

# Alicante News

Up to date information on IP and EUIPO-related matters

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### The Anti-Counterfeiting Blockathon Forum

The EUIPO has launched a new forum designed to encourage the development of cutting edge technological solutions to combat counterfeiting.

The [Anti-Counterfeiting Blockathon Forum](#) was unveiled by the Director General of DG Grow, Lowri Evans, at an Industry Days event held in Brussels.

The Forum will bring together people and organisations to shape and deliver the future anti-counterfeiting infrastructure based on blockchain.

The need for such a structured collaboration was clearly indicated during the [Blockathon event held by EUIPO in 2018](#), and during its follow-up workshop. The Blockathon competition saw 11 teams of coders work for 48 hours to co-create a series of anti-counterfeiting blockchain solutions for consumers, enforcement authorities, logistic operators and businesses.

In the follow-up Blockathon workshop, participants recognised the need to promote greater synchronisation, collaboration and decentralisation to connect all the relevant players. In response, the EUIPO initiated the Forum to facilitate this collaboration.

The Forum will fulfil this task by interconnecting private organisations, enforcement authorities and citizens to support the identification of authentic and counterfeit goods throughout the distribution chain.

It will focus on drafting and defining the anti-counterfeiting use case and related pilot with the ultimate goal of delivering the next level of anti-counterfeiting infrastructure based on blockchain.

The Executive Director of the EUIPO, Christian Archambeau, called on private sector organisations, and all interested individuals to join the anti-counterfeiting forum to help develop and test solutions that would successfully combat the “global plague” of counterfeiting.

“In today’s fast moving world, we need to use the latest technology to keep a reliable record of the origin of goods and their progress through international supply chains. Blockchain’s ability to create permanent and unchangeable records makes it one of the best candidates to deliver results on the ground”, he added.

[More information on the Anti-Counterfeiting Blockathon Forum.](#)

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## Registered Community Design



### 12th edition of the LOCARNO Classification

On 01/01/2019 the 12th edition of the Locarno Classification enters into force. The effects of this entry into force are identified in Communication 1/2019 of the Executive Director. The Communication indicates that the filing date of

any application will dictate the edition according to which it will be classified. This means that Locarno 12/2019 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.

The changes concerned are as follows

#### DELETED SUBCLASS:

Class	Subclass	Title
23	23-02	<a href="#">SANITARY APPLIANCES</a> [vacant]

#### NEW SUBCLASS:

Class	Subclass	Title
1	01-05	TOFU AND TOFU PRODUCTS
3	03-05	DEVICES FOR CARRYING AND WALKING WITH BABIES AND CHILDREN
7	07-09	STANDS AND HOLDERS FOR HOUSEHOLD APPLIANCES AND UTENSILS
7	07-10	COOLING AND FREEZING DEVICES AND ISOTHERMAL CONTAINERS
8	08-11	HARDWARE FOR CURTAINS
9	09-10	HANDLES AND GRIPS FOR THE TRANSPORT OR HANDLING OF PACKAGES AND CONTAINERS
12	12-17	RAILWAY INFRASTRUCTURE COMPONENTS
13	13-04	SOLAR EQUIPMENT
14	14-05	RECORDING AND DATA STORAGE MEDIA
	14-06	HOLDERS, STANDS AND SUPPORTS FOR ELECTRONIC EQUIPMENT, NOT INCLUDED IN OTHER CLASSES

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Class	Subclass	Title
15	15-10	MACHINERY FOR FILLING, PACKING OR PACKAGING
23	23-06	SANITARY APPLIANCES FOR PERSONAL HYGIENE
	23-07	EQUIPMENT FOR URINATION AND DEFECATION
	23-08	OTHER SANITARY EQUIPMENT AND ACCESSORIES, NOT INCLUDED IN OTHER CLASSES OR SUBCLASSES
27	27-07	ELECTRONIC CIGARETTES
28	28-05	AIR FRESHENERS
30	30-10	GROOMING ARTICLES FOR ANIMALS
	30-11	LITTER AND DEVICES FOR REMOVING ANIMAL EXCREMENT
	30-12	TOYS FOR ANIMALS

### CHANGE SUBCLASS - TITLE (and scope - underlined):

Class	Subclass	Title
1	01-01	BAKERS' PRODUCTS, BISCUITS, PASTRY, <u>MACARONI</u> PASTA AND OTHER CEREAL PRODUCTS, CHOCOLATES, CONFECTIONERY, ICES
7	01-05	TABLE CUTLERY <u>TABLE KNIVES, FORKS AND SPOONS</u>
8	08-09	METAL FITTINGS AND MOUNTINGS FOR DOORS, WINDOWS AND FURNITURE, AND SIMILAR ARTICLES, <u>NOT INCLUDED IN OTHER CLASSES OR SUBCLASSES</u>
14	14-03	<u>COMMUNICATIONS</u> TELECOMMUNICATIONS EQUIPMENT, WIRELESS REMOTE CONTROLS AND RADIO AMPLIFIERS
15	15-03	AGRICULTURAL AND FORESTRY MACHINERY
	15-04	CONSTRUCTION AND MINING MACHINERY
19	19-07	TEACHING MATERIALS AND APPARATUS
28	28-04	WIGS AND FALSE BEAUTY ARTICLES <u>WIGS, FALSE HAIRPIECES</u>
30	30-06	BEDS, NESTS AND FURNITURE FOR ANIMALS <u>BEDS AND NESTS</u>

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## Registered Community Design



These changes form part of a joint proposal made by National Offices participating in EUIPOs Convergence Programmes CP6 and CP7, aimed at harmonising graphic representation requirements and acceptability of product indications, respectively. These projects created a set of principles that defined common requirements for the graphic representation of designs, produced a harmonised database of accepted product indications and their accepted translations in all EU languages, and a search tool (DesignClass) to easily find these product indications and their translation.

When developing the harmonised database, the CP7 Working Group revised all existing Locarno product indications and identified improvements that could be made to the Locarno Classification in order to bring the system in line with market realities. These improvements were combined into the joint proposal for changes to the Locarno Classification. The proposed improvements will benefit designers and practitioners alike, as a Locarno system that better reflects of contemporary products and trends will facilitate classification and ensure more adequate design protection.

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

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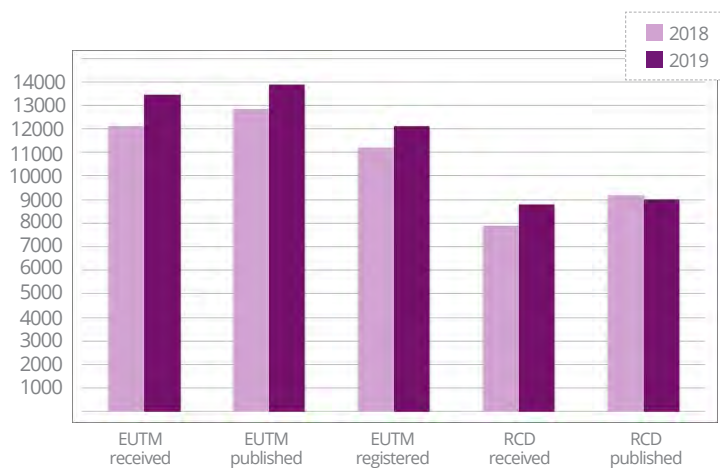


## Statistical Highlights



Monthly statistical highlights January*	2018	2019
European Union Trade Mark applications received	12 106	13 453
European Union Trade Mark applications published	12 863	13 877
European Union Trade Marks registered (certificates issued)	11 209	12 106
Registered Community Designs received	7 865	8 800
Registered Community Designs published	9 194	8 989

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



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## Sweden launches new online services for trade marks and designs

The Swedish Patent and Registration Office (PRV) has introduced a new service that allows users to file oppositions online. This e-service is part of the Software Package Front Office, a tool developed under the auspices of the EUIPO's European Cooperation Fund.

Over the last 12 months, PRV has launched 15 new e-services for trade marks and designs in cooperation with the EUIPO.

PRV's online services platform is expected to serve around 13 000 applications per year. The platform and the new e-services facilitate the introduction of future IP legislation by streamlining and modernising the way users perform all activities connected with the trade mark and design lifecycle.

Under the provisions of Article 151 EUTMR, the EUIPO and its stakeholders are working together on five major European cooperation projects. The overall aim of the projects is to benefit users across the EU by providing modern, state-of-the-art tools and services for EU IP offices.

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### New Decision on communication by electronic means and list of official fax numbers

On 1 March 2019, Decision No EX-19-1 of the Executive Director of the Office on 'communication by electronic means' entered into force.

According to the Decision, as from 1 March 2019, in all procedures relating to EU trade marks and Community designs where fax is an accepted means of communication, all incoming fax submissions must be sent to the official general fax number of the Office in order to be acceptable.

The list of official fax numbers is available in Annex 1.

Consequently, any incoming fax that is addressed to a fax number not included in Annex 1 of Decision No EX-19-1 will be deemed not to have been received as from this date.

### Applications for Division of International Registrations available

As of 1 February 2019 it is possible to file applications for the Division of International Registrations designating the EU (according to the Amendments to the Madrid Protocol Regulation - Rule 27bis).

The request must be submitted via the EUIPO in the language of the International Registration using the WIPO form MM22 available [here](#). Please see more on the Division of International Registrations in the [Help & FAQs](#) section.

### IP Mediation Conference 30-31 May 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. More information, including the conference programme and registration details, can be found [here](#)

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### Luxembourg trade mark and design news

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

**C-340/17 P; ALCOLOCK; Alcohol Countermeasure Systems (International) Inc. v EUIPO; Judgment of 29 November 2018; EU:C: 2018:965;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Distortion of facts or evidence, Evidence of use, Identity of the signs, Matters of fact appealed to CJ, Proof of use, Suspension of the proceedings

**FACTS:** The EUTM proprietor registered the word mark ALCOLOCK as an EUTM for goods and services in Classes 9, 37 and 42. An invalidity application was filed pursuant to Article 60(1)(a) EUTMR in conjunction with, inter alia, Article 8(1)(a) and (b) EUTMR and based on the earlier United Kingdom word mark ALCOLOCK for goods in Class 9. The Cancellation Division (CD) upheld the invalidity application. It found that the earlier mark had been put to genuine use, that the goods and services in question were identical or similar, and that the signs at issue were identical. The invalidity applicant filed

an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the invalidity applicant had established to the requisite legal standard that the earlier mark had been put to genuine use in the United Kingdom, that some of the goods in question were identical, as were the signs at issue, and that there was a LOC between those signs within the meaning of Article 8(1) EUTMR. The proprietor appealed to the General Court (GC), contesting, in essence, the BoA's assessment of the genuine use of the earlier mark. The GC dismissed the appeal. It found that proof of genuine use of the earlier mark could be furnished by means of evidence relating to the use of another word mark consisting of the same sign, ALCOLOCK. The proprietor appealed to the Court of Justice of the European Union (CJ).

**SUBSTANCE:** Proof of genuine use of earlier marks. Use of a sign identical to that constituting the earlier mark and itself registered as a trade mark under a different number from the earlier mark, constitutes use of that mark for the purposes of applying the first subparagraph of Article 18(1) EUTMR (para. 58). Impact of the 23 June 2016 referendum on withdrawal of the United Kingdom from the EU. The GC may not, according to the case-law of the CJ, annul or alter a decision of the BoA on grounds that come into existence subsequent to its adoption (para. 116). The GC was thus not required to stay the proceedings pending before it following the United Kingdom's referendum on withdrawal from the EU on the ground, moreover purely hypothetical at

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that stage, that said withdrawal would retroactively affect the outcome of invalidity proceedings based on an earlier trade mark of that Member State (para. 117). Furthermore, the mere communication by a Member State of its intention to leave the EU in accordance with Article 50 of the Treaty on European Union (TEU) does not have the effect of suspending the application of EU law in that Member State. Consequently, EU law continues in full force and effect in that Member State until the time of its actual withdrawal from the European Union (para. 118).

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

**T-681/17; KHADI / KHADI; Khadi and Village Industries Commission v EUIPO; Judgment of 29 November 2018; EU:T:2018:858;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Bad faith, Belated evidence, Claim for alteration of EUIPO decision, Deceptive element, Distortion of facts or evidence, Emblem, Functional continuity, Ratio legis, Word mark

**FACTS:** The EUTM proprietor registered the word mark KHADI as an EUTM for goods in Classes 3, 21 and 31. An invalidity application was filed pursuant to Article 59(1)(b) EUTMR, Article 59(1)(a) in conjunction with Article 7(1)(g) and (i) EUTMR, Article 60(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR, and Article 60(1)(c) in conjunction with Article 8(4) EUTMR. The Cancellation Division (CD) dismissed the invalidity application. The invalidity applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the applicant had not adduced proof of any of the grounds of invalidity relied on. The invalidity applicant filed an action with the General Court (GC), relying on five pleas in law: (i) infringement of Article 95(2) EUTMR, (ii) distortion of the evidence, (iii) infringement of Article 7(1)(g) and Article 59(1)(a) EUTMR, (iv) infringement of Article 7(1)(g) and Article 59(1)(a) EUTMR and (v) infringement of Article 59(1)(b) EUTMR.

**SUBSTANCE:** Submission of items of evidence for the first time before the BoA. Since the special rule contained in the third subparagraph of Rule 50(1) of Regulation 2868/95, which allows the BoA to take into account additional and supplementary facts and evidence in certain cases, refers only to opposition proceedings, the BoA erred in concluding that it applied to these invalidity proceedings based on both relative and absolute invalidity grounds. However, that error has no effect on the lawfulness of the contested decision, as the BoA examined the nature and the content of the evidence and

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concluded it was not relevant to the outcome of the case, before finding it to be inadmissible in the exercise of its discretion (paras 22-25). Distortion of evidence. The invalidity applicant has failed to provide proof of distortion of evidence by the BoA (paras 33-36). Deceptiveness. None of the invalidity applicant's evidence or arguments permit the inference that the general public, or even the part of the United Kingdom population that is of Indian origin, is generally familiar with the term 'khadi' or its role for Indian industry and, consequently, the BoA rightly assessed that the term is an uncommon word and that it cannot be assumed that the term will be understood by that public. If the relevant public does not associate the term 'khadi' with any specific meaning, the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived cannot be established (paras 48-53). Prohibition of marks which include badges, emblems or escutcheons of particular public interest. Since the evidence submitted by the applicant is insufficient to allow it to be concluded that the relevant public will attribute any meaning to the term 'khadi' or would associate it with any organisation whatsoever, the BoA rightly concluded that no badge, emblem or escutcheon would be identified by that public in the sign at issue (para. 61). Bad faith. The BoA did not err in concluding that it had not been established that, when the application for registration of the contested mark was filed, the intention of the applicant for that registration was to usurp the invalidity applicant's reputation, inter

alia because no recognition or extensive use of the invalidity applicant's mark had been demonstrated (para. 79). The contested decision is not vitiated by any ground of unlawfulness and the action of the invalidity applicant must therefore be rejected (paras 81-82).

**T-682/17; khadi Naturprodukte aus Indien (fig.) / KHADI et al.; Khadi and Village Industries Commission v EUIPO; Judgment of 29 November 2018; EU:T:2018:856;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Bad faith, Belated evidence, Claim for alteration of EUIPO decision, Deceptive element, Distortion of facts or evidence, Functional continuity, Ratio legis, Figurative trade mark

**FACTS:** The EUTM proprietor registered the figurative mark below as an EUTM for inter alia goods in Class 3. An invalidity application was filed pursuant to Article 59(1)(b) EUTMR, Article 59(1)(a) in conjunction with Article 7(1)(g) and (i) EUTMR, Article 60(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR, and Article 60(1)(c) in conjunction with Article 8(4) EUTMR. The Cancellation Division (CD) dismissed the invalidity application. The invalidity

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applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the applicant had not adduced proof of any of the grounds of invalidity relied on. The invalidity applicant filed an action with the General Court (GC), relying on four pleas in law: (i) infringement of Article 95(2) EUTMR, (ii) distortion of the evidence, (iii) infringement of Article 7(1)(g) and Article 59(1)(a) EUTMR, and (iv) infringement of Article 59(1)(b) EUTMR.

### EUTM



**SUBSTANCE:** Submission of items of evidence for the first time before the BoA. Since the special rule contained in the third subparagraph of Rule 50(1) of Regulation 2868/95, which allows the BoA to take into account additional and supplementary facts and evidence in certain cases, refers only to opposition proceedings, the BoA erred in concluding that it applied to these invalidity proceedings based on both relative and absolute invalidity grounds. However, that error has no effect on the lawfulness of the contested decision, as the BoA examined the nature and the content of the evidence and concluded it was not relevant to the outcome of

the case, before finding it to be inadmissible in the exercise of its discretion (paras 22-25). Distortion of evidence. The invalidity applicant has failed to provide proof of distortion of evidence by the BoA (paras 33-36). Deceptiveness. None of the invalidity applicant's evidence or arguments permit the inference that the general public, or even the part of the United Kingdom population that is of Indian origin, is generally familiar with the term 'khadi' or its role for Indian industry and, consequently, the BoA rightly assessed that the term is an uncommon word and that it cannot be assumed that the term will be understood by that public. If the relevant public does not associate the term 'khadi' with any specific meaning, the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived cannot be established (paras 48-53). Bad faith. The BoA did not err in concluding that it had not been established that, when the application for registration of the contested mark was filed, the intention of the applicant for that registration was to usurp the invalidity applicant's reputation, inter alia because no recognition or extensive use of the invalidity applicant's mark had been demonstrated (para. 72). The contested decision is not vitiated by any ground of unlawfulness and the action of the invalidity applicant must therefore be rejected (paras 74-75).

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**T-683/17; Khadi Ayurveda-KHADI; Khadi and Village Industries Commission v EUIPO; Judgment of 29 November 2018; EU:T:2018:860;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Bad faith, Belated evidence, Claim for alteration of EUIPO decision, Deceptive element, Distortion of facts or evidence, Functional continuity, Ratio legis, Word mark

**FACTS:** The EUTM proprietor registered the word mark Khadi Ayurveda as an EUTM for inter alia goods in Class 3. An invalidity application was filed pursuant to Article 59(1)(b) EUTMR, Article 59(1)(a) in conjunction with Article 7(1)(g) and (i) EUTMR, Article 60(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR, and Article 60(1)(c) in conjunction with Article 8(4) EUTMR. The Cancellation Division (CD) dismissed the invalidity application. The invalidity applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the applicant had not adduced proof of any of the grounds of invalidity relied on. The invalidity applicant filed an action with the General Court (GC), relying on four pleas in law: (i) infringement of Article 95(2) EUTMR, (ii) distortion of the evidence, (iii) infringement of Article 7(1)(g) and Article 59(1)(a) EUTMR, and (iv) infringement of Article 59(1)(b) EUTMR.

**SUBSTANCE:** Submission of items of evidence for the first time before the BoA. Since the special rule contained in the third subparagraph of Rule 50(1) of Regulation 2868/95, which allows the BoA to take into account additional and supplementary facts and evidence in certain cases, refers only to opposition proceedings, the BoA erred in concluding that it applied to these invalidity proceedings based on both relative and absolute invalidity grounds. However, that error has no effect on the lawfulness of the contested decision, as the BoA examined the nature and the content of the evidence and concluded it was not relevant to the outcome of the case, before finding it to be inadmissible in the exercise of its discretion (paras 22-25). Distortion of evidence. The invalidity applicant has failed to provide proof of distortion of evidence by the BoA (paras 33-36). Deceptiveness. None of the invalidity applicant's evidence or arguments permit the inference that the general public, or even the part of the United Kingdom population that is of Indian origin, is generally familiar with the term 'khadi' or its role for Indian industry and, consequently, the BoA rightly assessed that the term is an uncommon word and that it cannot be assumed that the term will be understood by that public. If the relevant public does not associate the term 'khadi' with any specific meaning, the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived cannot be established (paras 48-53). Bad faith. The BoA did not err in concluding that it had not been established that, when the application for

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registration of the contested mark was filed, the intention of the applicant for that registration was to usurp the invalidity applicant's reputation, inter alia because no recognition or extensive use of the invalidity applicant's mark had been demonstrated (para. 71). The contested decision is not vitiated by any ground of unlawfulness and the action of the invalidity applicant must therefore be rejected (paras 73-74).

**T-651/17; Spray guns for paint; Sata GmbH & Co. KG v EUIPO; Judgment of 29 November 2018; EU:T:2018:855;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Functional element, No bearing on decision, Statement of grounds

**FACTS:** The RCD proprietor registered the design below as an RCD for goods in Class 08.05 of the Locarno Classification. An invalidity application was filed pursuant to Article 25(1)(b) CDR in conjunction with Articles 4 to 9 CDR, relying, inter alia, on the earlier design below. The Invalidity Division (ID) upheld the invalidity application. It found that the contested design lacked individual character. The RCD proprietor filed an appeal. The Board of Appeal (BoA) dismissed the appeal, insofar as it found

that that the contested design lacked individual character with regard to the earlier design, since the differences between them were insufficient to produce a different overall impression on the informed user. The RCD proprietor filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 25(1)(b) CDR in conjunction with Article 6 CDR, and (ii) infringement of Articles 62 and 64 CDR.

### RCD



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**SUBSTANCE:** The designer's degree of freedom. Paint spray guns follow the same basic concept: they share the same basic shape of a gun and the components necessary for their function of painting, namely the handle, the trigger and the muzzle, as well as the devices for adjustment of paint flow and pressurised air. However, it is perfectly possible that the size, the shape of the handle, the weight, the structure and the arrangement of the components of paint spray guns will vary from one design to another (para. 34). There is a considerable degree of design freedom for paint spray guns with regard to their appearance and specific arrangement (para. 35). Individual character. It does not automatically follow from the technical function of the components of a paint spray gun that all these components must have identical features of appearance. The appearance of all these components, namely the gun body, the spray head, the trigger and the handle might vary in shape and proportions. The BoA was right to find that, despite the fact that the informed user will not give great weight to the presence of these components on account of their technical function, there is no reason to ignore their specific appearance in the overall impression (para. 42). The use of the notion of 'déjà vu' is in keeping with settled case-law in this area, in particular, on the notion of the individual character of a design (para. 48). Possible saturation of the state of the art. The differences between the designs would not tend to give rise to a different overall impression for an informed user even in the

event of saturation of the state of the art. Although the BoA did not use the expression 'saturation of the state of the art', it did address the relevant argument (para. 55). In addition, the RCD proprietor merely repeated before the BoA established case-law, and mentioned in that context a possible impact of a saturation of the state of the art. However, the RCD proprietor did not submit sufficient evidence to establish the existence of a saturation of the state of the art in the field of paint spray guns, or that the saturation of the state of the art might affect the informed user's perception (para. 56). The RCD proprietor did not submit other designs to substantiate its claims relating to the saturation of the state of the art (para. 57).

**T-460/17; DARSTELLUNGEINESGLEICHWINKLIGEN ACHTECKS; Carsten Bopp v EUIPO; Judgment of 21 November 2018; EU:T:2018:816;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Burden of proof, Distinctive element, Right of defence, Right to be heard, Substantial procedural violation

**FACTS:** The applicant sought to register the figurative mark below claiming the colour 'blue' as an EUTM for the goods and services in Classes 16, 42

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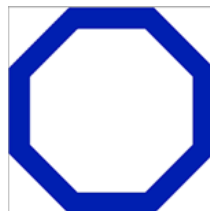
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and 45. The examination proceedings were stayed until the final outcome on the registrability of the applicant's parallel EUTM application (EUTMA) for a green octagonal frame. When the Court of Justice (C-653/15) dismissed the appellant's appeal regarding the latter, confirming that the parallel EUTMA lacked distinctive character, the examiner gave the applicant the opportunity to submit observations on the judgment. The Office did not receive any observations. Irrespective of this fact, it refused the EUTMA referring to the ECJ judgment. The applicant appealed, claiming before the Boards of Appeal (BoA) that (i) he submitted observations that were not taken into account, (ii) he was never given the opportunity to submit observations regarding the claim that the EUTMA was not registrable in part of the EU and (iii) the EUTMA were distinctive. The BoA dismissed the appeal confirming non-distinctiveness of the mark. Since the examiner refused the EUTMA, with reference to the judgment regarding the green octagonal frame, it was up to the applicant to prove that the contested mark would be perceived as an indication of the origin. 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 94 EUTMR.



### EUTM application



**SUBSTANCE:** (i) The BoA correctly endorsed the analysis carried out in line with judgment T-209/14 (Green octagonal frame) (para. 59). The EUTM application is devoid of distinctive character across the EU. The sign is a regular, blue-coloured octagon. Compared to a simple octagon, an octagonal frame does not possess any perceptible difference that would be capable of attracting the attention of the relevant public to any greater extent. As a purely decorative element, such as a blue seal or label or a blue outline, the exact meaning of the seal or label is not obvious, consequently, the sign will not be perceived as a commercial identification (para. 57). In the absence of any additional text or images, or any other particular measures (continued advertising, etc.), the relevant public (both general and specialised) would not be able to assign the contested mark to a specific undertaking (para. 63). When an applicant challenges the Office's assessment of non-distinctiveness, it is up to that applicant to provide specific and substantiated information to show that it has either an intrinsic

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distinctive character or a distinctive character acquired by usage (para. 60). The applicant did not substantiate its argument that the mark was unusual (para. 62). The mark is in fact very simple and does not contain any element which could be perceived as an indicator of origin (para. 63). The contested decision does not lack reasoning as to the assessment of the goods and services applied for. A general reasoning may be given for a homogenous group of goods. Since the reasoning that the sign is merely decorative applies to all goods and services, the group is homogenous (paras 55-57). The contested decision does not lack reasoning as to the registered marks quoted by the applicant, either. The BoA was not obliged to provide specific reasons in that regard (para. 67). (ii) As to the claim that the Office infringed the applicant's right to be heard by not taking one of its submissions into account, the applicant admitted that it had only saved a draft of its observations in its user account without proceeding to click on the 'confirm' button in order to submit the draft. It failed to show that it had indeed sent its observations producing a receipt on behalf of the Office (para. 40). Therefore, these observations were presented as evidence for the first time before the GC, and were, thus, inadmissible (para. 49).

**T-82/17; Exxtra Deep; PepsiCo, Inc. v EUIPO; Judgment of 21 November 2018; EU:T:2018:814;**

**Language of the case:** EN

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

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

**FACTS:** The EUTM proprietor registered the word mark Exxtra Deep as an EUTM for goods in Classes 29, 30 and 31. An invalidity application was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The Cancellation Division (CD) partially granted the invalidity application. It noted that some goods, in particular, dried fruits and vegetables, were not sold cut in ridges in the same way as crisps therefore concluding that registration of the contested mark had to be maintained for preserved, dried, and cooked fruits and vegetables in Class 29. The invalidity applicant appealed, but the Board of Appeal (BoA) dismissed the appeal and confirmed that the contested mark was neither descriptive nor devoid of distinctive character for preserved, dried, and cooked fruits and vegetables in Class 29. According to the BoA, the relevant public could, at most, view the contested mark as an allusion to a particular cut of vegetables or fruits, but not as a description of the characteristics of those goods. The

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invalidity applicant appealed to the General Court (GC), relying on two pleas in law: (i) infringement of Articles 7(1)(b) and (c) EUTMR, and (ii) infringement of Article 33(2), (4) and (5) EUTMR.

**SUBSTANCE:** Snack products, in particular, crisps, are made from potatoes, which are vegetables, as demonstrated by the definition in the Oxford English Dictionary produced before the Office (para. 54). However, crisps can be made from vegetables other than potatoes, or from fruit (para. 55). Crisps made from vegetables or fruit could be regarded as dried or cooked vegetables or fruits, and they can be fried, dried or cooked (para. 56). Fruit and vegetables in Class 29 are preserved, dried and cooked. Crisps, or more broadly, extruded and pelletised or otherwise manufactured or processed vegetable and potato products for snacks, are produced from preserved, dried or cooked vegetables and fruits (para. 57). Therefore, extruded and pelletised or otherwise manufactured or processed vegetable and potato products for snacks in Class 29 are covered by the preserved, dried and cooked fruit and vegetables category in the same class (para. 58). There is a certain inconsistency in the Office's recent decision-making practice in regard to preserved, dried, and cooked fruits and vegetables (para. 62). In order to assess its descriptive character for preserved, dried or cooked fruits and vegetables in the same class, the BoA should have taken into account the finding that the contested mark had descriptive character for extruded and pelletised or otherwise manufactured

or processed vegetable and potato products for snacks in Class 29, (para. 64). Consequently, the contested decision must be annulled insofar as it did not refuse the contested mark in respect of preserved, dried and cooked fruits and vegetables in Class 29 (para. 66).

**T-416/17; fino Cyprus Halloumi Cheese (fig.) / HALLOUMI; Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO; Judgment of 23 November 2018; EU:T:2018:834;**

**Language of the case:** EN

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

**KEYWORDS:** Collective mark, Common element, Conceptual similarity, Distinctive element, Dominant element, Identity of the goods and services, No bearing on decision, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods in Class 29 (cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination); rennet). An opposition based on the earlier EU collective word mark HALLOUMI registered for goods in Class 29 (cheeses), was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5)

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EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) compared the marks and found that there was no visual, phonetic or conceptual similarity. The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

### EUTM application



### Earlier trade mark

**HALLOUMI**

**SUBSTANCE:** Relevant public. Contrary to the opponent's submissions, the BoA did not seek to limit its analysis to the public of the UK only, but has merely referred to the perception of the term 'fino' by that public on account of its resemblance to the English word 'fine', and its meaning in Spanish or Italian, solely in assessing the distinctiveness of that term as it appears in the contested trade mark (para. 31). The relevant public is the EU average end consumer with an average level of attention (para. 30). Similarity of the goods. The goods are

identical (para. 30). Similarity of the signs. (i) Visual similarity is low. The word 'fino' is dominant because of its central position and its size, colour and inclusion in a golden, oval background, which serves to highlight it. The common word element 'halloumi', situated in the lower part, is also situated in a central position, written in white letters on a red background, enabling it to easily stand out; however, it is the sole element composing the earlier mark. The figurative elements of the contested mark do not alter the impression, since they are not very original and do not modify the visibility of the word element 'halloumi' (paras 61-62). (ii) It cannot be excluded that part of that public, even a minority, may read the mark in full or pronounce the word 'fino' followed by the word 'halloumi'. The fact that the earlier mark is contained within the contested mark inevitably results in a phonetic similarity, however, in view of the different number of syllables, this must be regarded as low (para. 64). (iii) Although the series of three words 'cyprus halloumi cheese' is only very weakly distinctive, it is linked with the goods designated by the contested mark. This does not, however, mean that the words, in particular the word 'halloumi', cannot be considered individually by a part of the relevant public. Therefore, there is a low degree of conceptual similarity (para. 66). No bearing on decision. The fact that the BoA described the earlier mark as a UK national trade mark is obviously an error of fact with no effect on the legality of that decision (para. 27).

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**T-417/17; fino Cyprus Halloumi Cheese (fig.) / HALLOUMI et al.; Republic of Cyprus v EUIPO; Judgment of 23 November 2018; EU:T:2018:833;**

**Language of the case:** EN

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

**KEYWORDS:** Certification mark, Common element, Conceptual similarity, Distinctive element, Dominant element, Identity of the goods and services, No bearing on decision, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods in Class 29 (cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination); rennet). An opposition based on the earlier UK certification word mark HALLOUMI registered for goods in Class 29 (cheeses), was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) compared the marks and found that there was no visual, phonetic or conceptual similarity. It also found that the references to the nature of UK certification marks and the scope of the protection that they confer under national law are irrelevant at the comparison of the signs stage. The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

### EUTM application



### Earlier trade mark

**HALLOUMI**

**SUBSTANCE:** Relevant public. Since the earlier mark is a UK mark, the relevant public is the UK general public. In the light of the category of the goods and their low price, the level of attention of that public is low to average (para. 41). Comparison of the goods. The goods are identical (para. 41). Comparison of the signs. (i) Visual similarity is low. The word 'fino' is dominant because of its central position and its size, colour and inclusion in a golden, oval background, which serves to highlight it. The common word element 'halloumi', situated in the lower part, is also situated in a central position, written in white letters on a red background, enabling it to easily stand out; however, it is the sole element composing the earlier mark. The figurative elements of the contested mark do not alter the impression, since they are not very original and do not modify the visibility of the word element 'halloumi' (paras 58-59). (ii) It cannot

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be excluded that part of that public, even a minority, may read the contested mark in full or pronounce the word 'fino' followed by the word 'halloumi'. The fact that the earlier mark is contained within the contested mark inevitably results in a phonetic similarity, however, in view of the different number of syllables, this must be regarded as low (para. 61). (iii) The concept conveyed by the earlier mark, which contains the series of three words 'cyprus halloumi cheese', is only very weakly distinctive, because it is linked with the goods designated by the contested mark. This does not, however, mean that the words, in particular the word 'halloumi', cannot be considered individually by a part of the relevant public. Therefore, there is a low degree of conceptual similarity (para. 63). Certification mark. The reasoning regarding the assessment of the distinctiveness of the earlier mark as a UK certification mark is irrelevant to the assessment of the lawfulness of the contested decision (para. 66).

**T-702/17; PAP PAPOUIS HALLOUMI / HALLOUMI (I); Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO; Judgment of 23 November 2018; EU:T:2018:832;**

**Language of the case:** EN

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

**KEYWORDS:** Collective mark, Common element, Conceptual similarity, Distinctive element, Dominant element, Geographical origin, Identity of the goods and services, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods in Class 29 (cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination), rennet). An opposition based on the earlier EU collective word mark HALLOUMI registered for goods in Class 29 (cheese made from sheep's and/or goat's milk; cheese made from blends of cow's milk; all included in Class 29), was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) compared the marks and found that there was no visual, phonetic or conceptual similarity. It found that, given the low inherent distinctiveness of the earlier mark and since the latter was not geographically descriptive, it could not fall within the exception of Article 74(2) EUTMR, which authorises, as an exception, the registration of an EU collective mark that is descriptive. With regard to the enhanced distinctiveness acquired through use of the earlier mark, the evidence adduced is not relevant, since it only shows use of the term 'halloumi' as a generic name designating a speciality cheese of Cyprus, but not as an EU collective mark. The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

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### EUTM application



### Earlier trade mark

**HALLOUMI**

**SUBSTANCE:** Relevant public. The relevant public is made up of average end consumers, given that cheese is a product that everyone consumes almost daily (para. 12). Similarity of the signs. (i) Visual similarity is low: although the common word element 'halloumi' is in a central position, written in stylised, white characters surrounded by blue and gold, however, it is the sole element composing the earlier mark. The figurative elements of the contested mark do not alter that impression, since they are not very original and do not modify the word element 'halloumi' (paras 54-55). (ii) It cannot be excluded that the relevant public will read the three, equally dominant, elements of the contested mark in full. The fact that the earlier mark is contained within the contested mark necessarily entails phonetic similarity when the three elements

forming the expression 'pap papouis halloumi' are pronounced. However, the degree of similarity is low due to, inter alia, the different number of syllables (para. 57). (iii) The elements 'pap' and 'papouis' are clearly distinctive and dominant in the contested mark, but the concept conveyed by the earlier mark via the word 'halloumi' (which might be considered individually, despite its weak distinctiveness) must lead to a finding that there is a low degree of conceptual similarity (para. 59). Previous judgments. The configuration of the earlier mark is different to the one in the judgments invoked by the Office regarding the common element, since the word 'halloumi' neither forms part of a larger word element, nor a series of words. Therefore, it retains its autonomy and, consequently, its visibility as regards the public. The solution arising from the three judgments, in which the common word element was incorporated into a longer word element and could be considered as constituting an inseparable unit, cannot be transposed to the present case. It cannot be ruled out that, in the overall impression produced by the contested mark, the word 'halloumi' may be taken into consideration (paras 51-52).

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**T-703/17; PAP PAPOUIS HALLOUMI / HALLOUMI (II); Republic of Cyprus v EUIPO; Judgment of 23 November 2018; EU:T:2018:835;**

**Language of the case:** EN

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

**KEYWORDS:** Certification mark, Common element, Conceptual similarity, Distinctive element, Dominant element, Identity of the goods and services, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods in Class 29 (cheese made out of cow's milk and/or sheep's milk and/or goat's milk (from any milk proportion and combination), rennet) An opposition based on the earlier UK certification word mark HALLOUMI registered for goods in Class 29 (cheese made from sheep's and/or goat's milk; cheese made from blends of cow's milk; all included in Class 29), was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) compared the marks and found that there was no visual, phonetic or conceptual similarity. As for the fact that the contested mark is a UK certification mark, it stated that this could only be taken into consideration during the overall assessment of the likelihood of confusion (LOC). The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.



### EUTM application



### Earlier trade mark

**HALLOUMI**

**SUBSTANCE:** Relevant public. Since the earlier mark is an EU mark, the relevant public is the UK general public. In light of the category of the goods and their low price, the level of attention is low to average (para. 38). Similarity of the goods. The goods are identical (para. 38). Similarity of the signs. (i) Visual similarity is low: although the common word element 'halloumi' is in a central position, written in stylised, white characters surrounded by blue and gold, it is the sole element composing the earlier mark. The figurative elements of the contested mark do not alter that impression, since they are not very original and do not modify the word element 'halloumi' (paras 56-57). (ii) It cannot be excluded that the relevant public will read the three, equally dominant, elements of the contested mark in full. The fact that the earlier mark is contained within

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the contested mark necessarily entails phonetic similarity when the three elements forming the expression 'pap papouis halloumi' are pronounced. However, the degree of similarity is low due to, inter alia, the different number of syllables (para. 59). (iii) The elements 'pap' and 'papouis' are clearly distinctive and dominant in the contested mark, but the concept conveyed by the earlier mark via the word 'halloumi' (which might be considered individually, despite its weak distinctiveness) must lead to a finding that there is a low degree of conceptual similarity (para. 61). Previous judgments. The configuration of the earlier mark is different to the one in the judgments invoked by the Office, since the word 'halloumi' neither forms part of a larger word element nor a series of words. Therefore, it retains its autonomy and, consequently, its visibility as regards the public. The solution arising from the three judgments, in which the common word element was incorporated into a longer word element and could be considered as constituting an inseparable unit, cannot be transposed to the present case. It cannot be ruled out that, in the overall impression produced by the contested mark, the word 'halloumi' may be taken into consideration (paras 53-54).

**T-372/17; LV POWER ENERGY DRINK (fig.) / LV (fig.); Louis Vuitton Malletier v EUIPO; Judgment of 29 November 2018; EU:T:2018:851;**

**Language of the case:** EN

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

**KEYWORDS:** Dissimilarity of signs, Dissimilarity of the goods and services, Reputation

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 32, 35 and 43. An invalidity application was filed for all the abovementioned goods and services pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(5) EUTMR, based on the earlier figurative mark below. The Cancellation Division (CD) dismissed the invalidity application. The invalidity applicant filed an appeal against the CD's decision and the Board of Appeal (BoA) dismissed the appeal. The invalidity applicant filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(5) EUTMR and (ii) infringement of the principle of legal certainty and infringement of Article 94 EUTMR.

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### EUTM application



### Earlier trade mark



**SUBSTANCE:** Infringement of Article 94 EUTMR. The CD's decision shows that based on documents provided by the invalidity applicant, the reputation of the earlier mark in the EU was established by the Office in four decisions between 2002 and 2015, and was supported by several national decisions between 2007 and 2013. At least some of the decisions also show that this reputation was for goods identical to those in the present case (para. 49). Although the earlier decisions of the Office were duly relied on by the invalidity applicant, they were not examined or even specifically identified in the contested decision. The BoA merely stated that the Office was not bound by its previous decision-making practice

(para. 41). The BoA should have explicitly stated its reasons for departing from the previous decisions concerning the reputation of the earlier mark, as the context in which it adopted the contested decision included reliance on those previous decisions. It is clear that the BoA did not show in any way that the mark no longer had a reputation, or that its reputation had become weaker since those decisions were handed down, or that the previous decisions were potentially unlawful (para. 52). The decision of the BoA was therefore adopted in breach of Article 94 EUTMR. It is not necessary to examine the alleged infringement of the principle of legal certainty (para. 53). Visual comparison. The combination of the letters 'l' and 'v' is the sole element of the earlier mark and the dominant element of the contested mark, while the element 'power energy drink' will attract the attention of the relevant public less. Contrary to the BoA's finding, the overall impressions created by the marks at issue do not differ significantly and the marks must be considered to have at least an average degree of visual similarity (para. 80). Phonetic comparison. For at least part of the relevant public, the letters 'l' and 'v' will be pronounced in the same order and in the first place, so there is, contrary to the findings of the BoA, an average phonetic similarity between the marks at the very least (paras 84-85). Conceptual comparison. The marks at issue are conceptually dissimilar due to the presence of the word element 'power energy drink' (para. 87). Even assuming they are conceptually dissimilar, overall,

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the signs are similar to an average degree, contrary to the BoA's assessment (para. 88). Reputation. The BoA erred in finding the reputation of the earlier mark could not be proved in the documents produced, with the exception of the brand rankings and the website Wikipedia, on account of the mere fact that it appeared as part of a pattern (the 'Monogram canvas') or together with the word mark LOUIS VUITTON (para. 95). The BoA conducted an incomplete assessment of the reputation of the earlier mark and, in addition, distorted the clear sense of some of the evidence (para. 100). The Court finds that the BoA's assessment regarding the application of Article 8(5) EUTMR is vitiated by several errors or lacunae, relating to the comparison of the signs at issue, the existence of the reputation of the earlier mark and the strength of that reputation (para. 112).

**T-373/17; LV BET ZAKŁADY BUKMACHERSKIE (fig.) / LV (fig.); Louis Vuitton Malletier v EUIPO; Judgment of 29 November 2018; EU:T:2018:850;**

**Language of the case:** EN

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

**KEYWORDS:** Dissimilarity of signs, Dissimilarity of the goods and services, Reputation

**FACTS:** The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 28, 35 and 41. An opposition based on the earlier figurative mark below was filed for all the abovementioned goods and services pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division (OD) upheld the opposition. It found that the signs had a low degree of visual similarity, that they had a low, average or very high degree of phonetic similarity, depending on the part of the relevant public taken into consideration, and that they were conceptually dissimilar. The OD also found that the reputation of the earlier mark was proven in the EU for a significant part of the goods it covered in Classes 18 and 25 and that an association between the marks was possible. Lastly, it considered that the mark applied for was likely to take unfair advantage of the reputation and the distinctive character of the earlier mark. The applicant filed an appeal. The Board of Appeal (BoA) upheld the appeal, annulled the OD's decision and rejected the opposition in its entirety. The opponent filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(5) EUTMR and (ii) infringement of the principle of legal certainty and infringement of Article 94 EUTMR.

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### EUTM application



### Earlier trade mark



**SUBSTANCE:** Infringement of Article 94 EUTMR. The OD's decision shows that based on documents provided by the opponent, the reputation of the earlier mark in the EU was established by the Office in four decisions between 2002 and 2015, and was supported by several national decisions between 2007 and 2013. At least some of the decisions also show that this reputation was for goods identical to those in the present case (para. 48). Although the earlier decisions of the Office were duly relied on by the opponent, they were not examined or even specifically identified in the contested decision. The BoA merely stated that the Office was not bound

by its previous decision-making practice (para. 40). The BoA should have explicitly stated its reasons for departing from the previous decisions concerning the reputation of the earlier mark, as the context in which it adopted the contested decision included reliance on those previous decisions. It is clear that the BoA did not show in any way that the mark no longer had a reputation, or that its reputation had become weaker since those decisions were handed down, or that the previous decisions were potentially unlawful (para. 51). The decision of the BoA was therefore adopted in breach of Article 94 EUTMR. It is not necessary to examine the alleged infringement of the principle of legal certainty (para. 52). Visual comparison. The combination of the letters 'l' and 'v' is the sole element of the earlier mark and the dominant element of the contested mark applied for, whereas the other elements of the mark applied for will play only a secondary role or will attract the attention of the consumer less. Contrary to the BoA's finding, the overall impressions created by the marks at issue do not differ significantly and the marks must be considered to have at least an average degree of visual similarity (para. 81). Phonetic comparison. Although the pronunciation of the marks at issue differs due to the pronunciation of the word 'bet' which is less distinctive for at least part of the relevant public than the letters 'l' and 'v' in respect of the goods and services covered by the mark applied for, there is, contrary to the findings of the BoA, a phonetic similarity between those marks, which must be characterised as average at the very

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least (para. 85). Conceptual comparison. The marks at issue are conceptually dissimilar due to the presence of the word element 'bet' (para. 87). Even assuming they are conceptually dissimilar, overall, the signs are similar to an average degree, contrary to the BoA's assessment (para. 88). Reputation. The BoA erred in finding the reputation of the earlier mark could not be proved in the documents produced, with the exception of the brand rankings and the website Wikipedia, on account of the mere fact that it appeared as part of a pattern (the 'Monogram canvas') or together with the word mark LOUIS VUITTON (para. 95). The BoA conducted an incomplete assessment of the reputation of the earlier mark and, in addition, distorted the clear sense of some of the evidence (para. 100). The Court finds that the BoA's assessment regarding the application of Article 8(5) EUTMR is vitiated by several errors or lacunae, relating to the comparison of the signs at issue, the existence of the reputation of the earlier mark and the strength of that reputation (para. 112).

**T-59/18; FEMIVIA / FEMIBION INTIMA; Endoceutics, Inc. v EUIPO; Judgment of 22 November 2018; EU:T:2018:821;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Conceptual similarity, Descriptive element, Distinctive element, Likelihood of confusion, Minimum degree of distinctiveness, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the word mark FEMIVIA as an EUTM for pharmaceutical preparations for the prevention and treatment of breast and uterine cancer, Alzheimer's disease, medical conditions related to menopause, bone loss, muscle loss, type 2 diabetes, fat accumulation, osteoporosis, hot flushes, skin atrophy, memory loss, and cognition loss in Class 5. An opposition based on the earlier EU word mark FEMIBION INTIMA registered for, inter alia, pharmaceutical preparations in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal finding that for the identical goods there would be a LOC on the part of the Spanish-speaking public, as the signs had an average degree of similarity visually and phonetically, and a certain degree of conceptual similarity. In particular, the prefix 'fem', common to the signs at issue, would be understood by the Spanish-speaking public as being an abbreviation of the Spanish word 'femenino', which describes the intended purpose for the goods. Despite its weak distinctive character, such a prefix should not be neglected in the comparison. As regards the element 'intima', its distinctive character for the

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goods covered by the earlier mark was weak or even non-existent. The applicant filed an action before the General Court (GC), relying on one single plea in law: infringement of Article 8(1)(b) EUTMR.

**SUBSTANCE:** Relevant public. It is not disputed that the relevant public consists of both the average consumer and professionals in the medical and pharmaceutical sectors of the EU and that this public will have a high level of attention. For reasons of procedural economy, the Court focuses the comparison on the Spanish-speaking public of the EU, as did the OD and the BoA (paras 22-24). Comparison of the goods. It is not disputed that the goods are identical (paras 25-26). Distinctive elements of the signs. Although the common element 'fem' will be understood by the Spanish public as referring to the word 'femenino' (meaning 'feminine'), which is descriptive of the purpose of some of the goods, it is still likely to attract the attention of the public, in particular, because of its position at the beginning of the mark (para. 34). The element 'intima' of the earlier mark, which would probably be perceived by Spanish consumers as an indication of intimate or personal use of the products concerned, or as a reference to their purpose, albeit a weak element, cannot be classed as negligible (paras 39-41). In any case, the element 'femibion' would be perceived as the most distinctive element in the earlier mark (para. 42). Comparison of the signs. The signs are visually similar at least to a low degree as 'femibion', which is the most distinctive

element of the earlier mark, and the mark applied for, 'FEMIVIA', coincide in their first four letters and are thus similar to an average degree (paras 46-48). The signs are phonetically similar to an average degree as the elements 'femivia' and 'femibion' have a high degree of similarity, in particular due to the pronunciation of the letter 'v' as a 'b' in Spanish and considering that the element 'intima' of the earlier mark is weakly distinctive (paras 50, 52, 54). Taken as a whole, the signs are conceptually similar at least to a low degree insofar as the common prefix 'fem' evokes the Spanish word 'femenino' (paras 53-56). Likelihood of confusion. As the goods are identical and the signs have at least a low degree of similarity visually and conceptually, and an average degree of similarity phonetically, in the light of the distinctive elements of the signs at issue, and despite a high level of attention of the relevant public, there is LOC in the mind of at least a part of the relevant public (para. 59) in view of the principle of interdependence between the factors to be taken into account for the assessment (para. 63).

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**07/01/2019, R 992/2018-5, BIG HORN (fig.) / DEVICE OF TWO BULLS RACING TOWARDS EACH OTHER (fig.) et al.**

#### Contested EUTM



#### Earlier national mark



**Outcome:** Decision annulled.

**Norms:** Article 24(1) EUTMDR, Article 8(5) EUTMR.

**Keywords:** Extension of the time limit, Identity of the goods and services, Similarity of the goods and services, Similarity of the signs, Reputation, Unfair advantage.

**Summary:** An opposition was filed against the above EUTM applied for on the basis of Article 8(1) (b) and Article 8(5) EUTMR. The Opposition Division rejected the opposition in its entirety on the grounds that there was no likelihood of confusion (§ 6).

First, the Board rejects the claim submitted by the applicants about the rejection of their request for extending the time limit for submitting observations, stating that the rejection was against the Office's Guidelines. Article 24(1) EUTMDR overrides the abovementioned Guidelines, according to which a reasoned request should be submitted when requesting such an extension. However, the applicants neither submitted any reasoning with their request, nor did they provide any further justification during the follow-up communication (§ 16-21).

As regards the merit of the case, the Board concludes that the reputation the opponent enjoys under the sign represented above is very broad (§ 24). An analysis of the evidence results in finding

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the survey supplied by the opponent convincing (§ 39), and following the comparison of the signs, the Board concludes that the similarities between the marks are of such a low degree, that the differences between the marks will not be overlooked by the average consumer (§ 52). The contested goods have been found identical or similar to the opponent's energy drinks (§ 63). The Board considers that it cannot be excluded that consumers of the services covered by the mark applied for may make a mental link with the earlier mark (§ 84). The Board concludes that the applicants would gain an unfair advantage by the use of their sign. It follows that the contested mark falls within the scope of Article 8(5) EUTMR with regard to all the goods applied for (§ 101).

18/12/2018, R 1933/2018-2, TH TOWNHOUSE HOTELS (fig.) / Townhouse

### Contested EUTM



### Earlier national mark

**TOWNHOUSE**

**Outcome:** Decision annulled.

**Norms:** Article 7 EUTMDR, Article 8 EUTMDR, Article 25 EUTMDR, Article 39(2) EUTMDR, Article 81(2)(b) EUTMDR.

**Keywords:** Essential element to be translated, Substantiation of earlier right, Belated evidence.

**Summary:** An opposition submitted against the above EUTM applied for on the basis of Article 8(1)(a) and (b) was rejected by the Opposition Division (§ 9). The ground for the rejection was that the opponent had failed to provide a translation of a critical piece of information ('the status of the opponent's mark') contained in the earlier right's registration certificate into the language of proceedings (English) (§ 21). The opponent filed an extract from the Benelux Intellectual Property Office in which all the field identifiers were in English (§ 28). However, the 'Status' field indicated Merk Ingeschreven ('registered trade mark') only in Dutch (§ 29), which led to the rejection of the opposition on the basis that the validity of the earlier mark could not be established (§ 30).

According to the established case-law, the failure to translate the registration certificate leads to the rejection of the opposition as unfounded (30/06/2004, T-107/02, Biomate, EU:T:2004:196, § 70, 72) (§ 24). The Board finds that there can be no serious doubt about the mark being registered and in force, since the 'expiration date' field on the extract

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indicates 25 August 2021 (§ 33). The Opposition Division was overly formalistic in rejecting the opposition on the basis of a marginal omission which was not even decisive for establishing its validity (§ 38). On appeal the opponent submitted 'supplementary' material which is 'highly relevant' for these proceedings: (i) copy of the registered trade mark in Dutch (ii) with a full translation into English, (iii), together with an extract from TMview and (iv) a copy of the registration certificate of the earlier mark. Therefore the defect has been amply rectified. There is no doubt that the earlier mark is valid (§ 39).

The Board considers it equitable to exercise its discretion under Article 95(2) EUTMR to admit the new material which rectifies the putative defect in the substantiation of the earlier right (§ 40) and remits the case back to the Opposition Division for an examination of the opposition on substance (§ 41).

**30/01/2019, R 1977/2018-4, REPRESENTACION DE ELEMENTOS FLORALES (fig.)**

### EUTM applied for



**Outcome:** Decision annulled.

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

**Keywords:** Distinctive element.

**Summary:** The mark applied for was rejected as the examiner found that the sign merely had a decorative character and might also refer to the products themselves, such as wines, which could bear floral aromas and floral flavours (§ 4).

First the Board concludes, in relation to 'wines' and 'sparkling wines', that although some floral and fruity aromas can be recognised in certain wines, the possible link between the wines and the flowers is indirect and at best an evocation of these products. Moreover, none of the leaves shown in the requested sign corresponds to leaves, from which the grapes are obtained, which are the raw materials used to make the wine. (§ 13-14). Second, with regard to 'alcoholic beverages (other than beers)', it is even less likely that a composition of flowers may be viewed by the public concerned as all the raw materials used in the distillation of a certain liqueur or alcoholic beverage (§ 15).

The floral arrangement applied for cannot, or might not be perceived, given the varying variety of elements involved, as a descriptive indication of the types of raw materials used to produce the alcoholic beverages in question (§ 16). Although the existence of a certain degree of creativity is not indicative of

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distinctive character, its presence in the present case enables the public concerned to identify easily and immediately the origin of the products concerned (§ 18). It is equally important to point out that the combination of the graphic elements, although being difficult to accurately described orally, is not sufficiently complex for the public not to be able to memorise it as an image that, taken as a whole, is more or less accurate to the sign as applied for (§ 19).

**07/12/2018, R 477/2017-1, CAFE Gran Colombiano con todo el aroma y sabor del buen café (fig.)**

### EUTM applied for



**Outcome:** Decision confirmed.

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

**Keywords:** Geographical indication.



**Summary:** The examiner rejected the EUTM applied for on the grounds of Article 7(1)(b) and (c) EUTMR (§ 4). The Board reopened the examination of absolute grounds for refusal on the basis of Article 7(1)(j) EUTMR (§ 6, 10-15).

'Café de Colombia' is a protected geographical indication (PGI) in the European Union in relation to 'coffee' (§ 17). The Board finds that the present EUTM applied for is covered by Article 14(1) and the application corresponds to the situation of Article 13(1)(a) of [Regulation \(EU\) No 1151/2012](#) (§ 24-25). The sign in question has such a close link with the PGI, that it is clearly indissociable from the indication (§ 31).

The products covered by the EUTM applied for are the same types of products as covered by the PGI (§ 36). As the EUTM applied for makes direct use of the PGI, its use in respect of products that are comparable to coffee ('coffee substitutes, malt coffee') in accordance with the criteria laid down by the Court of Justice, in its 'Cognac II' judgment ([14/07/2011, C-4/10 & C-27/10, BNI Cognac, EU:C:2011:484](#), § 54), would constitute 'direct commercial use' for 'comparable products' (§ 39). The 'direct use' of the PGI for 'coffee with a coffee flavour, a coffee flavoured beer', covered by the EUTM applied for in Class 32, in the case of products using coffee as an ingredient or flavouring, would also fall under the prohibition in Article 14(1)(a) of Regulation (EC) No 1151/2012 (§ 41).

Consequently, the EUTM applied for relates to the

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absolute ground for refusal of Article 7(1)(j) EUTMR in conjunction with Article 14(1) and Article 13(1) (a)-(d) of Regulation (EU) No 1151/2012, for all products in Classes 30 and 32 covered by it (§ 45).

14/12/2018, R 2222/2013-1, CHACOMENA (fig.) / Chacoli de Bizkaia denominación de origen

### Contested EUTM

CHACOMENA



### Earlier national mark

CHACOLÍ DE BIZKAIA  
DENOMINACIÓN DE  
ORIGEN

**Outcome:** Decision partially annulled.

**Norms:** Article 8(1)(b) EUTMR, Article 45 EUTMR.

**Keywords:** Complex mark, Likelihood of confusion, Similarity of the goods and services, Similarity of the signs, Weak element.

**Summary:** Due to third-party observations, the Board sent the case back to the first-instance department, and as a consequence the mark applied for was refused on the basis of Article 7(1) (g), (j) and (k) EUTMR as regards Class 33 (§ 9-10). The opposition proceedings continued as regards Classes 35 and 39.

The relevant territory is Spain, the relevant public comprises professionals and the general public (§ 27-29). As regards the retail and wholesale services, the Board, based on established case-law (05/05/2015, T-715/13, *Castello*, EU:T:2015:256, § 28-33), finds that they are similar to the earlier goods, namely to wines (Class 35) (§ 36). In relation to the services in Class 39 the Board also finds certain similarities, taking into consideration that wines are indispensable for 'packaging, transport, etc.' services (14/05/2013, T-249/11, *Pollo*, EU:T:2013:238, § 43-63) (§ 37). As a result of the comparison between the signs the Board finds that they are visually similar to a low degree and phonetically similar to a low or medium degree (identity at the beginnings of the marks). The signs are also conceptually similar (§ 39-45). As a consequence, the Board finds that a likelihood of confusion exists as regards the goods and services that have been proven to be similar. Therefore the contested decision is partially annulled and the opposition partially upheld (§ 52).

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16/01/2019, R 2600/2017-3, Key rings

**Outcome:** Decision confirmed.

**Norms:** Article 6 CDR.

**Keywords:** Individual character, Informed user, Overall impression.

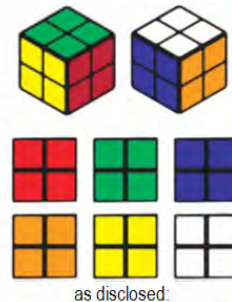
**Summary:** The Office declared the RCD invalid on the ground that it lacked individual character with respect to the earlier EUTM (§ 9).

The decision is confirmed by the Boards of Appeal. The application for a declaration of invalidity was based on the ground foreseen in Article 25(1)(b) CDR, in particular, as regards the requirement foreseen in Article 6 CDR (§ 14). The informed user is the person who is familiar with the various designs which exist in the sector of key rings and key holders, and shows a relatively high degree of attention when he or she uses them (§ 16). The designer of key rings and holders has a very broad degree of freedom, basically it is substantially unlimited as regards the decorative object attached to them (§ 19). The RCD represents the same cube as the earlier EUTM. Both cubes show sides which are identically divided by dark lines into four small squares, and in addition the lines, which separate the squares from each other, have a similar thickness (§ 22). Neither the fact that there are two cubes in the RCD, united at one corner only, nor that the EUTM is in colour, alters their similar overall impressions (§ 24).

### Contested RCD



### Earlier EUTM



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