

# Alicante News

Up to date information on IP and EUIPO-related matters



**Powering ahead:  
international  
cooperation at** **EUIPO**

## First Page

---

- Powering ahead: international cooperation at EUIPO

## Registered Community Design

---

- CP10 — Criteria for assessing disclosure of designs on the internet

## Statistical Highlights

---

- December 2017

## EUIPN Updates

---

- India joins Designview
- IP Key China official launch

## More News

---

- Summary judgement on fraudulent invoices case: Sweden
- IP case Law Conference 7-8 May

## Case Law

---

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## First Page



### Powering ahead: international cooperation at EUIPO

Embedded in the core business of the Office under the amended trade mark Regulation and spanning nearly every continent and region in the world, international cooperation is gearing up for another intense year of activity at EUIPO.

EUIPO's [international cooperation mission](#) is user-centred at its heart. Cooperation, be it bilateral, multilateral or regional, helps to strengthen intellectual property systems in our increasingly interconnected world.

Today, the scope and reach of international cooperation has taken a quantum leap forward at bilateral, regional and multilateral levels, through a set of project and activities founded in the Office's Strategic Plan 2020 and its reinforced legal basis (Article 151(2) EUTMR). Those activities focus around the [strategic objective](#) of extending the reach of the tools and services developed under the European Intellectual Property Network (EUIPN) around the globe.

At regional level, in 2017, the Office became the implementing agency for four new EU-funded projects which will be launched this year (IP Key China, launched on 17 January, an IP Key South East Asia and an IP Key Latin America, plus a fourth project in the South East Asian region called ARISE+). This follows the closure of two projects in China and South East Asia, a project in India which closes in 2018, and a project in Russia which closed in 2017. Overall, EUIPO will manage projects, on behalf of the European Commission, for a total value of EUR 25.5 million (of which EUR 22 million is funded by the Commission).

All these projects are aimed at building capacity, fostering convergence and providing a level playing field for EU business in the countries and regions in question. They allow the Office to contribute to the EU's trade and development

goals in key third country markets, and they also provide long-lasting benefits for users on the ground and project partners. Already, international cooperation at EUIPO has led to more than 400 actions and 72 activities carried out in the Office's role as implementing agency for the European Commission.

Multilateral cooperation is a strong cornerstone of international cooperation at EUIPO. Those original Trilateral meetings have grown to form the TM5, a grouping of the world's largest trade mark offices (with the Korean Intellectual Property Office and the State Administration for Industry and Commerce of the People's Republic of China joining the grouping). ID5, centred on designs, has been born, with the four TM5 partners plus the State Intellectual Property Office of the People's Republic of China taking part. These two groupings have a host of projects, each centred on improving user experience and harmonising systems and processes at global level. In 2017, EUIPO hosted its partners in Alicante, for the regular annual meetings which review progress and establish new priorities.

Among 13 on-going TM5 cooperation projects, EUIPO reported on the current status of "[Common Statistical Indicators](#)", "[User-friendly Access to Trade Mark Information \(China's possible integration into TMview\)](#)", "[Taxonomy and TMclass Link](#)" and "[User Association Involvement](#)" projects. The TM5 Partner Offices successfully concluded two projects of which all deliverables have been met, notably: Common Statistical Indicators and Madrid Protocol. The Partner offices also reached a consensus on the formal adoption and launch of three new cooperation projects, of which EUIPO will lead one and co-lead two: Quality Management (JPO/EUIPO), Priority Rights Documents (EUIPO), Fraudulent Solicitations (USPTO/EUIPO). The meeting served to reinforce the user driven policies of the Partner Offices by dedicating one full session to informing users and their associations of the progress made on cooperation projects. During the User Session, topics such

## First Page



as Bad Faith Trademarks from an e-commerce perspective, Fraudulent Solicitations, and Quality Management, were discussed.

During the ID5 meeting, the ID5 Partner offices shared their progress on 12 ongoing collaborative projects. As a result of the meeting, projects on View and Drawing Requirements, the Compilation of Industrial Design Statistics and the Study of Design Classification Conventions and Practices projects were officially moved into maintenance mode as all deliverables have been met. The Partners discussed and officially adopted the new operational guidelines for the functioning of the forum. A one day session for users from User Associations from the five Partner Offices was held on the second day, which included discussions with stakeholders on Emerging Designs, namely new types of designs and new types of representations and formats.

On top of these forms of cooperation, EUIPO continues to hold bilateral ties with a number of organisations across the globe: it now has formal cooperation arrangements in place with 37 non-EU organisations, including WPO and EPO (the new agreements being with Chile and Taiwan), all of which are fully aligned with the EU's trade and foreign policies as corroborated by the Commission. Those cooperation arrangements are not just confined to inter-office meetings and collaboration – they have a real and positive effect for users in terms of integrations into TMview, Designview, TMclass and other valuable databases and services.

Thanks to international cooperation at EUIPO, TMview, Designview and TMclass are now truly global tools. TMview's footprint now covers 62 IP offices worldwide, making it an invaluable multi-lingual search and reference tool. It includes trade mark data from the world's most advanced economies (and the EU's major trading partners) as well as rapidly developing nations, and receives around seven million searches every year.

Designview, with 63 participating offices, is a true child of cooperation at EUIPO; it was developed under the Cooperation Fund during the lifetime of the Office's first Strategic Plan. International cooperation has super-charged its reach. 2017 saw the integration of industrial design powerhouse Japan into Designview, joining the USPTO, KIPO, SIPO and, of course, EUIPO, to bring every ID5 member under the database's umbrella. Last month India entered its design data into the tool, giving EU and global users access to designs from one of the world's most rapidly growing economies.

International cooperation at EUIPO has expanded the reach of TMclass to 66 EU and non-EU offices; a real advantage for EU and non-EU users. Additionally, 2018 will see further progress made on Designclass, which will be expanded beyond the EU IP offices to add an international dimension.

Thanks to international cooperation, these global databases constitute a single passport to a vast range of trade mark and design data. Participating offices are drawn from EU accession countries (like Albania, Serbia and the former Yugoslav Republic of Macedonia), all EFTA countries (Lichtenstein, Iceland, Norway and Switzerland), and third countries with which the EU has relations. Added to the list are regional organisations, like the two African regional groupings, OAPI (for Francophone Africa) and ARIPO (for Anglophone Africa). WIPO has also added its data to both TMview and Designview, enhancing the truly international reach of the tools.

The next steps continue to be, as mandated in the Office's Strategic Plan 2020, to extend the reach of those tools globally. In 2018, the State Administration for Industry and Commerce of the People's Republic of China is expected to add its trade mark data to TMview, consolidating the database with information from the EU's second-largest trading partner. China's huge volume of intellectual property registrations



## First Page



in recent years and the international focus of its millions of innovative companies means that its integration into TMview will bring real, lasting benefits for both Chinese and global users.

In addition, the pace of integrations of non-EU countries into the suite of cooperation tools developed under EUIPO's first Strategic Plan has picked up during 2017 with 24 integrations. It will continue to pick up speed in 2018. Tools like Forecasting (currently used by the USPTO) and the User Satisfaction Survey, developed under the Cooperation Fund (implemented during 2017 in Albania, Georgia and Bosnia-Herzegovina), will



## Registered Community Design



### CP10 — Criteria for assessing disclosure of designs on the internet

In March 2018 the EUIPO is planning to launch a new convergence initiative within the ambit of the European Trade Mark and Design Network<sup>1</sup>. The new project, called 'CP10 — Criteria for assessing disclosure of designs on the internet', will form part of the European Cooperation Projects under the heading ECP4 Shared Services and Practices.

Following the existing legal order a design is protected as long as no identical design or no design producing the same overall impression on the informed user has already been made available to the public. However, the ever-increasing role of the internet in global business is changing the way that designs are being disclosed. Due to the nature of the internet, which allows unprecedented access to information as well as its exchange, a number of aspects need to be taken into account when assessing disclosures of designs online, such as the effective date of disclosure and the extent to which the information could become known to the circles specialised in the sector concerned.

The results of the analysis carried out by the EUIPO when assessing the feasibility of this convergence project have shown that a considerable part of the evidence of disclosure already originates from online sources. At the same time, feedback received from the national IP offices of the EU Member States and various user associations also reveals that practices when it comes to assessing such evidence tend to diverge. For instance, in some jurisdictions a design would be considered properly disclosed if it were made public on a web page that required a login, whereas in other countries information contained on such a web page would be considered inaccessible.

Moreover, neither EU law nor national laws specifically regulate the disclosure of designs on the internet, and most EU Member States have no established practice in this respect. Currently, only the EUIPO's Guidelines on current designs practice contain a section dedicated to this topic<sup>2</sup>.

Furthermore, case-law relating to online disclosures of designs is also scarce, in particular at national level. Although the EUIPO's Boards of Appeal have developed a certain practice in respect of some of the issues concerned (e.g. evidence originating from the 'WayBack Machine'<sup>3</sup>), this has not yet been sufficiently tested before the European Union courts.

Therefore, in view of the growing number of design disclosures that take place online, there is an obvious need for the convergence of practices in this area.

The aim of the current project is to identify the relevant criteria and establish a common practice for assessing prior art disclosed on the internet. The scope of the project will cover the following issues in particular:

- types of evidence acceptable for presenting information obtained from the internet (e.g. printouts from web pages, URL addresses);
- submission requirements and recommendations for evidence of prior art obtained from the internet (e.g. visibility of date, web address);
- relevant factors for assessing effective disclosure via the internet to the circles specialised in the sector concerned (e.g. searchability of a web page, targeted audience, period of time during which information was accessible);
- means of establishing the relevant date of disclosure (e.g. indexing of web pages, internet archiving services);
- specific aspects related to prior art disclosed in social media or on websites (e.g. access to account, indicators of popularity, purpose of account).



## Registered Community Design



The project is expected to benefit, first of all, the users of the Community design system, who will be able to expect the harmonised criteria to be applied to the assessment of disclosures on the internet. In addition, those national IP offices of the Member States that do not yet have any established practice in this respect will be able to adopt the best practices of the other offices instead of having to create their own practice from scratch. The fact that in some jurisdictions disclosure of designs is not assessed during proceedings before the national IP offices but before the courts cannot undermine the practical benefits that the convergence project will bring in this area.

The project is expected to last until the second quarter of 2020, with its outcome being published in the form of a Common Practice on the criteria for assessing disclosure on the internet.

---

<sup>1</sup>See <https://www.tmdn.org>.

<sup>2</sup>Guidelines for Examination of Design Invalidation Applications, Chapter 5, paragraph 5.5.1.5, Disclosures derived from the internet (<https://euipo.europa.eu/ohimportal/en/design-guidelines>).

<sup>3</sup>See, for instance, decisions of 06/08/2015, R 1103/2012-3, Inflatable toys; 13/07/2016, R 277/2016-3, Smoke alarms (part of); 22/08/2016, R 779/2015-3, Bangles; 20/12/2016, R 1852/2015-3, Doors; 05/03/2015, R 1341/2013, Packaging.

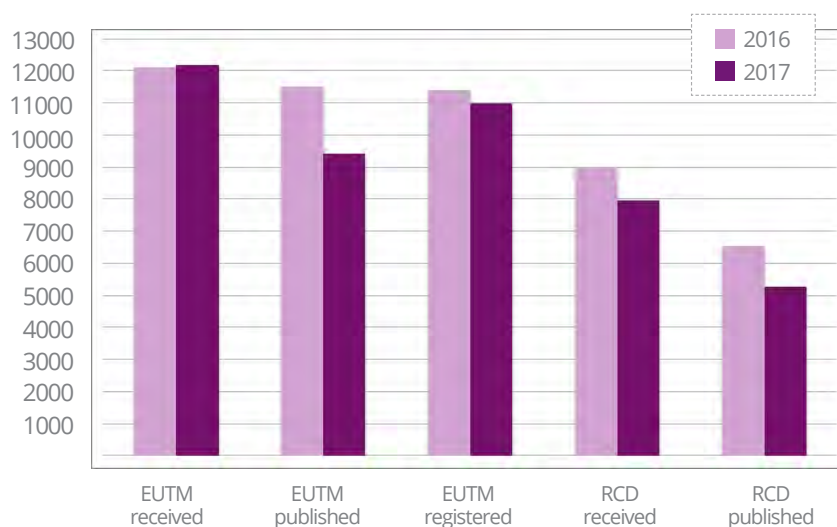


## Statistical Highlights



Monthly statistical highlights December*	2016	2017
European Union Trade Mark applications received	12 097	12 195
European Union Trade Mark applications published	11 505	9 399
European Union Trade Mark registered (certificates issued)	11 382	10 966
Registered Community Designs received	8 960	7 969
Registered Community Designs published	6 537	5 275

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







## EUIPN Updates



### India joins Designview

As of 19 January 2018 the Indian Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM) has made its design data available to the Designview search tool.

This successful integration is the result of the EU-INDIA Intellectual Property Cooperation (IPC-EUI) project co-funded by the European Commission and the EUIPO within the International Cooperation framework and in close collaboration with CGPDTM.

With CGPDTM on board, Designview now contains data from 63 participating offices.

With the addition of more than 30 000 designs from CGPDTM, Designview provides information and access to almost 13.4 million designs.

Since the introduction of Designview on 19 November 2012 the tool has served more than 3.2 million searches from 161 different countries, with users from Germany, the UK and Spain among the most frequent users.

You can find out more at [www.tmdn.org](http://www.tmdn.org)

### IP Key China official launch

On 17 January the Office officially launched the new IP Key China in Beijing, during an event attended by Christian Archangeau, EUIPO Deputy Executive Director, Mr Chen Fuli, Director General of China's Ministry of Commerce, and representatives of the European Commission and the EU Delegation to China.

Directed by the European Commission and implemented by the Office, IP Key China aims to facilitate economic exchanges, trade and investment between EU and China, while developing a level playing field as regards IP protection. IP Key will provide support to EU firms seeking to make inroads into the Chinese market or already doing business in China through a range of activities. Overall, the project is designed to strengthen intellectual property protection and raise awareness about its importance as a driver of economic growth.

Through close cooperation with Chinese stakeholders and the involvement of the industry, academia, enforcement and judicial authorities, the IP Key China project will:

- cover the full intellectual property lifecycle;
- encompass a wide spectrum of IP rights; patents, trade marks, designs, geographical indications, copyright, trade secrets and plant varieties;
- focus on IP enforcement, collaborating with enforcers to train Chinese judges dealing with intellectual property matters;
- provide and extend access to online IP search database to increase the global transparency of IP Rights.

A first cycle of [IP Key China](#) ran for four years from 2013-2017, carrying out 250 activities which reached approximately 6,000 people working in public and private EU and Chinese IP related fields and professions.



## More News



### Summary judgement on fraudulent invoices case: Sweden

On 20 December 2017, the Court of Appeal in Stockholm handed down a judgement in a criminal case against fraudsters who had sent misleading invoices to EUTM owners under the letterhead “OMIH.”

The main charged people were sentenced to imprisonment for completed gross fraud.

The Court of Appeal also approved all claims for damages presented by some of the recipients who had made payments when they received the fraudulent invoices.

The Office has prepared a summary of the judgment which is available [here](#).

### IP case Law Conference 7-8 May

The Office is holding its second IP Case Law Conference on 7-8 May 2018.

The event, which takes place at the Office’s headquarters in Alicante, is dedicated to substantive and procedural issues surrounding trade mark and design registration.

This conference builds on the [first IP Case Law Conference](#) which took place in May 2016.

The conference brings together users of the international IP systems, practitioners, judges, national and international institutions and administrations.

More details, including how to register, are available [here](#).



## Case law



### Luxembourg trade mark and design news

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

**Case C-291/16; Schweppes SA v Red Paralela SL; Judgment of the Court (Second chamber) of 20 December 2017; EU:C:2017:990; Preliminary ruling from the Juzgado de lo Mercantil No 8 of Barcelona; Language of the case: ES**

**KEYWORDS:** Exhaustion

**FACTS:** The sign Schweppes protecting tonic water in particular is not registered as an EU trade mark, but as a national mark in each of the Member States of the EEA. This bundle of parallel national trade marks was originally owned by one single proprietor (Schweppes). Subsequently, the latter assigned some of those parallel trade marks to Coca-Cola (see the blue areas below) and the bundle of national parallel trade marks was thus divided territorially as follows.



Schweppes' licensee in Spain sought to impede Red Paralela from importing tonic water already placed on the EU market under the Schweppes mark owned by Coca-Cola. In its defence, Red Paralela contended that Schweppes' exclusive trade mark rights were already exhausted, given that Schweppes had consented to the placing of the goods in the EEA under its mark.

The referring judge asked the Court of Justice under what conditions the proprietor of a national trade mark can impede the importation of identical goods bearing the same mark originating in another Member State that it had originally owned, but had subsequently assigned to a third party.

**SUBSTANCE:** The judgment confirms the principle that there is no exhaustion of a national trade mark in such a situation — provided that there is no economic link between the old and the new proprietor of the parallel national marks. In the absence of such economic links, the parallel national marks fulfil their essential function within the different territories of protection (paras 38-39, 43). In the presence of such economic links, the partitioning of the national markets is neither justified by the need for, nor is it necessary for, preserving the essential function of the marks concerned (para. 47).

The judgment clarifies that the existence of an economic link is to be assessed on the basis of functional criteria as opposed to purely formal criteria (para. 46): the mere possibility of controlling the quality of the goods concerned is sufficient (para. 49). An economic link between the proprietors of the different trade marks exists where the proprietors coordinate their commercial policies or reach an agreement in order to exercise joint control over the use of those marks (para. 46).

In line with previous case-law on exhaustion, the judgment alleviates the parallel importer's burden of proof regarding the existence of an economic link between the trade mark owners of a divided bundle of parallel national marks (paras 52-54). It is sufficient to put forward a body of precise and consistent (circumstantial) evidence [FR: indices and ES: indicios] from which it may be inferred that such economic links exist (para. 54).



## Case law



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

**Case T-771/16; Toontrack Music AB v EUIPO; Judgment of 22 November 2017; EU:T:2017:826; Language of the case: SV**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Restriction of the list of goods and services, Principle of legality

**FACTS:** The applicant sought to register the word mark EZMIX as an EUTM for goods and services in Classes 9, 15 and 42. The examiner refused to register the word mark as an EUTM for goods within Classes 9 and 15 on the grounds of Article 7(1) (b) and (c) EUTMR and agreed to register the word mark for goods within Class 42 (cloud computing). Upon appeal, the applicant filed — inter alia — the restriction all goods/services intended for use together with digital audio workstations (DAW) only, and for professional composers and music creators at the end of Classes 9 and 42. The Board of Appeal (BoA) dismissed the restriction to particular persons and the appeal. The applicant filed an action before the General Court (GC), relying on three pleas in law: i) infringement of Article 49 EUTMR, ii) infringement of Article 7(1)(c) and 7(2) EUTMR and iii) infringement of Article 7(1)(b) and Article 7(2) EUTMR.

**SUBSTANCE: RELEVANT CONSUMER:** Since the mark is made up of English words, the relevant public consisted of consumers in the English-speaking Member States, namely Ireland, Malta and the United Kingdom, and in those Member States where English is well understood, namely Denmark, Cyprus, the Netherlands, Finland and Sweden. Given the nature of the goods concerned, the professional target public's level of attention would be high, while the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect (paras 31-32). **DESCRIPTIVENESS:**

The term 'EZMIX' has the meaning of 'easy, simple mixing'. The word is descriptive for the goods and services (para. 36). The term 'easy' is a laudatory term, and no great mental effort is required on the part of the relevant public to perceive the immediate positive message embodied in the sign. The customer is very well aware that a major selling point in connection with music recording equipment and software is the ease with which they can be used for mixing, and this is one of the key factors in deciding whether or not to buy the product (para. 42). **DISTINCTIVENESS:** As one ground for refusal is sufficient, there is no need to go into this plea of law (para. 66). **PREVIOUS REGISTRATIONS:** The fact that the Office has registered previous marks containing the word element 'ez' cannot affect the assessment (para. 53). **RESTRICTION OF THE LIST OF GOOD AND SERVICES:** The restriction of the goods and services to professional composers and music creators at the end of the specification cannot be divided from the further restrictions within the specification; it builds a unit. Therefore, the BoA correctly found the entire limitation inadmissible. It was not necessary to assess the admissibility of the further restrictions. In addition, the further goods restricted to namely, for amplifier simulator are also used in mixing music. The limitation cannot affect the direct link between the trade mark and the goods and services. The same applies to the restriction for composers and creators of music (paras 70-75).

**Case T-31/16; adp Gauselmann GmbH v EUIPO; Judgment of 28 November 2017; EU:T:2017:845; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element

**FACTS:** The applicant sought to register the word mark JUWEL for goods and services in Classes 9, 28 and 41. The examiner refused to register the word mark as an EUTM in its entirety



## Case law



on the grounds of Article 7(1)(b) and (c) EUTMR. The EUTM applicant appealed against the Office. The Board of Appeal (BoA) dismissed the applicant's appeal because the mark was non-distinctive for all the goods concerned and descriptive for part of the goods that are related to games. The applicant filed an action before the General Court (GC), relying on two pleas in law: i) infringement of Articles 7(1)(b) EUTMR and ii) infringement of Article 7(1)(c) EUTMR.

**SUBSTANCE:** RELEVANT CONSUMER: Since the mark is made up of German words, the relevant public is mainly the German-speaking general public and professionals that pay a high level of attention (paras 10, 21). MEANING OF THE SIGN: According to the dictionary, 'JUWEL' can have two meanings in German: i) precious gemstone and ii) something that is precious for someone (para. 26). The word mark indicates that the goods and services concerned are good or precious. DISTINCTIVENESS: i) It is not because of its direct descriptiveness that the mark is refused but because of its lack of distinctiveness (para. 33); both grounds are independent. The public will perceive the word mark as a direct indication of the quality of the goods and services and not as an indication of commercial origin (paras 30, 33). Without being precise, the sign indicates that the goods are precious. The semantic content therefore concerns the goods' value (para. 39). (ii) Since one ground for refusal is sufficient, there is no need to examine Article 7(1)(c) EUTMR (paras 52-55).

**Case T-120/16; Tulliallan Burlington Ltd v EUIPO; Judgment of 6 December 2017; EU:T:2017:873; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Similarity of signs, Identity of the goods and services, Detriment to earlier mark, Tarnishment of reputation, Lack of reasoning

**FACTS:** An application was filed for the figurative mark represented below to be registered as an EUTM for goods in Classes 3, 14, 18 and 25. The opponent filed an opposition against the goods in Classes 3, 14 and 18 based, inter alia, on the earlier United Kingdom word mark BURLINGTON (Classes 35 and 36), the earlier United Kingdom word mark BURLINGTON ARCADE (Classes 35, 36 and 41) and the United Kingdom and EU figurative mark represented below covering, in the EU scope, advertising and promotion services and information services relating thereto; the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores (Class 35), rental of shops; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops (Class 36) and entertainment services; provision of live entertainment (Class 41). The opposition was filed pursuant to Article 8(1)(b), (4) and (5) EUTMR. The Opposition Division (OD) fully upheld the opposition, examining only Article 8(5) EUTMR based on the earlier figurative EUTM. An appeal was filed by the EUTM applicant. The Board of Appeal (BoA) found the Appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had not been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the services of bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from general merchandise retail stores in Class 35. However, the BoA denied the existence of a 'link' between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument for any of the three types of infringement of Article 8(5) EUTMR. With regard to Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. With regard to Article 8(1)(b) EUTMR, it was held that the goods and services



## Case law



at issue were dissimilar and that, for this reason alone, a likelihood of confusion was ruled out, irrespective moreover of the similarity of the marks concerned. The opponent filed an action before the General Court (GC) relying on three plea(s) in law: (i) infringement of Article 8(5) EUTMR and an infringement of the procedural rules, (ii) an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) EUTMR, and (iii) infringement of Article 8(1)(b) EUTMR.

### EUTM application



### Earlier trade marks

**BURLINGTON**  
**BURLINGTON ARCADE**



**SUBSTANCE:** REGARDING THE FIRST PLEA IN LAW: The signs at issue are similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also includes a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation provides no specific evidence that the use of the contested mark would make its earlier marks less attractive, nor would

the fact that another economic agent may be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45). REGARDING THE SECOND PLEA IN LAW: The BoA analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, throughout the proceedings before the Office, the applicant was indeed in a position to submit its observations. The BoA cannot be criticised for not requesting additional observations from the parties. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position that the BoA intends to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off were duly met, since, before the BoA, the applicant simply stated that it maintained its arguments submitted before the OD, without any further substantiation, either in fact or in law (para. 61). REGARDING THE THIRD PLEA IN LAW: As for the services in Class 36, there is no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. Regarding the services in Class 35, no similarity or complementarity can be established: the absence of any precise statement of the goods that may be sold in the various shops comprising a shopping arcade precludes any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' is insufficient to specify the goods concerned (paras 70-71).

**Case T-121/16; Tulliallan Burlington Ltd v EUIPO; Judgment of 6 December 2017; EU:T:2017:872; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Similarity of signs, Identity of the goods and services, Detriment to earlier mark, Tarnishment of reputation, Lack of reasoning



## Case law

**FACTS:** An application was filed to register the figurative mark represented below as an EUTM for goods in Classes 3, 14, 18 and 25. An opposition against the goods in Classes 3, 14 and 18 was filed, based, inter alia, on the earlier United Kingdom word mark BURLINGTON (Classes 35 and 36), the earlier United Kingdom word mark BURLINGTON ARCADE (Classes 35, 36 and 41) and the earlier EU and United Kingdom figurative mark represented below (Classes 35, 36 and 41), pursuant to Article 8(1)(b), (4) and (5) EUTMR. The Opposition Division (OD) fully upheld the opposition, examining only Article 8(5) EUTMR, based on the earlier figurative EUTM. An appeal was filed against the OD's decision. The Board of Appeal (BoA) found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from general merchandise retail stores, in Class 35. However, the BoA denied the existence of a 'link' between the conflicting marks and irrespective of this held that the applicant had not submitted a consistent line of argument for any of the three types of infringement of Article 8(5) EUTMR. With regard to Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Thirdly, as regards Article 8(1)(b) EUTMR, no likelihood of confusion was found, given that the goods and services were dissimilar, irrespective of the similarity of the marks. The opponent filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and an infringement of the procedural rules, (ii) an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) EUTMR, and (iii) infringement of Article 8(1)(b) EUTMR.



### EUTM application



### Earlier rights



**SUBSTANCE:** REGARDING THE FIRST PLEA IN LAW: The signs at issue are similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also includes a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation provides no specific evidence that the use of the contested mark would make its earlier marks less attractive, nor would the fact that another economic agent may be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45). REGARDING THE SECOND PLEA IN LAW: The BoA analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, throughout the proceedings before



## Case law



the Office, the applicant was indeed in a position to submit its observations. The BoA cannot be criticised for not requesting additional observations from the parties. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position that the BoA intends to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off were duly met, since, before the BoA, the applicant simply stated that it maintained its arguments submitted before the OD, without any further substantiation, either in fact or in law (para. 61). REGARDING THE THIRD PLEA IN LAW: As for the services in Class 36, there is no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. Regarding the services in Class 35, no similarity or complementarity can be established: the absence of any precise statement of the goods that may be sold in the various shops comprising a shopping arcade precludes any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' is insufficient to specify the goods concerned (paras 70-71).

**Case T-122/16; Tulliallan Burlington Ltd v EUIPO; Judgment of 6 December 2017; EU:T:2017:871; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Similarity of signs, Identity of the goods and services, Detriment to earlier mark, Tarnishment of reputation, Lack of reasoning

**FACTS:** The intervener filed an application for protection in the European Union for the figurative mark below for Classes 3, 14, 18 and 25. The applicant filed a notice of opposition in respect of the goods in Classes 3, 14 and 18. The opposition was

based on the word mark i) BURLINGTON designating services in Classes 35 and 36; ii) BURLINGTON ARCADE designating services in Classes 35, 36 and 41 and iii) the figurative mark reproduced below designating services in Classes 35, 36 and 41. The opposition was based on Article 8(1)(b) and Article 8(4) and (5) EUTMR. The Opposition Division (OD) fully upheld the opposition, examining only Article 8(5) EUTMR, based on the earlier figurative EUTM. An appeal was filed against the OD's decision. The Board of Appeal (BoA) found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from general merchandise retail stores, in Class 35. However, the BoA denied the existence of a 'link' between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument for any of the three types of infringement of Article 8(5) EUTMR. With regard to Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Thirdly, as regards Article 8(1)(b) EUTMR, no likelihood of confusion was found, given that the goods and services were dissimilar, irrespective of the similarity of the marks. The opponent filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and an infringement of the procedural rules, (ii) an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) EUTMR, and (iii) infringement of Article 8(1)(b) EUTMR





## Case law



### IR designating EU



### Earlier trade mark



**SUBSTANCE:** REGARDING THE FIRST PLEA IN LAW: The signs at issue are similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also includes a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation provides no specific evidence that the use of the contested mark would make its earlier marks less attractive, nor would the fact that another economic agent may be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45). REGARDING THE SECOND PLEA IN LAW: The BoA analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, throughout the proceedings before the Office, the applicant was indeed in a position to submit its observations. The BoA cannot be criticised for not requesting additional observations from the parties. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position that

the BoA intends to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off were duly met, since, before the BoA, the applicant simply stated that it maintained its arguments submitted before the OD, without any further substantiation, either in fact or in law (para. 61). REGARDING THE THIRD PLEA IN LAW: As for the services in Class 36, there is no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. Regarding the services in Class 35, no similarity or complementarity can be established: the absence of any precise statement of the goods that may be sold in the various shops comprising a shopping arcade precludes any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' is insufficient to specify the goods concerned (paras 70-71).

**Case T-123/16; Tulliallan Burlington Ltd v EUIPO; Judgment of 6 December 2017; EU:T:2017:870; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Similarity of signs, Identity of the goods and services, Detriment to earlier mark, Tarnishment of reputation, Lack of reasoning

**FACTS:** The intervener filed an application for protection in the European Union for the figurative mark below for Classes 3, 14, 18 and 25. The applicant filed a notice of opposition in respect of the goods in Classes 3, 14 and 18. The opposition was based on the word mark i) BURLINGTON designating services in Classes 35 and 36; ii) BURLINGTON ARCADE designating services in Classes 35, 36 and 41 and iii) the figurative mark reproduced below designating services in Classes 35, 36 and 41. The opposition was based on Article 8(1)(b), Article 8(4) and (5) EUTMR. The Opposition Division (OD) fully upheld



## Case law

the opposition, examining only Article 8(5) EUTMR, based on the earlier figurative EUTM. An appeal was filed against the OD's decision. The Board of Appeal (BoA) found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from general merchandise retail stores, in Class 35. However, the BoA denied the existence of a 'link' between the conflicting marks and irrespective of this held that the applicant had not submitted a consistent line of argument for any of the three types of infringement of Article 8(5) EUTMR. With regard to Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Thirdly, as regards Article 8(1)(b) EUTMR, no likelihood of confusion was found given that the goods and services were dissimilar, irrespective of the similarity of the marks. The opponent filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and an infringement of the procedural rules, (ii) an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) EUTMR, and (iii) infringement of Article 8(1)(b) EUTMR.

**SUBSTANCE:** REGARDING THE FIRST PLEA IN LAW: The signs at issue are similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also includes a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation provides no specific evidence that the use of the contested mark would make its earlier marks less attractive, nor would the fact that another economic agent may be authorised to



### IR designating EU

**BURLINGTON**

### Earlier trade mark



use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45). REGARDING THE SECOND PLEA IN LAW: The BoA analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, throughout the proceedings before the Office, the applicant was indeed in a position to submit its observations. The BoA cannot be criticised for not requesting additional observations from the parties. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position that the BoA intends to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off were duly met, since, before the BoA, the applicant simply stated that it maintained its arguments submitted before the OD, without any further substantiation, either in fact or in law (para. 61). REGARDING THE THIRD PLEA IN LAW: As for the services in Class 36, there is no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. Regarding the services in Class 35, no similarity or complementarity can be established: the absence of any precise statement of



## Case law

the goods that may be sold in the various shops comprising a shopping arcade precludes any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' is insufficient to specify the goods concerned (paras 70-71).

**Case T-456/16; Galletas Gullón v EUIPO; Judgment of 16 November 2017; EU:T:2017:811; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Evidence of use, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Similarity of the signs, Phonetic similarity, Proof of use, Substantiation of earlier right, Visual similarity, Scope of proceedings

**FACTS:** The applicant sought to register the word mark GULLON DARVIDA as an EUTM for goods in Class 30. An opposition was filed by the IR holder and national trademark holder (NTM holder) pursuant to Article 8(1)(b) EUTMR, based on the earlier international trade mark Dar Vida for goods in the same class, as well as on the Danish word mark DAR VIDA, the Finnish word mark DAR VIDA, the Swedish word mark DAR VIDA and the UK word mark DAR VIDA. The Opposition Division (OD) dismissed the opposition in so far as the evidence submitted upon its request for proof of use was not sufficient to establish genuine use of those marks in the relevant territories, namely in Denmark, Finland, Sweden and the United Kingdom, during the relevant period for the goods concerned. The IR and NTM holder filed an appeal, which was upheld by the Board of Appeal (BoA). The BoA found that the IR and NTM holder had established its earlier right during the relevant period, evidence of genuine use of the earlier international mark had been provided, and, last, taking into account the fact that the relevant goods were identical, the average level of visual and phonetic similarity of the signs, the



normal level of attention of the relevant public and the normal inherent distinctive character of the earlier mark, there was a likelihood of confusion. The applicant filed an action before the General Court (GC) relying on three plea(s) in law: (i) infringement of Article 95 EUTMR and Article 7 EUTMDR, (ii) infringement of Article 47(2) and (3) EUTMR and Article 10(2) EUTMDR and (iii) infringement of Article 8(1)(b) EUTMR.

### EUTM application

GULLON DARVIDA

### Earlier trade mark

DAR VIDA

**SUBSTANCE:** The GC emphasised on the fact that the BoA has discretion to admit additional evidence produced for the first time before it regarding the entitlement to file an opposition and also to decide whether or not it is necessary to take into account the additional evidence (paras 40 and 43). The BoA correctly assessed the evidence presented before it. The GC makes particular reference to EUIPO's Guidelines for Examination (Part C, Section 1) as a reference source for the practice of the BoA when it examines the name of the opponent company, since it constitutes a self-imposed restriction on EUIPO, namely that of compliance with the rules which it has itself established (paras 55-57). **PROOF OF USE:** In examining whether there had been genuine use of the earlier marks, the BoA is entitled to take into account the earlier international registration that took effect in the relevant territory (Germany), without having to examine the genuine use for the other national earlier marks (para. 71). **RELEVANT TERRITORY AND PUBLIC:** The relevant territory for the purposes of likelihood of confusion was Germany, and the relevant public is the average consumer who is reasonably



## Case law

well informed and reasonably observant and circumspect (paras 17 and 86). COMPARISON OF GOODS: They were found to be identical (para. 111). COMPARISON OF THE SIGNS: The GC stated that the need for the sign 'vida' to be available for economic operators cannot be one of the relevant factors to be taken into account when assessing the likelihood of confusion (para. 88). Assessment: (i) the signs have an average degree of visual similarity, since the word 'darvida' has no meaning for the German consumer, and because of the considerable similarity between the word elements 'dar vida' and 'darvida', which is not counteracted by the first element 'gullon' (paras 89 and 93); (ii) the signs have an average degree of phonetic similarity, since the three syllables 'dar', 'vi' and 'da' are identical, despite the fact that the word 'gullon' appears at the beginning of the mark (para. 102); (iii) the signs are conceptually neutral, since neither the word 'gullon' nor the word 'darvida' had any meaning in German (para. 103). There is no proof of limited distinctiveness in the relevant territory (para. 92). LOC: Taking into account the identity of the relevant goods, the average degree of visual and phonetic similarity, the normal level of attention of the relevant public and the normal degree of distinctiveness of the earlier mark, there is likelihood of confusion. The relevant public may believe that the goods come from the same undertaking (paras 110 and 112).

**Case T-767/16; Nanogate AG v EUIPO; Judgment of 16 November 2017, EU:T:2017:809; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive character, Principle of legality, Scope of proceedings, Descriptive element, Figurative trade mark

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 1, 2, 17 and 40. The examiner refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)



### EUTM application



(b) and (c) in conjunction with the Article 7(2) EUTMR. The applicant appealed against the above decision before the Board of Appeal (BoA), which dismissed the appeal. The applicant filed an action before the General Court (GC), relying on two pleas in law: i) infringement of Article 7(1)(c) EUTMR and ii) infringement of Article 7(1)(b) EUTMR.

**SUBSTANCE:** Since the figurative mark has as the only word element the English word 'metals', the relevant public in the first place is the English-speaking public within the EU. The targeted public consists of both the general and a specialised public (for instance, in the sector of surface treatments) with a higher degree of attention, at least with regard to part of the goods and services covered (paras 27, 28). **DESCRIPTIVENESS:** i) Regarding the word element, the applicant has not brought forward any independent argumentation as to why the word 'metals' should not be deemed descriptive, but has merely made a general reference to the arguments already made in the course of the administrative procedure. As an application before the GC needs to contain at least a short description of the pleas, which cannot be substituted by mere general references to prior submissions, the claim is inadmissible (para. 30). ii) Regarding the figurative element, it consists of a banal representation of a red arch, without any easily memorable details or anomalies, which is perceived as a merely decorative element and is not capable, per se, of communicating a message that consumers will remember (paras 40-41). Moreover, the distinctive character is not reinforced by the striking red colour or the letter stylisation. The figurative elements of the mark applied for do not make it possible to diverge from the mere perception of the word element used (para. 34). Overall, the EUTMA is descriptive for all



## Case law



the goods and services covered (para. 46). **DISTINCTIVENESS:** Given the descriptive character of the mark, there is no need to assess the distinctiveness, since it is sufficient that one of the absolute grounds for refusal applies (para. 62). **SCOPE OF PROCEEDINGS:** i) the legality of the decisions of the Boards of Appeal must be assessed solely on the basis of the EUTMR as interpreted by the GC and not on the basis of a previous decision-making practice (para. 48); ii) the decision regarding the registration of the international trade mark cannot be taken into account since it was issued eight days after the BoA issued the contested decision. The GC may not annul or alter the contested decision on grounds which come into existence subsequent to its adoption (paras 53-54); iii) the merely indicative reference (in form of examples) to other previous registrations of the same brand is insufficient and cannot be taken into account (para. 56); iv) the previous registrations of identical national (German and USA) trade marks have no influence on the case at hand, since the Office and the GC are not bound by a decision rendered in a Member State or a third country (para. 57).



## Case law



### New Decisions from the Boards of Appeal

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

15/02/2017 R 1792/2017-5 Santé (fig.)



**Result:** Decision confirmed

**Keywords:** Descriptive, Figurative element, Figurative trade mark, Laudatory mark, Non-distinctive

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 114(4) EUTMR

**Facts:** The applicant sought the registration of the figurative sign for goods in Classes 29 and 30 (such as meat, jams, dairy products, biscuits and sauces). The examiner rejected the application on the grounds that the word 'Santé' (that in French means health) would be perceived by the consumers as laudatory, descriptive of the characteristics of the goods and also non-distinctive.

**Substance:** The Board confirms the examiner's decision that the mark applied for is descriptive and lacks distinctive character. Therefore the application is rejected.

The Board refers to Article 114(4) EUTMR for denying the

request for confidentiality stating that it has to be accompanied by proof of a special interest of the party who submitted it, for which it was necessary to treat the grounds of the appeal as confidential (§ 13).

Since the nature of the document is not confidential per se, the request is dismissed.

27/11/2017 R 1308/2017-1 23 VODKA (fig.)



**Result:** Decision annulled

**Keywords:** Descriptive element, Distinctive element, Figurative element, Figurative trade mark

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

**Facts:** The applicant sought to register the sign in Classes 33 (vodka), 35 (retailing and wholesaling services of vodka) and 43 (serving and catering services related to vodka). The examiner refused the application, stating that the sign at issue was descriptive and not distinctive in relation to the goods and services covered, potentially referring to the grade of alcohol present or to the number of ingredients used.

**Substance:** The Board reverses the decision of the first instance.

After a limitation of the list of goods and services in the appeal proceedings, the figurative trade mark is not descriptive for vodka as such () since it does not indicate any of its characteristics. There are very strict requirements for the production and marketing of vodka products at EU level, as



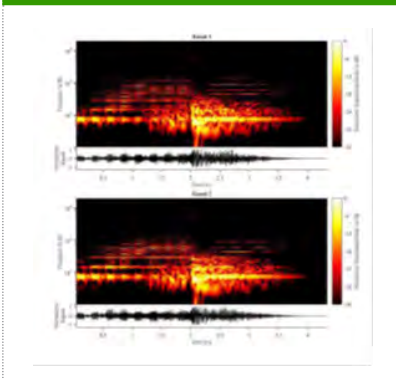
## Case law



listed in the Annex II of the EU Regulation 110/2008 for the definition, description, presentation and labelling of spirits (Official Journal L 039, 13/02/2008 P. 0016 - 0054) (§ 26-27). In the light of that, the number 23 cannot indicate its alcoholic strength, or its ingredients, or even its ageing (§ 30). Given that the number 23 has no relation to the products and services at issue, the Board states that the application can proceed to registration.

**12/12/2017 R 2059/2016-4 KLANG VON ELEKTRONISCHER SEQUENZ (sonit.)**

### EUTMA



**Result:** Decision confirmed

**Keywords:** Sound mark

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

**Facts:** On 29 April 2016, the applicant sought to register a sound sign represented by two pictures of its electronic sequence, for goods in Classes 9 (goggles, helmets, protective clothing), 10 (earplugs), 25 (clothing and boots, riding gloves) and 28 (body protection pieces items for motorcyclists, snowboarders etc.). The examiner refused the application under Article 7(1)

(b) EUTMR, grounding its decision on the fact that the sign in itself is a very common electronic sound, typical for example in telephones as a ringtone. For those reasons, it could not be considered as distinctive.

**Substance:** The appeal is dismissed.

The Board finds that the sound at issue, as represented, meets the requirements set by Rule 3(6) CTMIR, that still applies to the trade mark applications filed before 1 October 2017 (§ 10). It focuses therefore its review on the distinctive character of the sign. In this regard, the Board considers that the sign, consisting of a four-second dissonant sequence of electronic sounds, cannot remain in the memory of the consumers, given its simplicity, shortness and similarity to other electrical buzzes that are common nowadays (§ 16).

The sign does not contain any melody, structure or harmony sufficient to consider the sign as distinctive.

**12/09/2017, R 0247/2017-3**

**Result:** Appeal inadmissible

**Keywords:** Admissibility, New submission on appeal  
**Norms:** Article 57 CDR, Article 63(2) CDR, Article 4(1)(e) CDIR

**Facts:** The examiner refused the design application because it lacked a graphical representation and the applicant failed to remedy the deficiency in the time frame set by the Office.

**Substance:** The appeal is inadmissible.

The filing of the new views of the design does not constitute a statement of grounds within the meaning of Article 57 last sentence of the Community Designs Regulation (CDR) (§ 8). The Board finds that the sole purpose of the appeal was quite clearly to remedy the deficiencies of the representation of the design and, in any case, these views cannot substitute the statement of grounds.

In the hypothetical case in which the appeal would have been considered admissible, the belated corrected views of the



## Case law

design submitted for the first time before the Board would have to be rejected as inadmissible in any case. The submission of facts and evidence remains possible after the expiry of a time-limit only if they are additional or supplementary and there is no provision to the contrary (§ 14).

In accordance with Article 46(2) CDR, if deficiencies in the application that concern the requirements for according a date of filing are not remedied within the prescribed period, the application shall not be dealt with as an application for a Community design (§ 15-16).

The belated corrected views of the design submitted for the first time before the Board would have to be declared inadmissible, even if the appeal itself were to be found to be admissible.

### 08/11/2017, R 1724/2016-5, *Crédit Mutuel* (under Appeal before the GC T-13/18)

**Result:** Decision confirmed

**Keywords:** Distinctiveness acquired by use, Minimum degree of distinctiveness, Press articles, Promotional material, Descriptive, Non-distinctive, Word mark

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(3) EUTMR

**Facts:** The cancellation applicant filed a cancellation request based on the lack of distinctive character and descriptiveness of the mark 'Crédit Mutuel' for bank-related goods and services. The proprietor demonstrated that the sign had acquired distinctive character through use in the French-speaking countries in relation to the banking goods and services, and therefore the Cancellation Division rejected the cancellation application.



**Substance:** The Board finds, as the first instance did, that the verbal mark 'Crédit Mutuel' is descriptive and lacks distinctive character for goods and services related to bank activities, but recognizes that the mark has acquired distinctive character through an intensive use (§ 20).

### 08/11/2017, R 0582/2017-5, *Shape of a spoon (3D)*



**Result:** Decision confirmed

**Keywords:** Shape mark, Technical result

**Norms:** Article 7(1)(e)(ii) EUTMR

**Facts:** The applicant sought to register a 3D trade mark reproducing a spoon in Classes 20, 21, 35 and 39. The examiner rejected the application for Classes 20 and 21 (containers of various materials for kitchen purposes) pursuant to Article 7(1)(b) EUTMR, because the trade mark was devoid of distinctive character and descriptive of the goods. The applicant filed an appeal.

**Substance:** The Board upholds the decision of the examiner, grounding its reasoning on Article 7(1)(e)(ii) EUTMR. The sign consists exclusively of a shape necessary to obtain the technical result of carrying a small quantity of liquids or materials. The Board considers that the sign does not contain





## Case law



any distinctive elements that could indicate the origin of the good from other similar goods from other manufacturers (§ 26) and also states that none of its features, as described by the applicant, can be considered as having a different use than the functional one (§ 25, § 30-32).

**16/11/2017, R 2063/2016-4, DEVICE (PHOTO) OF THE HEAD OF A WOMAN (fig.)**

EUTMA



**Result:** Decision reversed in full

**Keywords:** Function of trade mark, Minimum degree of distinctiveness, Descriptive, Non-distinctive

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

**Facts:** The applicant sought to register as a trade mark the passport-size photo of the face of a woman, for goods and services in Classes 3, 9, 14, 16, 18, 25, 35, 41, 42 and 44. The examiner rejected the application on the grounds of Article 7(1)(b) and Article 7(1)(c) EUTMR, because the sign was descriptive and devoid of distinctiveness.

**Substance:** The Board disagrees with the conclusion of the first instance.

It finds that, even though pictures of people are customary and appear on the packaging of all kinds of goods or are used in connection with all kinds of services (especially those related to body care, clothing and fashion), the sign at issue is not generic per se, since it clearly depicts a certain person, with her unique facial features (§ 36).

Besides elements including a person's first name and last name, a depiction of a person's face in the form of a passport photo serves to identify that person and therefore to distinguish him/her from others. In the Board's opinion, the image at issue is therefore capable of fulfilling the essential function of a trade mark, namely distinguishing the goods and services in respect of which registration is sought from those with a different origin (§ 37).

The appeal is therefore upheld and the contested decision is annulled.