 7-8 May 2018 at EUIPO's headquarters in Alicante.

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### Luxembourg trade mark and design news

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

**Cases C-361/15P and C-405/15P (joined cases); Easy Sanitary Solutions BV v EUIPO; Judgment of 21 September 2017; EU:C:2017:720; Language of the case: NL**

**RESULT:** Actions dismissed

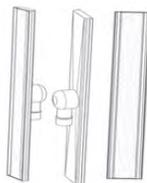
**KEYWORDS:** Novelty, Individual character, Informed User, Disclosure within the EU

**FACTS:** Easy Sanitary Solutions B.V (the applicant) registered the Community design represented below and gave as an indication of product shower drains. An invalidity action based on a prior design was filed pursuant to Articles 4 to 9 CDR. The Invalidation Division declared invalid the contested RCD due to lack of novelty. The Board of Appeal (BoA) upheld the appeal of the applicant and annulled the contested decision. The General Court (GC) upheld the action filed by the holder of the earlier design, annulling the contested decision. As regards Article 5 CDR and the examination of novelty, the GC found that any disclosure, irrespective of the product, is relevant. The reasoning is based on two distinct pillars: i. since the scope of protection is not limited to the

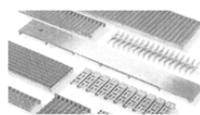


product indicated in the application (Article 36(6) and 19(1) CDR), it would be paradoxical if a RCD was immune against the disclosure of earlier design applied to a different product while this RCD gave the right to oppose the use of the earlier design; ii. a literal interpretation of Article 7 CDR leads to the conclusion that the 'sector concerned' is that concerned by the disclosed design, not that of the contested RCD. As regards Article 6 CDR and the examination of individual character, the GC held that it cannot be assumed that the informed user of the 'shower drains' (contested RCD) is aware of the existence of the earlier design which may pertain to a totally different industrial field. It is only if this knowledge is established that the earlier design can rule out the individual character of the contested RCD (para. 132). The applicant filed an appeal before the Court of Justice of the European Union (CJEU).

#### Contested RCD



#### Earlier design



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**SUBSTANCE:** 1. Regarding the plea related to the infringement of the principles governing the BURDEN OF PROOF, the CJ found that it is for the invalidity applicant to identify what the 'earlier design' is, and not for the Office to deduce it from the evidence. In this case, the GC erred in criticising the BoA for not having compared the contested RCD with 'the entirety of the liquid drainage device' marketed by the invalidity applicant. The GC thus erred in law when requiring the Office to combine extracts from various catalogues in order to identify the earlier design. According to Article 63(1) CDR, in proceedings relating to a declaration of invalidity the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties (paras 56-60). As to the ASSESSMENT OF NOVELTY, the CJEU criticised the GC for holding that, where a design is made up of several elements, it must be considered disclosed where those elements were disclosed, even separately, provided it is clear that these elements are intended to be combined in order to constitute a predetermined product. The CJ clarified that the contested design must be compared with earlier individualised and defined designs and not with a combination of designs that have already been made available to the public (paras 61, 65, 69). However, the CJ did not invalidate the contested judgment since its operative part is well founded in other legal grounds (paras 73 to 77).

2. As regards to the DISCLOSURE of the earlier design, the CJ confirmed that the product in which this earlier design is incorporated is irrelevant when comparing it with the contested RCD for the purpose of examining the latter's novelty: an RCD 'cannot be regarded as being new (...) if an identical design has been made available to the public before the dates specified in that provision, even if that earlier design was intended to be incorporated into a different product or to be applied to a different product' (para. 96).

3. As to the plea related to the assessment of the INDIVIDUAL CHARACTER of the contested design, the CJ stated that the GC erred in law when requiring knowledge, by the informed user of the product in which the contested RCD is incorporated, of the earlier design where this earlier design is incorporated in a different product (para. 126). According to the CJEU, the prior art is composed of all designs disclosed pursuant to Article 7 CDR, that is, all designs known to the professional circles, not to the (non-professional) informed users. Thus, for the purpose of applying Article 6 CDR, the informed user must be assumed to have knowledge of the entirety of the prior art, even if such prior art includes designs which are incorporated in products which belong to industrial sectors that are different from that of the contested RCD (paras 130-133).

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**Case C-56/16P; EUIPO v Instituto dos Vinhos do Douro e do Porto IP; Judgment of 14 September 2017; EU:C:2017:693; Language of the case: EN**

**RESULT:** Action upheld (GC judgment annulled)

**KEYWORDS:** Geographical origin, Free movement of goods

**FACTS:** The EUTM proprietor registered a EUTM for the word sign PORT CHARLOTTE for goods in Class 33. The invalidity applicant filed an application for a declaration of invalidity pursuant to Article 53(1) (c) read in conjunction with Article 8(4), Article 52(1) (a) read in conjunction with Articles 7(1)(c) and (g) of the EUTMR and Article 53(2)(d) EUTMR. In response to the application, the EUTM proprietor limited the list of goods to the following description: whisky. The Cancellation Division rejected the application for a declaration of invalidity. The invalidity applicant filed an appeal which was dismissed by the Board of Appeal (BoA) and lodged an appeal before the General Court (GC) relying on one plea in fact and five pleas in law. The GC upheld the third plea and the first part of the fourth plea, inasmuch as those pleas essentially criticised the BoA for not applying the relevant rules of Portuguese law relating to the protection of the appellations of origin Porto or Port and rejected the other pleas. The Office brought an appeal against the GC judgment. The invalidity applicant (appellant before the GC) brought a cross-appeal against the same judgment.

### EUTM

PORT CHARLOTTE

### Earlier right

Porto/Port

**SUBSTANCE:** The Office relied on a single ground of appeal, alleging an infringement of Article 53(1) (c) EUTMR, read in conjunction with Articles 8(4) and 53(2)(d) EUTMR (para. 33). The invalidity applicant (appellant before the GC) put forward in support of its cross-appeal three grounds of appeal (para. 50). With regard to the first ground of the cross-appeal, the Court of Justice of the European Union (CJ) found that the GC did not err in law by applying to the system provided for by the Regulation No 1234/2007 the principles laid down by the CJ in the judgment *Budějovický Budvar (C-478/07)* regarding the uniform and exclusive nature of the system of protection provided for by Regulation No 510/2006 (para. 75). It held that although the system of protection established by Regulation No 1234/2007 is not identical to that provided for by Regulation No 510/2006, the GC was right in holding that the two systems had essentially the same in nature, since their objectives and characteristics were similar. In analysing the objectives of the system of

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protection of Regulation No 1234/2007, the CJ drew an analogy with the conclusions in *Budějovický Budvar*. Consequently, the CJ concluded that the GC was right in holding, as regards the designations of origin 'Porto' or 'Port', which are protected under Regulation No 1234/2007, that it contains a uniform and exclusive system of protection, resulting that the BoA did not have to apply the relevant rules of Portuguese law (para. 96). With regard to the single ground of appeal in the main appeal, the CJ reaffirmed that the system provided for by Regulation No 1234/2007 is exhaustive in nature, with the result that it precludes the application of a national system of protection for geographical indications that are protected under that regulation (para. 103). In this light, the CJ found that the GC erred in law in holding that the protection conferred on protected designations of origin and geographical indications under Regulation No 1234/2007 may be supplemented by the relevant national law granting additional protection (para. 108) and upheld the single ground of appeal in the main appeal (para. 109). With regard to the second ground of appeal in the cross-appeal, alleging infringement of Article 118(m)(2)(a) of Regulation No 1234/2007, the CJ found that the incorporation in a trade mark of a protected designation of origin (PDO) cannot exploit the reputation of such PDO if the relevant public does not associate that mark or the goods in respect of which it is registered with the PDO or the product protected by the PDO. The GC assessment of the facts of the perception of the trade marks is

not open to challenge. It is not established that there was a manifest distortion of evidence (paras 113-116). Therefore, the second ground of appeal in the cross-appeal was rejected (para. 119). The third ground of appeal of the cross-appeal concerned the alleged infringement of Article 118(m)(2)(b) of Regulation No 1234/2007 namely that the contested mark 'Port Charlotte', which was registered in respect of a whisky did not involve 'misuse, imitation or evocation', within the meaning of that provision, of the protected designation of origin Porto or Port (para. 120). The CJ found that the GC without erring in law, applied the fundamental criterion deriving from the case law by holding that even though the term 'port' forms an integral part of the contested mark, the average consumer, even if he is of Portuguese origin or speaks Portuguese, in reaction to a whisky bearing that mark, will not associate it with a port wine covered by the designation of origin in question (para. 124). The CJ further stated that the assessments carried out by the GC to conclude on the lack of evocation are factual assessments and the appellant before the GC had not established that there was any distortion of the evidence (para. 126). The ground was rejected (para. 127). Consequently, the main appeal was upheld and the cross-appeal dismissed. The CJ ordered the judgment of the GC to be set aside (para. 128).

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

**Case T-411/15; PP Gappol Marzena Porczyńska v EUIPO; Judgment of 4 October 2017; EU:T:2017:689; Language of the case: EN**

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

**KEYWORDS:** Ancillary appeal, Claim for alteration of EUIPO decision, Clarity of party submission, Conceptual similarity, Functional continuity, Identity of the goods and services, Lack of reasoning, Likelihood of confusion, Phonetic similarity, Reputation, Similarity of the signs, Unfair advantage, Visual similarity

**FACTS:** The applicant sought to register the mark represented below as an EUTM for goods and services in Classes 20 and 25. An opposition based on the earlier word mark GAP, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The Opposition Division (OD) partly upheld the opposition in respect of goods in Class 25 (likelihood of confusion) and rejected it in respect of goods in Class 20. The Board of Appeal (BoA) dismissed the applicant's appeal and upheld the opponent's ancillary appeal in respect of Class 20 goods furniture. It found that there was a likelihood of confusion for the identical



goods in Class 25 and that there is unfair advantage taken from the distinctiveness of the earlier mark if the contested mark is used for furniture in Class 20. The applicant filed an action before the General Court (GC) relying on 5 pleas in law: (i) Infringement of Article 59 EUTMR and of Article 64(1) EUTMR, (ii) Infringement of Article 75 EUTMR and Rule 50(2) (h) EUTMR, (iii) Infringement of Article 76 EUTMR, (iv) Infringement of Article 8(1)(b) EUTMR and Infringement of Article 8(5) and 9(1)(c) EUTMR and Rule 19(2)(c) EUTMR. The GC partly upheld the appeal.

#### EUTM application

#### Earlier mark

**SUBSTANCE:** The GC has confirmed that the BoA was entitled to examine and uphold the opponent's ancillary appeal (paras 24-36). The public has an average degree of attention. The goods are identical. The signs are visually and aurally similar to (at least) average degree, and they have a certain conceptual similarity for a part of the public. There

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is a likelihood of confusion (paras 38-109). There is no breach of duty to state reasons (paras 110-138). The GC accords certain probative value to the documents coming from the opponent in order to prove reputation of the earlier mark (paras 162-167). The BoA was correct to uphold OD's finding that there is reputation of the earlier mark. But the BoA did not determine the strength of that reputation. There is a very limited degree of proximity between furniture in Class 20 and clothing, footwear, headgear in Class 25. The BoA could have upheld the opposition on the basis of Article 8(5) EUTMR only if it had found that the earlier mark had acquired a sufficiently strong reputation or a sufficiently high degree of distinctiveness. As the strength of reputation was not established, the BoA infringed Article 8(5) EUTMR.

**Case T-670/15; Osho Lotus Commune e. V. v EUIPO; Judgment of 11 October 2017; EU:T:2017:716; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Contrary to public policy or principles of morality

**FACTS:** An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b), (c) and (f) EUTMR against the word mark OSHO for services in Class 41 Educational

services; yoga instruction and Class 42 Religious services; meditation services. The Cancellation Division rejected the application. The Board of Appeal (BoA) dismissed the applicant's subsequent appeal. The BoA found that there was no evidence that OSHO beyond being a personal name and a reference to his teachings has acquired over the years a descriptive meaning with regard to a specific type of education, yoga practice, meditation technique or religious service. The BoA found also that the use of the name of a spiritual leader in relation to the services at hand could not be considered as offensive by the relevant public. The applicant filed an action before the General Court (GC) relying on three pleas in law, namely infringement of Article 7(1)(b), infringement of Article 7(1)(c) and infringement of Article 7(1)(f) EUTMR. The GC dismissed the action.

**EUTM**

**OSHO**

**SUBSTANCE:** The GC found that the BoA made a mistake by defining the relevant public, wrongly considering that the services in question address only the general public who is deemed to be reasonably well-informed and reasonable observant and circumspect. By referring to previous case-law the GC found that these services are directed also at a specialised public with knowledge in the fields of yoga, meditation and spirituality. Despite

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this wrong assessment by the BoA, which would be as such a sufficient reason for the annulment of the contested decision, the GC proceeded with the analysis in order to establish whether as of the date of registration of the contested EUTM (1999), the mark possessed distinctive character in relation to the relevant public as defined by the GC. The GC found that the BoA did not err in the assessment of the evidence and confirmed the conclusion that the relevant public in 1999 could not establish a direct and immediate connection between the word 'OSHO' and the description of the specific content of educational services; yoga instruction and religious services. In relation to meditation services the GC found that the word 'OSHO' and even the combination 'Osho-Meditations' as of the time of the filing of the trade mark (1999) was eventually known only to an insignificant part of the relevant public in Germany. Therefore, the BoA was right to conclude that the contested trade mark is not descriptive in relation to meditation services either. In relation to the claim pursuant to Article 7(1)(f) EUTMR the GC found on one hand that the word 'OSHO' as such is in no way offensive for the relevant public. Moreover, it was registered in relation to spiritual services — the ones promoted by 'OSHO' himself, so that in the eyes of the relevant circles it can in no way be perceived as offensive or harming. On the other hand, even if it cannot be excluded that

monopolising the name of a spiritual teacher for commercial purposes can be perceived as offensive and against public order, in this particular case this has not been proven. The GC reasoned that it cannot be inferred from the evidence that a significant part of the relevant public in Germany and in Europe knew 'OSHO' as a spiritual teacher as of the filing date of the application (1999) so as to perceive the registration of the mark as contrary to public policy. Without going into the question of admissibility the GC addressed also the applicant's claim raised for the first time in the oral hearing, namely breach of Article 9(1) of the European Convention on Human Rights according to which everyone has the right to freedom of thought, conscience and religion. The GC stated that the applicant did not provide reasons and did not explain why the registration of the trade mark OSHO will deprive the applicant from the right to freedom of thought, conscience and religion, in particular how this registration would prejudice its rights to change religion or belief or the freedom to profess the latter. The mere claim that the monopolising of the name of a spiritual teacher will prevent the applicant from professing its belief is not enough to justify a finding of a breach against public order.

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**Case T-685/15; Sulayr Global Service v EUIPO; Judgment of 26 October 2017; EU:T:2017:761; Language of the case: ES**

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

**KEYWORDS:** Likelihood of confusion, Dissimilarity of the goods and services

**NORMS:** Article 8(1)(b) EUTMR

**FACTS:** The applicant sought to register as an EUTM the figurative mark reproduced below for services in Classes 39 transport of plastic materials, and 40 recycling, treatment and transformation of plastic materials; and selection of recyclable material (transformation). An opposition based on the earlier Spanish word mark SULAYR (Class 42, industrial analysis services and legal services), was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) upheld the opponent's appeal. It found that there was an average degree of similarity between the services applied for in Class 40 and industrial analysis services designated by the earlier mark in Class 42, since they are related to the conservation of the environment and are complementary. As the signs were found highly similar, the BoA stated that there was a likelihood of confusion. The applicant filed an action before the General Court (GC) alleging the infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal.

### EUTM application



### Earlier trade mark

SULAYR

**SUBSTANCE:** DISSIMILARITY OF THE SERVICES: Although the BoA based its finding of similarity of the services on the fact that they are both related to the conservation of the environment in an industrial context, the GC disagreed and stated that the scope of the conflicting services is not among the relevant factors expressly laid down by the case-law. The nature and purpose of the services differ in so far that those in Class 42 consist essentially of a consultancy activity, while those in Class 40 are related to the treatment of certain materials, whose objective is the management of waste. The possible existence of a relation with environmental protection cannot characterise significantly the relation between the conflicting services and thus is not sufficient to conclude that they are similar (para. 30). Regarding the complementarity of the services, the GC held that, although the conflicting services were targeting the same public, the BoA did

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not base its assessment on the fact that industrial analysis services were essential or important for the use of the services applied for in Class 40 (para. 36). The fact that the services are naturally and frequently used together is not sufficient to establish that they are complementary (para. 40). The GC insisted on the fact that, in order to assess the similarity of the services, only those protected by the conflicting marks must be taken into account, and not those that are actually used. Therefore, a copy of the corporate purpose indicating the services actually used is not relevant to assess the complementarity of the conflicting services (para. 43). As it had not been established that the services at issue were complementary or perceived by the relevant public as having the same commercial origin, the GC found the services dissimilar (paras 44 to 48).

**Case T-717/16; Waldhausen GmbH & Co. KG v EUIPO; Judgment of 26 September 2017; EU:T:2017:667; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Figurative trade mark

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods in Classes 9, 18, 25 and 28. 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 Board of Appeal dismissed the applicant's appeal. It found that the EUTMA shows a true-to-life silhouette of a horse's head without any peculiarities. The goods are related to horse riding and keeping. For the public at hand, which include horse riders and keepers, the EUTMA lacks distinctive character. The applicant filed an action before the General Court (GC) relying on an infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application



**SUBSTANCE:** Even if parts of the relevant goods are sold in specialised stores for equestrian gear, the relevant public's attention is not necessarily high. Goods such as clothing and accessories vary in quality and price. Sports glasses and bags may be purchased without specific knowledge and by the general public. Furthermore, a relevant part of the public displaying only low degree of attention may not be excluded. In any event, even for a highly attentive public a figurative mark may lack distinctive character (paras 25-31). The relevant public may be accustomed to animal representations placed on

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specific parts of the goods being used to indicate a specific commercial origin. However, the distinctive character under Article 7(1)(b) EUTMR cannot depend on a particular marketing method and it is thus irrelevant for its assessment (paras 38-43). None of the silhouette's features gives rise to an impression which is sufficiently distinct from a simple representation of a horse's head. Furthermore, in respect of accessories for animals such as leather goods or bags, true-to-life or stylised images of animals regularly indicate their relevant genus. Therefore, the EUTMA will be perceived as a general indication for horses, the area for which the goods are used, and it thus lacks distinctive character (paras 48-53).

**Case T-704/16; Murka Ltd. v EUIPO; Judgment of 17 October 2017; EU:T:2017:728; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Distinctiveness acquired by use

**FACTS:** The applicant filed an application for the registration as EU trade mark for the word mark represented below in respect of the services in Class 41. The examiner rejected the application for registration on the ground that the mark



### EUTM application

#### SCATTER SLOTS

applied for fell under the grounds for refusal set out in Article 7(1)(b) and (c) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC) relying on three pleas in law, i.e. infringement of Article 7(1)(c) EUTMR, infringement of Article 7(1)(b) EUTMR and infringement of Article 7(3) EUTMR. The GC dismissed the appeal.

**SUBSTANCE:** ADMISSIBILITY: The GC rejected as inadmissible the applicant's claim requesting that the registration of the mark applied for be allowed. Moreover, the GC declared inadmissible the evidence submitted by the applicant for the first time before the GC. The GC endorsed the BoA's findings that the level of attention of the relevant public ranged from normal to high (para. 28). However, differently from the BoA, the GC considered that the words 'scatter' and 'slots' are not basic English words that would be understood throughout the EU. Therefore, the assessment of the absolute ground for refusal was limited to the English-speaking part of the relevant public (paras 30-32). The GC confirmed that the relevant public would perceive the combination of the words 'Scatter Slots' as designating 'services connected with gambling machines characterises by the "scatter" function' (para. 40). Therefore, the

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mark was found to be descriptive of the subject matter of the services covered by the mark (para. 47). Moreover, the GC confirmed that the BoA was entitled to adopt general reasoning with regard to all the services in question because they all cover gaming services related to slot machines, including provided by means of the internet or mobile phones (para. 53). The GC considered that there was no need to rule on the alleged infringement of Article 7(1)(b) EUTMR since the mark applied for had already been refused under Article 7(1)(c) EUTMR (para. 59). Finally, the GC rejected the applicant's arguments that the BoA failed to find that the mark applied for had acquired distinctiveness through use under Article 7(3) EUTMR. It was acknowledged that the submitted evidence shows that there was some use but it was not sufficient to show that the mark applied for had acquired distinctive character (paras 60-79).

**Case T-421/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:615; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Slogan mark, Laudatory mark

**FACTS:** The applicant sought to register the word mark Beste Oma as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly understandable for the relevant German speaking public with an average level of attention in its laudatory meaning of 'Grandma is the best!'. The sign merely conveys the message that the goods belong to 'the best Grandma', are suitable as gifts and will be understood by the addressee as an expression of gratefulness or personal affection, but not as a source indicator.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.

### EUTM application

Beste Oma

**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Beste Oma' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to

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be understood as a laudatory message of personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual family situation. Therefore, the connection between all the claimed goods and the laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Beste Oma' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA, which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Beste Oma' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about a family member, particularly about grandmothers. It does not contain any additional elements that would trigger a thought process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

**Case T-422/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:606; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to register the word mark Beste Mama as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7 (1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly understandable for the relevant German speaking public with an average level of attention in its laudatory meaning of 'Mummy is the best!'. The sign merely conveys the message that the goods belong to 'the best Mummy', are suitable as gifts and will be understood by the addressee as an expression of gratefulness or personal affection, but not as a source indicator.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.

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### EUTM application

#### Beste Mama



**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Beste Mama' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to be understood as a laudatory message of personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual family situation. Therefore, the connection between all the claimed goods and the laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Beste Mama' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA, which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Beste Mama' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement

campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about a family member, particularly about mothers. It does not contain any additional elements that would trigger a thought process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46 and 47). Based on the foregoing, the action was dismissed.

**Case T-449/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:610; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to register the word mark Bester Opa as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly

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understandable for the relevant German speaking public with an average level of attention in its laudatory meaning of 'Grandpa is the best!'. The sign merely conveys the message that the goods belong to 'the best Grandpa', are suitable as gifts and will be understood by the addressee as an expression of gratefulness or personal affection, but not as a source indicator.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.

### EUTM application

Bester Opa

**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Bester Opa' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to be understood as a laudatory message of personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual family situation. Therefore, the connection between all the claimed goods and the

laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Bester Opa' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA, which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Bester Opa' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about a family member, particularly about grandfathers. It does not contain any additional elements that would trigger a thought process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46, 47).

Based on the foregoing, the action was dismissed.

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**Case T-450/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:609; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to register the word mark Beste Freunde as an EUTM for goods in Classes 3, 9, 14, 18, 20, 21, 25 and 33. The examiner refused the application as non-distinctive based on Article 7 (1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly understandable for the relevant German speaking public with an average level of attention in its laudatory meaning concerning close friends. The sign merely conveys the message that the goods belong to 'best friends', are suitable as gifts and will be understood by the addressees as an expression of gratefulness or personal affection, but not as a source indicator.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.



**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Beste Freunde' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to be understood as a laudatory message of personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual situation. Therefore, the connection between all the claimed goods and the laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Beste Freunde' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA, which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Beste Freunde' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about friendship. It does not contain any additional elements that would trigger a thought process and convey a minimum degree

### EUTM application

Beste Freunde

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of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

**Case T-451/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:608; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to register the word mark Bester Papa as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly understandable for the relevant German speaking public with an average level of attention in its laudatory meaning of 'Daddy is the best!'. The sign merely conveys the message that the goods belong to 'the best Daddy', are suitable as gifts and will be understood by the addressee as an expression



of gratefulness or personal affection, but not as a source indicator. The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.

### EUTM application

#### Bester Papa

**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Bester Papa' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to be understood as a laudatory message of personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual family situation. Therefore, the connection between all the claimed goods and the laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Bester Papa' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA,

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which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Bester Papa' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about a family member, particularly about fathers. It does not contain any additional elements that would trigger a thought process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

**Case T-452/16; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:614; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to register the word mark Beste Freundin as an EUTM for goods in Classes 3,



9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the trade mark consists of a combination of words, which is grammatically correctly construed and directly understandable for the relevant German speaking public with an average level of attention in its laudatory meaning concerning 'the best girlfriend'. The sign merely conveys the message that the goods belong to 'the best girlfriend', are suitable as gifts and will be understood by the addressee as an expression of gratefulness or personal affection, but not as a source indicator.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(b) EUTMR.

### EUTM application

#### Beste Freundin

**SUBSTANCE:** The GC noted that the EUTMA consists of a classic slogan, which is grammatically correct and which merely conveys a laudatory message of personal affection. 'Beste Freundin' is a rather banal slogan that the relevant public is used to in various contexts. Contrary to what the applicant claims, it does not take several mental steps for the slogan to be understood as a laudatory message of

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personal affection. All the goods at issue can serve as presents and are offered in a way that allows consumers to choose presents or goods specifically tailored for their individual situation. Therefore, the connection between all the claimed goods and the laudatory slogan is concrete enough to prevent the application from fulfilling its essential function as an indicator of source (para. 31).

The banal character of the EUTMA is reinforced by various examples, which can be found on the internet and which use the slogan 'Beste Freundin' on goods similar to those listed in the EUTMA's specification coffee mugs, pillows, t-shirts etc. (para. 36). The BoA, which in its examination of the distinctiveness of the EUTMA had rightly relied on 'common knowledge' for its finding that 'Beste Freundin' or similar slogans are attached to similar goods as the ones at issue, was not obliged to prove this well-known fact with concrete evidence or examples from advertisement campaigns (para. 40).

The EUTMA merely and exclusively contains a laudatory message about friendship. It does not contain any additional elements that would trigger a thought process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44).

Finally, the BoA is not bound by previous decisions or former Office practice concerning allegedly 'similar' registrations (paras 46, 47). Based on the foregoing, the action was dismissed.



**Case T-779/16; Lothar Rühland v EUIPO; Judgment of 28 September 2017; :EU:T:2017:674; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Freedom of designer, Individual character, Informed user, Overall impression

**FACTS:** The applicant obtained the registration of the design represented below for lights. An application for invalidity was filed by the other party, based on Article 25(1)(b) and (d) CDR, arguing that the contested RCD is not new, lacks individual character and is in conflict with the other parties' earlier RCD, represented below.

The Invalidity Division (ID) upheld the application for invalidity and declared the contested RCD invalid due to a lack of individual character. The Board of Appeal (BoA) confirmed the ID decision and rejected the applicant's appeal. The BoA, in essence, argued that the overall impression of the RCD's is the same and that the freedom of the designer in respect of lamps is not restricted. The BoA emphasised in particular that the claimed form of a pyramid of the upper arm of the star-shaped RCD cannot be inferred from the submitted images. The differences between the RCD's at issue, which consist in a different width of the upper and lower arms of the contested star-shaped RCD, are only visible after close inspection of the lateral view and cannot constitute an individual character. The applicant filed an action

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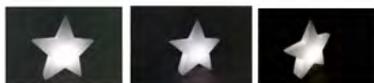
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before the General Court (GC), relying on one single plea in law, i.e. infringement of Article 25(1)(b) CDR in conjunction with Article 6 CDR. The GC dismissed the appeal.

### EUTM application



### Earlier trade mark



**SUBSTANCE:** The GC confirmed the BoAs findings concerning the informed user, who — due to his knowledge of available lamps in the market — is aware that they usually have a housing, in which a means of illumination, normally a light bulb, is contained (para. 21). The designer's degree of freedom in the case of lamps is restricted insofar as, in the case of lamps with housings, the latter have to be capable of receiving customary means of illumination. However, the designer is not subject to any restrictions in the specific design of the lamps (para. 25).

The BoA rightly found the overall impression of the RCD's to be determined by the following identical



features: (i) the lamp consists of a housing; (ii) the housing is in a light-coloured shade; (iii) the housing is in the shape of a star with five star arms (iv) the housing stands on the two lower star arms; (v) the inside of the housing is brighter in the shape of a circle than the star arms. The only differing visible feature of the RCD's is that, in the contested RCD, the width of the upper star arm runs obliquely upwards and forms a triangle, whereas in the earlier RCD all star arms have the same width (paras 31-38).

As regards the overall impression, the star shape of the lamp housing has the greatest significance in the overall impression of the features of the two RCD's. The only difference between the RCD's, namely the width of the upper star arm of the contested RCD, cannot substantiate the individual character of the RCD. In light of the numerous common features of the RCD's, which are part of the most visible and most important elements, the only described difference cannot lead to a different overall impression for the informed user (paras 42, 43).

The applicant's claim that the common feature (v) — the inside of the housing appears brighter than the star arms — as a mere technical feature is of less importance for the overall impression cannot succeed. Even if the lesser importance of this technical feature for the overall impression was assumed, the fact remains that the RCD's also coincide in various other non-technical features (para. 52).

Finally, the applicant's claim that the informed user is familiar with star-shaped lamps and therefore

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attaches less importance to the five coinciding features of the RCD's in question results from a misinterpretation of the term 'informed user'. The 'informed user', despite being familiar with various designs in a certain commercial area, is not a designer or technical expert himself. The applicant's interpretation of 'informed user' would erroneously imply very thorough knowledge about the state-of-the-art technology of lamps (para. 53). Based on the foregoing, the action was dismissed.

**Case T-336/16; Versace 19.69 Abbigliamento Sportivo Srl v EUIPO; Judgment of 5 October 2017; EU:T:2017:691; Language of the case: IT**

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

**KEYWORDS:** Proof of use, Identity of the goods and services, Nature of goods and services, Purpose of the goods and services

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods in Classes 9, 24 and 25. An opposition based, inter alia, on the earlier word mark VERSACE, registered for goods in Classes 9, 24 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partially upheld the opposition and allowed



the registration of the mark for goods in Class 9, apart from optical apparatus, glasses, sunglasses and lenses. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC) requesting the GC to annul the contested decision.

### EUTM application



### Earlier trade mark

VERSACE

**SUBSTANCE:** The applicant claimed that registration of the EUTMA was allowed under an agreement signed with the opponent. The GC pointed out that the applicant must clearly indicate which provisions of this agreement are relevant for the case, since the GC cannot search for such provisions in the evidence (para. 33). Regarding the PROOF OF USE filed by the opponent, the GC challenged the BoA's decision in respect of goods in Class 24: the opponent has not proven the use of its sign for textiles but only for household linen, which

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forms an autonomous sub-category consisting of textiles for domestic use only (paras 51-54). On the contrary, the GC rejected the motion filed by the applicant for goods in Class 25, considering that it is not possible to distinguish a sub-category of luxury clothing within the general category of clothing (para. 58). As to the SIMILARITY BETWEEN THE GOODS in Class 9, the GC confirmed the general principle according to which the products can be considered as identical when the goods designated by the trade mark application are included in a more general category, designated by the earlier trade mark, also bearing in mind their nature, their final use and destination. Thus, it concluded that optical apparatus, glasses, sunglasses and lenses fall within the general category of spectacles. With respect to the SIMILARITY BETWEEN THE SIGNS, the GC rejected the applicant's claim aimed at comparing the requested sign with the earlier figurative trade mark. To this regard, the GC reminded that, pursuant to Article 65 of Regulation No 207/2009, it might only carry out a review of the legality of the BoA's decision but it does not have the power to substitute its own reasoning for that of the BoA (paras 84-88).



**Case T-316/16; Moravia Consulting spol. s r.o. v EUIPO; Judgments of 12 October 2017; EU:T:2017:717; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complementary evidence, Non-registered trade mark, Substantiation of earlier right

**FACTS:** The applicant sought to register the word mark represented below for goods in Class 9. An opposition based on the earlier non-registered trademark identical to the trade mark applied for was filed pursuant to Article 8(4) EUTMR. The Opposition Division dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the General Court (GC). The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 76(1) EUTMR, (ii) infringement of Article 52(1)(b) EUTMR.

### EUTM application

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**SUBSTANCE:** A bad faith plea is inadmissible in the context of opposition proceedings (para. 26-31). The opponent must provide evidence of national law before the EUIPO (para. 38-43). Such evidence cannot be filed for the first time before the BoA, if there is no evidence filed before OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence filed for the first time before it, as it could not be considered additional or supplementary (para. 38-61). The evidence produced by the opponent for the first time at the hearing is inadmissible (para. 63). Even if the evidence was to be considered additional or supplementary, the discretion would have had to be exercised in the negative, because the opponent had to be aware, also because of the standard letter sent by OD on how to prove its case, that it had to produce some evidence to establish the content of the national law before OD. The principle *iura novit curia* is not applicable, national law is a matter of fact. It is only in circumstances where the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).



**Case T-317/16; Moravia Consulting spol. s r.o. v EUIPO; Judgments of 12 October 2017; EU:T:2017:718; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complementary evidence, Non-registered trade mark, Substantiation of earlier right

**FACTS:** The applicant sought to register the word mark represented below for goods in Class 9. Opposition based on the earlier non-registered trademark identical to the trade mark applied for was filed pursuant to Article 8(4) EUTMR. The Opposition Division dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the General Court (GC). The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 76(1) EUTMR, (ii) infringement of Article 52(1)(b) EUTMR.

### EUTM application

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**SUBSTANCE:** A bad faith plea is inadmissible in the context of opposition proceedings (para. 26-31). The opponent must provide evidence of national law before the EUIPO (para. 38-43). Such evidence cannot be filed for the first time before the BoA, if there is no evidence filed before OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence filed for the first time before it, as it could not be considered additional or supplementary (para. 38-61). The evidence produced by the opponent for the first time at the hearing is inadmissible (para. 63). Even if the evidence was to be considered additional or supplementary, the discretion would have had to be exercised in the negative, because the opponent had to be aware, also because of the standard letter sent by OD on how to prove its case, that it had to produce some evidence to establish the content of the national law before OD. The principle iura novit curia is not applicable, national law is a matter of fact. It is only in circumstances where the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).



**Case T-318/16; Moravia Consulting spol. s r.o. v EUIPO; Judgments of 12 October 2017; EU:T:2017:719; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complementary evidence, Non-registered trade mark, Substantiation of earlier right

**FACTS:** The applicant sought to register the word mark represented below for goods in Class 9. Opposition based on the earlier non-registered trademark identical to the trade mark applied for was filed pursuant to Article 8(4) EUTMR. The Opposition Division dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the General Court (GC). The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 76(1) EUTMR, (ii) infringement of Article 52(1)(b) EUTMR.

### EUTM application

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### Earlier right

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**SUBSTANCE:** A bad faith plea is inadmissible in the context of opposition proceedings (para. 26-31). The opponent must provide evidence of national law before the EUIPO (para. 38-43). Such evidence cannot be filed for the first time before the BoA, if there is no evidence filed before OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence filed for the first time before it, as it could not be considered additional or supplementary (para. 38-61). The evidence produced by the opponent for the first time at the hearing is inadmissible (para. 63). Even if the evidence was to be considered additional or supplementary, the discretion would have had to be exercised in the negative, because the opponent had to be aware, also because of the standard letter sent by OD on how to prove its case, that it had to produce some evidence to establish the content of the national law before OD. The principle iura novit curia is not applicable, national law is a matter of fact. It is only in circumstances where the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).



**Case T-878/16; Ino Karelia v EUIPO; Judgment of 6 October 2017; ECLI:EU:T:2017:702; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Geographical origin, Descriptive element, Nature of goods and services, Purpose of the goods and services

**FACTS:** The applicant sought to register the word mark KARELIA as an EUTM for goods in Class 4. The Office dismissed the application pursuant to Article 7 (1)(b) and (c) EUTMR and Article 7(2), as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) requesting the GC to annul the contested decision.

### EUTM application

KARELIA

**SUBSTANCE:** With its first plea, the applicant contested the BoA's decision when it found the sign to be descriptive of the requested goods. The GC reminded that Article 7(1)(c) EUTMR prevents the registration of signs which may serve to designate the geographical origin of the categories of goods for which registration of the sign is applied for,

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because: i. These signs should remain available to the public; ii. They may be an indication of quality of the categories of goods concerned and influence consumer tastes (paras 14-15). In order to make this assessment, the Office should verify if the geographical name is known by the relevant public. The GC confirmed the finding of the BoA's decision when it states that the relevant public is composed by the general public in Finland and Sweden, considering that the word 'Karelia' refers to a region situated in Finland with historical connections to Sweden (para. 20). Furthermore, since that region has a reputation for the production of biomass and biofuels, that relevant public can easily make a connection between the requested sign and goods in Class 4 (para. 22). Finally, the GC reminded that according to Article 7(1)(c) EUTMR and to the settled case law, the Office can refuse registration of a trade mark in the following cases: i. when the requested sign/indication could be used in the future — and not only at the time of the application — in a way which might be descriptive of the requested goods and services (para. 34); ii. when the sign has several meanings but at least one of these identifies a feature of the goods and services concerned (paras 37, 42). Consequently, the GC dismissed the action.



**Case T-337/16; Versace 19.69 Abbigliamento Sportivo Srl. v EUIPO; Judgment of 5 October 2017; ECLI:EU:T:2017:692; Language of the case: IT**

**RESULT:** Action dismissed

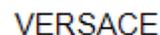
**KEYWORDS:** Proof of use, Identity of the goods and services, Likelihood of confusion

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 25. An opposition based, inter alia, on the earlier word mark VERSACE, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC) requesting the Court to annul the contested decision and to register the sign for the claimed products.

### EUTM application



### Earlier trade mark



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**SUBSTANCE:** The applicant contested the conclusions of the BoA in relation to the PROOF OF USE of the earlier trade mark. To this regards, the GC clarified as follows: i. According to Rule 22 of Regulation No 28688/95, where the evidence supplied by the opposing party are not in the language of the opposition proceedings, it is up to the Office to require the opposing party to submit a translation of the evidence in that language. In the present case, the Office did not require a translation due to the fact that the opposing party filed invoices in English (i.e. the language of international trade), which clearly refer to clothing and footwear (paras 31-34). ii. If the earlier mark does not appear beside the sold goods, this does not mean that the provided invoices lack of relevance for the purposes of proving the genuine use of that mark. In fact, it is necessary to ascertain whether they did actually cover such goods or, at least, whether that mark was used in accordance with its essential function (para. 44). iii. The holder of the previous trade mark is not obliged to prove the continuous use of its sign during the relevant period, but only that, in respect of that period, there was a real commercial exploitation (para. 51). As to the claim related to the assessment of the LIKELIHOOD OF CONFUSION, the GC stated that in order to analyse the SIMILARITY BETWEEN THE GOODS, the Office can only consider the list of goods and services as filed within the trade mark application. Since the applicant did not limit the requested goods in Class 25 to clothing for children, the BoA has correctly taken into consideration all

the requested goods within that Class (paras 80-81). As to the SIMILARITY BETWEEN THE SIGNS, the GC rejected the applicant's claim aimed at comparing the contested sign with the earlier figurative trade mark (a comparison which the BoA did not carry out as a measure of procedural economy). To this regard, the GC reminded that, pursuant to Article 65 of Regulation No 207/2009, it might only carry out a review of the legality of the BoA's decision but it does not have the power to substitute its own reasoning for that of the BoA (paras 83-84).

**Case T-404/16; Galletas Gullón, SA v EUIPO; Judgment of 23 October 2017; EU:T:2017:745; Language of the case: EN**

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

**KEYWORDS:** Three dimensional mark, Distinctive element, Evidence of use

**FACTS:** The 3D EUTM represented below was registered for biscuits in Class 30. An application for revocation was filed pursuant to Article 51(1)(a) EUTMR. The Cancellation Division (CD) dismissed the application for revocation. The Board of Appeal (BoA) annulled the CD decision and revoked the applicant's rights on the contested mark on the ground of non-use in connection with the goods in question, as the mark was used in a form which

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— according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the General Court (GC) relying on one single plea in law, related to the infringement of Article 51(1) EUTMR.

### EUTM as registered



### EUTM as used



**SUBSTANCE:** Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action and the defendant and the intervener to prepare their defence (paras 18-19). The GC found that the only differences between the registered EUTM and the mark as used are the white colour in the upper part of the packaging and



the stylisation of the element 'gullón' and of the letter 'O' and the number '2', which are considered minor changes, ornamental in nature and do not significantly alter the overall impression created by the registered mark (para. 32). Therefore, it stated that the use of the EUTM in a new combination of colours cannot alter the distinctive character of the registered mark, since the combination of colours 'blue-yellow-blue' is not a distinctive or dominant element of the registered mark and colours possess little capacity of conveying specific information, especially when they are rather commonplace. They will be understood more as elements for purely aesthetic purposes or as presentational features but not as an indication of commercial origin (para. 33). As to the GENUINE USE, the GC declared that, even though the mark is not referred to on invoices, this does not mean that the latter are irrelevant in order to prove genuine use of that mark (para. 51). The GC finds that the extent of use was sufficiently widespread to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the invoices submitted very regularly allow to conclude that the use of the mark was genuine (paras 56 and 60). Finally, it is not relevant whether the goods in question reached the consumers, since the genuine use only requires a mark to be used publicly and outwardly (para. 62).

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**Case T-418/16; Galletas Gullón, SA v EUIPO; Judgment of 23 October 2017; ECLI:EU:T:2017:745; Language of the case: EN**

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

**KEYWORDS:** Three dimensional mark, Distinctive element, Evidence of use

**FACTS:** The 3D EUTM represented below was registered for biscuits in Class 30. An application for revocation was filed pursuant to Article 51(1)(a) EUTMR. The Cancellation Division (CD) dismissed the application for revocation. The Board of Appeal (BoA) annulled the CD decision and revoked the applicant's rights on the contested mark on the ground of non-use in connection with the goods in question, as the mark was used in a form which — according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the General Court (GC) relying on one single plea in law, related to the infringement of Article 51(1) EUTMR.

**SUBSTANCE:** Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action and the defendant and the intervener to prepare their defence (paras 18-19). The GC found that the only differences



### EUTM as registered



### EUTM as used



between the registered EUTM from the mark as used are the white colour in the upper part of the packaging, the stylisation of the element 'gullón', of the letter 'O' and the number '2', and the addition of the descriptive term 'chocolate' to the element 'mini O2', which are considered minor changes, ornamental in nature and do not significantly alter the overall impression created by the registered mark (para. 32). Therefore, it stated that the use of the EUTM in a new combination of colour cannot alter the distinctive character of the registered mark, since the combination of colours 'red-yellow-red' is not a distinctive or dominant element of the registered mark and colours possess little capacity of conveying specific information, especially when they are rather commonplace. They will be understood more as elements for purely aesthetic

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purposes or as presentational features but not as an indication of commercial origin (para. 33). As to the GENUINE USE, the GC declared that, even though the mark is not referred to on invoices, this does not mean that the latter are irrelevant in order to prove genuine use of that mark (para. 51). The GC finds that the extent of use was sufficiently widespread to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the invoices submitted very regularly allow to conclude that the use of the mark was genuine (paras 56 and 60). Finally, it is not relevant whether the goods in question reached the consumers, since the genuine use only requires a mark to be used publicly and outwardly (para. 62).

**Case T-810/16; Barmenia Krankenversicherung AG v EUIPO; Judgment of 23 October 2017; EU:T:2017:749; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the word mark Mediline as an EUTM for goods and services in Class 36. The examiner refused the application as non-distinctive and descriptive based on Article 7(1) (b) and (c) in conjunction with Article 7(2) EUTMR.



The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that the trade mark applied for has a clear meaning regarding the purpose and nature of the services, and was therefore devoid of distinctive character. Indeed it will not, for the English-speaking relevant public, fulfil the function of indicating origin of the services applied for.

The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR; and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application

#### Mediline

**SUBSTANCE:** The GC dismissed the first plea. Thus, it found that the BoA correctly held that the public targeted by the contested mark consists of the general European public and of professionals, and that the public to be considered when analysing the descriptive character of the sign is the English-speaking European public, for the sign is made up entirely of English words (para.19). Then, the GC confirms that the term 'medi' would be understood by the relevant public as the abbreviation for 'medical' and that the term 'line' is a generic term in the assurance field designating a branch of assurance. Therefore, 'Mediline' would be understood as an 'insurance sector whose

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insurances concern the medical field' (paras 26 to 29). Consequently, the GC considers that the verbal sign is descriptive for the services covered by the trade mark application (para. 38). Finally, the second plea is also dismissed. Indeed, the GC recalls that as the sign is considered descriptive, then it cannot be registered for it lacks distinctive character (para. 40). Based on the foregoing, the action was dismissed (para. 42).

**Case T-683/16; Kuka Systems GmbH v EUIPO; Judgment of 19 October 2017; ECLI:EU:T:2017:735; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the word mark MATRIX BODY SHOP as an EUTM for goods and services in Classes 7, 9, 12 and 42. The examiner refused the application as non-distinctive and descriptive based on Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that the sign was descriptive for the goods and services concerned for the relevant English speaking public, and was therefore devoid of distinctive character.

The applicant filed an action before the General



Court (GC) relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR; and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application

#### MATRIX BODY SHOP

**SUBSTANCE:** The GC confirms the statement of the BoA that the relevant public is composed of English-speaking professionals, and that the potential descriptive aspect of the sign should be assessed based on this relevant public, for the sign is made up entirely of English words (paras 23 and 24). Then the GC dismissed the first plea. Thus, it recalls that the term 'MATRIX', which refers to 'metal mould for moulding', and its association with the term 'BODY SHOP' immediately denotes a metallic mould to be used in the place where the bodywork of motor vehicles is built or repaired (para. 41). And, consequently, the GC considers that the verbal sign presents a sufficiently direct and specific link with the goods and services covered by the trade mark application. Indeed, the sign describes the nature, the place of use as well as the final products, which are listed among the Classes 7, 9, 12 and 42 (para. 53). Finally, the second plea is also dismissed. Indeed, the GC recalls that as the sign is considered descriptive, then it cannot be registered for it lacks distinctive character (para. 61). Based on the foregoing, the action was dismissed.

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**Case T-202/16; UAB Keturi kambariai v EUIPO; Judgment of 24 October 2017; EU:T:2017:750; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complex mark, Conceptual similarity, Dominant element, Evidence of use, Extent of use, Figurative element, Likelihood of confusion, Phonetic identity, Proof of use, Sales figures, Similarity of the signs, Visual similarity, Weak element

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for services in Classes 35 and 43.

An opposition based, in particular, on the earlier Estonian figurative mark represented below, registered for goods and services in Classes 30 and 43, was filed pursuant to Article 8(1)(b) EUTMR. At the applicant's request the opponent furnished proof of use. The Opposition Division (OD) partly upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the evidence of use submitted by the opponent, taken as a whole, showed the genuine use of the earlier trade mark in Estonia. Concerning the likelihood of confusion (LOC), the BoA held that the services were partly identical and partly similar and that the signs were visually and conceptually similar to an average degree and phonetically highly similar/identical. Thus there was



LoC given also the average distinctiveness of the earlier mark.

The applicant filed an action before the General Court (GC) relying on 2 pleas in law: violation of Article 42(2) of Regulation No 207/2009; and violation of Article 8(1)(b). The GC dismissed the appeal.

### EUTM application



### Earlier trade mark



**SUBSTANCE:** The GC endorsed the overall assessment of the evidence of use of the earlier mark noting that the applicant did not dispute their authenticity or accuracy but rather the extent. It emphasised the probative value of the annual reports and stated that the fact that the name of the opponent's undertaking coincides with the word elements of its mark may also constitute an indication of use of the earlier mark for the

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opponent's main activity and thus for the services forming part of that activity and protected by that mark (para. 42). The GC also held that the supply of coffee cups bearing the earlier trademark as evidenced by numerous invoices makes it possible to assume with a reasonable degree of certainty that those cups were used in the opponent's commercial activity since they could be considered essential equipment for the sale of coffee as a service (para. 44). The GC dismissed the applicant's argument that no information was provided on the market share held and the turnover achieved since this information is just one of the factors to be assessed and the lack of such information is not capable of showing, in itself, that the use of the mark did not make it possible to maintain or create a market share (para. 62).

As regards the comparison of the goods and services the GC confirmed that there was no need to compare Class 30 goods of the earlier mark with the contested Class 35 and 43 services as such a comparison would have had no effect on the outcome of the case based on the comparison of the earlier services in Class 43 with those in Classes 35 and 43 (paras 75-78).

In relation to the degree of attention of the relevant public the GC stated that the fact that the determination of the relevant public at issue and its level of attention was not challenged by the applicant before the BoA in no way precludes the Office from having jurisdiction over the question whether the relevant public was correctly identified. Therefore,

that fact does not deprive a party of the right to challenge, before the Court and within the factual and legal context of the dispute before the BoA, the findings of that body on that point (paras 84-85). On substance the GC dismissed applicant's claim that the coffee consumers present brand loyalty and thus are particularly careful and selective.

The GC endorsed the comparison of the signs performed by BoA. It confirmed that the figurative elements and the graphic structure of the signs are not particularly striking and thus their word elements dominate the overall impression (paras 102-107). It also dismissed the applicant's arguments that the signs are conceptually different due to the different meanings of 'in' and 'inn' that will be understood by Estonian public. The GC held that the terms 'coffee in' and 'coffee inn' do not have a clear and established meaning in English thus BoA did not err in holding that the signs were conceptually similar inasmuch as Estonian consumers would recognise the reference to 'coffee' in both word elements.

Given the identity or similarity of the services, the identity of a very significant number of letters in the same position in the word elements of the two signs and their dominant character and phonetic identity of those word elements, there is LOC. The GC held, in particular, that in respect of the catering services the visual aspect plays a secondary role. In order to choose a restaurant or café a consumer usually refers to it by name (para. 138).

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**Case T-36/17; Forest Pharma BV v EUIPO; Judgment of 5 October 2017; EU:T:2017:690; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Complementary goods and services, Distinctive element, Identity of the goods and services, Similarity of the goods and services, Purpose of the goods and services, Similarity of the signs, Likelihood of confusion, Well-known facts need no evidence, Competence of the Boards, Modification of subject-matter

**FACTS:** The Board of Appeal (BoA) (R 500/2016-5) dismissed the appeal against the decision of the Opposition Division (OD). The earlier goods in Class 5 were identical to the contested goods in Class 5 and lowly similar to those in Class 10, the signs were similar and there was a likelihood of confusion (LOC). The GC dismissed the action.

### EUTM application

COLINEB

### Earlier trade mark

„Colina“



**SUBSTANCE:** Challenging the proof of use (PoU) for the first time before the GC is inadmissible as the issue of PoU does not form part of the opposition itself whose legality the BoA must review on its own initiative (paras 16-26). The BoA did not breach the adversarial principle as it was entitled to rely on information it considered ‘well-known’ (namely, that certain gastric disorders may cause respiratory disorders) without any obligation of (i) proving the accuracy of the fact or (ii) even bringing examples to illustrate the fact (paras 30, 33, 35, 72). **COMPARISON OF THE GOODS AND SERVICES:** The goods in Class 5 are identical; in particular, the contested veterinary preparations include, as a broader category, the earlier pharmaceutical products for the treatment of gastrointestinal disorders (paras 53-66). Those earlier goods are also similar, to a low degree, to the contested goods in Class 10. In particular, pharmaceutical products for the treatment of gastrointestinal disorders are similar to a low degree to the contested medical apparatus for the treatment of respiratory diseases (such as inhalers) essentially because certain gastric conditions are linked to respiratory conditions that the contested apparatus are used to treat (paras 67-74). **COMPARISON OF THE SIGNS:** The signs will not be broken down into parts; the relevant German public will not single out the elements ‘COLI’ or ‘NEB’. The signs are visually similar, phonetically similar to a high degree and a conceptual comparison is not possible (paras 75-96). Notwithstanding the high degree of attention of the relevant public, there is LOC even in relation to the goods that were found similar only to a low degree (paras 97-102).

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**Case T-87/17; KuKa Systems GmbH v EUIPO; Judgment of 19 October 2017; ECLI:EU:T:2017:732; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the word mark Matrix light as an EUTM for goods and services in Classes 7, 9, 12 and 42. The examiner refused the application as non-distinctive and descriptive based on Article 7 (1) (b) and (c) EUTMR. The applicant filed an appeal before the Boards of Appeal (BoA). The BoA dismissed the appeal. It found that the sign was descriptive for the goods and services concerned for the relevant English speaking public, and was therefore devoid of distinctive character.

The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR; and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application

Matrix light

**SUBSTANCE:** The GC confirms the statement of the BoA that the relevant public is composed of English-speaking professionals, and that the potential descriptive aspect of the sign should be assessed



based on this relevant public, for the sign is made up entirely of English words (paras 23 and 24). Then the GC dismissed the first plea. Thus, it recalls that the term 'Matrix', which refers to 'metal mould for moulding', and its association with the term 'light' would be understood by the relevant public as a 'light metal mould for moulding' or as a 'non-bulky metal mould for moulding'. Furthermore, the GC considers that the relevant public, specialised in the development and design of assembly shop, will perceive the sign as referring essentially to 'metal mould for moulding'. Indeed, the term 'light' will not be decisive in their mind, for they will still be able to establish a link with the goods and services mentioned in the application (para. 42). And, consequently, the GC considers that the verbal sign presents a sufficiently direct and specific link with the goods and services covered by the trade mark application. Indeed, the sign describes the nature, the place of use as well as the final products, which are listed among the Classes 7, 9, 12 and 42 (para. 54). Finally, the second plea is also dismissed. Indeed, the GC recalls that as the sign is considered descriptive, then it cannot be registered for it lacks distinctive character (para. 62). Based on the foregoing, the action was dismissed.

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11/10/2017, R 1537/2017-2, IMMERSION (fig.)

EUTMA



**Result:** Decision confirmed

**Keywords:** Emblem, Right to be heard.

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

**Facts:** The appellant applied for a figurative mark representing a round frame, containing 12 flags, arbitrary combination of commonly used signal flags from maritime symbolism; the written element 'Immersion' stays inside of such frame. Some of those flags are identical, in colours and shape,



to the official flags of some states. After a first provisional refusal, the applicant did not submit any evidence from the competent authorities of the entities concerned authorizing the registration of the trade mark. The examiner consequently refused the application.

**Substance:** The sign applied for contains elements which may be regarded as an identical reproduction or at least a heraldic imitation of the flag of the following countries: Japan



Luxembourg



Denmark



and England



(§ 14).

The fact that not all of the state flags at issue are registered under WIPO's Article 6ter database is irrelevant. According to Article 6ter (3)(a) of the Paris Convention, state flags enjoy protection per

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se without them needing to be registered through WIPO (§ 19). Contrary to the applicant's claim, it is irrelevant that the contested mark does not only contain the state flags at issue, but also the prominent word element 'IMMERSION'. Article 6ter(1)(a) Paris Convention prohibits the registration and use of a State emblem, not only as a trade mark, but also as an element of a trade mark (§ 21). Hence, there is no need to examine the overall impression produced by the mark (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d'érable, § 47; 21/04/2004, T-127/02, ECA, EU:T:2004:110, § 40-41). It is not disputed that the depiction or imitation of state flags in the sign at issue was made without the competent authorities' authorization. Therefore, the mark applied for cannot be registered according to Article 7(1)(h) EUTMR. The appeal is unfounded (§ 35).

25/09/2017, R 61/2017-5, [ASUS VivoWatch \(fig.\) / VIVOFIT et al.](#)

EUTMA

ASUS VivoWatch

**Result:** Decision annulled.

**Keywords:** Common element, Company name, Conceptual dissimilarity, Descriptive element,

Distinctive element, Dominant element, Enhanced distinctiveness, Identity of the goods and services, Non-registered trade mark, Passing off, Phonetic similarity, Promotional material, Reputation, Similarity of the goods and services, Visual similarity, Weak element, Word mark.

**Norms:** Article 8(1)(b) EUTMR, Article 8(4) EUTMR, Article 8(5) EUTMR.

**Facts:** On the basis of the earlier trade mark 'VIVOFIT', the Opposition decision upheld the opposition filed against the figurative trade mark for the Classes 9, 10 and 14, finding likelihood of confusion. Such trade mark was also recognized as having a high degree of distinctiveness, acquired through the use in the market. The applicant decided to appeal the decision, in order to obtain its full annulment.

**Substance:** With regard to Article 8(1)(b) EUTMR, the Board of Appeal stated that there is no likelihood of confusion on the part of the relevant public between the earlier trade marks ('VIVOFIT', 'VIVOSMART', 'VIVOACTIVE') and the trade mark applied for. Even though the trade mark 'VIVOFIT' benefits from enhanced distinctiveness acquired by use, the signs are lowly similar on both visual and aural levels and dissimilar on the conceptual level. Moreover, the contested sign includes the dominant element 'ASUS', while the public will focus its attention on 'VIVO' in the earlier signs because of the weak distinctive character of the elements 'FIT',

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'SMART' and 'ACTIVE'. Overall, even though some of the goods at stake are identical, the signs are overall too different for a likelihood of confusion to occur, also in the light of the fact that the relevant public is likely to display a high level of attention (§ 89).

In relation to Article 8(4) EUTMR, the applicant's assertion based on passing off of unregistered trade marks has to be rejected as the signs are overall too different in order to consider that there would be misrepresentation.

The opponent failed also to demonstrate that the earlier trade marks benefitted from a reputation, as it merely submitted documents showing promotional efforts and a certain amount of invoices. Indeed, the opponent submitted no proof of the public's recognition of the earlier trade marks or of the opponent's market shares (§ 96).

With regard to Article 8(5) EUTMR, the Board after globally assessing the proof of reputation submitted by the opponent, considers that by only showing promotion efforts and providing overall limited proof of sales, without giving any relevant information as to its market share or the public's degree of awareness of the trade marks, and taking into account the limited duration of their use, the opponent has failed to establish the reputation of the earlier EUTMs 'VIVOFIT', 'VIVOACTIVE' and 'VIVOSMART' in the European Union (§ 113-114).



29/09/2017, R 1591/2016-5, LA PEDRIZA (fig.)



**Result:** Decision confirmed.

**Keywords:** Geographical origin, Descriptive, Non-distinctive.

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

**Facts:** The Cancellation Applicant sought the cancellation of the figurative trade mark above, registered for goods in Classes 29, 30 and 31 (mainly agricultural products, coffee, tea and dairy products) as well as for of the word trade mark 'La Pedriza', registered in Class 29 (capers, vegetables preserves) alleging that both marks were not distinctive but descriptive and recalled to the public the region of La Pedriza in Spain. The Cancellation Division rejected the declaration of invalidity in its entirety.

**Substance:** The Board found that the Spanish and the European consumers of agricultural products and foodstuff, in general, who know the place name 'La Pedriza', would not associate the name in the future with the goods at issue. The Cancellation Applicant did not offer any evidence regarding the fact that 'La Pedriza' is traditionally known as place

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of origin of some particular product, or in respect of the fact that the public could associate 'La Pedriza' to any of the goods at issue. The Board also took into account that the morphology of the place speaks strongly against any chance of growing crops in the region, characterized by rocks and huge granite walls. Likewise, the Cancellation Applicant did not show any evidence that the competitors of the EUTM Proprietor may want to use the name 'La Pedriza' as an indication of the geographical origin for agricultural products and foodstuff in the future. The Board found that the term at issue is not laudatory, generic, or descriptive of the characteristics of the products it distinguishes and, in the light of the above, it decided to dismiss the appeal.

**29/09/2017, R 1272/2017-5, RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO (fig.)**

EUTMA



**Result:** Decision confirmed.

**Keywords:** Distinctive element, Figurative trade mark, Non-distinctiveness, Remittal from the General Court.

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

**Facts:** The Examiner refused the registration application of a trade mark constituted of two semi-spherical elements in red colour, in Classes 7, 35, 37, 42, for lack of distinctiveness. The Board of Appeal confirmed such decision. Afterwards, the Applicant filed an appeal (T-130/16) before the General Court. The latter annulled the Board's decision for lack of reasoning regarding the perception of the trade mark by the relevant part of the professional and experienced public.

**Substance:** The Board of Appeals confirms the contested decision by assessing the distinctive character of the sign in the perception of the public, as required by the previous judgment of the General Court. The Board agrees with the Appellant that the public at issue is attentive and generally professional, but disagrees that the products and services at stake are dedicated to the expert in the specific sector of packaging and confectioning. Also, the fact that the element at issue has been used by the Applicant for the same products and services in conjunction with other elements and inside another trade mark ('C(esia)') cannot be taken in account by the Board since only the element '()' is the object

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of the application and such element, per se, lacks distinctiveness.

The Applicant did not bring any evidence or case law supporting the argument that a professional can appreciate better than a general consumer the distinctiveness of a simple element like the one at issue. The Board stated that the figurative element 'O' is simple, it cannot be perceived as an O by the public, and there is a high possibility that such public would perceive it as a decorative element, more than a trade mark.

In fact, the higher level of attentiveness of the professional public cannot compensate the lack of distinctiveness of a trade mark that, as a consequence, cannot be perceived as an indication of origin of any product or service. Consequently, the appeal is dismissed.

**29/09/2017, R 1006/2017-5, CA' DEL MAGRO**

**Result:** Decision confirmed.

**Keywords:** Geographical origin, word mark.

**Norms:** Article 7(1)(j) EUTMR.

**Facts:** The examiner refused the application for the registration of the word mark 'CA' DEL MAGRO' because it is not likely to identify the products at issue (alcoholic beverages (except beers), wines, grappa) without evoking the Italian designation 'Val

Di Magra', which identifies wines.

**Substance:** Given the similarity or identity of the products at issue, evocation is deemed to exist when at least a part of the geographical indication is contained in the name of the product so that, as a consequence, when the consumer hears the name of the product (meaning the trademark) he/she associates the same product to the geographical indication. It is noted that 'Val Di Magra' is a Protected Geographical Indication for wines (PGI-IT-A1431). 'MAGRO' is considered as the dominant element of the trade mark and, as such, the one that draws the attention of the consumer more. The Board of Appeal therefore finds that 'MAGRO' is sufficient to evoke the geographical indication 'MAGRA' in the mind of the non-Italian consumer (§ 30). The Board upheld the decision of the examiner.

**21/09/2017, R 2157/2016-1, GOGO 21 / GOGO et al.**

**Result:** Decision annulled.

**Keywords:** Competence of the Board, Complementary evidence, Database printout, International registration, New submission on appeal, Substantiation of earlier right, Reasons of equity

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**Norms:** Article 152 EUTMR, Article 76(2) EUTMR, Article 64(1) EUTMR, Rule 50(1) CTMIR, Rule 20(1) CTMIR.

**Facts:** The Opposition Division rejected the opposition based on Article 8(1)(b) EUTMR on the ground that it was unfounded.

**Substance:** The opponent overlooked the fact that the only central official register for International Registrations (IR) is the WIPO database ROMARIN (26/11/2014, T-240/13, Alifoods, EU:T:2014:994, § 28) and presented only an extract of the eSearch plus database. However, he did submit the extract of the ROMARIN database at the appeal stage, as further substantiation of its earlier right. In the present case, the Board considers a) that it is appropriate to accept the new extract of the ROMARIN database as supplementary evidence to the previously submitted eSearch database extract (§ 21-22), b) that examining the opposition case on its merits will give more legal security to both parties (§ 23), c) that it is also in the general interest of third parties to ensure that marks, the use of which could later on successfully be challenged by means of annulment proceedings or counterclaim, are not registered (§ 24). Consequently, the Board annuls the contested decision and remits the case to the Opposition Division for a further ruling.

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