

Alicante News

Up to date information on IP and EUIPO-related matters

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Stakeholder Consultation: Strategic Plan 2025

The EUIPO is calling upon all stakeholders to help guide the Office's strategic priorities up until 2025.

An important aim of the EUIPO Strategic Plan 2025 (SP2025) will be to help companies to gain full benefit from their innovation and creativity, whether in Europe or the global marketplace, having regard to technological advances shaping business models.

Based on the achievements of the Office's first two strategic plans, and, in particular, following the successful creation of the European Union Intellectual Property Network (EUIPN), we need to ensure this network is both sustainable and able to respond to the globalisation of the marketplace, the rise of e-commerce, and the threat of IP infringements, which frequently has a cross-border dimension.

Overall, the Office needs to ensure it is an attractive and reliable entry point to IP protection covering a broad range of IP rights. It should develop into an IP excellence hub providing high quality public service making European businesses more competitive in an ever more global and digital environment.

The forces of globalisation, technological change, and the rapidly changing world of work are all factors that need to be considered. Navigating this complex

landscape successfully will require partnership between public and private stakeholders at the national, EU and global levels in order to anticipate, and prepare for the future.

Consequently, SP2025 will focus on adding value to the internal market; on ensuring the effectiveness of the IP system for the benefit of European businesses (with an emphasis on SMEs) and citizens; and on contributing to the creation of jobs and economic growth, in alignment with the EU's priorities.

The overall aim of SP2025 will be to create Added Value and Growth for the benefit of EU citizens, businesses and IP stakeholders.

Three strategic drivers are provided to support an effective consultation process:

- **Strategic Driver 1:** Interconnected, Effective and Reliable IP System
- **Strategic Driver 2:** Customer Centric IP Services
- **Strategic Driver 3:** Dynamic Organisational Skillsets and Effective Support to Operations

Your contribution is highly valued. Please play a part in shaping the future of the EUIPO by filling in [this form](#) and sending it to SP2025@euipo.europa.eu by 28 February 2019.

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2019 version of the 11th edition of the NICE Classification

On 01/01/2019 the 11th edition of the Nice Classification enters into force. The effects of this entry into force are identified in Communication 2/2018 of the Executive Director. The Communication indicates that the filing date of any application will dictate the edition and version according to which it will be classified. This means that Nice 11/2019 will have to be applied to any application received as of 1st January 2019. As in previous years, there will be no reclassification of previous applications.

As this is a new version (annual), not edition (every five years), the changes are limited to additions to, and deletions from, the alphabetical list and small modifications or corrections to the wording of existing entries.

All changes to the Nice Classification have already been fully reflected in the Harmonised database using the Taxonomy structure and may be used for all EUTM applications filed after 1 January 2019 using the Office's e-filing system.

The main change in the 2019 version is the introduction of the term concierge services into the alphabetical list in Class 45: this term will no longer be seen as too vague, and will now be accepted.

The Guidelines have been updated to reflect this change of practice. In addition, the guidelines have been clarified to explain the procedure when all goods/services in a class are claimed.

Fast-track change to the guidelines

Part C, Section 2, Comparison of Goods and Services
Following recent case-law from the General Court, the Guidelines on the Comparison of Goods and Services have been updated to reflect changes in practice:

- In case T-150/17 of 04/10/2018, *Flugel*, EU:T:2018:641, § 77-84, the Court found that 'it cannot be considered that an alcoholic drink and an energy drink are similar merely because they can be mixed, consumed or marketed together, given that the nature, intended purpose and use of those goods differ, based on the presence of, or absence of alcohol in their composition. Furthermore, it must be held that the undertakings which market alcoholic drinks premixed with a non-alcoholic ingredient do not sell that ingredient separately and under the same or a similar mark as the premixed alcoholic drink at issue.'

In view of this case law, the Knowledge Circle Goods and Services Issues has amended its practice as reflected in the guidelines. Non-alcoholic beverages in Class 32 are now generally considered to be dissimilar to alcoholic beverages (except beers) in Class 33. However some specific alcoholic and non-alcoholic beverages may still be similar, such as wine and non-alcoholic wine. Any exception from the general rule will be included in the Similarity tool.

- In case T-83/16 of 26/09/2017, *Wibida*, EU:T:2017:662 § 59-69 the Court found that 'the

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sole objective of the production of 'credit cards' is their use in the course of 'financial services', with the result that it is of little importance whether they are manufactured by entities that are distinct from the financial institutions which issue them. Such goods, which are therefore developed in order to market certain specific services, would be meaningless in the absence of those services. Accordingly, 'credit cards' are closely connected with 'financial services' and, hence, with 'financial affairs', with the result that those goods and services are complementary'. The Guidelines have been updated to reflect this change of practice with credit cards in Class 9 now being considered to be similar to financial, monetary and banking services in Class 36. Similarity tool pairs have also been amended.

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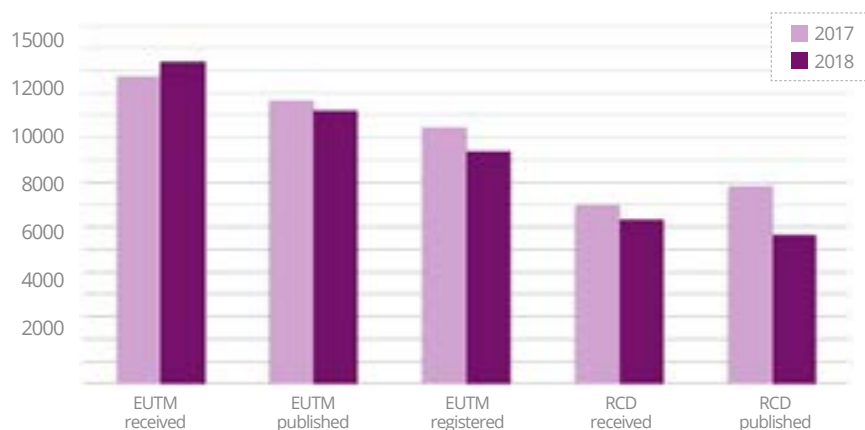


Statistical Highlights



Monthly statistical highlights November	2017	2018
European Union Trade Mark applications received	13 734	14 408
European Union Trade Mark applications published	12 679	12 244
European Union Trade Marks registered (certificates issued)	11 510	10 391
Registered Community Designs received	7 986	7 343
Registered Community Designs published	8 864	6 646

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



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General Court confirms official character of TMview

By a judgment rendered on 6 December 2018 in case [T-848/16, Deichmann v EUIPO - Vans \(V\)](#), the General Court confirmed that extracts from TMview are acceptable evidence in inter partes proceedings before EUIPO in order to substantiate earlier trade marks registered with the participating offices, as long as they contain all relevant data.

TMview database is an online consultation tool managed by the EUIPO. It collects and provides free of charge access to trade mark applications and registrations of the participating trade mark offices, including WIPO. The information is made available by the trade mark offices, which own the content and are responsible for the update. You can find out more at <https://www.tmdn.org/tmview/welcome>.

The General Court held that in view of these characteristics, an extract from TMview, in relation to international registrations designating the European Union, constitutes a copy of the registration certificate issued by WIPO and, where appropriate, a document equivalent to the most recent renewal certificate within the meaning of Rule 19(2)(a)(ii) of Regulation No 2868/95 [now Article 7(2)(a)(ii) EUTMDR], provided that the extract contains all relevant information. If the list of goods or services contained in the TMview extract is not in

the language of the proceedings, the excerpt must be submitted together with a translation of that list.

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IP Mediation Conference 2019

The EUIPO Boards of Appeal, together with the EUIPO Academy and the International Cooperation and Legal Affairs Department of EUIPO, are organising the second IP Mediation Conference, which will be held on 30-31 May 2019.

The conference takes place in EUIPO's headquarters in Alicante, Spain. Leading experts from national and international institutions, academia and from EUIPO itself will gather to address a wide range of topics in the field of intellectual property mediation.

Mediation is a growing trend in intellectual property, and an increasingly sought-after method of dispute resolution. Through panel discussions, audience interaction and real-world examples of IP mediation in practice, the conference will explore the benefits and added value of mediation for all parties.

More information on the conference, plus registration details and an agenda, can be found [here](#).

Evaluation of EU legislation on design protection

The European Commission has launched a stakeholder consultation to gather evidence and views on the current EU legislation on design protection.

Since the publication of the Design Directive in 1998 and the Community Design Regulation in 2002, no overall evaluation of EU design protection legislation has been carried out.

The consultation is launched with the intention of collecting the input of stakeholders on the functioning of the design protection systems in the EU, at Union and at national levels.

It builds on and follows previous research, analysis and targeted surveys conducted as part of two studies on the economic and legal review of those systems.

The consultation activities will help the European Commission to draw conclusions on the need for improvement, modernisation and further harmonisation of the current legal acts.

Access the survey [here](#).

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Luxembourg trade mark and design news

C-433/17P; GREEN STRIPES ON A PIN (Col.); Enercon GmbH v EUIPO; Judgment of 25 October 2018; EU:T:2018:860; Language of the case: EN

RESULT: Appeal dismissed

KEYWORDS: Colour mark, Non-distinctive

FACTS: The trade mark applicant sought to register the sign below, identified as a colour mark, for goods in Class 7. An invalidity application was filed pursuant to Article 59 EUTMR. The Cancellation Division (CD) upheld the invalidity application on the basis of Article 7(1)(b) EUTMR. The trade mark applicant filed an appeal, which the Board of Appeal (BoA) upheld, thereby annulling the CD's decision. The invalidity applicant filed an action with the General Court (GC), which partially upheld the action and annulled the BoA decision (12/11/2013, T 245/12, GREEN STRIPES ON A PIN (col.), EU:T:2013:588). The case was remitted to the BoA, which ruled that the contested mark was a colour mark and not a figurative mark, and that the CD had correctly found that it lacked distinctive character. The trade mark applicant filed an action with the GC. The GC dismissed the action in its entirety. The trade mark applicant appealed to the CJ on two grounds: (i) that the GC had erred in law in taking the view that the designation of the contested mark as a colour mark in the application form determined the nature of the mark in law and

therefore affected the assessment of its inherent distinctive character and (ii) that the GC had erred in dismissing information presented by the trade mark applicant, which had in turn led it to the erroneous finding that the contested mark was a colour mark.

EUTM application



SUBSTANCE: On the first ground of appeal. The designation of the category of mark by the applicant for registration of an EUTM is a legal requirement (para. 23). Article 43(2) of Regulation No 207/2009 [now Article 49(2) EUTMR] does not authorise the category of EU trade mark chosen by the applicant in its application to be changed to another category of mark (para. 24). The GC was therefore fully entitled to take the view that the distinctive character of the mark had to be assessed according

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to the category of mark chosen (para. 27). It follows that the first ground of appeal must be rejected (para. 28). **On the second ground of appeal.** Despite the fact that INID code 546 is referred to in the registration certificate, the appellant at no time mentioned that code during the procedure before the Office. On the contrary, it explicitly chose to have its mark registered as a colour mark (para. 37). It is neither for the Office nor for the GC to reclassify the category chosen for a mark. It cannot be held that the Office is required to decipher of its own motion all of the documentation filed when registration of a 'colour mark' is applied for in order to decide on its own initiative that the mark in question is to be reclassified as a 'figurative mark' outside the legal framework laid down by the applicable rules on trade marks (para. 38). It follows that the second ground of the appeal must be rejected (para. 39). Consequently, the appeal must be dismissed in its entirety (para. 40).

T-8/17; GOLDEN BALLS / BALLON D'OR et al.; *Golden Balls Ltd v EUIPO*; Judgment of 17 October 2018; EU:T:2018:692; Language of the case: FR

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Reputation, Res judicata, Right to be heard, Tarnishment of reputation, Unfair advantage

FACTS: The applicant sought to register the word sign **GOLDEN BALLS** as an EUTM for goods and

services in Classes 9, 28 and 41. An opposition based on the earlier word mark **BALLON D'OR**, registered for goods and services in Classes 9, 28 and 41, was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) rejected the opposition in its entirety. The opponent filed an appeal. The Board of Appeal (BoA) annulled the OD's decision, finding likelihood of confusion (LOC) for all of the goods except apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity in Class 9. Grounds under Article 8(5) EUTMR were not examined. The applicant filed an action with the General Court (GC) pursuant to Article 8(1)(b) EUTMR and the opponent filed a cross-claim pursuant to Article 8(5) EUTMR. In T 448/11, the GC upheld the applicant's action and rejected the opponent's cross-claim. The opponent appealed to the Court of Justice (CJ). In C 581/13P & C 582/13P, the CJ annulled the GC's judgment insofar as it concerned the dismissal of the opponent's cross-claim. The case was remitted to the BoA, which noted that the specification of the trade mark application had been restricted by deleting apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity in Class 9 and that the refusal of the opposition based on Article 8(1)(b) EUTMR was already final. It therefore remitted the case to the OD for examination on the grounds of Article 8(5) EUTMR. The OD partially upheld the opposition on Article 8(5) EUTMR for some of the goods and services. The applicant also appealed against

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this decision, insofar as it rejected the trade mark application. The opponent filed a cross-appeal, seeking revision of the OD's decision pursuant to Article 8(3) of Regulation (EC) No 216/96 for the goods and services that had not been rejected. The BoA dismissed the applicant's appeal, upheld the opponent's cross-appeal and rejected the EUTM application in its entirety. The applicant filed an action with the GC, relying on four pleas in law: (i) infringement by the BoA of the authority of res judicata, (ii) that the BoA had exceeded the subject-matter of the appeal before it, thus infringing the applicant's right of defence, (iii) that the BoA failed to take into account developments subsequent to the filing of the EUTM application and (iv) infringement of Article 8(5) EUTMR.

SUBSTANCE: The ground for opposition of Article 8(5) EUTMR was still pending in respect of all the goods and services referred to, with the exception of those for which the applicant had withdrawn its application for registration, on the dates on which the BoA's second decision, the OD's second decision and the BoA's contested third decision were adopted by the EUIPO. The first plea must be rejected as unfounded (paras 46-53). The applicant was not invited to file observations on the opponent's appeal seeking revision of the OD's decision pursuant to Article 8(3) of Regulation (EC) No 216/96. By annulling the second OD decision to the extent requested by the opponent, the BoA infringed Article 94 EUTMR. The contested decision is annulled insofar as it

upheld the opponent's appeal seeking revision of the OD's decision (paras 61-68). The reputation of the earlier mark must be examined at the time when the contested EUTM application was filed (para. 77). **Comparison of the signs.** The BoA was bound by the GC's findings in T 448/11: there is no visual or phonetic similarity between the signs at issue and, at most, a weak conceptual similarity (paras 88, 92). **Reputation.** The use of 'Ballon d'or' together with 'FIFA' and 'France Football' has no decisive consequence on the appreciation of the reputation of the earlier mark 'Ballon d'or' (paras 99-101). The earlier mark enjoys a very strong reputation, particularly in France, for *competitions in sports matters, organisation of sports competitions and awarding of trophies* included in Class 41 (para. 103). The link. The BoA concluded that all goods and services covered by the trade mark applied for were sufficiently close to the services for which the earlier trade mark was renowned because they were all likely to relate to a sporting theme. The BoA failed to make a global assessment of the link between the marks for the goods and services not rejected by the OD decision (paras 124-125). The GC explicitly takes a position against the existence of a link for those goods and **services** rejected by the BoA (paras 133, 150). **Unfair advantage.** The GC confirms the risk of the applicant taking unfair advantage of the reputation of the earlier mark for the goods and services already rejected by the OD (paras 139, 141, 142). **Tarnishment.** The BoA did not analyse the ground of opposition based on tarnishment and the

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GC cannot substitute the BoA. On the other hand, the GC notes that the vulgar connotation of 'balls' in English is only one of its possible meanings and that it simply means 'several balls' in standard language (para. 151).

T-109/17; **VIPER / VIPER et al.**; *FCA US LLC v EUIPO*; Judgment of 18 October 2018; EU:T:2018:697; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Belated evidence, Complementary evidence, Evidence of use, Extent of use, Nature of use, No bearing on decision, Press articles, Proof of use, Purpose of the goods and services, Right to be heard

FACTS: The EUTM proprietor registered the word mark **VIPER** as an EUTM for goods in Classes 12, 28 and 37. An invalidity application was filed pursuant to Articles 59(1)(a) and 60(1)(a) EUTMR in conjunction with Article 8(1)(a) and (b) and Article 8(5) EUTMR, based, inter alia, on the earlier United Kingdom word mark **VIPER**, registered for *Sports cars; all included in Class 12*. The Cancellation Division (CD) partially upheld the invalidity application for *motor vehicles and parts thereof* in Class 12. The EUTM proprietor filed an appeal, which the BoA dismissed. It found that genuine use of the earlier mark had been proved for *sports cars in kit form*, which were regarded as a subcategory of the *sports cars* covered

by that mark. The EUTM proprietor appealed to the General Court (GC), relying on a single plea in law: infringement of Article 64(2) and (3) EUTMR.

SUBSTANCE: Alleged incomplete nature of kits and decisiveness for proof of use. The BoA correctly defined kit cars as cars that, in principle, must be assembled by the customers themselves. The latter are car enthusiasts who are prepared to devote considerable time and resources to assembling a vehicle themselves using the particular concept developed and sold by the kit car supplier. The purpose is thus to have a specific car, which, following assembly, may be deemed roadworthy. It is also apparent from articles published in specialist magazine *kitcar* that such cars may take several months or even years to build (para. 47). Therefore, kit cars have certain specificities and are, moreover, niche products (para. 48). The BoA correctly took account of the nature of the goods as well as the characteristics of the relevant market (para. 50). The BoA also referred to the comprehensive nature' of the kits, but that does not mean it concluded that the goods sold by the invalidity applicant were kits containing all the components necessary to build a car (paras 52-53). It is apparent from the file that the kits proposed also include components from other manufacturers, such as the engine or suspension (para. 58). However, even the use of the earlier trade mark for partial kits only, sold for the building of specific sports cars in kit form, may be considered, taking account of the purpose of the

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goods, as falling within the scope of sports cars in kit form. Accordingly, the question whether all the components of the VIPER sports cars in kit form are manufactured or sold by the invalidity applicant is not decisive (para. 59). **Regarding the alleged reliance on a dictionary definition of the term 'kit-car'.** The BoA based its analysis on the evidence submitted that dated from the relevant period, and, in particular, on the articles published in specialist magazine kitcar, as well as on the frequent and regular insertion of advertisements concerning the earlier mark in that magazine. The BoA did not err in finding that the earlier mark had been used for sports cars in kit form (paras 60-61). **Proof and extent of use of the earlier mark.** The evidence produced by the invalidity applicant shows that kits for building VIPER sports cars were consistently sold or, at least, offered on the relevant niche market during the relevant period (para. 71). The invalidity applicant regularly promoted the VIPER sports car in specialist magazine *kitcar* during the relevant period. The initial evidence was sufficient to show that the VIPER sports car and, therefore, the earlier mark, were present at several kit-car showrooms during the relevant period (para. 69). Moreover, the initial evidence is corroborated by additional evidence (invoices, press articles, certificates, search results, etc.) regarding use of kits for the construction of a VIPER sports car (para. 70). Admittedly, none of the evidence pertaining to the relevant period, taken individually, demonstrates the volume of goods sold under the earlier mark, and only a few invoices refer

essentially to partial kits for the construction of the VIPER sports car. However, given the specificities of the relevant market, the evidence, taken as a whole, shows genuine use that cannot be considered symbolic or for the sole purpose of preserving the rights conferred by the mark (para. 72).

T-261/17; **SALOSPIR (fig.) / Aspirin et al.; Bayer AG v EUIPO**; Judgment of 24 October 2018; EU:T:2018:710; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Dissimilarity of the signs, Distinctive element, Dominant element, Identity of the goods and services, Likelihood of confusion, New submission on appeal, Packaging, Phonetic dissimilarity, Reputation, Survey, Visual dissimilarity

FACTS: The applicant sought to register the mark below as an EUTM for goods in Class 5 (*pharmaceuticals*). An opposition based on the earlier German figurative mark **Aspirin** (below) and the earlier German word mark Aspirin, the earlier EU figurative trade marks (below), as well as the non-registered sign **ASPIRIN** (packaging) in Germany, was filed pursuant to Article 8(1)(b) EUTMR, Article 8(4) EUTMR (§4(2) German Law) and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent appealed. The Board of Appeal (BoA) dismissed the

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appeal. It held that the contested mark was different from the earlier German marks and from the earlier EU figurative marks, and that the opponent had not proved that German law granted protection to the non-registered sign. The opponent filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR, and (iii) infringement of Article 8(4) EUTMR.

EUTM application	Earlier trade marks / rights
	

SUBSTANCE: Inadmissibility of the new evidence before the GC. The new evidence filed before the GC intended ‘to prove a matter of common knowledge’ (a presentation referring to methodology in surveys). However, as the accuracy of the methodology governing the

consumer recognition surveys is contested, this cannot be considered ‘a matter of common knowledge’ and is, therefore, inadmissible (para. 19). New evidence which seeks to contest an assessment made by the BoA is also inadmissible (para. 20). **Earlier EU figurative marks. Relevant public and comparison of goods.** The relevant public is the EU general public and professionals in the field of medicine and pharmacy, with a high degree of attentiveness with regard to pharmaceuticals. The goods are identical (pharmaceuticals) (para. 32). **Dominant and distinctive element.** Taking account of its large size and its central position on a white background, the word element ‘salospir’ is dominant, in addition to the fact that pharmaceuticals issued without prescription are purchased in a pharmacy and the purchaser, as a general rule, will say their name. Moreover, the word element ‘salospir’ has no meaning and, therefore, has an inherent distinctive character (paras 38-39). It is well-known that the combination of green and white is commonplace in the pharmaceutical sector and the intervener had filed evidence in support of that argument (para. 42). The white and green colour combination does not have independent distinctive character in the contested mark as it is commonplace in the pharmaceutical sector (para. 47) and it is not identical to the earlier mark (paras 45, 56, 75). **Probative value of the surveys.** The survey on neutralised packaging does not concern the contested mark and is thus not capable

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of demonstrating the independent distinctive character of the combination and configuration of the white and green colours (para. 55). Regarding the Salospir survey, the legal principles applicable to the assessment of LOC between the signs constitute a point of law (para. 59). Furthermore, the neutralised packaging survey and the Salospir survey were not carried out in the objective circumstances in which the marks are present, or may be present, on the market. Firstly, a purchaser does not just look at the packaging, and neutralised packaging is not present as such on the market. Secondly, the surveys were conducted at the homes of the survey participants, therefore not under the conditions that purchases of the goods concerned usually occur (in pharmacies). Thirdly, the SALOSPIR product is not traded in Germany where the surveys took place (para. 65)). Finally, participants were not shown several images, but only one single image with leading questions being asked inducing participants to think about the over-the-counter pharmaceuticals they knew in Germany (paras 68-69). **Comparison of the signs.** As regards earlier EU figurative marks, the dominant and distinctive word element 'salospir' has no counterpart in the earlier marks. The visual differences outweigh the common combination of the colours white and green (paras 74-76). Since the earlier EU figurative marks do not contain any word element that could be pronounced or understood, no phonetic or conceptual comparison is possible (para. 78).

The overall impression is different (para. 79). **Earlier German trade marks.** The relevant public is the German public, composed of professionals and of end consumers with a high degree of attention (para. 87). The goods covered are identical (para. 88). The signs are visually different, as the word 'salospir' differs from the word 'aspirin' in the beginning, the middle and the end, and the contested mark contains figurative elements that are absent from the earlier marks (paras 89, 93). The signs are also phonetically different, since the syllables, sequences of vowels and overall phonetic impressions are different (para. 90). Conceptually, no comparison is possible, since the words 'salospir' and 'aspirin' have no meaning in German (para. 91). The signs are dissimilar overall (para. 98). **Recognition of the non-registered sign.** The opponent, who bears the burden of proof, has not proved to the requisite legal standard, according to the national law upon which it relies, that the potential recognition 'as a trade mark' of certain elements that make up the packaging of a product entailed the recognition 'as a trade mark' of that packaging (para. 128). Judgments concerning the interpretation of provisions of EU law, rather than the interpretation of German law, are irrelevant (para. 123).

T-164/17; **WILD PINK / PINK LADY et al.**; *Apple and Pear Australia Ltd v EUIPO*; Judgment of 15 October 2018; EU:T:2018:678; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

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KEYWORDS: Conceptual similarity, Likelihood of confusion, New submission on appeal, Phonetic similarity, Right of defence, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the word mark **WILD PINK** as an EUTM for goods in Classes 29 to 31. An opposition based on the earlier EU and national (Benelux, German, UK, French) word marks **PINK LADY**, as well as the earlier EU figurative marks below, registered for goods in Classes 29 to 31, was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition and the opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal without assessing any reputation the earlier marks may enjoy, since it found them to be dissimilar to the mark applied for. The opponents filed an action before the General Court (GC), relying on four pleas in law: (i) infringement of Article 95(1) EUTMR, (ii) infringement of Article 94 EUTMR and Article 296 TFEU, (iii) infringement of Article 8(1)(b) EUTMR and (iv) infringement of Article 8(5) EUTMR.

EUTM application	Earlier trade marks
Wild pink	<p>PINK LADY</p> 

SUBSTANCE: Examination of the facts and right of defence. The considerations concerning the pinkish-red colour of apples do not stem from the BoA acting on its own initiative and are in fact based on facts and evidence submitted by the parties (para. 22). The opponents were perfectly able to dispute the conclusions relating to the colour of the apples before the Office and their right of defence were not in any way infringed (para. 27). As to the BoA's comment regarding 'a short visit to any local fruit market', it is a supplementary statement that was made for the sake of completeness (para. 28). **Relevant public.** The relevant consumer is the EU public at large with a low level of attention (para. 51). **Descriptive and dominant element.** The word

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element 'pink' is descriptive, as it indicates a specific quality of the goods, namely their colour (para. 69). The term 'pink' plays a secondary but not negligible role vis-à-vis that of the word 'lady', which is at the end of the earlier mark, and the word 'wild', which is at the beginning of the contested mark (paras 73-74). **Visual and phonetic similarity.** Due to the common word 'pink', which is not negligible, the signs have, at least, a low degree of visual and phonetic similarity (paras 79, 81). **Conceptual similarity.** Both the relevant English-speaking and non-English-speaking public will perceive the presence of the word 'pink' in both signs as denoting the colour pink (para. 88). The word 'pink' must be regarded as part of basic English vocabulary regularly used both in everyday life and in advertising. It is clear that the relevant public throughout the EU has had extensive and repeated exposure to that word (para. 58). The non-English-speaking public will also understand the meaning of the word 'lady', since it can be found in most dictionaries in the official languages of the EU and, even if it does not appear, its meaning is well known, since it is a common English word very widely used in most languages of the EU and in the media (para. 86). The presence of the square in the figurative marks does not convey any meaning other than the colour pink (para. 90). Therefore, the signs have some conceptual similarity, which is deemed to be low, due to the descriptiveness and low distinctiveness of the term 'pink' (para. 89). **Global assessment.** On the basis of an incorrect assessment, the BoA wrongly concluded that the

signs were dissimilar overall, without carrying out any global assessment of LOC (para. 91). **Regarding infringement of Article 8(5) EUTMR.** The BoA erred in finding that Article 8(5) EUTMR was not applicable without carrying out an overall assessment that also took into account the renown or reputation enjoyed by the earlier mark (para. 101).

T-359/17; **ALDI / ALDO (fig.);** *Aldo Supermarkets v EUIPO*; Judgment of 25 October 2018; EU:T:2018:720; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Graphical representation, Legal certainty, Proof of use, Ratio legis, Representation of a mark, Right to be heard, Substantiation of earlier right

FACTS: The applicant sought to register the word mark **ALDI** as an EUTM for, inter alia, services in Class 35. An opposition was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR, based on the earlier Bulgarian figurative mark, identified in colour in the opposition notice and attached to it in a separate document in colour, although this additional document showed no source of origin. The Office found the opposition admissible and invited the opponent to substantiate the earlier right. During the substantiation period, the opponent submitted a black-and-white copy of the registration certificate of the Bulgarian mark and a

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translation of that document, including a translation of the colours of the earlier mark, into the language of proceedings. The Opposition Division (OD) partially upheld the opposition. However, the BoA rejected it as unsubstantiated. The opponent appealed to the General Court, relying on four pleas in law: (i) infringement of Article 7 EUTMDR and of the principle of legal certainty, (ii) contradictory reasoning, (iii) infringement of the rights of the defence and of the principle of the right to be heard and (iv) infringement of Article 47(2) EUTMR and Article 10(3) and (4) EUTMDR.

EUTM application	Earlier trade marks
ALDI	

SUBSTANCE: (i) The legal requirements concerning the presentation of the facts, evidence and arguments and of the supporting documents are not conditions of admissibility of the opposition, but conditions relating to the examination of its substance (paras 39, 64). For the purposes of admissibility, it suffices that the notice of opposition includes a representation of the earlier mark, in colour if necessary, whatever its source, to enable

clear identification of the earlier mark invoked. Those requirements are distinct from those applicable to proof of the existence, validity and scope of protection of the earlier mark (para. 43). The requirement to produce the registration certificate is not an end in itself, but is intended to ensure that the EUIPO has reliable proof of the existence, validity and scope of protection of an earlier trade mark on which an opposition is based (para. 37). The production of a copy of a registration certificate that is fully in line with the original from which it was copied does not satisfy the aim of identification, as in the notice of opposition, but that of demonstration of the existence, validity and scope of protection of the earlier mark as registered. The copy of the registration certificate should be identical in every respect to the original certificate, and therefore must show any colours claimed (paras 40, 44, 45, 54). In the Office's letter requesting the opponent to provide evidence of its earlier mark, it was expressly stated that the registration certificate or any equivalent official document submitted as evidence of the existence of the earlier right should include a representation of the mark as registered, that is to say, in colour if necessary (para. 47). The different variations of the representation of the earlier mark (in orange, blue and white, in black and white, and in red, black and white) did not satisfy the condition of accuracy and reliability inherent to Article 7 EUTMDR (para. 48). Furthermore, the possibility offered by the Office Guidelines to provide other documents to support a claim of a colour mark applies only to

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marks registered in States in which the certificate does not make it possible to provide representation of the registered mark in colour (para. 53). (ii) There was no contradictory reasoning: on the one hand, the BoA found that the opposition was admissible under Article 2 EUTMDR, as the notice of opposition contained a colour representation of the earlier mark, while, on the other, it concluded that the applicant had not provided proof of the earlier right, as it had not filed a copy of the registration certificate identical to the original, in colour, in accordance with Article 7 EUTMDR (para. 65). (iii) In the information note attached to its letter, the Office had informed the opponent that the registration certificate or an equivalent official document had to be submitted as evidence of the existence of the earlier right, and that this document had to include a representation of the mark as registered, that is to say, in colour if appropriate (para. 70). Further, the evidence of the existence, validity and scope of protection of a mark to be submitted during opposition proceedings is set out precisely and exhaustively in Article 7 EUTMDR, so that an opponent is in a position to be aware, even before filing its notice of opposition, of the specific documents it must produce in support of that opposition (para. 69). Moreover, in this case, as the applicant had challenged the conditions of representation of the earlier mark before and/or during OD and BoA proceedings, the opponent had had ample opportunity to provide the registration certificate or another equivalent official document (paras 71, 72, 75). The BoA is empowered neither

to provide guidance as regards the production of evidence nor to assist an opponent in proving the facts, evidence or arguments it must produce to demonstrate the existence of its earlier right (para. 74). (iv) Since proof of the earlier mark had not been adduced, there was no need to examine the fourth plea, that the earlier mark was used for the goods and services for which registration was granted, since it was ineffective (para. 79).

T-581/17; **DEVICE OF FOUR CROSSING LINES (fig.) / DEVICE OF FOUR CROSSING LINES (fig.) et al.**; *Asics Corporation v EUIPO*; Judgment 16 October 2018; EU:T:2018:685; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dissimilarity of signs, Figurative trade mark, Identity of the goods and services, Lack of reasoning, Likelihood of confusion, Scope of proceedings, Visual dissimilarity

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods in Classes 18, 24 and 25. An opposition based on the earlier EU figurative mark below (for goods in Class 18) and the earlier Spanish figurative mark below (for goods in Class 25) was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal, finding that the signs

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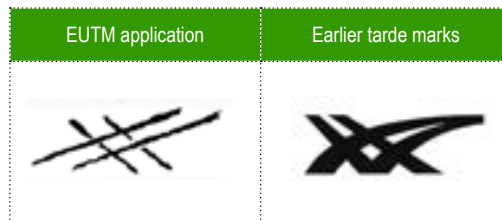
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gave an overall different impression. It added that, as the signs were purely figurative, no phonetic comparison was possible and that the conceptual comparison remained neutral. The opponent filed an action before the General Court (GC), relying on five pleas in law: (i) infringement of Article 95(1) EUTMR, as the BoA committed a manifest error in the assessment of the facts and an infringement of essential procedural requirements during the comparison of the signs, (ii) infringement of the obligation of the BoA to review the legality of the OD's decision, (iii) infringement of Article 94 EUTMR as the BoA infringed its obligation to state reasons, (iv) infringement of Article 8(1)(b) EUTMR, and (v) infringement of Article 8(5) EUTMR.



SUBSTANCE: Scope of proceedings and statement of reasons. The BoA did not disregard the existence of the earlier Spanish mark, but, in essence, considered that, for the purposes of their comparison with the contested mark, it was possible to disregard the slight differences between the two earlier marks (para. 20). Moreover, the applicant claimed the seniority of the earlier Spanish mark for

the purposes of registration of the earlier EU trade mark, which demonstrates that the applicant itself considered that those marks were identical (para. 22) As the BoA did not overlook the existence of the earlier Spanish trade mark, a statement of reasons concerning the failure to take that earlier sign into account is not warranted (para. 31). **Relevant public and comparison of goods.** The relevant public consists of consumers in the EU (para. 38) and the goods are identical. **Comparison of the signs.** Even if the consumer does not recall details such as the size or thickness of the lines, the overall impression between the thick lines and curves forming a letter 'x' superimposed on a character " on the one hand, and the thin straight lines that can be perceived as a character '#' inclined backwards to 45 degrees on the other, is so different that the consumer will not make a connection between the signs solely on the basis that they are both composed of parallel lines crossing two other, longer lines (para. 46). The overall impression given by the marks was different, and therefore, there is no visual similarity (para. 47). The signs are figurative marks without any word elements, therefore, it is not possible to compare the signs phonetically. The conceptual comparison remains 'neutral', since none of the graphic forms have a conceptual content (para. 48). **No LOC.** Given the lack of similarity between the signs, there is no LOC (paras 53-54). **Article 8(5) EUTMR.** The first of the three cumulative conditions for the application of Article 8(5), namely, the identity or similarity of the signs, is not fulfilled (paras 63-64).

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T-367/17; **Electrically operated lifting column, in particular for tables**; *Linak AS v EUIPO*; Judgment of 18 October 2018; EU:T:2018:694; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Freedom of designer, Individual character, Informed user

FACTS: The applicant applied for registration of the Community design (RCD) below for products in Classes 06-06 and 15-99. An application for a declaration of invalidity of the contested design was filed pursuant to Article 25(1)(b) CDR. The Invalidation Division (ID) upheld the application for a declaration of invalidity on the grounds that the design was not new within the meaning of Article 5 CDR. The Board of Appeal (BoA) confirmed the ID's decision, but based its argumentation on Article 25(1)(b) CDR in conjunction with Article 6 CDR and declared that the contested RCD lacked individual character. The applicant filed an action with the General Court (GC), relying on a single plea in law: infringement of Article 6 CDR.



SUBSTANCE: Nature of the products and the industrial sector concerned. The Court confirmed the BoA's findings as regards the common features of the designs compared (inverted L-shape, a smooth surface, a telescopic arm consisting of two telescoping tubes with rounded edges, a smaller rectangular plaque positioned on the lower tube of the telescopic arm, the housing on top of the telescopic arm and the rectangular shape of the housing) and the differences between them (differences in housings, the telescopic arms and the colour of the designs) (paras 21, 23). The Court also confirmed the BoA's conclusion that the sector in question was the furniture industry (paras 22, 23). **The informed user.** The Court agreed that the qualifier 'informed' suggests in addition that, without being a designer or a technical expert,

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the user is familiar with the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include and, as a result of his or her interest in the products concerned, shows a relatively high degree of attention when using them (para. 26). Thus, the concept of the 'informed user' may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his or her personal experience or his or her extensive knowledge of the sector in question (para 27). The BoA had correctly described the informed user as a purchaser of lifting columns (para. 29). Further, it stated that the BoA's definition also encompassed sellers and distributors of electrically operated lifting columns, as well as users who purchased them for their own needs. Therefore, in the present case, the informed user must be held to be both the end consumer and commercial seller (para 30). The overall impression produced by the contested design in relation to one of the two groups of informed users was the impression produced on an expert with a high level of attention (para. 32). Therefore, the BoA's assessment concerning the definition of the informed user was correct and should be confirmed (para.33). **Assessment of individual character.** The BoA had been right in finding that the appearance and structure of the designs were the same and that the only differences between them were in the details of the finish and the thickness of the housing on top of the telescopic arm, the diameter

and shape of the telescopic arm, and the colour of the designs (para. 37). Therefore, the designs were too similar to be able to produce a different overall impression on the informed user. The designs therefore did not differ from one another before or after their incorporation in a piece of furniture (para 42). The BoA had correctly stated that, even when the designs were looked at from all possible angles, the overall impression remained unchanged given the coincidence of the main features of the designs (para. 44). The Court also confirmed the BoA's conclusion that, when the contested design was incorporated in a table, it did not display differences that were sufficiently marked for it to produce a different overall impression on the informed user and to be found to have individual character (para. 46). The applicant's single plea in law therefore had to be rejected (para. 47).

T-368/17; **Electrically operated lifting column, in particular for tables**; *Linak A/S v EUIPO*; Judgment of 18 October 2018; EU:T:2018:695; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Freedom of designer, Individual character, Informed user

FACTS: The applicant applied for registration of the Community design (RCD) below for products in Classes 06-06 and 15-99. An application for a

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the housing) and the differences between them (differences in housings, the telescopic arms and the colour of the designs) (paras 21, 23). The Court also confirmed the BoA's conclusion that the sector in question was the furniture industry (paras 22, 23). **The informed user.** The Court agreed that the qualifier 'informed' suggests in addition that, without being a designer or a technical expert, the user is familiar with the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include and, as a result of his or her interest in the products concerned, shows a relatively high degree of attention when using them (para. 26). Thus, the concept of the 'informed user' may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his or her personal experience or his or her extensive knowledge of the sector in question (para 27). The BoA had correctly described the informed user as a purchaser of lifting columns (para. 29). Further, it stated that the BoA's definition also encompassed sellers and distributors of electrically operated lifting columns, as well as users who purchased them for their own needs. Therefore, in the present case, the informed user must be held to be both the end consumer and commercial seller (para 30). The overall impression produced by the contested design in relation to one of the two groups of informed users was the impression produced on an expert with a high level of attention (para. 32). Therefore, the



SUBSTANCE: Nature of the products and the industrial sector concerned. The Court confirmed the BoA's findings as regards the common features of the designs compared (inverted L-shape, a smooth surface, a telescopic arm consisting of two telescoping tubes with rounded edges, a smaller rectangular plaque positioned on the lower tube of the telescopic arm, the housing on top of the telescopic arm and the rectangular shape of

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10/12/2018, R 1328/2018-4, EMPOWERING INNOVATION TOGETHER

Outcome: Decision confirmed.

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

Keywords: Slogan mark.

Summary: The examiner refused protection for the International registration designating the European Union for all the goods and services (Class 41 – Educational and entertainment services) on the grounds that the mark is devoid of any distinctive character (§ 3).

The Board indicates first the criteria for slogan-like word marks as defined by the EU courts (from 05/12/2002, [T-130/01, Real People, Real Solutions](#), EU:T:2002:301, § 28, 29 to 12/07/2012, C 311/11, [Wir machen das Besondere einfach](#), EU:C:2012:460, § 32) (§ 10-12) underlining that the mere fact that the word combination applied for does not convey any information about the nature of the goods or services concerned is not sufficient to make that sign

distinctive (30/06/2004, [T-281/02, Mehr für Ihr Geld](#), EU:T:2004:198, § 31; 15/12/2009, [T-476/08, Best Buy II](#), EU:T:2009:508, § 19) (§ 13). In the present case, the word sequence indicates that the appellant's company empowers its clients by offering innovative solutions and works together with its clients. There is nothing fanciful, unusual or striking in this expression. The meaning of the three words together is not more than the sum of its parts. The appellant does not offer any alternative meaning or any explanation as to how this word sequence could be vague or fanciful. The meaning of the mark is immediately clear to any customer, be it an average end consumer or a member of a specialised public in the field of conferences, electronic equipment, IT or any other field of business. For the specific services applied for, this expression is devoid of any distinctive character. The claimed services in Class 41 are four subsets of services, which have in common that they provide online information about innovation, downloadable or not, also in the form of educational or entertainment content. (§ 19-22). This conclusion is consistent with the outcome of a number of cases for other slogans with a plain laudatory meaning and a broad promise of innovation and orientation towards the future (§ 30).

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06/12/2018, R 1744/2018-4, PLASTIC FREE (fig.)

EUTM application



Outcome: Decision confirmed.

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

Keywords: Figurative mark, Non-distinctive.

Summary: The examiner rejected the application for all the goods applied for (inter alia for packaging; bags, containers, cartons; containers; etc.) since the sign was descriptive and non-distinctive (§ 3).

The Board also considers that in relation to the goods applied for the sign will be understood in the meaning that the goods are free of plastic, i.e. not made of plastic. The relevant consumer will perceive the sign as providing obvious and direct information on the kind and quality of the goods in question. At the same time, it conveys a promotional message that the goods are environmentally friendly and consumers contribute to reducing plastic waste and pollution by purchasing them (§ 15). The mere fact that the word 'PLASTIC' is depicted on the upper side of the cuboid form and the word 'FREE' is depicted on the two front sides, both 'following' that cuboid form, does not distract consumers from the perception of the meaning of the words. Although

the applicant is seeking to derive distinctive character from the graphic arrangement of the sign, it must be held that this simple stylisation leaves the purely descriptive meaning of the words 'PLASTIC FREE' unaffected and is incapable of justifying the distinctiveness of the sign applied for (§ 18).

29/11/2018, R 1516/2018-5, W GIRLS DOING WHATEVER THE F ___ THEY WANT (fig.)

EUTM application



Outcome: Decision annulled.

Norms: Article 7(1)(f) EUTMR.

Keywords: Contrary to public policy or principles of morality.

Summary: The examiner stated that the sign was ineligible for registration because it would be considered offensive for a large part of the English-speaking public in the European Union.

The Board considers that despite the fact that the mark applied for, considered as a whole, evokes a concept which falls within the domain of vulgarity and profanity, the effect is attenuated by the observation that the implicit word does not appear in the mark as such and, in the given context, will not be

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understood as an insult, but rather as an intensifier. The presence of the initial figurative element “W”, combined with the euphemistic presentation of ‘F___’, also suppresses the offensive potential of the sign. As a result, the overall impression conveyed by the mark, differs from that which would result where the coarse word appears on its own, is obvious or is directly very vulgar, obscene or insulting. It is probable that consumers with a normal level of sensitivity and tolerance would not be offended or upset by regular commercial exposure to the term in connection with the relevant goods and services (§ 31). Consequently, the sign must not be declared contrary to accepted principles of morality within the meaning of Article 7(1)(f) EUTMR in relation to all of the goods and services at stake (§ 32).

08/11/2018, R 784/2017-5, PINK (fig.)

EUTM application

Outcome: Decision confirmed.

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

Keywords: Figurative mark, Descriptive, Non-distinctive.

Summary: The examiner partially refused the mark applied for certain goods in Class 3.

As regards Article 7(1)(c) EUTMR the Board finds that the word element ‘pink’ in the sign applied for is descriptive in so far as it refers to the visual aspect of the goods at issue in Class 3 (personal care products and perfumery products) covered by the mark and, second, the figurative elements do not distract the public’s attention away from the descriptive message conveyed by that word element (§ 32).

As regards Article 7(1)(b) EUTMR the sign applied for consists of a descriptive term which merely describes a principal characteristic of the goods in question. It is limited to a simple message about the colour of the goods it covers. The Board takes the view that the meaning of the sign will be understood by the consumers targeted without any analytical thought process (§ 36).

23/10/2018, R 2168/2017-5, Delcato (fig.) /delikato (fig.)

EUTM application

Earlier EUTM



Outcome: Decision partially annulled.

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Norms: Article 42(2) CTMR, Rule 22 CTMIR, Article 8(1)(b) EUTMR.

Keywords: Complementary goods and services, Evidence of use, Extent of use, Place of use, Promotional material.

Summary: The Opposition Division rejected the opposition in its entirety.

Within the assessment of proof of use, it has been found sufficient that the earlier mark has only been used in part of Germany. Taken as a whole, the evidence supports, at least indirectly, the claims made in an affidavit as to the turnover and sales under the mark (§ 45-46). With regard to the comparison of the goods and services, the use of rather broad terms by the applicant leads to the finding of there being an identity and similarity to the goods of the earlier mark (§ 57-77). As the signs are similar, a likelihood of confusion has been found to exist for the identical and similar goods and services (§ 94).

[26/10/2018, R 187/2018-2, Appgyver](#)

EUTM application

Appgyver

Outcome: Decision partially annulled.

Norms: Article 33(8) EUTMR.

Keywords: Nature of goods and services.

Summary: The trade mark was first registered as an IR in 2010, under the 9th Edition of the Nice Classification. The IR holder applied to register a declaration of goods and services other than those covered by the literal meaning of the indications of the class heading, under Article 33(8) EUTMR. The examiner took a decision ('the contested decision') partially refusing protection of the IR under Article 33(8) EUTMR after not receiving any observations as regards the deficiencies notified to the IR holder.

The Board clarifies that although the international registration at issue was registered on 4 April 2011, the Finnish priority of the application dates back to 28 February 2010, therefore, the applicable edition of the Nice Classification is not the tenth, but the ninth, valid until 31 December 2010 (§ 12). The first-instance decision is partially annulled for the Class 9 goods. The Board confirms that the Class 9 heading, in the ninth edition of the Nice Classification, did not contain the category of 'computer software' so that anything falling under that category and contained within the alphabetical list of the ninth edition is acceptable. Therefore, the goods specified as 'computer programs [downloadable software]', and previously formulated in a different manner ('computer programs and software applications'), can be accepted now, in the appeal.

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As regards the remaining goods and services the Board confirms that they are all alphabetical list terms, covered by the literal meaning of the indications of the relevant class headings and therefore are not subject of a declaration under Article 33(8) EUTMR.

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