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Evaluation of EU legislation on design protection

Public consultation

Design is a motor of economic growth and employment here in the European Union, as well as being an important driver of international trade.

A study by the EUIPO and the European Patent Office shows that design-intensive industries contribute 13.4% of the EU's GDP and 11.9% of its employment.

Design is also an important driver of international trade. Industries which intensively use design contributed more than 243 billion euros to the EU external trade balance in 2013.
Design protection helps encourage innovation and the development of new products. The EU design protection system acts as a support to every kind of business, from multinationals to micro-enterprises, allowing them to protect the results of their creativity and innovation at national, regional and European level.

Against this backdrop, the European Commission has launched a stakeholder consultation on the functioning of the design protection systems in the EU, at Union and at national levels.

The feedback gathered will support the evaluation of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs ('Design Directive') and of Council Regulation (EC) No 6/2002 of 12 December 2001 on the Community designs ('Community Design Regulation') with a view to establishing the degree to which that legislation works as intended and can still be considered fit for purpose.

The consultation builds on and follows previous research, analysis and targeted surveys conducted as part of two studies, one carried out in 2015 and the other carried out in 2016, on the economic and legal review of the design protection systems in the EU, at national and at Union level.

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

The results of the consultation may feed into an impact assessment study for a possible legislative review of the existing legislation.
The consultation is open until 31 March and can be accessed here.

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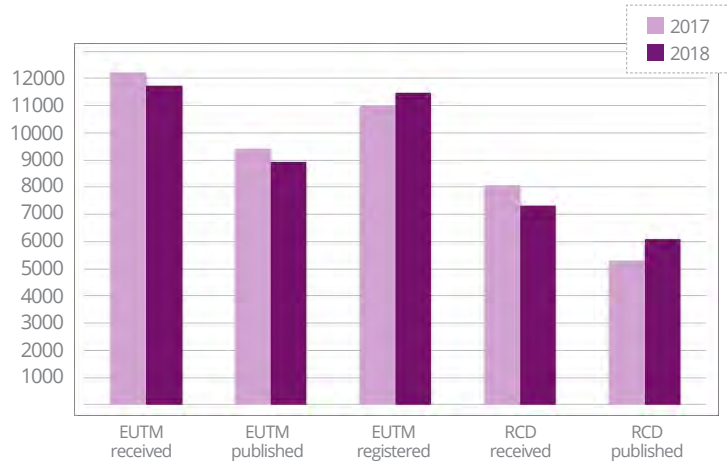
Monthly statistical highlights December*	2017	2018
European Union Trade Mark applications received	12 198	11 714
European Union Trade Mark applications published	9 397	8 925
European Union Trade Marks registered (certificates issued)	10 966	11 455
Registered Community Designs received	8 057	7 315
Registered Community Designs published	5 281	6 094

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



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Austrian Patent Office implements e-filing for trade marks

The Austrian Patent Office (Österreichisches Patentamt, ÖPA) has implemented the Software Package Front Office (SPFO) for the e-filing of trade marks, a tool developed under the EUIPO's European Cooperation Projects.

The new e-filing system represents a step forward in the way trade marks are processed and registered and is expected to serve more than 5,500 trade mark applications per year.

The e-filing software is able to process standard, fast track and divisional applications of trade marks.

ÖPA started the analysis phase of the project in March 2018, with the aim not only to start using a new software but to also contribute to the transposition of the Directive for new type of trade marks (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks) as of 14 January 2019.

The implementation is an important milestone, bringing to 20 the number of IP offices using the e-filing software. It is also the triggering point for the launch of further projects in collaboration with ÖPA, such as e-filing for designs and e-services as well as the implementation of the Software Package Back Office in 2020.

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.

Patent Office of Latvia implements a quality management system

The Patent Office of the Republic of Latvia (LRPV) has successfully completed the external audit that certifies the implementation of a Quality Management System (QMS) according to ISO 9001:2015 standard.

The audit was carried out on 27-28 of November 2018 by the certification body DNV-GL.

The implementation was carried out within the framework of the European Cooperation Projects (ECP5 – "Support for Management Systems for IP Offices").

The conclusions of the audit were very positive, illustrating the success of the implementation process and certifying that LRPV's quality management system has the ability to meet the requirements of ISO 9001:2015. Risk management was selected as the most significant area by the audit team, and the achievements to date in this area were reflected in the audit report.

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Also noteworthy during the process was the excellent cooperation and knowledge transfer among LRPV, the Icelandic Patent Office, the Slovenian Intellectual Property Office (SIPO), the Danish Patent and Trademark Office (DKPTO) and the EUIPO.

The results and lessons learned will be useful for the remainder of the participating IP Offices.

Cyprus implements the Capture and Store Historical Files project

The Cypriot Department of Registrar of Companies and Official Receiver (CY DRCOR) has successfully implemented the Capture and Store Historical Files. The project, within the framework of European Cooperation Projects, aims at digitising paper files across the EU IP offices to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

The Cypriot implementation started in December 2017 with the support from teams at the EUIPO and the Cypriot office. This implementation is the third one for the project team, following the Lithuanian and Maltese IP offices, bringing the current number of digitised dossiers to 200,000.
The implementation of this project will deliver concrete benefits to CY DPCOR employees in reducing waiting times for documents and easy access to data.

The ultimate goal of the project is to support the participating offices in creating a paperless working environment, by digitising all trade mark and design images and paper files.

IP Australia joins TMclass

As of 19 December 2018 IP Australia has joined TMclass with the latest version of the Nice classification.

This latest addition brings the total number of national and regional IP Offices, including ARIPO, OAPI, WIPO and EUIPO, in the tool to 73.

TMclass offers users the opportunity to search and translate goods and services to and from any of the 44 languages available.

The integration of IP Australia is a concrete result of the EUIPO's International Cooperation framework in collaboration with its international partners.

You can find out more at www.tmdn.org and http://euipo.europa.eu/ec2

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Brunei joins TMview and DesignView

As of 23 January 2019 the Brunei Intellectual Property Office (BruIPO) has made its trade mark and design data available to the TMview and DesignView search tools.

With BruIPO on board TMview and DesignView now contain data from 68 participating offices.

The integration of BruIPO in TMview and DesignView is a concrete result of the IPKey South East Asia programme directed by the European Commission and executed by the EUIPO.

You can find out more at www.tmdn.org and www.ipkey.eu

Monaco joins TMview

As of 28 January 2019 the Industrial Property Office of Monaco (MCIPO) has made its trade mark data available to the TMview search tool.

The integration of MCIPO is a concrete result of the International Cooperation programme managed by the EUIPO in collaboration with its international partners.

With MCIPO on board, TMview now contains data from 69 participating offices.

With the addition of more than 16,000 trade marks from MCIPO, **TMview provides information and access to almost 52.6 million trade marks in total**.

Since the introduction of TMview on 13 April 2010, the tool has served more than 51.2 million searches from 166 different countries, with Spain, China and Germany among the most frequent users.

You can find out more at www.tmdn.org

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Updating of Decisions and Communications of the Executive Director of EUIPO

A number of Decisions and Communications of the Executive Director of EUIPO have been updated, to align them in substance and/or in terminology with the new EUTMR, EUTMDR and EUTMIR.

In addition the section of the EUIPO website where the Decisions and Communications of the Executive Director are stored has been revised to increase ease of searching for users and to focus more on those decisions which are more frequently consulted.

The section now contains on the one hand the most relevant EX Decisions, Communications and ADM Decisions and on other hand a searchable repository of decisions and communications, which have been categorised and tagged for more efficient searching and document retrieval.

IP Mediation Conference in Alicante 30-31 May

Mark your calendar! 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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B: General Court: Orders and Judgments on appeals against decisions of the EUIPO

T-718/16; SPINNING; Mad Dogg Athletics, Inc. v EUIPO; Judgment of 8 November 2018; EU:T:2018:758; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Relevant territory, Revocation grounds, Specialised public

FACTS: The applicant sought to register the word mark SPINNING for goods and services in Classes 9, 28 and 41. A partial revocation application was filed pursuant to Article 58(1)(b) EUTMR for goods and services in Classes 28 and 41. The Cancellation Division (CD) revoked the applicant's rights in their entirety. The applicant filed an appeal against the CD's decision. The Board of Appeal (BoA) annulled the CD's decision in part for goods in Class 9, even though they were not the subject matter of the partial revocation. The appeal was dismissed for the rest of the goods and services. The applicant filed an action with the General Court (GC), relying on three pleas in law: (i) infringement of Article 58(1)(b) EUTMR (based on four complaints), (ii) infringement of Article 41(2)(a) of the Charter of Fundamental Rights of the EU, and (iii) infringement of Article 41(2)(c) of the Charter of Fundamental Rights.

SUBSTANCE: Relevant date. The revocation decision must be based on one of the grounds referred to in Article 58 EUTMR that applied, at the latest, on the date of filing of the application for revocation. It follows from that provision that the applicability of the ground for revocation must be examined in the light of the factual and legal context on that date at the latest (para. 17). Regarding the revocation of a trade mark on the ground of a lack of genuine use, only circumstances that arise before the filing of the application for revocation may be taken into account, without prejudice to the possibility of taking into consideration circumstances arising after that filing (para. 18). As the case-law referred to in para. 18 concerns the revocation of the rights of the proprietor of a trade mark on the ground of a lack of genuine use, it can be transposed, mutatis mutandis, to the context of examining an application for revocation of a trade mark on the ground that it has become the common name for goods or services (para. 19). By submitting evidence relating to the period after the application for revocation, the applicant is not seeking to confirm or better assess circumstances prevailing on or arising before that date. On the contrary, it seeks to give itself an opportunity to show that the ground for revocation might no longer apply after the filing of the application for revocation

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(para. 20). The possibility that the contested sign would have been regarded, by the relevant public, as a common name at the time of the revocation, and then once again as a trade mark by that public at the time of adoption of the revocation decision, still would not permit derogation from the rule set out in Article 62(1) EUTMR, which requires that the ground for revocation be examined in the light of the factual and legal context on the date of filing of the application for revocation at the latest (paras 21-22). The parties may submit evidence only within the periods laid down by the Office for submitting observations (para. 25). The consideration of evidence that was not submitted within the period prescribed by the Office, instead being submitted at a later stage of the proceedings, cannot be accepted, except to complement the evidence already submitted within the prescribed period. However, this does not authorise the BoA to extend its discretion to new evidence (para. 26). Evidence submitted late cannot be taken into account unless it confirms or makes it possible to better assess circumstances arising before, or prevailing on, the date of the application for revocation (para. 27). Relevant territory. EU trade marks are given uniform protection and their effects are valid for the whole of the EU territory (para. 31). Article 58(2) EUTMR states that there may be a partial revocation for some of the goods or services (para. 32). A revocation decision has binding force for the whole EU territory (para. 33). The Court has previously held that the case-law referred to in para. 42 concerns the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the EU or in the Member State in which they have been registered (para. 43). The BoA was right in noting that the unitary character of the EU trade mark is the basic legal principle underpinning the entirety of the EUTMR. That principle implies, in particular, that an EU trade mark is, at the time of its registration, distinctive throughout the EU, and retains that distinctive character by not becoming, in even a limited part of the EU or, as the case may be, in a single Member State, the common name in the trade for goods and services for which it was registered (para. 46). The Court notes that a revocation decision based on such a principle, however far-reaching its consequences for the proprietor of the trade mark in question, is inherent in the rule of law sought by the EU legislature (para. 49). The BoA did not err in law in relying on evidence limited to Czechia in order to revoke the contested mark and, accordingly, the second complaint must be rejected as unfounded (para. 50). Relevant public. The BoA was wrong to consider that professional customers were not part of the relevant public for exercise equipment, since indoor cycles are purchased by commercial operators of gyms, sports facilities and rehabilitation facilities (para. 59). The BoA was wrong to exclude professional customers' perception of exercise equipment from its analysis in order to assess whether the contested mark had become the common name in the trade. The BoA made an

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error of assessment in defining the relevant public for exercise equipment in Class 28 by failing to take account of the perception of professional customers (para. 61). In light of the above, the third complaint of the first plea must be upheld, and the contested decision must be annulled insofar as it concerns the goods in Class 28 and the services in Class 41 of the contested mark. Consequently, it is not necessary to examine either the fourth complaint of the first plea or the second and third pleas (para. 67).

T-486/17; DIETOX (fig.) / Dietor (fig.); Foodterapia, SL v EUIPO; Judgment of 14 November 2018; EU:T:2018:778; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Complex mark, Conceptual similarity, Dominant element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity, Weak element

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 3, 5, 29, 30 and 43. An opposition based on the earlier EU figurative mark below, registered for goods in Classes 5, 29 and 30, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition, so the opponent filed an appeal. The Board of Appeal (BoA) upheld the opposition. The applicant went on to file an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

EUTM Application

DIETOX

Earlier trade mark

Dietor

SUBSTANCE: Relevant public. The relevant public consists of the general public with regard to all of the goods, and of professionals with regard to certain goods. However, it is the section of the public with the lowest level of attention that has to be taken into account for the purposes of assessing the likelihood of confusion (para. 26) The level of attention is lower than average in the case of goods that might be bought spontaneously, average in the case of most of the goods covered, and higher in the case of the consumer health goods in Class 5 (para. 28). Comparison of the goods. The goods

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covered are identical (para. 33). Comparison of the signs. (i) The signs have the sequence of letters 'dieto' in common, positioned in the same order. The weak distinctiveness of the stem 'diet' does not mean it should be neglected in the visual analysis of the signs, however (para. 66). The signs differ clearly in their figurative elements, their design and the last letter of their word elements ('dietor' for the earlier mark and 'dietox' for the contested mark) (para. 67). The fact that the word element of the earlier mark is its dominant element reinforces both the similarities and the differences between the signs (para. 68). Since the figurative element of the contested mark reproduces or announces the stylised letter of its word element and also makes up the grey background on which the word element is written, the relevant public will remain focused on that word element. In addition, reading that word element reveals its similarity to the word element of the earlier mark (para. 69). (ii) The signs are phonetically very similar: no matter how they are pronounced, the letters common to the word element in each of the signs, 'd', 'i', 'e', 't' and 'o', will always be pronounced in the same way. Moreover, the last syllables of the words are almost identical, being based on the same vowel 'o'. They also have the same rhythm, sound and intonation because of their almost identical structure (para. 74). (iii) The words 'dietor' and 'dietox' have no known meaning as such (para. 82). However, the common stem 'diet' alludes to the concept of diet or dietetic foodstuffs. Therefore, both words 'dietor' and 'dietox', whether they are written or pronounced, allude to the word 'diet' in some way, that is to say, to a particular diet (para. 83). Finally, the figurative elements of the signs at issue have no definite meaning (para. 84) and are similar overall (para. 86). LOC. The goods covered by both marks are identical, and the signs have some visual and conceptual similarity and a high degree of phonetic similarity (para. 91). Consequently, there is LOC (para. 93). Scope of proceedings. The Office's guidelines are a self-imposed restriction, which cannot go against the interpretation that the EU Courts have given to a legal rule (para. 96).

T-758/17; PERFECT BAR; Perfect Bar LLC v EUIPO; Judgment of 8 November 2018; EU:T:2018:762; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark PERFECT BAR as an EUTM for nutritional energy bars for use as a meal substitute; nutritional supplement meal replacement bars for boosting energy; nutritional supplement energy bars; protein supplements; dietary and nutritional supplements; nutritional supplements in the form of bars and bites; nutritional supplements in the form of food bars for use as a meal substitute; nutritional and

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dietary supplements formed and packaged as bars in Class 5. The Office refused to register the EUTM application pursuant to Article 7(1)(c) and (b) EUTMR, as it was descriptive and devoid of distinctive character. The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the mark applied for was descriptive of the nature and quality of the goods in question, given that the English-speaking part of the general public would understand the word elements of the mark applied for as referring to a bar of food having all the essential elements required and being excellent in all respects. Insofar as the mark was descriptive of the nature and quality of the goods in question, it was devoid of distinctive character for those goods. 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: Descriptiveness. The combination of the word elements of the mark refers to goods presented in the form of a bar that is excellent in all respects. This is one of the possible meanings of 'perfect bar', and one that does not require any additional cognitive effort to perceive (paras 24-27). Therefore, as regards the goods presented in the form of a bar, the BoA validly concluded that the mark applied for is descriptive (para. 39). However, the BoA had not established, to the requisite legal standard, the descriptive character of the mark in relation to 'protein supplements' and 'dietary and nutritional supplements' because it has not been established whether these specifications include goods presented in the form of a bar (paras 51-53). The applicant cannot validly rely on the fact that the Office has registered similar marks in order to seek annulment of the BoA decision for the goods in the form of a bar, as the Office had established the descriptive character of the mark for such goods based on the EUTMR (paras 56-60). The applicant cannot rely on the fact that an identical mark was registered in the United States either, as an EU mark must be assessed by reference only to the relevant EU rules and, consequently, the EU Courts are not bound by a decision in a third country (paras 61-63). Distinctive character. Insofar as the mark applied for is descriptive for the goods in the form of a bar, it also lacks distinctive character (para. 72). However, since it has not been established whether the mark is descriptive for 'protein supplements' and 'dietary and nutritional supplements', the conclusion that it automatically lacks distinctiveness for these goods is invalid (para. 74). Consequently, it is necessary to annul the contested decision insofar as these goods are concerned (para. 76).

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T-759/17; PERFECT BAR (fig.); Perfect Bar LLC v EUIPO; Judgment of 8 November 2018; EU:T:2018:760; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Descriptive element

NORMS: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

FACTS: The applicant sought to register the figurative mark below as an EUTM for nutritional energy bars for use as a meal substitute; nutritional supplement meal replacement bars for boosting energy; nutritional supplement energy bars; protein supplements; dietary and nutritional supplements; nutritional supplements in the form of bars and bites; nutritional supplements in the form of food bars for use as a meal substitute; nutritional and dietary supplements formed and packaged as bars in Class 5. The Office refused to register the EUTM application pursuant to Article 7(1)(c) and (b) EUTMR, as it was descriptive and devoid of distinctive character. The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the mark applied for was descriptive of the nature and quality of the goods in question, given that, first, the English-speaking part of the general public would understand the word elements of the mark applied for as referring to a bar of food having all the essential elements required and being excellent in all respects and, second, the figurative elements of the mark applied for, which are of decorative value, were not sufficient to divert the relevant public's attention from the descriptive message of the word elements. Insofar as the mark was descriptive of the nature and quality of the goods in question, it was devoid of distinctive character for those goods. 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.

EUTM Application

SUBSTANCE: Descriptiveness. The combination of the word elements of the mark refers to goods presented in the form of a bar that is excellent in all respects. This is one of the possible meanings of 'perfect bar', and one that does not require any additional cognitive effort to perceive (paras 24-27). The figurative elements, namely the position of the word elements perpendicular to each other, the different sizes and fonts, the rectangular frames and the contrast of black and white, correspond to standard graphic elements that will be perceived by the relevant public as simple decorative elements. Moreover, it cannot be ruled out that these will emphasise the message of the word 'bar' by

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reinforcing the expected form of a bar (para. 32). Therefore, for the goods presented in the form of a bar, the BoA validly concluded that the mark applied for is descriptive (para. 42). However, the BoA had not established, to the requisite legal standard, the descriptive character of the mark in relation to 'protein supplements' and 'dietary and nutritional supplements' because it has not been established whether these specifications include goods in the form of a bar (paras 54-56). The applicant cannot validly rely on the fact that the Office has registered similar marks in order to seek annulment of the BoA decision for goods in the form of a bar, as the Office had established the descriptive character of the mark for such goods on the basis of the EUTMR (paras 59-62). Nor can the applicant rely on the fact that an identical mark was registered in the United States, as an EU mark must be assessed by reference only to the relevant EU rules and, consequently, the EU Courts are not bound by a decision in a third country (paras 64-66). Distinctive character. Insofar as the mark applied for is descriptive for the goods in the form of a bar, it also lacks distinctive character (para. 75). However, since it has not been established whether the mark is descriptive for 'protein supplements' and 'dietary and nutritional supplements', the conclusion that it automatically lacks distinctiveness for these goods is invalid (para. 77). Consequently, it is necessary to annul the contested decision insofar as these goods are concerned (para. 78).

T-339/17; SEVENOAK (fig.) / 7seven (fig.); Shenzhen Jiayz Photo Industrial Ltd v EUIPO; Judgment of 21 November 2018; EU:T:2018:815; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Common element, Conceptual similarity, Dominant element, Figurative element, Identity of the goods and services, Likelihood of confusion, Numerical mark, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark below as an EUTM for, inter alia, optical lenses and bags adapted for carrying photographic apparatus in Class 9. An opposition based on the earlier figurative mark below, registered for optical apparatus and instruments and cases for photographic apparatus, for glasses, inter alia, in Class 9 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition finding that, notwithstanding the identity of the goods, there was no LOC because, overall, the observant consumer would notice the differences between the signs at issue. The opponent filed an appeal. The Board of Appeal (BoA) upheld the appeal, finding that, given the similarities between the marks and the identity of the goods concerned and because of the principle of the interdependence of factors, there was a LOC, in particular for English-speaking consumers, even

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when paying a high level of attention for goods in the optics sector. The applicant filed an action before the General Court (GC), relying on one plea in law: infringement of Article 8(1)(b) EUTMR.

EUTM Application

Earlier trade mark

SUBSTANCE: Comparison of the goods. The goods are identical and this is not disputed. The relevant public and its level of attention. The goods are directed not only at professionals but also at the general public who have an interest in photography — whose level of attention is deemed to be average (paras 43-44). Comparison of the signs. Visually, although the signs share the word element 'seven', they differ in several respects: firstly, while the mark applied for is represented in eight grey letters with a slim, vertical appearance that are not joined together, the earlier mark is composed of six bold letters with black outlines, white on the inside, aligned at the bottom and interconnected with regard to the element 'seven'; secondly, whilst the mark applied for is represented in capital letters, the earlier mark is represented in lower-case letters; and thirdly, the mark applied for does not include the number 7, which appears at the beginning of the earlier mark. However, it includes the letter 'n', which is much more stylised than the 'n' in the earlier mark, and the ending 'oak', which does not appear in the earlier mark. The marks are thus visually dissimilar, and not similar to a certain degree, as wrongly held by the BoA (paras 73-79). The pronunciation of the common word element 'seven' can create a certain phonetic similarity between the marks, which is not offset by the presence of the letters 'o', 'a' and 'k' at the end of the mark applied for (para. 83). There is some conceptual similarity between the marks as regards the English-speaking public because the common word element 'seven' will be understood as referring to the concept of the number 7 (paras 86-87). Even though the purchase of the goods may be made on an oral recommendation, the marks will generally be perceived visually prior to purchase (para. 93) and, in the present case, the visual aspect plays a greater role in the assessment of the similarity of the marks. Therefore, the differences in the respective visual perception of the marks outweigh the similarities found at the phonetic and conceptual levels, so the relevant public will not have the impression that the marks are similar (para. 95). Likelihood of confusion. Insofar as the visual aspect plays a greater role in the assessment of the similarity of the marks, as in the present case, the differences in the respective visual perception of the marks outweigh the similarities found at the phonetic and conceptual levels, so that

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the relevant public would not have the impression that the marks are similar. Therefore, in the absence of a minimum degree of similarity, the principle of interdependence does not apply and there is no LOC between the marks (paras 101-103). It follows that the contested decision must be annulled (para. 106).

T-296/17; SPÜLUNGEN FÜR W.C. (WASSER-); Buck-Chemie GmbH v EUIPO; Judgment of 22 November 2018; EU:T:2018:823; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Definition of a design, Individual character, Overall impression

FACTS: The intervener obtained the registration of the Community design (RCD) depicted below, intended to be applied to toilet flushes in Class 09-05 of the Locarno Classification. A declaration of invalidity of the RCD has been filed pursuant to Article 25(1)(b) CDR. The Invalidity Division (ID) rejected the application. The applicant filed an appeal against the ID's decision and the Board of Appeal (BoA) dismissed the appeal finding that the earlier designs relied on did not preclude the novelty and individual character of the RCD within the meaning of Articles 4 to 6 CDR. The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 63 CDR read in conjunction with Article 25(1)(a) and Article 3(a) CDR, (ii) infringement of Article 62 CDR read in conjunction with Article 25(1)(b) CDR and Articles 4 and 5 CDR and (iii) infringement of Article 25(1)(b) CDR and Articles 4 and 6 CDR.

SUBSTANCE: (i) The first plea is manifestly unfounded insofar as it is clear from the wording of Article 63(1) CDR that, in a declaration of invalidity, the examination of the facts is limited to the pleas in law relied on and the applications submitted by the parties. The applicant itself admits that it did not invoke the ground for invalidity referred to in Article 25(1)(a) CDR in its application form for a declaration of invalidity (paras 19-20). (ii) The BoA was entitled to conclude that the RCD was new in view of the fact that it was found to be individual (para. 31). (iii) The first view of the RCD shows that the four balls are aligned contiguously in a coherent arrangement and in relation to each other. It is without error that the BoA defined the product concerned as a detergent 'block' and not as four isolated products (para. 46). Since this type of product naturally imposes constraints in terms of its material, the BoA was right in finding that the degree of freedom of the designer was limited (para. 48).

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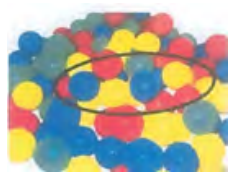
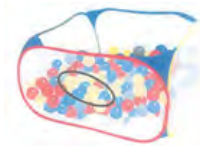
RCD

Earlier designs



Earlier designs



Regarding the ball pools invoked as earlier designs, it is well known that they are characterised by a random and unpredictable mixture of balls, the applicant's assertion that the said representations are 'static' and show a specific order of balls is manifestly unfounded (para. 50). Regarding the puzzle called 'Hungarian rings' (earlier design depicted at the top), it must be noted that the succession of blue and yellow balls can only be visible in the part of the previous design underlined by an oval, this part is not independent in nature and

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cannot be separated from the overall impression produced by the product received in its entirety (para. 52). The extract from the instructions of the game differs considerably from the contested design, which represents a linear arrangement of four balls alternately blue and yellow (para. 53).

T-790/17 and T-791/17; ST ANDREWS; St. Andrews Links Ltd v EUIPO; Judgment of 20 November 2018; EU:T:2018:811; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Geographical origin, Descriptive

FACTS: The applicant sought to register the word sign ST ANDREWS as an EUTM for goods and services in Classes 25, 28, 35 and 41. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(3) EUTMR, as it was descriptive of certain positive characteristics of the goods and services covered. Secondly, the evidence adduced by the applicant was found insufficient to prove acquired distinctiveness through use of the contested mark. The applicant filed an appeal and the Board of Appeal (BoA) partially dismissed the appeal. It found that a link could be established between several services covered by the contested mark in Class 41 and the expression 'st andrews'. Those services were all directly related to the sport of golf, that is, to the particular field for which the town of St Andrews (United Kingdom) is very well known. Consequently, the use of that expression in connection with those services would be perceived by the relevant public as a descriptive indication of the geographical origin of those services. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(c) EUTMR.

SUBSTANCE: Relevant public. The relevant public is composed both of average consumers and golf professionals and amateurs in the EU (para. 28). Meaning of the mark. The mark consists of a sole expression that refers to a place well known for the sport of golf and in respect of which the services are, inter alia, 'arranging and conducting competitions', 'club services (entertainment or education)', etc., and will therefore indicate, at the very least to golf professionals and amateurs, that those services relate to golf (para. 56). Link between the mark and the services. (i) The services could all directly relate to the sport of golf, and in particular, to the organisation and planning of golf events, competitions, etc., that is, to the particular field for which the town of St Andrews is well known (para. 35). (ii) The services covered by the contested mark do not possess any particular quality that could lead the relevant public to disassociate the geographical indication from the geographical origin of those services (para. 36). (iii) The services could, to a certain extent and for part of the relevant public, be linked to some specific competitions that are played on the

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applicant's courses (para. 37). (iv) There is a link between the expression 'st andrews', in the mind of the relevant public, at the very least insofar as golf professionals and amateurs are concerned, and the services covered by the contested mark in Class 41 (para. 38). (v) The expression 'st andrews' is likely to designate the geographical origin of those services. Therefore, there is a link between the expression 'st andrews', in the mind of the relevant public, at the very least insofar as golf professionals and amateurs are concerned, and the services covered in Class 41, and the expression 'st andrews' is likely, in that public's mind, to designate the geographical origin of those services (para. 38).

T-44/17; CAMOMILLA / CAMOMILLA (fig.); Camomilla Srl v EUIPO; Judgment of 13 November 2018; EU:T:2018:775; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Belated evidence, Catalogue, Common element, Complementary evidence, Conceptual identity, Document from third party, Dominant element, Evidence of use, Extent of use, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Place of use, Press articles, Remittal from GC/ECJ, Sales figures, Similarity of the goods and services, Visual identity, Word mark

FACTS: The EUTM proprietor registered the word mark CAMOMILLA as an EUTM for goods in, inter alia, Classes 18 and 25. An invalidity application was filed pursuant to Articles 59(1)(b) EUTMR and 60(1)(a) EUTMR in conjunction with Article 8(1)(b) and (5) EUTMR, based on the earlier Italian figurative mark below, registered for Class 25 (clothing and clothing accessories of all types). The Cancellation Division (CD) dismissed the invalidity application, insofar as it found, inter alia, that the invalidity applicant had not adduced proof of use of the earlier mark and there was no likelihood of confusion (LOC). The invalidity applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal, finding, inter alia, that the use of the earlier mark was not sufficiently proven, and that certain documents were inadmissible as submitted for the first time before the BoA. The invalidity applicant filed an action before the General Court (GC), which the GC upheld considering the belated evidence to be admissible as complementary. After remittal, the BoA re-examined the appeal and partially upheld it, insofar as it found that the earlier mark had previously been used in Italy for goods in Class 25 and that there was LOC for goods in Classes 18 and 25. The EUTM proprietor filed an action before the GC, relying on four pleas in law: (i) infringement of Article 94 EUTMR, (ii) infringement of Article 95(1) EUTMR, (iii) infringement of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR, and (iv) infringement or Article 64(3) EUTMR in conjunction with Article 64(2) EUTMR.

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EUTM

CAMOMILLA

Earlier trade mark

SUBSTANCE: Dominant element. The trade mark appears in forms that include the dominant word element 'CAMOMILLA', accompanied by other descriptive figurative and word elements such as 'Italia' and 'Moda donna' (paras 47-48). Place of use. The list of sales points provided by the invalidity applicant and the declarations made by several clients prove that the trade mark has established a particular presence in southern Italy and has, moreover, been marketed — albeit to a much lesser extent — in other shops and franchise points throughout the country (para. 61). Nature of use. Regarding the use of the trade mark to designate the relevant goods, a pair of shoes bearing the label 'CAMOMILLA' appears in the invalidity applicant's catalogue for the spring/summer 2004 collection. In addition, a blouse sporting the 'CAMOMILLA' label appears in the March 2006 and September 2006 editions of Camomilla Magazine (para. 62). Therefore, it is proven that the trade mark was used to designate goods such as clothing, footwear and clothing accessories during the relevant period (para. 63). Extent of use. The purpose of proof of use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection only to large-scale commercial use of the marks (para. 64). In any case, it is clear from the summary tables of sales figures that the invalidity applicant recorded annual sales of over EUR 10 million from 2004 to 2009 (para. 65). The information relating to 2004 is corroborated by the newspaper article published in Italia Oggi, which describes 'CAMOMILLA' as a 'Neapolitan' trade mark that recorded sales figures of EUR 20 million in 2004 (para. 68). Relevant public. The relevant public is the Italian public with an average level of attention (paras 85-86). Comparison of the goods. The goods in Class 25 are either identical (footwear) or similar due to complementarity, especially from an aesthetic perspective, and since they also share the same distribution channels, they target the same public and are normally manufactured by the same undertakings (paras 90-91). The contested goods in Class 18 (rucksacks, key cases, etc.) are also slightly similar with items of clothing, since they usually share the same manufacturers, distribution channels and end consumers (para. 92). Comparison of the signs. (i) There is a certain degree of visual similarity between the signs: the respective stylisations are similar and devoid of any

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fanciful elements, whereas the dominant element 'CAMOMILLA', which will attract most of the public's attention, counteracts the differences arising from the presence of certain figurative elements in the earlier trade mark. (ii) They are phonetically identical, given that their only word element, 'CAMOMILLA', will be pronounced in the same way. (iii) The signs are also identical from a conceptual perspective, since they both allude to the concept of 'camomile', which is widely understood to be a variety of annual herbaceous plant of the Asteraceae family (para. 98). LOC. Given the level of attention of the relevant public, the identity or similarity of the goods and the high similarity of the signs and also taking the normal distinctive character of the earlier mark into account, there is LOC (paras 104-105).

T-724/17; VIANEL / VIANIA et al.; The Vianel Group LLC v EUIPO; Judgment of 22 November 2018; EU:T:2018:825; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Proof of use

FACTS: An opposition based, inter alia, on the EUTM registration for the word mark VIANIA was brought against the international registration (IR) designating the EU for the word mark VIANEL, pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partially upheld the opposition, namely, for clothing, namely, sweaters, t-shirts, shirts, blouses, corsets, suits, vests, raincoats, skirts, coats, trousers, pullovers, dresses, jackets, shawls, sashes for wear, scarves, neckties, pocket squares, suspenders, gloves, belts, stockings, tights, socks, singlets, bathing suits and bath robes in Class 25. It found that genuine use of the earlier mark was proven only for underwear in Class 25, and that there was a likelihood of confusion with the contested IR for the abovementioned goods in Class 25. The Board of Appeal (BoA) dismissed the appeal filed by the IR holder. It noted that the IR holder had accepted the OD's findings concerning genuine use of the earlier mark and the identity and similarity of the goods. The BoA thus endorsed the OD's reasoning both in this respect and regarding the likelihood of confusion. The IR holder brought an action before the General Court (GC), relying on two pleas in law: (i) irrelevance of the evidence of genuine use submitted by the opponent before the OD and (ii) infringement of Article 8(1)(b) EUTMR.

Subject matter of the dispute. Since the question of proof of genuine use of the earlier mark was not submitted to the BoA and the latter did not therefore rule on that matter, the plea to this effect must be declared inadmissible (paras 19-22). Furthermore, since the applicant expressly stated before the BoA that it did not dispute the OD's findings concerning the comparison of the goods, the claim relating to the dissimilarity of the goods must also be rejected as inadmissible (paras 25-

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26). Likelihood of confusion. Visually, neither the difference between the last two letters of the signs at issue, nor the repetition of the group of letters 'ia' in the earlier mark, can counteract the visual similarity resulting from the signs being of the same length and coinciding in their first four letters (paras 34-37). Phonetically, the homophony of the sounds produced by the repeated vowels 'ia' is not in itself sufficient to counteract all phonetic similarity between the signs, in view of the presence of the common group of letters 'vian', so that the marks are phonetically similar to an average degree (paras 39-40). Conceptually, the signs are dissimilar as the earlier mark has no meaning while the contested IR 'VIANEL' might be perceived in France as a family name (para. 41). As the signs are similar overall to an average degree and the goods are partly identical and partly similar, the BoA correctly concluded that there was a likelihood of confusion between the signs in relation to the abovementioned goods in Class 25 (para. 45).

T-826/17; FYYO / FIO et.al.; TeamBank AG Nürnberg v EUIPO; Judgment of 22 November 2018; EU:T:2018:819; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the word mark FYYO as an EUTM for goods and services in Classes 9 and 38, inter alia. An opposition based on the earlier word mark FIO, registered for goods and services in Classes 9 and 38, inter alia, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition. The opponent filed an appeal. The Board of Appeal (BoA) upheld the appeal. It found that there was LOC, considering that the goods and services were identical and that the signs were similar, or even identical, from a phonetic point of view, and had a lower than average level of visual similarity, whereas from a conceptual point of view the comparison was neutral. The applicant filed an action before the General Court (GC), relying on one sole plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: It is not disputed that the relevant public consists of the English-speaking final consumers of the EU, whose degree of attention is average; that the goods and services are identical; and that the earlier mark has an average distinctive character (para. 19). It is also undisputed that the signs are phonetically very similar or even identical and that the similarity is conceptually neutral (para. 20). Visual similarity of the signs. The structure of the marks is the same, as they both consist of a single word element (para. 27). In addition, two of the letters in the signs are identical and placed in the same order, namely the letter 'f', by which the signs begin, and the letter 'o', by which they end. Thus, the

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differences between the signs are limited to their central parts, namely 'yy' on the one hand, and 'i' on the other (paras 29-30). However, even if the letters 'y' of the mark applied for attract attention, insofar as this is an unusual combination of letters, this feature does not, on its own, exclude any similarity between the two signs (para. 30). Although, in the present case, the difference concerning their central parts prevents the signs from being regarded as having a high degree of visual similarity, it does not in any way preclude that they are considered similar to a lower than average degree (para. 33). The fact that, for the goods and services at issue, the visual perception plays a decisive role in the overall assessment of LOC, because it may be considered that they are mainly purchased and used online (in particular, computer software and providing access to platforms and portals on the internet), this does not call into question the finding of LOC. First, because the signs are visually similar, albeit to a lower than average degree; second, because it cannot be ruled out that in certain cases the goods and services are offered aurally, on the radio or by other consumers; and third, because for the identical goods and services, the differences between the signs are not capable of counteracting the similarities between them (paras 42-43). There is LOC and the appeal must be rejected (para. 44).

T-09/18; STRAIGHTFORWARD BANKING; Addiko Bank AG v EUIPO; Judgment of 22 November 2018; EU:T:2018:827; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS: The applicant sought to register the word mark STRAIGHTFORWARD BANKING as an EUTM for, inter alia, financial affairs; monetary affairs in Class 36. The Office refused to register the EUTM application in respect of these services pursuant to Article 7(1)(b), (c) and (2) EUTMR. The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal finding that the mark objectively designates the kind and quality of the services and that it would be understood as a promotional message and not as an indication of their commercial 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 7(1)(b) EUTMR.

SUBSTANCE: Descriptiveness. It is not disputed that the relevant public is the English-speaking public in the EU, composed, inter alia, of the general public (para. 19). Since the mark would be understood as making reference to the simplicity of the services provided by the applicant, which is a desirable feature, it constitutes a promotional formula referring to the quality of the services

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and thus, has a descriptive character within the meaning of Article 7(1)(c) EUTMR (paras 20-22). The fact that the relevant public could perceive the expression 'straightforward banking' as meaning that the applicant will seek to provide services relating to financial and monetary affairs in an understandable way, even though they are complex, does not confer on that term an unusual character capable of indicating the commercial origin of the services (para. 24). The fact, if proved, that the expression 'straightforward banking' has never been used before in a way that is descriptive of the services and that the word 'straightforward' may have several meanings, is not in itself sufficient to conclude that the mark applied for is devoid of any descriptive character, since that mark may, in at least one of its possible meanings, designate a characteristic of the services within the meaning of Article 7(1)(c) EUTMR (para. 25). The fact that the Office has held in previous decisions that, in the banking sector, the relevant public perceives marks with a descriptive character as an indication of the commercial origin of the services in question, does not lead to the conclusion that the BoA, in the present case, infringed Article 7(1)(c) EUTMR, as the Office is not bound by its previous decision-making practice but must rather undertake an examination of the factual circumstances of each specific case (paras 30-31). Distinctive character. Since the sign applied for has a descriptive character within the meaning of Article 7(1)(c) EUTMR, there is no need to consider the merits of the plea alleging infringement of Article 7(1)(b) EUTMR, as it is sufficient that one of the absolute grounds for refusal applies for the sign at issue not to be registrable as an EU trade mark (paras 37-38). The action must, therefore, be dismissed in its entirety.

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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. Decisions of the Presidium of the Boards of Appeal can be found here and the EUIPO Official Journal here. For best results, please use either the Mozilla Firefox or Google Chrome browsers.

04/12/2018, R 676/2018-2, RAPPRESENTAZIONE D'UN FIORE STILIZZATO (fig.)

EUTM applications

Outcome: Decision confirmed.

Norms: Article 33(8) EUTMR, Article 71(1) EUTMR.

Keywords: Declaration.

Summary: The examiner partially refused the declaration based on Article 33(8) EUTMR regarding goods and services other than those covered by the literal meaning of the indications of the class heading, explaining that the declaration contained some terms already covered by the class heading or some terms which were not included in the alphabetical list of the Nice Classification (§ 6).

The Board clarifies the two stages for examining declarations filed under Article 33 EUTMR. The examiner should check first whether the goods and services of the declaration are included within the literal meaning of the indications in the title of the corresponding class. If so, the statement should be rejected in relation to those goods or services. If not, the examiner should proceed to the second stage namely a consultation of the alphabetical list of the Nice Classification in force at the time when the mark was filed, in order to check whether or not those goods or services are included therein. If the goods and services appear on that list, the statement will be accepted in relation to those goods or services, otherwise it will be rejected (§ 19). In the present case, all the goods claimed are covered by the class headings, except for 'flight suits', not being part of the alphabetical list of the applicable 8th edition of the Nice Classification, which therefore have to be rejected (§ 25, 27).

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10/12/2018, R 1239/2018-4, MICRO-PAK (fig.)

EUTM application

MICRO-PAK

Outcome: Decision confirmed.

Norms: Article 67 EUTMR, Article 68 EUTMR, Article 27 EUTMDR.

Keywords: Distinctiveness acquired by use.

Summary: The application was rejected because it was found to be descriptive and non-distinctive on the basis of Article 7(1)(b) and (c), in conjunction with Article 7(2), EUTMR (§ 4).

The Board finds that in the statement of grounds, the applicant did not clearly identify the infringement of the abovementioned provisions as a ground of appeal, nor did the applicant raise or indicate any other ground that would allow for the annulment of the contested decision, which, already for this reason, makes the appeal inadmissible (§ 11). The applicant's statement of grounds identified one ground of appeal only, namely a new claim as regards the acquired distinctiveness of the mark applied for pursuant to Article 7(3) EUTMR (§ 12). The Board notes that according to Article 27(3) (a) EUTMDR, the examination of the appeal shall include a claim of distinctiveness acquired through use as referred to in Article 7(3) EUTMR only provided that it was raised in due time in the proceedings before the instance of the Office which adopted the decision subject to appeal. Such a claim must be made, either together with the application or, at the latest, in reply to the examiner's first decision (§ 13-14). Since in the present case the applicant's claim of acquired distinctiveness was raised for the first time before the Board, the examination of this claim cannot be assessed by it (§ 15) and the appeal must be dismissed.

07/12/2018, R 707/2018-5, Stopgrund

Outcome: Cancellation rejected

Norms: Article 58(1)(b) EUTMR.

Summary: The request for a declaration of revocation was filed against the word mark 'Stopgrund' registered for 'paints and primers' in Class 2. The request based on Article 58(1)(b) EUTMR, however, was rejected by the Cancellation Division. The Cancellation Division agreed with the cancellation applicant that the basic English word 'stop' was likely to be understood throughout Europe and, in light of the evidence, the term 'grund' would be understood in German, Danish, Swedish and Romanian, however, the revocation request was unfounded as the mark 'Stopgrund' had not become a common name in trade (§ 5).

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In order for the proprietor of a European Union trade mark to have its rights revoked, two conditions need to be met: as an objective element, that the trade mark has become the common name in trade for the product or service in respect of which it is registered; as a subjective element, that the development occurred as a consequence of the EUTM proprietor's acts or inactivity as regards the trade mark (§ 17). The relevant point in time, in respect of which the assessment of the claim that the sign has become a common name, is the registration date (§ 27). The relevant public is composed of German-, Danish-, Swedish- and Romanian-speaking consumers (§ 32). The cancellation applicant submitted an extensive number of documents, however, only some of them can be considered as relevant (§ 35). If the sign had become a common name in trade, the cancellation applicant clearly should have been able to provide more ample, and thus, convincing evidence. The cancellation applicant did not provide any further and more conclusive material on appeal showing extensive use of the sign to the effect that the term 'Stopgrund' had come to be used and seen as a common name for 'painting primers', and that this use has led to the term becoming a common name in trade for a substantial part of the relevant public (§ 46).

30/11/2018, R 1630/2017-3, Stiefel

Contested RCD

Earlier RCD

Outcome: Decision confirmed.

Norms: Article 6(1) CDR, Article 7(1) CDR.

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Keywords: Freedom of designer, Individual character.

Summary: An application for invalidity was submitted against the above RCD based on several earlier RCDs, claiming its lack of novelty and individual character. The Invalidity Division accepted the application.

The Board finds that the appeal is unfounded, the RCD compared with the earlier right (model 'KISS') has no individual character in the sense of Article 6 CDR (§ 15). It is confirmed that the documents submitted by the invalidity applicant are sufficient (printouts from a dated and accessible part on an internet blog) as evidence of disclosure (§ 22-23). In relation to winter boots, the degree of the designer's freedom is high, the consumers' expectations with regard to comfort and protection from the cold do not limit the freedom of the design (§ 28). Consequently, even small differences may lead to a different overall impression (§ 30). However, in the present case, taking into account the designer's high degree of freedom, the differences between the two samples are not sufficient to create a different overall impression on the informed user. The differences in colour cannot be decisive given that the informed user is aware that boots are offered in a great variety of colours. The other differences, if perceived, would appear to be functional and essentially due to the different perspectives in their reproduction (§ 39-40).

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