

Alicante News

Up to date information on IP and EUIPO-related matters



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Declarations under Article 28(8)

On March 23, 2016, the EU trade mark regulation (EUTMR) amended by Regulation (EU) 2015/2424 of the European Parliament and the Council amending the Community trade mark regulation entered into force.

Article 28(8) of the EUTMR allows for a transitional period of six months during which proprietors of EUTMs applied for before 22 June 2012 and registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal meaning of that heading.

In essence, this means that from the end of the transitional period, all trade marks containing class headings will be interpreted according to their literal meaning regardless of their filing date.

The Executive Director of EUIPO issued a [Communication](#) on February 15, 2016, setting the framework for proceedings before the Office for entering a declaration under Article 28(8) EUTMR in the Register.

The [Annex to Communication 1/2016](#) of the Executive Director concerning the implementation of Article 28 EUTMR contains a non-exhaustive list of examples of goods and services clearly not covered by the literal meaning of the general indications of the Nice class headings for each of the editions of the Nice classification concerned (6th to 10th edition). Users are reminded that, in accordance with paragraph 8 of Communication 1/2016, declarations for any of the goods or services included in the Annex of examples of terms clearly not covered by the literal meaning of the respective class headings will not be objected to by the Office on the ground of being covered by the literal meaning of the class heading.

As a result of feedback from users, the Office has prepared a non-exhaustive list of terms considered to be not clearly covered by the literal meaning of the respective class headings for the purpose of declarations under Article 28(8) EUTMR. The list is purely for the guidance of trade mark owners wishing to submit declarations for the purposes of Article 28(8) EUTMR. The list is available [here](#).

When making a declaration:

The Office has created an [online form for declarations](#), accessible through the User Area of its website.

When making a declaration, users are kindly reminded that, as mentioned in paragraph 8 of Communication 1/2016, the Office will object to:

- claims for the entire alphabetical list;
- the use of unclear, imprecise or unspecific expressions;
- declarations for goods and services that are clearly covered by the literal meaning of the class heading;
- declarations for goods or services not contained in the alphabetical list in question.

The following check-list may serve to help users avoid receiving an office objection, by verifying the requirements before filing their Article 28(8) declarations:

Formal requirements

- Declaration filed before 24/09/2016
- Correct language (Office language for EUTMs, language of the IR for IRs designating the EU)
- Representative appointed where necessary
- Mark identified
- Owner identified



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Regarding the mark

- EUTM filed before 22/06/2012
- EUTM registered before 23/03/2016
- EUTM covers entire class heading

Regarding the content of the declaration

- Identifies goods and services that go beyond the literal meaning of the class heading and
- Identifies goods and services that appear on the alphabetical list in force at the time of filing the EUTM.

Resources for users

- [Communication 1/2016 of the Executive Director concerning the implementation of Article 28 EUTMR](#)
- [Annex to Communication 1/2016 of the Executive Director concerning the implementation of Article 28 EUTMR](#)
- [Frequently Asked Questions: Declarations under Article 28\(8\) EUTMR](#)
- [Webinar: Questions and Answers on Regulation \(EU\) No 2015/2424](#)
- [Link to the online form for filing a declaration](#)
- [EUIPO information section on Regulation \(EU\) No 2015/2424](#)
- [Contact our Information Centre](#)



The James Nurton Interview



Kate O'Rourke, Charles Russell Speechlys, London and president of the Institute of Trade Mark Attorneys

How did you get into trade marks?

I am from Australia. I did my law degree in Australia and while I was a student I had a part-time job at a patent and trade mark law firm as a trade mark searcher. It was a great job – partly because all the searchers from different firms used to go to the trade mark office and it was very sociable.

I studied IP while at university and when I graduated I qualified as a solicitor in New South Wales, Australia. After a couple of years I moved to New York for a year to do something completely different and then I moved to London where I joined the patent and trade mark firm of Jenkins. During my time there I took my trade mark attorney exams, which I'm pleased to say I passed first time.

I subsequently moved to a law firm and re-qualified as a solicitor in England and Wales, so I am a dual-qualified solicitor and registered trade mark attorney. London is the best place to live in the world: I wouldn't live anywhere else. It is so easy to get to other places and there is so much going on in London – it feels like the centre of the universe.



Kate O'Rourke

What does your day-to-day work involve?

It's mostly advisory work relating to trade mark and design protection. A lot of my clients are UK based so I do all of their work, and a lot of their other legal work is done by the firm. You get to know all sorts of aspects of the client. With those businesses I know what they are planning and what they think about.

I do oppositions, revocations and cancellations but not big-ticket litigation. I can't see how anyone who advises clients day-to-day can also be involved in major litigation because it takes you away from your desk so much. We have IP litigators in the firm so if something is going to go to court they will handle it.

We have a transactional IP team here as well. If the client needs a contract, there are people here who deal with that. We have about 16 people in total, all based in London.

What is your role at ITMA?

I became president on 19th April for a two-year term. I've had a six-year lead-in – two years as treasurer, two as second vice president and two as first vice-president. That lead-in means you are fairly well informed about the membership, the Institute and its structures by the time you become president.

It's a fantastic year to be elected as the week before we received notification that the Royal Charter would be granted. It's very exciting: it's a recognition of the value and importance of the Institute and its members and also it will be very useful as a consumer protection tool to say to people: if you want reputation, look for the charter mark – we're going to use it almost as a kite mark and a badge of quality.

We will rebrand: ITMA will become CITMA. We have appointed a brand agency and will have a PR campaign around it, as it's great for our members to be able to say they are chartered trade mark attorneys.



The James Nurton Interview



ITMA has about 650 ordinary members who will be able to say they are chartered trade mark attorneys. When you include associate members such as students and solicitors the total is about 1900.

How long did it take to get the charter?

It took a massive amount of work. We must pay credit to ITMA Chief Executive Keven Bader who kept on top of it and liaised with the Privy Council. He was the right person at the right time. It was one of my projects as vice president but it was thanks to Keven that it happened. It took less than two years, which is faster than we anticipated.

We commissioned a scribe last week to start writing the front page of the charter on vellum and he is hoping to complete it by September. Then it will have to go to the Queen for final signature.

Hopefully by October or November we will then have a campaign to say what it all means. That's the big thing for my first year and nothing can detract from that!

What are your other priorities?

Another priority is to progress the IP pro bono scheme that we are working on with CIPA, the Law Society, the IP Bar and other organisations such as the IP Federation. We hope that will launch in October as well and we're pleased to have the support of His Honour Judge Hacon of the IP Enterprise Court.

The programme will be targeted at contentious issues. People feel there is enough pro bono advice on the initial stages on selecting and registering trade marks in the UK but people need assistance on litigation. Judge Hacon sees a gap and a need to address the imbalance in the justice system. All of the interested parties feel very passionately about it. ITMA and CIPA members have been canvassed and we know there are already volunteers ready and willing to help.

The most recent impetus came from Judge Hacon and IPEC is our primary target, but we'll also offer services for contentious

cases at the IPO, before the Appointed Person and potentially in the High Court. I'm on the INTA Pro Bono Committee and there is a similar initiative being planned by them, so I'm acting as liaison on that.

One other priority is membership engagement. We want to get our younger members more involved in the Institute. We'll have a student forum and also looking at what we can offer people internationally, many of whom attend our events. They are called overseas members. One of my thoughts is that we should not be so island-centric and should call them international members!

We have strong ties with other associations in Europe such as BMM in Belgium, APRAM, UNION and GRUR in Germany. We all get together at least once a year to discuss issues of common interest, often but not exclusively the EUIPO.

ITMA is a permanent member of the EUIPO Users Association group, and we are a rotating member of the Management Board and Budget Committee. We also meet with MARQUES, ECTA and INTA and all of that liaison is really important to make sure the interests of IP practitioners are heard.

How well do you think the EU IP systems work?

The EU trade mark and design system is incredibly efficient: the EUTM covers 28 member states and EUIPO has done a great job in bringing it together. They've also done a great job in sharing their knowledge in technical and IT issues with other offices. That works really well.

We're never going to agree on everything. There are some convergence projects that EUIPO has proposed that we'll contribute to the debate on. The ones we see as most potentially problematic are not coming up this year, so we won't be participating as ITMA on those. We will do so on others coming up in the future and will be putting our views forcibly forward. But we will coordinate responses as much as possible with other associations, as that has more impact.



The James Nurton Interview



Are there any changes you would like to see?

I would love to see a separate IP court at the EU level – partly to ensure cases go through more quickly and also as it might enable specialist judges. I don't think we are going to get it but it's on my wish list.

I would also like to see more consistency between the Boards of Appeal, but I think EUIPO President António Campinos is working on that. You want to be able to expect that there isn't a great deal of divergence between them, even though they are independent. That would be good for everyone.

What will happen to trade marks and designs following the recent Brexit vote in the UK?

Nothing is going to happen for a while: that's the message we have put out. Don't panic!

We had a meeting with the IPO and we have written to both the head of the IPO and the IP minister saying we would like to discuss proposals for the future.

As trade mark attorneys we are aware that leaving the EU would mean potentially we are no longer part of the EU trade mark system. That's why even before the referendum ITMA was saying as far as our members and our clients were concerned it would be better to stay in the EU. Now we are all aware it could take up to two years: that gives us an opportunity think carefully about what might be done.

We will be raising technical questions with the IPO. I think a conversion process is likely. There are precedents with Papua New Guinea becoming independent from Australia and more recently Montenegro, when rights in Yugoslavia had to be re-registered when it became independent. There will be detail to be determined such as will there be re-examination of applications (like with conversions of EUTMs now), fees and priority dates. With designs it may not be possible to have a conversion process as if they are re-examined they will fail on the basis of novelty.

There are other possibilities: for example, in Jersey, EUTMs apply directly. That is an extreme possibility – that the UK government could say that all EU trade marks and designs continue to have direct effect. Then the jurisprudence becomes difficult because we wouldn't go to the CJEU from the UK, so it is not a perfect solution. But it does show there are various options.

At the Institute one of our key issues will be to ensure that practitioners can represent clients at the EUIPO. We have discussed whether we could lobby for UK practitioners' rights separate from the UK becoming part of the EEA, which could take a long time to negotiate. There is no reason not to lobby for that separately, but with the EEA as a back-up plan.

Do you think trade mark attorneys benefit from being involved in the EU system?

As an Institute we did go public and say it would be better for us to stay in, and we did not receive a single complaint about that from any member. We also had an open meeting about it. I think the trade mark profession is fairly well united on this.

Are you seeing increasing interest in filing UK trade mark and design applications?

Absolutely. I've already had enquiries from places as diverse as Australia, Italy and the US on that question. The disadvantage is that if there is a conversion process, you would retain a priority date. But there's no reason why individuals should not advise clients to do that. As an Institute we will prepare a list of questions and answers addressing what our members should be thinking about, but not telling them how to advise their clients.

We have a Brexit Task Force which has its first meeting this month. One key issue is coexistence agreements that refer to EU countries – should they be looked at again? Different considerations may apply to renewals: if you claimed seniority from a UK mark, should you abandon it? It's up to practitioners to look at each issue and advise their clients individually.



The James Nurton Interview



One of the more humorous suggestions is that we all qualify as Irish practitioners! We are certainly getting a good message about greater liaison with other countries. People from all over the world have written to us to say they are shocked and surprised and offering to help in any way they can.

It's certainly true that the combination of Royal Charter and Brexit has got my presidency off to a flying start.

What do you like about working in trade marks?

So much of my work is in so many different countries: so there are so many people you meet and interact with which is fabulous. It means I am still in contact with many people in Australia as well!

Also, trade marks and designs are real: you see them when you are walking down the street. Often you get to deal with marketing issues as well and it takes in different legal elements. It's more holistic than other fields of law, and IP has now got a lot more law than other areas. We have many courts giving judgments at different levels.

What's the most interesting case you've worked on?

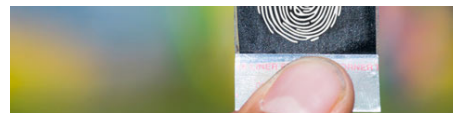
One of my clients is Wagamama and I've seen it through various rebrands and tweaks.

The weirdest case was when a Wagamama restaurant opened in Colombia and it wasn't us. Everything about it was perfect – it was a complete copy down to the place mats. It took my breath away. We had to close it down, which wasn't difficult as it turned out. I now have a very good Colombian lawyer.

We continue to enforce the Wagamama brand everywhere successfully. I've worked for that brand for longer than any of the senior management team at Wagamama, which is a lovely position to be in. It is one of my favourite clients.



European Union Trade Mark



WP2/2016 Review and changes of practice

Introduction

In 2016, the work of the Knowledge Circles, the teams of experts entrusted with keeping the Office practice up to date, continued with the review of the existing guidelines.

The cycle to review these guidelines is usually divided in two work packages. This year a third cycle was added due to the introduction of the changes further to the 'Amending Regulation'¹ on trade marks.

The revision of the first work package was completed at the end of 2015 and the text entered into force on 1 February 2016.

In the meantime also the changes in the guidelines further to the 'Amending Regulation' have been included in the Guidelines. They have entered into force on the 23rd of March 2016.

Now, also the review process of work package 2 has been completed. All Parts, Sections and Chapters of the Guidelines contained in this work package have been reviewed by the Knowledge Circles and have been approved by the internal and external stakeholders.

They are adopted by the Executive Director by means of Decision EX-16-5 and will enter into force on 1 August 2016.

Parts of the Guidelines contained in WP2/2016

Part A: General Rules

- Section 1, Means of communication, time limits
- Section 2, General principles to be respected in proceedings
- Section 4, Language of proceedings
- Section 6, Revocation of decisions, cancellation of entries in the Register and correction of errors

- Section 7, Revision
- Section 8, Restitutio in Integrum
- Section 9, Enlargement

Part B: Examination

- Section 1, Proceedings
- Section 3, Classification
- Section 4, Absolute grounds for refusal Article 7(1)(f) to 7(1)(m) EUTMR, Collective marks

Part C: Opposition

- Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)
- Section 4, Rights under Articles 8(4) and 8(4a) EUTMR
- Section 5, Trade marks with reputation Article 8 (5) EUTMR

Part D: Cancellation

- Section 2, Substantive provisions

Part E: Register Operations

- Section 1, Changes in a registration
- Section 3, EUTMs as objects of property
- Chapter 1, Transfer
- Chapter 2, Licences
- Chapter 3, Rights in rem
- Chapter 4, Levy of execution
- Chapter 5, Insolvency proceedings or similar proceedings

Part M: International marks

Registered Community Designs

- Examination of Applications for Registered Community Designs
- Renewal of Registered Community Designs

1. Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015



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General changes

All changes made appear in legal black line (with track-changes) so our users can easily see what has been updated. In the near future, the Office will highlight only the substantial changes; however, it has not been possible to implement it in this cycle of the revision of the guidelines.

In general the changes concern modifications to the format and structure, updated case-law and cross-references, corrections of errors and clarifications in wording. There are also a few changes of practice which are described below.

Changes in practice

Part A: General Rules

Most of the changes in the Guidelines in the area of proceedings have been introduced taking into account the feedback received from external users during the previous revision cycle. Although some sections of the Guidelines have been substantially altered these changes merely clarify the existing practice.

Part A: General Rules. Section 1, Means of communication, time limits

Point 2, Procedure for filing and for communication with the Office

In order to avoid potential confusion regarding the hours when documents may be handed personally at the Office's reception desk a reference to the Office's website has been added.

Point 3, Notification and communication of documents

Sections on notification and communication of documents have been revised and amended to reflect the user's current

preferences. As a consequence, the cascade of the means of notification by the Office and communication to the Office now starts with those corresponding to electronic means as these are the most commonly used. Some means of notification by the Office, such as notification by deposit in a post box and notification by hand delivery have been deleted.

In relation to the time of receipt of communication by fax, the Guidelines now clarify that the time of receipt is the local time in Alicante (Spain) at which the Office receives the complete fax transmission. This will allow avoiding possible interpretation in those cases when the transmission was not completed before the time limit expired. Finally, due to comments from User Associations, it has been specified that all notifications will be sent solely to the appointed representative.

Point 4, Time limits

A reference to time limits expressed in weeks or years has been added to the paragraph on expiry of time limits. In addition, the paragraph dealing with extension of time limits has been amended to reflect the latest case law which rendered that extensions of time limits will not be granted automatically; however as a general rule first extensions of time will continue to be granted where the reasoning is considered appropriate.

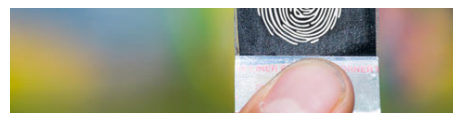
Part A: General rules. Section 2, Principle to be respected in proceedings

Point 1, Adequate Reasoning; Point 2, The Right To Be Heard; Point 3, Other General Principles of EU Law

Due to the comments from User Associations, the text dealing with general principles of adequate reasoning and the right to be heard have been reviewed in depth and redrafted to improve their structure and content. Various aspects related to the correct application of these principles have been clarified taking into account the latest case law.



European Union Trade Mark



As regards the paragraph dealing with other general principles of EU Law, references to the latest case law have been added.

Point 6.2, Apportionment of costs

The structure of the paragraph on apportionment of costs has been modified in order to clarify what are the costs incurred by the parties in the proceedings as well as some aspects of their apportionment. Moreover, it has been specified that the part of the decision dealing with fixation of costs can be enforced in simplified proceedings in all Members States of the EU and a cross reference to the Guidelines, Part C, Section 1, Procedural matters has been introduced.

Part A: General rules. Section 4, Language of proceedings

This section has been substantially modified in order to improve its structure and the clarity of the content. In addition, after the modification of the text of paragraph 2, it has been made clear that the first language which may be used by the applicant during the proceedings can be any language of the EU.

The paragraph on ancillary procedures has been re-structured to clarify the language regime and distinguish between the language rules applicable for a request filed before registration (excluding oppositions) (new paragraph 4.1) and a request filed after registration (excluding cancellation) (new paragraph 4.2). Opposition and Cancellation have separate language regimes as explained under paragraph 3.

Part A: General Rules. Section 6, Revocation of decisions, cancellation of entries in the Register and correction of errors

Only minor linguistic changes have been made within this section.

Part A: General rules. Section 7, Revision

Due to various comments received, the part dealing with the verification whether the appeal is well founded has been restructured and substantially modified.

All the subparagraphs of this part have been deleted. The text has been rewarded in order to clarify cases when the appeal is considered to be well-founded and, consequently, when the revision may be granted.

The Guidelines now specify that an appeal is well-founded if the first instance decision is replaced by a decision with the opposite result or at least otherwise gives full relief to the claim of the appellant. Revision will only be granted when there has been a procedural violation or an error made by the Office. To explain better when revision will and will not be granted, new examples have been added.

Part A: General Rules. Section 8, Restitutio in integrum

Point 3.4, Time limits excluded from restitutio in integrum

The paragraph dealing with time limits, which are excluded from restitutio in integrum, has been reviewed and two modifications have been made. The first one is the deletion of the reference to priority for trade marks being an excluded time limit. Consequently, only the six months priority period regarding designs remains excluded from restitutio in integrum under Article 41(1) CDR. The second modification relates to time limits mentioned in Article 82 EUTMR, namely the time limit for requesting continuation of proceedings and the time for paying the corresponding fee. These have been added to the list of time limits excluded from restitutio in integrum.



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Point 3.9, Particulars and Evidence

The text clarifying that statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence has been added to the paragraph on particulars and evidence.

Point 4, Third-Party Proceedings

Following the request from User Associations, it has been specified that in third parties proceedings, its nature as inter partes proceedings means that the Office will hear both parties before taking a decision.

Part B. Examination

Part B: Examination. Section 1, Proceedings

Only minor clarifications have been introduced within this section. The paragraph on 'other elements of an application' has been deleted as confusing.

Part B: Examination. Section 3, Classification

The main changes and clarifications introduced during the normal revision cycle for this section of the guidelines are explained. The various improvements in wording and in the examples given are excluded from this explanation.

An introductory sentence has been provided under heading **2. The Nice Classification** to explain that there are not just editions of the Nice Classification, but also versions. A reference to the Communication of the President has been inserted under heading **3. Administrative Tools for Classification Purposes**. The "natural and usual meaning" has been defined under heading **4.1.1. General principles**. In relation to the **Use of expressions (e.g. 'namely', 'in particular') to determine the scope of the list of goods/services**, examples have been

updated and a paragraph has been added to explain that the HDB does not support the use of such expressions and that when used in a specification, the file will require verification.

On the issue of **punctuation** the section has been updated to further expand on the different types of acceptable punctuation.

As regards the **Procedure of Examination**, the section on **Objections** has been further expanded to explain how to overcome objections. Furthermore, additional information has been provided under **Amendments** to exclude limitations that are ambiguous in different regulatory regimes, and to explain other non-acceptable limitations and partial limitations in view of the Pramino/Premeno judgments.

The **Annex** has been updated to include: Assembly services, Blogging services, Consulting and advisory services, Commercial intermediation services, Customer services, Expert opinion services, Gadgets, Hotline services, Personal assistant services, Providing an online platform, Providing information, Statistics, Wellness services. Other entries in the annex have been updated with better examples or to clarify the text. In particular, **Computer games and computer games apparatus** has been updated. This will result in a change of practice in that the class will now limit the scope of protection. Until now computer games and video games were only acceptable in class 9. The new wording explains that these terms will be acceptable in class 28 but in that class they will be understood to be the computer/video game apparatus. The reason for this change is that previous practice was not supported by a valid definition and in the understanding of the native English speakers, video/computer games is not limited only to the software but also to the device. **Electricity and energy** has been updated with more examples and includes a specific paragraph on the fact that energy cannot be retailed and **Franchising** has been updated with more examples and includes a specific definition from the general remarks of the Nice Classification.



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Part B: Examination. Section 4, Absolute grounds for refusal

- Part B: Examination, Section – Absolute Grounds for refusal –Article 7(1)(f)

An important clarification has been added to the introduction part, in the sense that the application of Article 7 (1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10 European Convention on Human Rights) since the refusal to register only means that the sign will not be granted protection under trade mark law, but will not stop the sign from being used – even in business (judgment of 09/03/2012, T-417/10, 'HIJOPUTA', para. 26).

Examples of trade marks which would be caught by the Article 7(1)(f) EUTMR prohibition have been added to the Guidelines. In particular, trade marks which are in contradiction with the Charter of Fundamental Rights of the European Union or trade Marks which use symbols of totalitarianism.

- Part B: Examination – Absolute Grounds for refusal – Article 7(1)(g)

Very minor changes have been introduced in this section. Two examples are now included aiming at clarifying when the consumer may be deceived.

- Part B: Examination – Absolute Grounds for refusal – Article 7(1)(h)-(m)

The part of the Guidelines on the protection of flags and other symbols has not been reviewed in the context of WP2-2016 as they are being reviewed under WP1-2017.

The parts of the Guidelines dealing with the absolute grounds for refusal under Article 7(1)(j) to (m) were created upon the WP Legal Reform. Those modifications entered into force on

23 March 2016, hence they have not been amended during WP2-2016.

- Part B. Collective marks

The Guidelines now clarify that the exception under Article 66(2) EUTMR applies not only to signs which exclusively consist of a geographical term but also to trade marks which consist of a geographical term and other non-distinctive/generic elements (e.g. bio, eco).

Part C: Opposition

Part C: Opposition. Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)

New case-law has been incorporated in chapter 4.1 “Agent or representative relationship” namely with the insertion of the decision of 21/11/2014, R 1958/2013-1 СЛОБОДА (FIG. MARK). The case clarifies that even if a relationship of agency or distribution was not explicitly defined as such, the fact that the parties appeared to be business partners suffices for Art. 8(3) EUTMR to be applied.

It was also clarified that the burden of proof regarding the existence of a cooperation relationship lies with the opponent (judgment T-262/09, “First Defense Aerosol Pepper Projector”).

In chapter 4.5 “Applicability beyond identical signs – goods and services” it has been clarified following the decision of 9/1/2014 R 344/2013 -1 – COGI / COGI, COGI The World Congress on CONTROVERSIES IN OBSTETRICS, GYNECOLOGY & INFERTILITY (FIG. MARK), that the identity or presence only of slight changes is not a requirement of Article 8(3) EUTMR.

The decision R-407/2013-4 “WOUXUN / WOUXUN has been inserted to clarify that Article 8(3) EUTMR does not apply with regard to dissimilar goods.



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Minor corrections of errors and clarifications in wording have been made in the whole section.

Part C: Opposition. Section 4, Rights under Articles 8(4) and 8(4a) EUTMR

In relation to point 3 "Conditions of Article 8(4) CTMR", a clarification of the structure of said conditions has been made.

In point 3.2.2 "Non-registered trade marks" it was clarified that, since non-registered trade marks are not protected at European Union level, a "European Union non-registered trade mark" is not an eligible basis for opposition.

As far as point 3.2.4.4 "the Scope of protection of PGIs" is concerned, the case-law cited has been updated with the introduction of the Judgment of 18 September 2015, T-387/13 "COLOMBIANO HOUSE".

The most important aspect in the updating process of this section is the clarification of Office's practise regarding the signs which are protected by national legislation against the subsequent registration and not **against their use** as required by the wording of article 8(4) EUTMR. After extended searches on the case-law of the EU Courts, and of the practice of the Boards and of the OD, it was created at that respect the new chapter "3.5 right to prohibit the use of a subsequent trade mark under the applicable law". By taking also into account the interpretation of article 8(4) CTMR orientated on its purpose, in addition to the trends identified by the case-law, the Office adopted a position that, although the wording of article 8(4) EUTMR refers to prohibition against the use, the Office will consider that the right to prohibit the registration of a later sign implies a fortiori the prohibition to use of that sign in the market. The registration may be seen as the first form or at least an indication of a will to use a mark (the purpose of a distinctive sign is to identify goods or services and not to remain in the Register).

Part C: Opposition. Section 5, Trade marks with reputation Article 8 (5) EUTMR

In relation to chapter 3.1.3 "Assessment of reputation – relevant factors" it was clarified, following users' comments that the factors are examples and do not need to be fulfilled cumulatively.

An amendment has been made with regard to the chapter 3.1.4.4 "Means of evidence": it was deleted any reference to the numbers of participants in the opinion pools, since it may be considered misleading, because a comparable number was considered insufficient in different circumstances, eg. R 1696/2010-1. A case by case approach is deemed to be more appropriate.

The Judgment C-581/13 "GOLDEN BALLS/ BALLON D'OR" has been added in chapter 3.2.1 "Notion of 'similarity' pursuant to Article 8(5) EUTMR compared with Article 8(1)(b) EUTMR".

In chapter 3.4.3.2 "Detriment to distinctiveness" the part related to C-383/12P "Wolf head image" has been redrafted in order to better present the message of the judgment.

The part regarding the first use has been redrafted for clarification.

In the table "cases on dilution by blurring" the example T-131/09 has been deleted, as this judgment was before the "Wolf head Image" – case-law and seems in contradiction with it. That example has been replaced by the Board's decision R-69/2013-4 "Camel".

Finally, in chapter 3.4.3.3 "Detriment to repute" some repetitive examples have been deleted upon users' comment.



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Part D: Cancellation. Section 2, substantive provisions

The Guidelines have been updated with reference to the latest case-law on bad faith, that is, T-257/11 Colourblind, T-556/12 Kaiserhoff and on invalidity T-506/13, 'URB'.

A precision on the point in time to be considered has been included. Facts subsequent to the date of application can, despite the general rule, also be taken into account where and to the extent that they allow conclusions to be drawn regarding the situation at the date of application of the EUTM. This might be the case, for example, for dictionary extracts that post-date the post-application- date entries in dictionaries.

The Introduction chapter (4-Relative Grounds for Invalidity, 4.1-Introduction) has been clarified. Namely, the wording has been aligned with the provision of Article 8(4) CTMR by clarifying that "a non-registered trade mark or other sign used in the course of trade can invalidate an EUTM registration if national legislation allows the proprietor of the earlier non-registered trade mark or another sign to prohibit the use of the subsequent EUTM (Article 53(1)(c) EUTMR in conjunction with Article 8(4) EUTMR)".

In the part of the grounds under Article 53(1) EUTMR (4.2 Grounds under Article 53(1) EUTMR) only minor corrections of the references have been made in relation to the point 4.2.1. "Standards to be applied".

Some clarifications have been made in relation to chapter 4.2.2.3 "temporal scope of application of Article 53(1)(d) EUTMR in conjunction with Article 8(4a) EUTMR and relationship to Article 53(1)(c) EUTMR in conjunction with Article 8(4) EUTMR": Regulation (EU) 2015/2424 amending Regulation No 207/2009 introduced Article 53(1)(d) EUTMR in conjunction with Article 8(4a) EUTMR as a specific ground of invalidity for designations of origin and geographical indications (GIs) protected under EU or national law. The introduction of this specific ground means

that as of the entry into force of Article 53(1)(d) EUTMR, GIs can only be invoked under the new ground and not under Article 53(1)(c) EUTMR as it was before. It was clarified however that, if an invalidity request based on a GI is filed after entry into force of the Amending Regulation, incorrectly indicating Article 53(1)(c) EUTMR as a ground for invalidity, the Office will examine the request to the extent that it is clearly based on a GI, as if the ground invoked were Article 53(1)(d) EUTMR. Article 53(1)(c) EUTMR in conjunction with Article 8(4) EUTMR continues to apply in invalidity proceedings based on GIs pending at the time of entry into force of the Amending Regulation.

The chapter about "A right to a name/right of personal portrayal" has been improved by the correction of few clerical mistakes (judgment of 05/07/2011, C-263/09P, 'Elio Fiorucci' and by the addition of case-law from the Boards of Appeal with regard to the right to a personal portrayal under German law (decisions of 17/07/2013, R 0944/2012-2 'BILLIE JEAN DANCE WALKING' (FIG. MARK) and R 0878/2012-2 'BILLIE JEAN THIS IS IT (FIG.MARK).

In chapter 4.3.2 "Copyright", following the users' comment, the verb "copying", was changed to "an unauthorised reproduction or adaptation" and it was clarified that similarity is not the relevant test to be applied. A cancellation decision has been added in relation to copyright protection in the United Kingdom (decision of 05/03/2012, 5377C 'MARYLAND CHICKEN' (FIG. MARK).

In chapter 4.3.3 related to Other industrial property rights and prior works such as a Registered Community design (RCD), it has been clarified with respect to the latter that the standards of the applicable design law of the European Union will be applied.

With regard to the chapter 4.5 "defence against an invalidity application based on relative grounds" the latest case-law (e.g. judgments T-544/12, T-546/12, and T-398/13) and the



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comments received from users, have revealed the need to clarify the Office practice regarding chapters 4.5.1 "Consent to registration" (Art. 53(3) CTMR), 4.5.1.1 "Earlier applications for declaration of invalidity or counterclaims" (Art. 53(4) CTMR) and 4.5.3 "acquiescence" (Art. 54 CTMR), as well as the practice regarding the interpretation of the notion "the same parties" in chapter 5 "Res Judicata". New examples coming from the Court, Boards of Appeal and Cancellation Division have been introduced.

Part E: Register Operations

Part E: Register Operations. Section 1, Changes in a registration

In general, several repetitive and redundant references as to the procedural flow (deficiencies etc.) have been eliminated.

The principle of veracity and correctness of the Register has been reinforced by establishing that any change in name and/or address of an owner will be done in any object of property (EUTMs, RCDs) and any proceedings.

In the context of seniorities, the reference to the HDB has been eliminated.

Part E: Register Operations. Section 3, EUTMs as objects of property. Chapter 1, Transfer, Licences, Rights in rem, Levy of execution and Insolvency proceedings or similar proceedings

Only few changes have been introduced in these parts. It has been clearly stated that as an object of property what is applicable for registered EUTMs is also valid for applications. The indication that the records referring to applications will be inserted in the "file" has been eliminated. The only mayor difference between registered EUTMs and applications is that the changes concerning applications will not be published as such.

The advantages of filing the requests online have been mentioned.

Part M: International marks

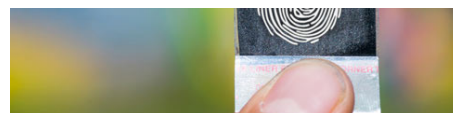
Also in the part of International Marks only very few changes have been introduced.

It has been added that in the context of International Applications where no translation of the goods and services has been submitted by the applicant, the Office will be authorised to provide such translation in the international application. Where no translation has been established in the course of the registration procedure for the EUTM application on which the international application is based, the Office must, without delay, arrange for the translation.

In case of EU designations and in order to avoid objections as to vague terms in the list of goods and services it has been added that the HDB database (terms accepted by most of the EU Offices) can be searched. The Users may then see if these terms are also accepted by WIPO in its own database of goods and services.



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Best filing practice for lists of goods and services

With the latest update of the Classification Guidelines of the Office coming into force in August, the Knowledge Circle Goods and Services Issues takes this opportunity to remind users about some

issues that affect the classification examination procedure and to present some quick and simple tips to bear in mind when filing an EUTM application.

The following table contains some of the goods and services topics that frequently cause a classification deficiency, slowing down the publication of the trade mark. It also gives recommendations on how to avoid such deficiencies:

	NOT RECOMMENDED	RECOMMENDED	Reason
Terminology in general	<ul style="list-style-type: none"> lists with your own wording online translations of lists old lists 	<ul style="list-style-type: none"> Build your list with the terminology of our Harmonised Database (HDB). The HDB is accessible when e-filing, via TMclass or when using the Goods and services builder 	Our extensive multilingual HDB allows for fully automated examination and translation of your list of goods and services.
Use plural forms except with uncountable nouns (e.g. milk)	<ul style="list-style-type: none"> toy violin book cake 	<ul style="list-style-type: none"> toys violins books cakes 	The automatic computerised examination works on plural forms.
Use a qualifier to differentiate goods from services	<ul style="list-style-type: none"> goods: painting services: dentist 	<ul style="list-style-type: none"> picture paintings (= goods), painting services dental instruments, dentistry services 	Qualifiers help to clarify the scope of protection.



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<p>Double-check the grammar including the correct use of accents</p>	<ul style="list-style-type: none"> telecom<u>un</u>nunication services cr<u>u</u>asans 	<ul style="list-style-type: none"> telecom<u>m</u>unication services cro<u>is</u>sants 	<p>Incorrect words will not be recognised by the system and might lead to wrong translations.</p>
<p>Use commas to indicate connection</p>	<ul style="list-style-type: none"> software for laboratory apparatus; robots; machines retail services related to clothing; footwear; headgear 	<ul style="list-style-type: none"> software for laboratory apparatus, robots, machines retail services related to clothing, footwear, headgear 	<p>Commas separate related products or services, sharing a common qualifier. In service classes, the goods listed in relation to the services for which protection is sought should always be separated by commas.</p>
<p>Use semicolons to indicate separate entries</p>	<ul style="list-style-type: none"> gardening gloves, lawn sprinklers, flowerpots, all made of porcelain 	<ul style="list-style-type: none"> gardening gloves; lawn sprinklers; flowerpots, all made of porcelain 	<p>Semicolons delimit one particular type of goods or services.</p>
<p>Vague terms</p>	<ul style="list-style-type: none"> Unacceptable general indications of the Nice class headings 	<ul style="list-style-type: none"> HDB equivalents of Nice Class Headings Clear and precise terms 	<p>Article 28(2) EUTMR requires goods and services to be clear and precise in order to clarify the scope of protection</p>



European Union Trade Mark



Expressions such as “namely” or “in particular” may be used to determine the scope of the list of goods/services. Other punctuation and symbols are acceptable, such as oblique strokes (“/”), colons (“:”) and parentheses, however, the [HDB](#) does not currently support use of such terms or punctuation. Therefore, if these are used in the description of goods and services, the classification will not be automatically accepted and will require verification, which will prevent your application from benefitting from the Fast Track handling, thus slowing down the examination procedure. The manual introduction of a list of goods and services into the online form is restricted to 512 characters per individual concept. Introducing more than this amount without using a semicolon break is technically not possible.

For choosing a correct and pre-approve list of terms for your trademark application in any EU language, search in our [HDB](#) when e-filing or in [TMclass](#) or just build your list using the [Goods and Services builder](#).

For further practical advice on classification issues please see our [Classification Guidelines](#) and watch our page for related updates.



Registered Community Design



Examination of Applications for Registered Community Designs

Following a **fast-track revision**, the Guidelines were updated with effect as of 15 April 2016 integrating the Common Communication for the **CP6 Convergence Project on Graphic representation of designs** (available under: <https://www.tmdn.org/network/converging-practices>).

In the following, only the main changes and clarifications introduced during the normal revision cycle taking effect as of 1 August 2016 will be explained, leaving aside several improvements in wording as well as in the examples provided.

With respect to the product indication(s) to be submitted together with the application for a RCD, reference throughout the Guidelines is made to the **product indication database** which will be replacing the Eurolocarno database in the near future. Like the Eurolocarno database, the harmonised product indication database is based on the Locarno Classification for classifying products. The use of this new database will not entail any change of practice for the application procedure but will improve the ability to easily search and find the desired product indication(s) (<https://www.tmdn.org/network/harmonisation-of-product-indications>).

Another update triggered by advancements in the Office's efforts to facilitate the application procedure relates to the **requirements for "Fast Track"** filings which are mirrored in their newest version of the Guidelines (making reference to any further changes to be published on the Office's website).

Following the introduction of the **3D images uploader** available on the Office's website for RCD e-filings, it is set out in the Guidelines that, based on the current legislative framework, 3D computer-animated designs generating motion simulation can only be considered as an additional means of viewing the design but do not replace conventional static views.

As to the representation requirement of a **non-neutral background**, the Guidelines have been updated to reflect the current practice that deficient views in that regard can be withdrawn whilst maintaining the filing date of the remaining views.

The section on **living organisms**, given as example for the required compliance with the definition of a design, has been aligned with the corresponding section of the RCD invalidity guidelines, clarifying that no objection is raised for products which do not actually show a living organism but rather mimic the shape thereof.

The section on the **format and structure of the publication** has been deleted since this information is readily available on the Office's website and does not provide any added value for the Guidelines.

As to the **recordal of licences**, the general statement that partial licences (licences granted in respect of specific products) cannot be granted has been reworded in order to clarify that this applies to recordals thereof only. This serves to avoid any misperception that under the law of contract partial licences cannot be granted.

The Office's practice concerning **product indications** strikes to find a balance between the applicant's free choice of a product indication, the legal requirement that it must correspond to the particular design despite not affecting the scope of protection of the design, and the statutory mandate to keep the registration and other procedural burdens on applicants to a minimum (see recital 18 of the CDR). To this end, ex officio changes in product indications are accepted in the vast majority of cases, often welcomed by applicants, but at time also criticised. The Guidelines have been modified in this respect with the aim to fine-tune the proceeding, as follows:



Registered Community Design



For **ex officio change of product indications not listed in the Locarno Classification or the (future) database of product indications** (see above), a new example has been chosen, in view of the fact that the Office seeks to choose synonymous terms, when available. Hence, if a product indication such as “running trainers” is not contained in said database(s), instead of the term “footwear” (as formerly indicated), the examiner will choose the term “running shoes” listed therein for an ex officio change. This avoids translating the term “running trainers” into all official languages of the EU, thereby speeding up the proceedings and reducing costs in the interest of all users.

At times, applicants **file the representation of a whole product but only specify a part thereof** as a product indication, thus giving rise to an objectionable mismatch between the representation and the product indication. The Guidelines have implemented a change of practice in that scenario, allowing the examiner to suggest the correct product indication. In case the applicant does not reply within the time limit set, the examiner will ex officio replace the applicant’s product indication with the provided suggestion, and thus proceed with the registration.

In relation to **“ornamentation”** as a product indication, if the filed design also shows the product to which it is applied without its contours being disclaimed, according to the former practice, the examiner would ex officio add the indication of the product. As this may not be in the interest of the applicant, the new practice foresees that the examiner will raise an objection suggesting to either disclaim its contours (i.e. representing the ornamentation only and disclaiming the remaining parts) or to add the product indication for the product shown (as formerly added ex officio). If the applicant does not reply within the time limit set, the examination will proceed with the added product indication.

The Guidelines extend this practice concerning ornamentation for the product indications of **graphic symbols, logos and**

surface patterns given that there is no relevant difference between them for the purpose of this practice.

As to **long lists of product indications**, containing more than five product indications, the Guidelines also enable the examiner to suggest a selection of those indications, on the basis of which the examination will proceed in case the applicant does not respond within the time limit set (or expressly agrees to such selection).

On a final note, users are also advised that in alignment with the guidelines relating to EUTMs, the courtesy notes identifying the holder of designs shown have been omitted. These designs are reproduced as instructional examples only.

No changes

The following parts have not been changed at all during the last revision cycle:

- Renewal of Registered Community Designs

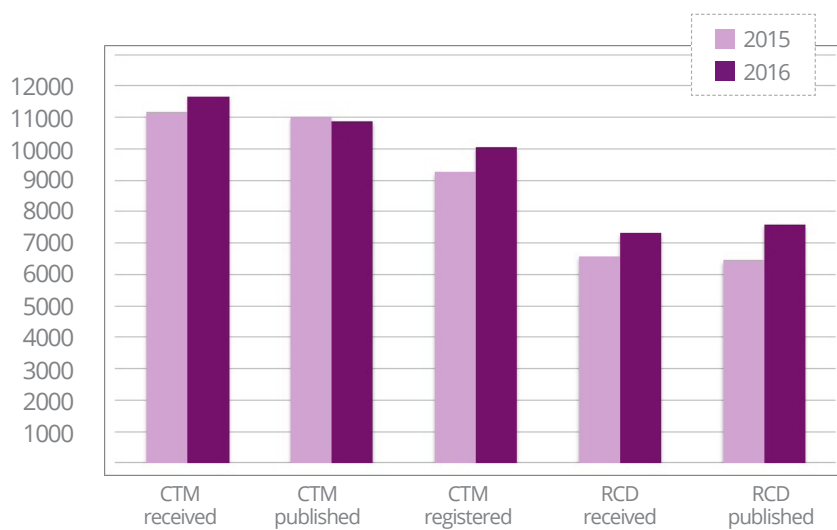


Statistical Highlights



Monthly statistical highlights June*	2015	2016
Community Trade Mark applications received	11 161	11 658
Community Trade Mark applications published	11 003	10 869
Community Trade Marks registered (certificates issued)	9 260	10 030
Registered Community Designs received	6 584	7 310
Registered Community Designs published	6 444	7 572

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





ETMDN Updates



Albania and Georgia join TMview and DesignView

The [Albanian General Directorate of Patents and Trademarks \(GDPT\)](#) [National Intellectual Property Center of Georgia \(NIPCG\)](#) have made their trade mark and design data available to the [TMview](#) and [DesignView](#) search tools.

With GDPT and NIPCG on-board, TMview now contains data from 55 participating offices and DesignView from 49 offices.

TMview now contains data from 56 participating offices and access to about 40 million trade marks in total. DesignView contains data from from 50 offices and more than 9.6 million designs.

Since the introduction of TMview on 13 April 2010, the tool has served more than 21.9 million searches from 151 different countries, with Spain, Germany and Italy among the most frequent users.

DesignView it went live on 19 November 2012 and has since then served more than 1.8 million searches from 143 different countries, with users from Germany, Spain and the UK among the most frequent users.



More News



DesignEuropa Awards – jury announced

The jury for the inaugural edition of the [DesignEuropa Awards](#) has been announced by the EUIPO.

The jury of 16 experts in the field of design, business, intellectual property and policy will decide the winners in three categories: Industry, Small and Emerging Companies and Lifetime Achievement.

The jury panel, chaired by Mr. Robin Edman, President of the Bureau of European Design Associations, is composed of internationally recognised leaders in their fields and bring a wealth of expertise gained over the course of their professional careers.

The [members of the jury](#) are:

- **Robin Edman**, the Chairperson of the jury and the President of the Bureau of European Design Associations (BEDA);
- **Benoît Battistelli**, the President of the European Patent Office;
- **Miklós Bendzsel**, the former President of the Hungarian Intellectual Property Office. Member of the European Design Leadership Board;
- **Therese Comodini Cachia**, Member of the European Parliament for Malta; ;
- **Claudio De Albertis**, member of the Executive Board at the Camera di Commercio Milano and President of the Triennale di Milano;
- **Loredana Gulino**, Director General of the Italian Patent and Trade Mark Office
- **Joanna Leciejewska**, award-winning industrial designer and owner of Joa Projekt;
- **Chie Mihara**, owner and designer at Studio Mihara Timeless;
- **Mugendi M'Rithaa**, President of the International Council of Societies of Industrial Design (Icsid);
- **Christian Peugeot**, President of UNIFAB and Executive Vice President of External Relations at PSA Peugeot Citroën;
- **Bettina Schultz**, editor-in-chief of “novum World of Graphic Design” magazine;

- **David Stone**, partner, Simmons & Simmons and chair of the INTA Designs Committee;
- **Thierry Sueur**, Vice-President of European and International Affairs at Air Liquide. Member of Business Europe's Legal Affairs Committee;
- **Giovanna Talocci**, award-winning Italian architectural and product designer. Vice-President of the Italian Association for Industrial Design (ADI).
- **Gert Würtenberger**, President of the German Association for the Protection of Intellectual Property (GRUR);
- **Cecilia Wikström**, Member of the European Parliament for Sweden.

The Awards are organised by EUIPO, in partnership with the Italian Patent and Trade Mark Office (UIBM). Finalists will be announced on October 17, 2016, and the DesignEuropa Award ceremony will take place on November 30, 2016, in Milan.

EURid and the EUIPO sign letter of collaboration

António Campinos, the EUIPO's Executive Director, and Marc Van Wesemael, the General Manager of EURid, signed a letter of collaboration on 23 June, committing both institutions to join forces in raising awareness about trade marks and domain names.

EURid is a non-profit organisation appointed by the European Commission to manage the .eu domain name. It also plays an active role in protecting .eu domain holders' rights against fraud.

As a first step in this collaboration, EU trade mark applicants will find a link to EURid's registry of top-level domain names at the end of the application process and in TMview.



More News



Launch of Online Business Models Infringing Intellectual Property Rights study

EUIPO, through the European Observatory on Infringements of Intellectual Property Rights, has published a report on Online Business Models Infringing Intellectual Property Rights.

The aim of this independent research is to provide an overview of different infringing business models, assessing how they function, how they are financed, how they generate profits for their operators, what kinds of content they disseminate and how large their user bases are.

The study will provide enhanced understanding to policymakers, civil society and private businesses. At the same time, it will help to identify and better understand the range of responses necessary to tackle the challenge of large scale online IPR infringements.

Read the report [here](#)

European Case Law on Infringement of Intellectual Property Rights – new book

EUIPO has co-sponsored a new book, edited by Professor Michel Vivant of the Institut d'Études Politiques in Paris, focusing on European case law on infringements of intellectual property rights.

The book looks at the main topics in this area (inter alia, competence of the courts, seizure, evidence, customs regulation and damages), through the case law of different national jurisdictions and the European Court of Justice. It has been written by a team composed of prestigious academics and practitioners from ten different countries. The book is published by Bruylant and is available to [order online](#).



Case law



Luxembourg trade mark and design news

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

Case C-207/15P; Nissan Jidosha KK v EUIPO; Judgment of 22 June 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Renewal, Grace period

FACTS: The applicant requested, within the six months prior to the expiry of its mark ('initial period'), the partial renewal of that mark for the goods registered in two (out of three) classes. After the expiry of the 'initial period', but before the end of the six months period following the expiry of its mark ('grace period'), the applicant requested in addition the renewal of its mark with respect to the goods in the third class.

This request was rejected by the EUIPO's trade marks department, the Board of Appeal (BoA) rejected the appeal, and the General Court (T-572/12) dismissed the action for annulment. The General Court (GC) held that the wording of Article 47 (3) EUTMR as well as considerations of legal certainty would preclude a EUTM holder to proceed to partial renewals staggered over the 'initial' and the 'grace' period.

EUTM

SUBSTANCE: Following the proposal of the Advocate General, the European Court of Justice (CJ) found that Article 47 (3) EUTMR does not prohibit an EUTM to be renewed by means of partial renewal requests staggered over both time periods mentioned in that provision (the 'initial' and the 'grace' periods) time (para. 51).

The GC's interpretation to the contrary based on the term 'failing this' in Article 47 (3) EUTMR was rejected on the grounds that (i) the different language versions differ on this particular point (excluding thus any interpretation based on particular language version, paras. 43-46), that (ii) the only clear condition established by that provision belated renewal requests filed within the 'grace period' is the payment of the 'penalty fee' for late submission (para. 48), and that (iii) this reading would be supported by the general objective underlying Articles 46 and 47 EUTMR which is to assist trade mark owners as much as possible in the renewal of their marks and preservation of these economic values (paras. 52-55). As far as the GC's interpretation was based upon the need to secure legal certainty (partial renewals create effects erga omnes), the CJ found that this was (i) partly based on the erroneous interpretation of Article 47 (3) EUTMR and (ii) partly based on the erroneous assumption that the registration of a partial renewal of a mark would necessarily require the cancellation from the register of the 'non renewed' goods before the end of the grace period (para. 57).

Therefore the CJ annulled both (i) the GC's judgment and (ii) the decision of the BoA.

Case C-419/15; Thomas Philipps GmbH & Co. KG v Grüne Welle Vertriebs GmbH; Preliminary ruling of 22 June 2016; Language of the case: DE

KEYWORDS: Licence agreement, Infringement

FACTS: Grüne Welle Vertriebs GmbH, the applicant at first instance ("the applicant") claims damages from Thomas



Case law

Philipps GmbH & Co. KG, the defendant at first instance (“the defendant”) in connection with a purported infringement of registered Community design (“RCD”) 000877030-0001 for a laundry ball.



The holder of the RCD is EMKER S.A., of Geneva (Switzerland). The applicant claims that it is the exclusive licensee of that RCD for Germany and has been empowered by the right holder to bring all claims arising from the design in its own name. The applicant has not been entered as a licensee in the register of RCD.

The first instance, the Landgericht (Regional Court) found in favour of the applicant and considered the applicant, as the exclusive licensee, to be empowered to bring the claims for damages in its own name. The defendant disputes the finding of the Landgericht and claims that the applicant is not entitled to bring claims arising from the RCD. According to the referring Chamber, the issues are twofold:

- Can the applicant bring claims arising from an infringement of the RCD despite not having been entered in the Community designs register as a licensee.
- Even if the applicant has the standing to bring an infringement action, does Article 32(3) RCD allow the licensee to pursue its own claim for damages independently.

Articles 32 and 33 CDR are set out in Annex 1.

The questions referred to the Court of Justice of the European Union (CJ):

1. Does the first sentence of Article 33(2) of Council



Regulation (EC) No 6/2002 of 12 December 2001 on Community designs preclude a licensee who has not been entered in the register of Community designs from bringing claims for the infringement of a registered Community design?

In the event that the first question is answered in the negative:

2. may the exclusive licensee of a Community design, with the consent of the right holder, bring an action on its own claiming damages for its own loss under Article 32(3) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs or can the licensee only intervene in an action brought by the right holder for an infringement of its Community design under Article 32(4) of that regulation?

FINDINGS OF CJ:

FIRST QUESTION

The CJ found that, in isolation, Article 33(2) CDR could be interpreted as requiring registration of the licence in order for a licensee to have the standing to bring an infringement action (para. 17). But, it is necessary to consider not only wording but also the CONTEXT (para. 18).

The context that the CJEU considered pertinent to Article 33(2) CDR is that it is aimed at safeguarding ‘Third parties who have, or are likely to have, rights in RCD’. The CJEU based its conclusions on the following factors:

- Article 33(2) CDR excludes ‘third parties who have acquired rights’ but who ‘knew of the legal act at the date on which the rights were acquired’ or acquired the RCD or rights by universal succession (para. 19).
- Title III CDR is entitled ‘Community Designs as objects of property’ (para. 20).
- Article 32(3) CDR, the licensee’s right to bring proceedings for infringement is subject only to the proprietor’s consent thereto (para. 21).
- Article 28(b) CDR would serve no useful purpose if a licensee had no standing to bring infringement actions



Case law



(para. 23).

The CJ concluded that Article 33(2) **CDR DOES NOT PRECLUDE** a licensee who is not entered in the Register of RCDs from bringing proceedings for infringement of a RCD.

SECOND QUESTION

Whereas Article 32(4) CDR states that a licensee is, for the purpose of obtaining compensation for damage suffered by him, entitled to intervene in an infringement action brought by the rightholder in a RCD, Article 32(3) CDR does not state whether the licensee can claim damages for that loss where it brings the infringement action envisaged in that provision in its own right (para. 27).

However, those two provisions, which establish a system of legal remedies open to the licence holder of a RCD against the infringer of that RCD, must be read together. Those provisions allow the licensee to bring proceedings either by way of an action, by bringing infringement proceedings with the consent of the design holder or, in the case of an exclusive licence, if having been given notice the rightholder does not itself bring infringement proceedings within an appropriate period, or by way of intervention in infringement proceedings brought by the rightholder in a RCD. The latter route is the only one available to the holder of a non-exclusive licence who does not obtain the consent of the rightholder of the design to act alone. (para. 28)

Whilst the licensee may seek damages for its losses by intervening in the infringement proceedings brought by the rightholder of the RCD, nothing prevents it from also doing so where it brings the infringement proceedings itself with the consent of the rightholder, or, if it is an exclusive licensee, without that consent in the case of inaction by that rightholder after having given it notice to bring proceedings (para. 29).

The system would, moreover, lack coherence if the licensee could defend its own interests only by joining an action brought by the rightholder of the RCD when he may act alone by way of an action with the consent of that rightholder, or without

its consent in the case of an exclusive licence, to defend their common interests (para. 30).

The possibility for the licensee to seek compensation for damage suffered by it is consistent with the objective set out in recital 29 of ensuring that the rights conferred by a RCD can be enforced in an efficient manner throughout the territory of the EU and also with the purpose of Article 32(4), which is to give to the licensee the procedural means to bring proceedings in respect of the infringement and thus to defend those rights which have been conferred on it. To prohibit it from acting for that purpose would make it totally dependent, including in the case of an exclusive licence, on the rightholder to obtain compensation for damage suffered by it and, should that right holder not bring proceedings, would, therefore, be detrimental to the exercise of those rights (para. 31).

Consequently, Article 32(3) CDR must be interpreted as meaning that the **LICENSEE CAN CLAIM DAMAGES FOR ITS OWN LOSS IN PROCEEDINGS FOR INFRINGEMENT OF A RCD** brought by it in accordance with that provision.

Case C-163/15; Youssef Hassan v Breiding Vertriebsgesellschaft mbH, Preliminary ruling of 4 February 2016; Language of the case: DE

KEYWORDS: Licence agreement, Infringement

FACTS: The applicant at first instance was a licensee of the European Union trade mark ("EUTM") ARKTIS, No. 2 818 680 owned by KBT & Co. Ernst Kruchen agenzia commerciale società. Under the licence agreement, the applicant is obliged to assert, in its own name, rights arising from the infringement of the licensor's trade mark rights. The licence was not entered in the Register of EUTMs.

The questions referred to the Court of Justice of the European Union (CJ):

1. Does the first sentence of Article 23(1) ... preclude a licensee who is not entered in



Case law



the Register of Community trade marks from invoking claims for infringement of a Community trade mark?

2. In the event that the first question is answered in the affirmative:

Does the first sentence of Article 23(1) ... preclude a national legal practice in accordance with which the licensee can enforce the trade mark proprietor's rights against the infringer by virtue of the power conferred on it for that purpose (Prozessstandschaft)?

FINDINGS OF CJ: ARTICLE 23(1) EUTMR READS: '[l]egal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark shall have effects vis-à-vis third parties ... only after entry in the register'. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired' (underline added).

The CJ found that, in isolation, Article 23(1) could be interpreted as requiring registration of the licence in order for a licensee to have the standing to bring an infringement action (para. 18). But, it is necessary to consider not only wording but also the CONTEXT (para. 19).

The context that the CJ considered pertinent to Article 23(1) is that it is aimed at safeguarding 'Third parties who have, or are likely to have, rights in EUTM'. The CJ based its conclusions on the following factors:

- Article 23 EUTMR excludes 'third parties who have acquired rights' but who 'knew of the legal act at the date on which the rights were acquired' or acquired the EUTM or rights by universal succession (para. 20).
- Section 4 EUTMR is entitled 'European Union trade marks as objects of property' (para. 21).
- Article 22(3) EUTMR, the licensee's right to bring proceedings for infringement is subject only to the proprietor's consent thereto (para 22).

- Article 17(6) EUTMR would serve no useful purpose if a licensee had no standing to bring infringement actions (para. 24).

The CJEU concluded that Article 23(1) EUTMR DOES NOT PRECLUDE a licensee who is not entered in the Register of EUTMs from bringing proceedings for infringement of a EUTM.

Case C-280/15; Irina Nikolajeva v Multi Protect OÜ, Preliminary ruling of 22 June 2016; Language of the case: ET

KEYWORDS: Infringement

FACTS: The applicant at first instance was the proprietor of the EUTMA HolzProf. The application of that trademark was filed on 24 April 2010 and then published on 31 May 2010. The mark was registered on 14 September 2010 and the registration was published on 16 September 2010. On 24 April 2010 the applicant licenses the EUTMA to a third party for a monthly licensing fee. The applicant brought an action against Multi Protect alleging unlawful use of its trademark in the period of 3 May 2010 to 28 October 2011, applying for a declaration that an act of infringement had occurred, for damages based on unjust enrichment, and compensation for non-material harm. The questions referred to the Court of Justice of the European Union (CJ):

1. Is a EUTM court required to issue the order provided for in Article 102(1) EUTMR [prohibiting the acts of infringement], if the applicant does not seek such an order in his claims and the parties do not allege that the defendant has infringed or threatened to infringe an EUTM after a specific date in the past, or does failure to make an application to that effect and to refer to this fact represent a 'special reason' within the meaning of the first sentence of this provision?
2. Is Article 9(3) EUTMR to be interpreted as meaning that



Case law

the proprietor of an EUTM may demand only reasonable compensation from a third party on the basis of the second sentence of Article 9(3) EUTMR for use of a sign identical with the trade mark in the period from the publication of the application for registration of the trade mark until the publication of the registration of the trade mark, but not compensation for the fair market value of what has been gained as a result of the infringement and for damage, and that there is also no right to reasonable compensation for the period prior to publication of the application for registration of the trade mark?

3. What type of costs and other forms of compensation are included in reasonable compensation under Article 9(3) EUTMR, second sentence, and can this also encompass in certain circumstances (and if so, in which circumstances) compensation for non-material harm caused to the proprietor of the trade mark?

FINDINGS OF CJ: The CJ found that, Article 102(1) EUTMR does not precluding an EUTM court from refraining, pursuant to certain principles of national procedural law, from issuing an order which prohibits a third party from proceeding with acts of infringement on the ground that the proprietor of the trade mark concerned has not applied for such an order before that court.

Furthermore, the CJ concluded that the second sentence of Article 9(3) EUTMR must be interpreted as precluding the proprietor of an EUTM from being able to claim compensation in respect of acts of third parties occurring before publication of an application for registration of a trade mark. In the case of acts of third parties committed during the period after publication of the application for registration of the mark concerned but before publication of its registration, the concept of 'reasonable compensation' in that provision refers to recovery of the profits actually derived by third parties from use of the mark during that period and excludes compensation for the wider harm such as for example moral prejudice.



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

Case T-292/12RENV; Mega Brands International, Luxembourg, Zweigniederlassung Zug v EUIPO; Judgment of 1 June 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Dominant element, Lack of reasoning

FACTS: The applicant sought to register the word mark represented below as a CTM for Class 28. The Opposition Division upheld an opposition against all goods in Class 28 of the CTM based on the earlier Spanish mark below. The Board of Appeal (BoA) entirely rejected the appeal. In a judgment on 4 February 2014 the General Court (GC) dismissed the appeal Case T-292/12. The Court of Justice of the European Union (CJ) C-182/14P later set aside the judgment of the GC of 4 February 2014. The CJ held, in essence, that the GC had erred in failing to take into account, in its assessment of the similarity of the signs at issue, the presence of the element '4' in the earlier mark.

EUTMA

MAGNEXT

Earlier mark

MAGNET 4

SUBSTANCE: Visually the element '4' will be noted and cannot be entirely neglected in the assessment of the visual impression of the signs at issue, and that it contributes to distinguishing between those signs. Phonetically only the first



Case law



syllable is common to the two signs at issue – “mag” and “next” versus five syllables, “mag”, “net”, “cu”, “a” and “tro”. The public will associate the earlier mark with the adjective “magnético”, commonly used by the relevant public to designate an article having magnetic properties. There is no conceptual similarity between the mark applied for, on the one hand, and the earlier mark, on the other, since the word “magnext”, which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful (paras. 27-29). Not only is there merely a low degree of visual similarity and a very low degree of phonetic similarity between the marks at issue, but also that they are conceptually dissimilar (para. 30).

The conceptual differences are capable of counteracting to a very large extent, and even cancelling, the visual and phonetic similarities. Only the earlier mark will be perceived as referring to the concept of magnetism, while the mark applied for will be perceived as being purely fanciful (para. 32). This distinctive overall impression is further reinforced by the possibility that the relevant public might identify the English word “next” within the mark applied for, whereas the mark MAGNET 4 does not contain any element that can associate it with that word (para. 33). Contrary to the assertions of the Office, the relevant public will identify the word ‘next’ within the mark applied for and will immediately grasp its meaning (para. 35). The earlier trade mark MAGNET 4 conveys a message that may be associated in the mind of the relevant public with characteristics of the goods for which the trade mark is registered, and therefore that it has only a weak distinctive character (para. 41).

In the context of a global assessment of the likelihood of confusion, taking into account the low degree of similarity between the mark applied for and the earlier mark, the conceptual differences between the two marks, the presence of the element “4” in the earlier mark alone and the weak distinctive character of that earlier mark, it must be held that the BoA erred in its assessment in recognising a likelihood of confusion between the marks within the meaning of Article 8(1)(b) EUTMR (para. 42).

Case T-840/14; International Gaming Projects Ltd v OHIM; Order of 11 March 2016 Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Restriction of the list of goods and services

FACTS: The Board of Appeal (BoA) refused the EUTM application for a figurative mark Sky BONUS for goods in Classes 9 and 28 upon an opposition based on an earlier UK word mark SKY affirming the likelihood of confusion pursuant to Article 8(1)(b) EUTMR.

The applicant filed an action before the General Court (GC) in which it limited the goods.

EUTMA



Earlier marks

SKY

SUBSTANCE: The GC dismissed the action as inadmissible, as the limitation of the goods that took place after the decision of the BoA was rendered changed the subject matter of the dispute before the BoA and was therefore against Article 65(2) EUTMR and Article 188 GCRP.

The case-law established rules for the admissibility of the limitation of the goods or services during the GC proceedings. Where the applicant was withdrawing its application solely in respect of certain of the goods covered by the initial application, this was treated either as a declaration that the contested



Case law

decision was being challenged only in so far as it referred to the remainder of the goods concerned, or, if such a declaration was made at an advanced stage of the proceedings before the GC, as a partial withdrawal of the action. If, however, by its restriction of the list of goods, the trade mark applicant is not seeking to withdraw one or more goods from that list, but to alter a characteristic of those goods, such as their purpose or their description, it is possible that that alteration may affect the examination carried out by the bodies of the Office during the administrative procedure. In those circumstances, to allow that alteration at the stage of the action before the GC would amount to changing the subject matter of the proceedings pending, which is prohibited by Article 188 GCRP. Such an alteration therefore cannot affect the legality of the contested decision or be taken into account by the GC when it examines the merits of the case (para. 22).

In the present case, it is clear both from the sole head of claim for annulment and from the arguments set out in support of it in the application that the applicant is not withdrawing any of the goods, but is merely specifying their purpose as relating “exclusively to Video Bingo games for recreational machines for casinos and amusement arcades”. The applicant itself confirms, at paragraph 16 of the application, that it is no longer trying to protect the goods contained ‘in general as a broader category’ but only in so far as they serve that particular purpose (para. 23). By its application, the applicant cannot obtain a partial annulment of the contested decision on the ground that it is based on an assessment — not made by the BoA — of a likelihood of confusion between the marks in question by including in that assessment goods with a specific purpose on which the BoA had not been asked to rule (para. 25).



Case T-411/14; The Coca-Cola Company v OHIM; Judgment of 24 February 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctiveness acquired by use, Evidence of use, Extent of use, Function of trade mark, Nature of use, Promotional material, Sales figures, Shape of the product, Survey, Three dimensional mark

FACTS: The applicant sought to register the three-dimensional sign reproduced below as a EUTM for goods and services in Class 6, 21 and 32.

The examiner refused the registration for some of the goods applied for on the basis of Article 7(1)(b) EUTMR and informed the applicant. The applicant decided to maintain its application in respect of all the goods concerned, claiming that the sign had acquired a distinctive character under Article 7(3) EUTM and having obtained extensions on the deadline for gathering and lodging all documents in support of its claims, the applicant submitted its arguments against the initial position adopted by the examiner.

The examiner dismissed the application for registration and also dismissed the application under 7(3) EUTMR. The Boards of Appeal (BoA) dismissed the applicant’s appeal. The applicant filed an action before the General Court (GC).

EUTMA





Case law

SUBSTANCE: ON THE INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR: The goods covered by the mark applied for are aimed at the general public with average level of attention (para. 41). The mark applied for is made up of a combination of elements, each of which is likely to be commonly used in the trade of the goods covered by the trade mark application and is therefore devoid of any distinctive character in relation to those goods. The mark is mere variation of the shape and packaging of the goods concerned which will not enable the average consumer to distinguish the goods in question from those of the other undertakings (paras. 42-51). Regarding the argument of the applicant that the relevant sector is highly competitive and that it is common for players on such market to try to make their products stand out by means of their packaging, the GC held that those circumstances do not suffice in themselves to render the mark applied for distinctive (para. 54).

ON THE INFRINGEMENT OF ARTICLE 7(3) EUTMR: It is not clear from the advertising material provided whether the bottle that is shown in them is a representation of the contour bottle with fluting or a representation of the mark applied for. The same is true regards the items of evidence showing contour bottles without fluting. The mark applied for is not used in combination with the mark it is alleged to be part of but absorbs that mark, or inversely, is itself absorbed by it to the extent that the silhouettes of the mark applied for and the mark it is alleged to be part of overlap (para. 76). The surveys provided are not sufficient, in themselves, to prove to the requisite standard that the mark applied for has acquired distinctive character through use, throughout the EU, in respect of a significant part of the relevant public (para. 81). As regards the investments which have been made in advertising and communication, the figures provided do not specifically relate to the mark applied for. They are secondary evidence and furthermore they do not show that the public targeted by the goods in question perceives the mark applied for as an indication of commercial origin. In addition, those sales figures are marred by inconsistencies (paras. 82-85). The rest of the evidence provided also fail to establish that the mark applied



for has acquired distinctive character in the EU (para. 88). As a result, none of the items of evidence, considered in isolation, is sufficient to establish that the mark applied for has acquired distinctive character through use. Likewise, the GC ruled that all the items as a whole also fail to establish that such is the case (paras. 90-91).

Case T-326/14; Novomatic AG v EUIPO; Judgment of 19 April 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The applicant sought to register the figurative mark HOT JOKER represented below as a CTM for goods and services within Classes 9 and 28.

An opposition based on the French earlier figurative mark JOKER represented below, registered for goods in Classes 28 and 41, was filed on the grounds of Article 8(1)(b) EUTMR.

The Opposition Division upheld the opposition in so far as it was not necessary to examine the other ground relied on in support of the opposition.

The Second Board of Appeal dismissed applicant's appeal. The applicant filed an action before the General Court (GC).

EUTMA



Earlier mark





Case law



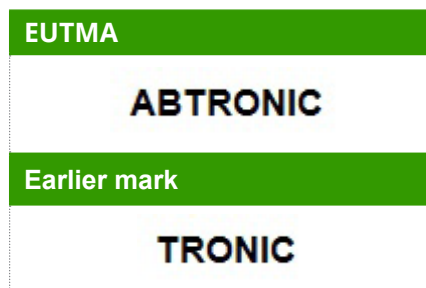
SUBSTANCE: The comparison of the goods in Class 9 “hardware and software” are complementary to the goods protected by the earlier mark under Class 28, inasmuch as the software and hardware in Class 9 are essential elements for the functioning of the electronic or on-line games of chance covered by the earlier mark (para.54). Concerning the comparison of the signs the GC maintains that the word element “joker” is not devoid of any distinctive character, since the applicant is not able to evidence that for the relevant French public is a descriptive sign in respect of games of chance or lotteries. Regarding the word element “hot” it does not create the unique impression of the mark applied for (paras. 75-78). **LIKELIHOOD OF CONFUSION:** the identity or similarity of the goods under comparison and the similarity of the signs at issue reveals the existence of likelihood of confusion, in spite of the high level of attention of professionals in the casinos and amusement arcades sector, who are part of the relevant public (paras. 79-80). From a probative perspective, the GC expresses that the applicant is not able to establish with accuracy, the relevant French public’s awareness of the character of the Joker who appears in the Batman films and comics, inasmuch as it was entitled to take the view that it was a well-known fact that those films and comics were famous and widely distributed throughout France (para. 93). The applicant confined itself to invoking Article 76 EUTMR in a general abstract manner, but did not provide any evidence to dispute the fame and wide distribution of the Batman films and comics in France and consequently, the relevant French public’s awareness of the character of the Joker. As a result, the GC establishes that the degree of similarity is sufficient to settle that there is a likelihood of confusion (para. 94).

Case T-643/14; Red Lemon Inc v EUIPO; Judgment of 12 Mai 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The Board of Appeal (BoA) confirmed the refusal of the EUTM application for a word mark ABTRONIC upon an opposition based on the earlier EU word mark TRONIC for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8(1)(b) EUTMR.



SUBSTANCE: First the GC rejected the request for the stay until a cancellation action brought by the applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot affect its legality (paras. 13 et seq.)

The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, which level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element “TRONIC” leads to a similarity despite of the existence of the



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additional element “AB” at the beginning of the contested mark (para. 37). The marks are phonetically similar for the same reasons (para. 41). The marks are conceptually similar, as far as the common element, even if it does not have any clear meaning, can allude to “electronic” (para. 47). The earlier mark must be attributed a minimum of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 52).

Case T-775/14; Red Lemon Inc v EUIPO; Judgment of 12 Mai 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The Board of Appeal (BoA) confirmed the refusal of the EUTMR represented below upon an opposition based on the earlier EUTM represented below for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8(1)(b) EUTMR.



SUBSTANCE: First the GC rejected the request for the stay until a cancellation action brought by the Applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot affect its legality (paras. 13 et seq.)

The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, which level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element “TRONIC” leads to a similarity despite of the existence of the additional element “AB” in the contested mark and its graphical features (para 42). The marks are phonetically similar, this finding was not contested by the applicant (para. 44). The marks are conceptually similar, as far as the common element, even if it does not have any clear meaning, can allude to “electronic” (para. 47). The earlier mark must be attributed a minimum of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 52).

Case T-776/14; Red Lemon Inc v EUIPO; Judgment of 12 Mai 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The Board of Appeal (BoA) confirmed the refusal of the EUTMR represented below upon an opposition based on the earlier EUTM represented below for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of Article. 8(1)(b) EUTMR.



Case law

EUTMA



Earlier marks

TRONIC

SUBSTANCE: First the GC rejected the request for the stay until a cancellation action brought by the applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot affect its legality (paras. 13 et seq.)

The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, which level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element "TRONIC" is visible and will not be overlooked despite the presence of further elements "AB" and "X" in the contested mark (para. 43). The marks are phonetically similar, this finding was not contested by the applicant (para. 45). The marks are conceptually similar, as far as the common element, even if it does not have any clear meaning, can allude to "electronic" (para. 48). The earlier mark must be attributed a minimum of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 53).



Joined Cases T-510/14 and T-536/14; Staywell Hospitality Group Pty Ltd v EUIPO and Sheraton International IP, LLC v EUIPO; Judgment of 2 June 2016; Language of the case: EN

RESULT: Actions dismissed

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

FACTS: The EUTM applicant sought to register the figurative mark below as an EUTM for services in Classes 35, 36 and 43. The opponent filed an opposition based on the earlier figurative and word EUTMs below on the grounds of Article 8(1)(b) EUTMR.

The Opposition Division (OD) upheld the opposition for a part of the relevant services. Both the applicant and the opponent filed an appeal. The Board of Appeal (BoA) joined the appeals and dismissed them. The applicant filed an action before the General Court (GC) in Case T-510/14. The opponent filed an action before the General Court (GC) in Case T-536/14.

EUTMA



Earlier mark





Case law



SUBSTANCE: ARTICLE 64(1) EUTMR BEFORE AMENDMENT:

The GC recalled that, following the examination as to the allowability of the appeal, the BoA is to decide on the appeal, and that it may either exercise any power within the competence of the OD or refer the case back to that division for further action. Therefore, when, as in the present case, the BoA confirms a lower-level decision of the Office in its entirety, that decision, together with its statement of reasons, forms part of the context in which the BoA decision was adopted, which is known to the parties and enables the GC to carry out fully its judicial review as to whether the BoA's assessment was well founded.

ARTICLE 8(1)(B) EUTMR BEFORE AMENDMENT: The contested services in Class 35 and the earlier mark's services in Class 43 are different in nature, provided by different types of undertakings and directed at other types of users. That finding is supported by the case-law, which found that, although the development and operation of hotels involves typical office functions, it is nevertheless the case that, within hotels, those services are usually performed by the hotel staff, and not by third parties. Furthermore, hotels usually do not offer office services to other undertakings, with the result that the "office functions" and "operation of hotels services" are different on the ground that they generally have different origins and target different publics. Although that case-law refers specifically to the operation of hotels and office tasks, the reasoning is transposable to the present case with respect to the similitude of promotion services or business management of hotels or restaurants, such as those in Class 35 covered by the mark sought, and "services for providing food and drink" and "temporary accommodation" as such included in Class 43 and covered by the earlier figurative mark. Those types of services are therefore not in competition with each other because services directed at different publics cannot be considered substitutable nor are the services at issue mutually complementary (paras. 53-55).

As far as the comparison of the signs is concerned, the term "regis" is the most distinctive element in the two marks: the

figurative elements of the marks are made up of relatively banal emblems, being perceived as having a decorative function. The element "park" in the contested mark will be perceived as highly evocative and even descriptive of the services at issue. By contrast, the element "regis" will either be perceived as having no meaning for the relevant public or, for a part of it, as a reference to the Latin term meaning "of the King, the idea of a place linked to royalty". However, even when that element was perceived as laudatory in relation to the services covered, it will remain the most distinctive element of the mark at issue. In relation to the earlier figurative mark, the element "st." will certainly be perceived internationally as referring to the notion of "saint" since it is also usually followed by a name and perceived as a mere attribute of that name (paras. 74-78). The signs are visually similar in so far as their most distinctive word element is the same and they both contain a sort of heraldic image. They are also phonetically and conceptually similar to a certain extent in that they share the sounds of the identical letters of the term "regis" and its meaning. Therefore the signs are overall similar (paras. 81-86).

There exists a likelihood of confusion, even taking account of a level of attention of the relevant public which is higher than average. In particular, since the services at issue refer in each case to hotel and real estate services, the mark applied for and the earlier figurative mark could be perceived as sub-brands in order to distinguish the scope of services of one provider from other services of the same provider. Actually, it is not unusual in the hotel and real estate markets for a principal mark to appear in various forms, depending on the type of service offered (paras. 82-98).



Case law



Case T-202/14; LR Health & Beauty Systems GmbH v OHIM; Judgment of 26 January 2016; Language of the case: EN

RESULT: Action dismissed

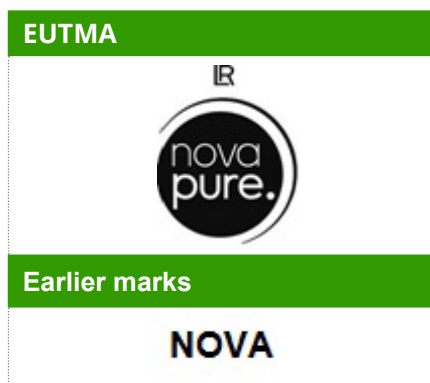
KEYWORDS: Likelihood of confusion; Phonetic similarity; Similarity of the signs; Visual similarity

FACTS: The applicant sought registered the figurative mark LR nova pure. represented below as a EUTM for goods and services within Class 3.

An opposition based on the earlier word mark NOVA represented below, registered for goods in Class 3, was filed on the grounds of article 8 (1) (b) EUTMR.

The Opposition Division upheld the opposition basing its decision on the earlier international word mark NOVA whose international protection was extended to Poland.

The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.



SUBSTANCE: The goods in issue are identical and the relevant public is the average Polish consumer (not disputed). Concerning the distinctive character of the word elements "nova" and "pure", as the earlier mark was already registered as international trade mark, the word "nova" had to be assumed to have at least a minimum degree of distinctiveness.

However, it has a low degree of inherent distinctive character since it evokes "newness" (paras. 42-46). The word elements "nova" and "pure" are the most dominant elements of the EUTMA. The word element "lr" is clearly ancillary, since it is highly stylised and difficult to read, having only a limited impact (para. 55). The presence of a full stop after the word "pure" is not an element capable of attracting consumer's attention. Otherwise, the word element "nova" plays an independent distinctive role in the EUTMA, which is not cancelled out by the presence of the word element "pure". Therefore, the marks display a medium degree of visual similarity (paras. 70-73). Regarding the phonetic comparison, for consumers who pronounce the word element "lr", the marks have a low degree of phonetic similarity, but for the consumers who do not pronounce the word element "lr", the level of phonetic similarity is average, given the presence in each of the word "nova" (para. 81). With respect to conceptual comparison, the additional concept of "pure" attached to the EUTMA is not able to supplant the reference to the concept of "newness", which will not be influenced by the weak distinctive character of the earlier mark and of the word element "nova" in the EUTMA. Thus, the marks are similar overall (paras. 89-90). **LIKELIHOOD OF CONFUSION:** The degree of similarity between the marks, the identity of the goods covered by them and the normal level of attention of the relevant public, considered cumulatively, are sufficient for the conclusion that there is a likelihood of confusion (para. 98).

Case T-301/15; Jochen Schweizer GmbH v EUIPO; Judgement of 31 May 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Slogan mark, Admissibility, Laudatory mark

FACTS: The trade mark Du bist, was Du erlebst had been applied for as a EUTM for kkmgoods and services in Classes



Case law



9, 16, 35, 36, 39 and 41. The Operations Department refused the application under Article 7 (1) (b) EUTMR. Upon appeal the Board of Appeal (BoA) confirmed the examination decision and rejected the appeal.

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

EUTMA

Du bist, was Du erlebst

SUBSTANCE: ADMISSIBILITY: Even though the appeal addresses an infringement of Article 7 (1) (c) EUTMR, it is clear from the writ's further reasoning that indeed the appeal claims an infringement of Article 7 (1) (b) EUTMR. Therefore Article 44 (1) (c) RoP GC is complied with and the appeal admissible.

The Office correctly and in line with the case law of the GC assessed whether the slogan indeed possessed distinctive character beyond its advertising and promotional function. It came to the conclusion that the slogan applied for did not primarily serve the relevant public as an indicator of commercial origin. Where slogans transmit a simple promotional message a certain originality is required to allow for the conclusion that the advertising slogan aside its laudatory message primarily also transmits a message of commercial origin. The Office therefore rightly assessed whether the EUTM incorporated any unusual, opaque or surprising elements, which could help confer it with distinctive character (paras. 23-30). The Office did not dissect the EUTM, but moreover did assess it in its entirety. The reference made to the beginning "Du" merely served to underline the overall interpretation (para. 36). The slogan is built as a simple, readily understandable sentence, which does not include any unusual elements. More specifically, it is incorrect to say that the sequence "Du bist...", necessarily has to be followed by an adjective in German. The slogan transmits the laudatory message that experience is the foundation for a rich life and that consumption of the

advertised products furthers the creation of such experiences. This message applies to all goods and services of the application. The Office may in its assessment globally address goods and services, where the message is generic enough to apply to categories of goods and services globally (paras 43, 48). Contrary to what the appellant claims, the reasoning of this global assessment applies also to "paper" and scientific apparatus and instruments". Finally, there is no discrepancy in the assessment of the first instance examination and the BoA. In any event, the BoAs have jurisdiction to assess a case both legally and factually anew and would therefore be entitled to replace a first instance reasoning by their own and still uphold the first instance decision by rejecting the appeal (paras 53, 54).

Based on the foregoing, the decision of the Office was confirmed.

Case T-198/14; 100% Capri Italia Srl v EUIPO - Inghirami produzione distribuzione SpA; Judgment of 19 April 2016; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the goods and services, Dominant element, Figurative element, Geographical origin

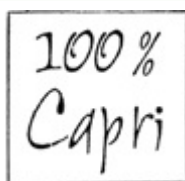
FACTS: The applicant sought to register the figurative mark 100% CAPRI (shown below) as a EUTM for goods in Classes 18 and 25. An opposition based on the earlier EU figurative mark CAPRI (shown below) was filed on the grounds of Article 8 (1) (b) EUTMR. The goods on which the opposition was based are "items of outer clothing" in Class 25. The Board of Appeal (BoA) upheld the Opposition Division's finding that there was likelihood of confusion between the conflicting marks and dismissed the appeal. The applicant filed an action before the General Court (GC).



Case law



EUTMA



Earlier marks



SUBSTANCE: As far as the procedural issues are concerned, the GC found that the applicant's argument, according to which the word "CAPRI" would be associated by the relevant public to a particular style of clothing, was raised for the first time before the GC and therefore it was deemed to be inadmissible. Furthermore, the applicant claimed, with its observations before the BoA, that "no consumer would associate the word "CAPRI" to shirts or other clothing but rather to a kind of cigarettes" (paras. 29-31).

On the likelihood of confusion, the GC firstly confirmed the finding of the BoA that the goods at issue are identical or similar. Secondly, the GC rejected the applicant's argument that "CAPRI" is devoid of distinctive character since it is the name of a known island of the Gulf of Naples. The GC recalled the case-law according to which when the name of a geographical place does not have any link with relevant goods or services it could be registered as a trade mark. Therefore, since the applicant did not show that any connection exists between the word "CAPRI" and goods at issue, the contested decision correctly found that the distinctive character of the word element "CAPRI" is of average degree (paras. 76-78). The GC also confirmed the BoA's finding that "CAPRI" is the dominant element of the earlier mark due to its central position and the

space it occupies. The common word "CAPRI" is the dominant element also of the contested mark since the element "100%" is just a semantic addition of the word "CAPRI" (paras. 90-93). The GC also confirmed that the findings of the BoA that there is an average degree of visual, phonetic and conceptual similarity between the signs at issue (paras. 95-115). In the light of the normal distinctiveness of the European Union earlier mark, the identity and similarity of the goods, and of the visual, phonetic and conceptual similarity between the conflicting signs, the GC stated that the BoA was correct in finding that there was a likelihood that between the signs at issue (paras. 116-122).

Case T-750/14; Ivo-Kermartin GmbH v EUIPO; Judgment of 12 Mai 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Right to be heard, Right of defence, Restriction of the list of goods and services

FACTS: The applicant consecutively declared (minor) restrictions of its goods/services in the course of the opposition proceedings, which were communicated to the opponent (Rule 18(3), 20(5) CTMIR). The opponent stated that the applicant merely seeks to extend the opposition proceedings and that it maintains its opposition regardless of any further restrictions. Following the fifth restriction, the Opposition Division (OD) notified its decision (opposition upheld) without communicating to the applicant beforehand the opponent's statement to maintain the opposition.

The applicant appealed claiming that the lack of communication of said statement before rendering the opposition decision amounts to a serious procedural error.

The BoA dismissed the appeal as inadmissible reasoning that the appeal does not contain any admissible grounds of appeal (Article 60 EUTMR) and that the plaintiff is not adversely affected by the circumstances claimed (Article 59 EUTMR).



Case law

EUTMA
ELGO
Earlier mark
ERGO

SUBSTANCE: The Office complied with Rules 18(3), 20(5) CTMIR when informing the opponent about the applicant's last restriction. In the circumstances of the present case, it does not amount to an infringement of the applicant's right to be heard / right of defence under Article 75 EUTMR that the applicant was not informed about the opponent's reaction before rendering the opposition decision. As follows from Rules 18(3), 20(5) CTMIR, the proceedings continue when an opponent maintains its opposition following a restriction. Article 43 EUTMR enables an applicant to restrict the specification of the mark applied for at any time but does not oblige the Office to postpone the opposition decision until the applicant declares a further restriction (paras. 32-41). Besides, the applicant could have made such declaration even after the decision was rendered (paras. 42-43). Furthermore, the applicant was aware of the opponent's prior statement to maintain the opposition regardless of any further restriction (para. 44). In any event, Article 75 CTMR was not infringed since it cannot be found that the proceedings would have resulted in a different decision on substance (paras. 47-48).

Case T-590/14; Zuffa, LLC v EUIPO; Judgment of 12 May 2016; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)



KEYWORDS: Lack of reasoning, Descriptive element, Minimum degree of distinctiveness, Distinctiveness acquired by use

FACTS: The EUTM applicant sought to register the word sign ULTIMATE FIGHTING CHAMPIONSHIP for goods in Classes 9, 16, 28 and 41. The examiner rejected the application in respect of all the goods (with the exception of "playing cards and computer game controllers" in Class 28). The Second Board of Appeal (BoA) dismissed the appeal. The EUTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

EUTMA
ULTIMATE FIGHTING CHAMPIONSHIP

SUBSTANCE: ON THE DUTY TO STATE REASONS: The decision was duly motivated. In particular, the finding that all the goods in Class 9 are "data support media" that, in conjunction with the contested mark, would be perceived as containing, involving or relating to the highest, best of most extreme combat is sufficient to understand the BoA's reasoning for all of the goods in that class. The same is true for the reasoning in relation to the "printed media" in Class 16, the "toys" in Class 28 and the "various forms of shows, entertainment, performances, programs, productions of recording, news and information" in Class 41 (paras. 25-34). As for the assessment of the evidence, admittedly the BoA did not take an express view on some of the exhibits. It did however adopt the findings of the examiner, who adopted a general statement of reasons in which he stated that he had carefully analysed each of the documents provided. The decision of the BoA was therefore duly motivated (paras. 35-43).

ON THE DESCRIPTIVENESS OF THE MARK: The contested mark will be perceived by the relevant public as denoting 'the highest, best or most extreme combat in the form of a contest or a series of contests held to determine a champion' and the expression, taken as a whole, is not capable of having a meaning



Case law

which is different from the sum of the word elements of which it consists. Each of the goods and services at issue could relate to an ultimate fighting championship, which is sufficient to establish that the mark applied for is descriptive even in the eyes of the specialist public with a particular interest in mixed martial arts. Moreover, even assuming that the applicant is justified in maintaining that the general public is accustomed to the use of the names of sporting competitions as trade marks, it must be held that all the competitions to which it refers (the World Cup, the Masters Golf, the Championships (Wimbledon)) are unquestionably well known, which is likely to render them distinctive. That argument therefore, in actual fact, relates to whether the mark applied for has acquired distinctive character through its use, and not to whether it has inherent distinctiveness (paras. 56-65).

ON THE DISTINCTIVE CHARACTER OF THE MARK: The BoA erred in deducing that the absolute ground for refusal of registration provided for in Article 7(1)(b) EUTMR was applicable solely because the mark applied for was descriptive. That error does not, however, affect the legality of the contested decision, since it is sufficient that one of the absolute grounds for refusal applies for the sign at issue not to be registrable (paras. 66-68).

ON THE ACQUIRED DISTINCTIVENESS OF THE MARK: After analysing every piece of evidence (paras 79-99), the GC concluded that the renown of the contested mark had been proved solely in respect of the specialist public of mixed martial arts fans. As a consequence, the BoA erred insofar as it found that the contested mark had not acquired distinctiveness for the specific goods and services described as “featuring/relating to/ in the field(s) of mixed martial arts” (paras. 100-102). The GC pointed out, in particular, that the evidence referring to the acronym UFC was not devoid of evidential value, as that acronym frequently appeared in association with the sign ULTIMATE FIGHTING CHAMPIONSHIP and such a slightly different use of the mark may be regarded as equivalent by specialists (para. 85).



Joined Cases T-727/14 and T-728/14; Universal Protein Supplements Corp. v EUIPO; Judgments of 29 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Burden of proof, Examination of facts ex officio, Non-registered trade mark, Substantiation of earlier right, Used in the course of trade

FACTS: The applicant registered the figurative signs below for goods and services in Classes 3, 6, 8, 9, 12, 14, 16, 18, 20 to 22, 24, 25, 27, 28, 35, 36, 39 and 42.

An application for declaration for invalidity was filed on the basis of the earlier unregistered word mark ANIMAL referred to goods within Class 25.

The invalidity applicant produced various documents seeking to demonstrate that its unregistered sign ANIMAL had been used for clothing in various European Union countries. However, it did not give details of the provisions of national law on which it based its applications for declarations of invalidity. The Cancellation Division (CD) rejected the application for declaration of invalidity. The Boards of Appeal (BoA) dismissed the appeals. The invalidity applicant filed an action for the annulment of the BoA decisions before the General Court (GC).

EUTMs



Earlier mark

ANIMAL



Case law



SUBSTANCE: The applicant relied on the use of the sign ANIMAL, as an unregistered mark, in several EU countries and made a general reference to the table annexed to the EUIPO guidelines. Even though the table contains all the information relating to one or several applicable national rights necessary to comply with the obligation arising under Rule 37(b)(ii) of Regulation No 2868/95 to provide the particulars of the right on which the application for a declaration of invalidity is based, in the present case, however, the applicant, did not identify, in a precise and unambiguous manner, the provisions of the various national laws on which it based its applications for declarations of invalidity (para. 33).

In order to satisfy the requirements of Rule 37(b)(ii) of Regulation No 2868/95, it is not sufficient for a party relying on rights flowing from Article 8(4) of Regulation No 207/2009 merely to set out or indicate, in abstracto, the conditions for the application of national provisions, but on the contrary requires, that it shows, in concreto, in the instant case, that it satisfies those conditions of application (para. 38).

Since the applicant has not provided to the Office particulars regarding the applicable national rights, the BoA was not required, in the present case, to exercise its power of verification of the relevance of the evidence produced by the invalidity applicant (paras. 41- 49).

Case T-614/14; Fútbol Club Barcelona v EUIPO; Judgment of 16 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Proof of use, Evidence of use, Nature of use, New submission on appeal

FACTS: Fútbol Club Barcelona filed an opposition against the EUTM application for the word mark KULE. The opposition was based on the earlier Spanish registration for the word mark CULE. The applicant requested proof of use. The evidence

of use filed by the opponent showed that the word “CULE” is used to denote a supporter or player of FC Barcelona. The Opposition Division (OD) considered that there was no trade mark use in relation to the goods concerned (Class 14, 18 and 25). The Board of Appeal (BoA) dismissed the appeal. It confirmed the OD’s findings on proof of use. As to additional evidence filed before BoA, it was considered that it cannot be taken into account. BoA took the view that (i) no proof of use was submitted within the original time-limit, and (ii) in any event the evidence submitted late did not prove genuine use. The opponent filed an action before the General Court (GC). It claimed infringement of Article 42(2) EUTMR and of Article 8(1) (b) EUTMR. It challenged the BoA’s rejection of new evidence and criticised its assessment of evidence.

EUTMA

KULE

Earlier marks

CULE

SUBSTANCE: In the first place GC considered the opponent’s challenge to the BoA’s refusal of new evidence. GC observed that BoA referred to the fact that the evidence was submitted at the late stage of the proceedings and it was not actually relevant to the outcome of the case as it did not provide any indication concerning the place, time or extent of use of the earlier trade marks in relation to the goods in question. By doing this, BoA effectively exercised its discretion, providing a statement of reasons for refusing new evidence (paras. 28-30). As regards the assessment of the evidence of use filed within the original time-limit, GC confirmed BoA’s findings. The opponent submitted extracts from dictionaries and various printouts from websites dedicated to football which show that the term ‘CULE’ denotes a supporter or player of FC Barcelona



Case law



and it is used in this meaning (Para 43-45). The evidence did not show use of the mark in relation to the goods concerned (Para. 44-46). Uncertainty of Wikipedia-based evidence was also recalled (para. 47).

GC confirmed that the evidence filed did not show use of 'CULE' in relation to the goods concerned.

Case T-844/14; GRE Grand River Enterprises Deutschland GmbH v EUIPO; Judgment of 12 May 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Minimum degree of distinctiveness, Laudatory mark

FACTS: The Board of Appeal confirmed the refusal of a EUTM application for a word mark Mark1 for goods in Class 9 and Class 34 pursuant to Article 7(1)(b) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of 7(1)(b) EUTMR.

EUTMA

Mark1

SUBSTANCE: The GC dismissed the action.

The word elements of the mark will be understood as "trade mark number 1" and have therefore a laudatory meaning. This will be directly perceived by the public, which will not see the signs as an indication of commercial origin (para. 36). The fact that it can have different meaning does not endow it with a distinctive character (further in para. 37). The argument of the applicant that several similar signs were registered before, must be refused due to the principle of legality (paras. 41 et seq.) The application of a EUTM must be examined strictly in each case, bearing in mind its particularities (para. 46).

Case T-32/15; GRE Grand River Enterprises Deutschland GmbH v EUIPO; Judgment of 12 May 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Graphical representation, Laudatory mark

FACTS: The Board of Appeal confirmed the refusal of a EUTM application represented below for goods in Class 9 and Class 34 pursuant to Article 7(1)(b) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of 7(1)(b) EUTMR.

EUTMA

Mark1

SUBSTANCE: The GC dismissed the action.

The word elements of the mark will be understood as "trade mark number 1" and have therefore a laudatory meaning. This will be directly perceived by the public, which will not see the signs as an indication of commercial origin (para. 41). The fact that it can have different meaning does not endow it

with a distinctive character (further in para. 41). The graphical elements are simple and cannot change the meaning of the word element (para. 43). The argument of the applicant that several similar signs were registered before, must be refused due to the principle of legality (paras. 45 et seq.) The application of an EUTM must be examined strictly in each case, bearing in mind its particularities (para. 50).



Case law



Case T-220/15; Beele Engineering BV v EUIPO; Order of 7 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, Laudatory mark, Slogan mark

FACTS: The applicant sought to register the figurative mark represented below as a EUTM for goods and services within Classes 1,6,9,17,19,25,28,37 and 41. The examiner refused to register the word as an EUTM on the ground that EUTMA will be perceived as no more than a promotional slogan informing the relevant public that the goods at issue are manufactured with particular care and that the services are provided likewise. Considering the nature of these goods and the green colour used in the mark, consumers might also perceive it as a reference to environmental concerns. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).



SUBSTANCE: The GC found that the pleas raised by the applicant in support of its action is manifestly lacking any foundation in law and that the action must be dismissed. The GC rejected the arguments put forward by the applicant in holding:

- 'WE CARE' informs the relevant consumers of a characteristic of the undertaking and of its goods and services, namely that it is attentive and that its goods and services are manufactured or provided with care.

Accordingly, the element 'we care' is laudatory (para. 33).

- The colour green could lead the relevant public to see in the expression 'we care' a reference to environmental concerns (para. 34).
- There is no tension between the character of the goods and services covered, on account of their blocking nature, and the meaning of the 'we care' element as argued by the applicant (para. 37).
- Contrary to what the applicant claims, there is nothing to show that the relevant public will perceive the colour green as having the meaning of letting of things come through and as, therefore, being in contradiction with the goods and services concerned (para. 40).
- Given its excessive simplicity, the circle at issue is not inherently capable of conveying a message which consumers will be able to remember (para. 43).
- As regards the overall composition of the mark applied for, the word element and figurative element, as the Board of Appeal correctly observed in point 19 of the contested decision, are simply placed one below the other. The Board of Appeal's analysis, according to which there is nothing striking in that composition which could make the mark as a whole more than the sum of its parts, must be confirmed (para. 46).

Case T-222/15; Beele Engineering BV v EUIPO; Order of 7 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, Laudatory mark, Slogan mark

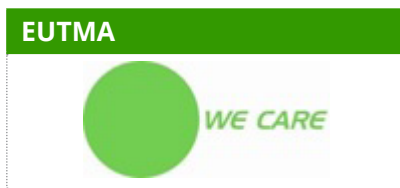
FACTS: The applicant sought to register the figurative mark represented below as a EUTM for goods and services within Classes 1,6,9,17,19,25,28,37 and 41. The examiner refused to



Case law



register the word as an EUTM on the ground that EUTMA will be perceived as no more than a promotional slogan informing the relevant public that the goods at issue are manufactured with particular care and that the services are provided likewise. Considering the nature of these goods and the green colour used in the mark, consumers might also perceive it as a reference to environmental concerns. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).



SUBSTANCE: The GC found that the pleas raised by the applicant in support of its action is manifestly lacking any foundation in law and that the action must be dismissed. The GC rejected the arguments put forward by the applicant in holding:

- "WE CARE" informs the relevant consumers of a characteristic of the undertaking and of its goods and services, namely that it is attentive and that its goods and services are manufactured or provided with care. Accordingly, the element 'we care' is laudatory (para. 33).
- The colour green could lead the relevant public to see in the expression 'we care' a reference to environmental concerns (para. 34).
- There is no tension between the character of the goods and services covered, on account of their blocking nature, and the meaning of 'we care' as argued by the applicant (para. 37).
- Contrary to what the applicant claims, there is nothing to show that the relevant public will perceive the colour green as having the meaning of letting of things come through and as, therefore, being in contradiction with the goods and services concerned (para. 40).

- Given its excessive simplicity, the circle at issue is not inherently capable of conveying a message which consumers will be able to remember (para. 43).
- The mark applied for is composed of the word element 'we care', to which the figurative element, representing a green circle, has been added on the left. The BoA's analysis according to which that combination does not present anything allowing the relevant consumers to see or remember it as an indication of the commercial origin of the goods and services concerned, must be endorsed. The mark applied for, viewed as a whole, does not have any peculiarity which could create an overall impression sufficiently far removed from that produced by the mere combination of the elements of which it is composed to confer on them added value (para. 46).

Case T-629/15; Hako GmbH v EUIPO; Order of 17 June 2016;
Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The examiner rejected the EUTMA SCRUBMASTER seeking protection for various cleaning-related apparatus (Class 7) on the basis of Articles 7(1)(c) and (b) CTMR. The Board of Appeal (BoA) dismissed the appeal as the sign would provide to the relevant public clear information of the purpose and quality of the cleaning machines applied for.





Case law



SUBSTANCE: The applicant claimed the breach of Articles 7(1)(c) and (b) CTMR due to the fact that (i) the BoA did not explicitly define the relevant public, (ii) did not consider the grammatical incorrectness and the alternative meanings of the terms “scrubmaster” and “master”, and (iii) did not consider the existence of previous similar registrations.

The General Court dismissed the action by a reasoned order. As to claim (i), it found that it was based on a misreading of the contested decision. The remaining claims were rejected on the basis of the well-established principles set out in the case-law.

Case T-61/15; 1&1 Internet AG v OHIM; Judgment of 1 March 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Descriptive element, Visual similarity, Phonetic similarity, Conceptual similarity, Complex mark

FACTS: The applicant sought the registration of the European word mark 1e1 for a range of services in Classes 35, 38, 42 and 45. An opposition was lodged based on the following Spanish marks shown below. The Opposition Division (OD) rejected the opposition. The applicant filed a notice of appeal with the Office. The Fifth Board of Appeal (BoA) upheld the appeal and annulled the OD’s decision. The applicant appealed to the General Court (GC), alleging the infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: The GC upheld the appeal. The GC endorsed the finding of the BoA that the relevant public is a professional public for the services in Classes 35, 42 and 45 and also the public in general for the services in Class 38. The GC found, however, that also the non-professional public will have a relatively high level of attention when purchasing those services (paras. 22-27).

EUTMA

1e1

Earlier marks

unoe 

UNO E

COMPARISON OF THE SERVICES: Regarding the comparison of the services, the GC found that “creation of domain names; maintenance of domains; domain name registration services and buying and selling of domains; allocating of domains; rental and leasing of domains” covered by the mark sought in Class 45 are neither identical nor similar to “legal services” covered by the earlier word mark in the same class. They have different nature, purpose or use. Nor has it been demonstrated that they are competing or complementary. Lastly, contrary to the BoA’s statements, there is nothing showing that those services have the same providers, distribution channels or end users (paras. 35-41). The GC upheld the finding of the BoA that “market analysis; organisational consultancy with regard to creating multimedia products, with regard to internet and communications technology, and with regard to audio-visual productions; display services for merchandising; compilation and systemisation of information into computer databases”, covered by the mark sought in Class 35 are included in the general category of “help in the exploitation or management of commercial or industrial firms” covered by the earlier figurative mark in Class 35 and the contested “compilation and systemisation of information into computer databases” are included in the category of “office work”. Therefore they must be considered identical. As regards the other services covered



Case law



by the mark sought in Class 35, the BoA correctly found that they are also identical (paras. 43-45). The GC confirmed also the finding of the contested decision that the services covered by the marks at issue in Classes 38 and 42 must be considered to be identical or highly similar.

COMPARISON OF THE SIGNS: As a preliminary remark, since the services covered by the earlier word mark were found to be dissimilar to the contested services, the comparison of the conflicting signs was limited to the comparison of the mark sought with the earlier figurative mark. The GC found that the relevant public will break down the word component of the earlier figurative mark into two parts, the first comprising the term “uno”, perceived as a reference to the number “1” in Spanish, and the second made up of the letter “e”. Contrary to what the applicant claimed, the letter “e” will not be perceived as referring to electronics or the internet. Although “e” is a well-known abbreviation for “electric” or “electronic”, as the Office has stated, it will generally be perceived as such only when placed before another word component, usually with a hyphen between the “e” and the other component, not after, as in the present case. It follows from the foregoing that, contrary to the applicant’s assertions and as argued by the Office, taken as a whole, the earlier figurative mark has an average degree of distinctiveness (paras. 61, 62). The GC confirmed that VISUALLY the signs will be perceived as completely different. PHONETICALLY, the GC found that the fact that the component “uno” is repeated in the mark sought may potentially accentuate the phonetic differences between it and the earlier figurative mark, particularly given the length and tone that repetition confers on the mark sought. In those circumstances, the conflicting signs may be phonetically similar, but only to an average degree (paras. 61-63). CONCEPTUALLY, the conflicting signs may be viewed as conveying a reference to the number “one”. However, the mark sought could as a whole be perceived as referring to the concept of connection, junction or joining of units or individuals. In the present case, the component “e” in that mark could be perceived as constituting a linking component

between the components “1” which surround it and refer to the unit. The positioning of the letter “e”, which resembles an ampersand, in the centre, combined with the fact that the component “one” is written as a number and the component “e” as a letter, reinforce that impression. Thus, the mark sought could be perceived as a play on words resembling the expression “1 + 1” or “1&1”. Such a concept, which in essence relates to the joining of a unit, is absent from the earlier figurative mark. The combination of the components “uno” and “e” does not seem to have its own conceptual meaning and, at the most, can be construed as also containing a reference to the number “1”. In those circumstances, it must be found, on the basis of an overall impression, that the conceptual similarity between the conflicting signs is weak. In the global assessment, the GC found that, taking into account the the relevant public’s heightened level of attention, the average degree of distinctiveness of the earlier figurative mark and the lack of visual similarity between the conflicting signs, which will offset their average degree of phonetic similarity and weak conceptual similarity, there is no likelihood of confusion between the conflicting signs within the meaning of Article 8(1) of Regulation No 207/2009 (paras. 71-72).

Case T-361/15; Choice sp. z o.o., v EUIPO; Judgment of 12 April 2016; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Descriptive element, Graphical representation

FACTS: The Board of Appeal confirmed the refusal of a EUTM application represented below for goods in Class 30 and services in Class 43 pursuant to Article 7(1)(c) EUTMR. The applicant filed an action before the General Court (GC) claiming an infringement of Art. 7(1)(c) and 7(1)(b) EUTMR.



Case law



EUTMA

Choice
chocolate & ice cream

SUBSTANCE: The GC dismissed both claims.

With regard to Article 7(1)(c)EUTMR, the concerned goods are chocolate, ice-cream and deserts, whereas the services are related to the production thereof (para. 17). The relevant public is general one and do not have an enhanced level of attention (para. 21). The word elements of the sign are related to the goods (chocolate, ice cream) or laudatory (choice), the combination thereof follows the grammar rules and has a clear meaning (paras. 24-25). The graphical element is not capable of distracting the public from the descriptive message of the word element (para. 28 et seq).

With regard to Article 7(1)(b) EUTMR there is no need to examine this ground for refusal, because one ground mentioned in Article 7(1) EUTMR is sufficient.

Case T-89/15; Niagara Bottling LLC v EUIPO; Judgment of 27 April 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Geographical origin, Lack of reasoning

FACTS: The Board of Appeal (BoA) confirmed the refusal of the word mark NIAGARA for goods in Class 32 pursuant to Article 7(1)(c) and 7 (1)(b) EUTMR with the reasoning that the mark can be perceived as an indication of the geographical origin of the goods.

The applicant filed an action before the General Court (GC) acclaiming an infringement of Articles 7(1)(c) EUTMR, 7(1)(b) EUTMR and failure to state the reasons.

EUTMA

NIAGARA

SUBSTANCE: The GC confirmed the decision of the BoA. As regards signs or indications that may serve to designate the geographical origin or destination of the categories of goods, or the place of performance of the categories of services, in respect of which the protection of an international registration designating the European Union is sought, especially geographical names, pursuant to Article 7(1)(c) EUTMR it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods or services concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may evoke positive feelings. Registration is not permitted of geographical names as trade marks if they designate specified geographical locations that are already famous, or are known for the category of goods or services concerned, and are therefore associated with those goods or services in the mind of the relevant class of persons, on the one hand, and nor is the registration of geographical names, liable to be used by undertakings, that must also remain available to such undertakings as indications of the geographical origin of the category of goods or services concerned, on the other (paras. 15-16 with a reference to settled case-law).

Is not disputed that the word "Niagara" is a geographical term that refers to the River Niagara and, above all, to the waterfalls of the same name known to the relevant public. as the BoA correctly stated, it must be noted that the most important characteristic of a waterfall is its abundance of water. The parties agree that the goods covered by the mark applied for are water-based drinks and include the word "water" in their name. Regarding the nature of the relationship between the sign NIAGARA and the goods at issue, the BoA rightly held that the relevant public will perceive that the goods concerned



Case law

originate from a geographical area in which the Niagara falls are situated (paras. 23-25)

The global reasoning for all goods concerned is acceptable, as all the goods build a homogenous group. The fact that certain of the goods concerned, such as distilled water, purified water, flavoured water; flavoured enhanced water or water with vitamins, have characteristics other than water is irrelevant, inasmuch as their essential element is water. Consequently, the BoA was able to proceed to an overall assessment of the descriptiveness of the mark applied for in relation to the goods concerned, rather than undertaking an assessment for each of those (paras. 32-33).

As the BoA was right to hold that the sign applied for was descriptive of the goods at issue and that, therefore, it could not be registered as an EU trade mark, pursuant to Article 7(1) (c) EUTMR. The case does not need to be examined in the light of Article 7(1)(b) EUTMR (paras 41-42).

Case T-326/15; Dima VerwaltungsGmbH v EUIPO; Order of 20 April 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Three-dimensional mark, Shape of the product

FACTS: The EUTM applicant sought to register a three-dimensional sign consisting of the shape of a box composed of two open cubes, represented below, for goods in Classes 16, 20 and 21. The examiner refused the application on the basis of lack of distinctive character in respect of all the goods. The Fifth Board of Appeal (BoA) dismissed the appeal. The EUTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

SUBSTANCE: The goods covered by the mark applied for are containers and boxes for transport and storage purposes. The GC found that the mark applied for consists of a simple geometrical body and does not depart from the common cubical-shaped containers and boxes on the market. The



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cut outs facilitate the transportation of the box and will be perceived as purely functional elements. The dark stripes represent minimum decorative embellishments or serve for stability of the container. The fact that two side walls are higher

than the transverse walls is not a distinctive feature. Also the fact that the box is not capable of being stacked is just a mere variation of the common shape of boxes or containers (para. 22).

The applicant's argumentation is confined to the allegation that the shape applied for departs significantly from the norm or custom of storage boxes or boxes for transportation as typical boxes did neither have heightened parts with handles nor decorative ornaments. The GC held that it is not unusual that boxes for transportation have handles and that the decorative ornaments are minimal (para. 25). Regarding the applicant's argument that for boxes for transportation usually aspects of practicability, stability and stackability are relevant whereas the mark applied for is characterized by aesthetic aspects, the GC points out that the shape of a not-stackable box represents a mere variation of the common shapes and does not suffice to render the mark applied for distinctive (para. 25).



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New Decisions from the Boards of Appeal

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Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'. e.g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 0219/2004-1

R1783/2015-2 HOMEKIT

RESULT: Decision annulled.

KEYWORDS: Descriptive element, Lack of reasoning, Nature of the goods and services, Reimbursement, Substantial procedural violation; Rule 51 CTMIR, Article 7(1)(c) EUTMR, Article 64(1) EUTMR, Article 75 EUTMR.

FACTS: The applicant sought to register the word mark 'HOMEKIT' for goods and services in Classes 9, 37 and 42. The examiner refused the application on the basis of Article 7(1) (b), (c) and 7(2) EUTMR.

SUBSTANCE: The Board annuls the contested decision due to a substantial procedural error and orders the reimbursement of the appeal fee on the basis of the following.

First, while the specification of the goods and services was modified (for classification purposes) after the first objection was issued, the contested decision does not refer to the new wording. In fact, it does not refer to any of the goods and services at issue (§ 30). Second, no correct link has been established between the alleged meaning of the mark and the goods and services because the examiner's reasoning goes beyond the literal meaning of the sign 'HOMEKIT'. The examiner has tried to guess what the sign was actually used for and in that light has interpreted the meaning of the sign

'HOMEKIT' (§ 31). Third, the contested decision cites some of the goods and services as examples but does not mention the others at all, whereas the specification of the goods and services comprises goods and services which do not form homogeneous categories (§ 32).

Given the insufficient reasoning of the contested decision, the Board finds that a fresh objection to the mark shall be formulated and communicated to the applicant, allowing it the opportunity to comment. In case the new objection is sustained, in light of any observations received from the applicant, a new decision must be issued by the examiner (§ 43).

Consequently, the case is remitted to the examiner for a further examination.

R2531/2015-2 IBIZA FLIRT

RESULT: Decision confirmed.

KEYWORDS: Geographical origin, Legal certainty, Nature of the goods and services, Restriction of the list of goods and services, Scope of proceedings; Article 7(1)(j) CTMR, Article 120(3) CTMR.

FACTS: By international registration No 1 240 486 dated 24 January 2015 designating the European Union, the IR holder sought protection for the word mark 'IBIZA FLIRT' for goods in Class 33. Despite the limitation request, the Office refused protection of the international registration for the European Union on the basis of Article 7(1)(j) CTMR.

SUBSTANCE: The Board confirms that the contested decision rightly refused, on the basis of Article 7(1)(j) EUTMR, protection of an IR which contains a significant part of a protected geographical indication in the EU.

In the present case, 'Hierbas Ibicencas' (Ibiza's herbs) is a protected geographical indication in the European Union,



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for 'aniseed-flavoured spirit drinks', pursuant to Regulation No 110/2008 (§ 31). Inasmuch as the mark 'IBIZA FLIRT' contains the term 'IBIZA' which is the noun corresponding to the adjective 'Ibicensas' in Spanish, 'Ibicensas' constitutes a significant part of the protected geographical indication 'Hierbas Ibicensas'. The part 'Hierbas' (meaning 'herbs') in the protected geographical indication only describes the ingredients of the spirit drinks. It is, therefore, 'Ibicensas' that conveys the geographical indication (§ 36).

The fact that the mark applied for contains the additional word 'FLIRT' does not mean that the public will not interpret the sign 'IBIZA FLIRT' as 'a flirt in Ibiza', contrary to the IR holder's claim. Therefore the mark applied for does not have its own autonomous meaning that would significantly distinguish it from the geographical indication (14/07/2105, T-55/14, Lembergerland, EU:C:2015:486, § 28).

All the claimed goods have the same objective characteristics as 'Hierbas Ibicensas', since they are spirits. As the IR holder argues, their alcoholic strength is stronger than that of 'Hierbas Ibicensas'. But still they belong to the same group of alcoholic beverages having a minimum alcoholic strength by volume of 15%, thus distinct from beverages such as beer, wine and cider which have relatively low alcohol content, typically less than 15% (§ 59).

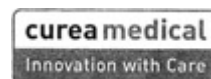
As regards the request for a limitation to 'Vodka', not in accordance with the requirements for the protected geographical indication ('GI'), 'Hierbas Ibicensas' it is inoperable since vodka is not a Hierbas Ibicensas spirit, but just a comparable product, and therefore the end-products in question can never comply with the conditions of the protected geographical indication 'Hierbas Ibicensas'. Since the product 'vodka' in accordance with the requirements for the protected geographical indication ('GI') 'Hierbas Ibicensas' does not exist, it cannot be excluded. This would result in wording which is not comprehensible and would not give a sufficiently clear and precise indication of the goods excluded. The goods for which the protection of the trade mark is sought should be identified with sufficient clarity and precision to



enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought (19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 49). Even if the requested limitation were accepted, it would not change the outcome since 'vodka', a comparable product to 'Hierbas Ibicensas', would remain in the specification (§ 67 - 68).

For the abovementioned reasons the Board dismisses the appeal.

R0664/2015-5



curea medical Innovation with Care (fig.) / Cura Medical (fig.) et al.

RESULT: Decision annulled.

KEYWORDS: Company name, Figurative element, Likelihood of confusion (no), Nature of the goods and services, Nature of use, Phonetic similarity, Proof of use, Purpose of the goods and services, Similarity between the goods and services, Substantiation of earlier right, Use not as registered, Used in the course of trade, Visual similarity, Weak element; Rule 22(3) CTMIR, Article 8(1)(b) EUTMR, Article 8(4) EUTMR, Article 15 EUTMR, Article 15(2) EUTMR.

FACTS: The IR holder sought to register the international registration for the figurative mark 'curea medical Innovation with Care' for, inter alia, goods in Classes 5 and 10. The opponent filed an opposition based on Article 8(1)(b) and 8(4) EUTMR. The opposition was based on three earlier rights: (i) the EUTM for the figurative mark '





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; (ii) the International registration for the verbal mark 'CURAMEDICAL'; and (iii) the company name 'CuraMedical B.V.' used in the course of trade. The Opposition Division upheld the opposition for the contested goods. By decision in case R 1576/2013-5, the Boards of Appeal annulled the contested decision and remitted the case to the Opposition Division for further prosecution. The Board found that the earlier EUTM registration, which had been taken into consideration for assessing the case, had expired and therefore it considered that the examination of the case had to be carried on the basis of the remaining rights. The Opposition Decision adopted a new decision (hereafter the 'contested decision'), based on the opponent's remaining earlier rights upholding the opposition. The IR holder filed an appeal against the contested decision.

SUBSTANCE: Contrary to the Opposition Division, the Board decides that the opposition has to be rejected on the basis of Article 8(1)(b) EUTMR and Article 8(4) EUTMR.

On the proof of use the Board does not agree with the conclusion of the contested decision as regards the nature of use. In the Board's opinion the use of the earlier figurative EUTM,



does not constitute use of the IR, which is the word mark 'CURAMEDICAL' (§ 19). The mark is almost exclusively used in a fanciful 'logo' form, displaying striking figurative elements, which, in the Board's view, sufficiently alter the distinctive character (questionable as it is) of the word mark 'CURAMEDICAL', to conclude that the use of the mark in such a form does not constitute use within the meaning of Article 15, first subparagraph, EUTM. Therefore, in the Board's view the opposition already fails on the grounds of proof of use (§ 20-21).

As regards Article 8(1)(b) EUTMR the Board has found that the Opposition Division completely ignored the fact that the same opposition was dismissed by the German Patent and Trade Mark Office, which, contrary to the contested decision

found no likelihood of confusion between the very same marks in Germany. In this regard the Board notes that it is up to the Office to request a translation of the evidence when it is deemed to be necessary, in the interest of the other party (equity of arms). In the present case the parties must have been familiar with said decision, therefore a translation was not necessary and the Office may not dismiss or disregard evidence which is submitted in one of the five working languages of inter-partes proceedings. It is true that a national judgment or decision is not binding per se, but it may not be dismissed in such a manner without giving substantial reasons for it (§ 32). The Board finds that the arguments of the GPTO decision are sound and in harmony with the legal principles laid down in the EUTMR, and the case-law of the ECJ and GC. The Board also concludes that there is no likelihood of confusion between the contested EUTM and the earlier IR. Regarding Article 8(4) EUTMR the Board finds that according to the registration extract submitted, the name contained therein is Curamedical B.V. and not CuraMedical B.V. This might be a minor mistake, but still, it cannot be denied that the company name is registered in a somewhat different form than it is used. Firstly, the Board notes that even the subject-matter of the opponent's claim has not been identified with the required precision (§ 50). Secondly, regarding the opponent's claims concerning national law, it must be observed that the opponent did not submit even a short extract of the national law, either in Dutch or its translation into English, but merely referred to them in a single sentence (§ 51). When the opponent relies on national law, within the framework of an opposition which is based on Article 8(4) EUTMR, the opponent must provide particulars showing that it is entitled under the national law applicable to lay claim to that right. Rule 19(2) (d) CTMIR requires the opponent to provide the EUIPO not only with particulars showing that it satisfies the necessary conditions, in accordance with the national law of which it is seeking the application, in order to be able to have the use of a European Union trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of



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that law (§ 52). Thus, the opponent did not provide sufficient information concerning the content of the rights invoked and the conditions to be fulfilled in the present case in order for it to be possible to prohibit the use of the contested trade mark under Dutch law, in short, it did not substantiate its claim as regards Article 8(4) EUTMR (§ 56).

Consequently, the opposition is entirely rejected and the appeal allowed.

R1105/2015-4



PORTOBELLO ROAD NO 171 (fig.) / PORTO (GI)

RESULT: Decision annulled.

KEYWORDS: Dissimilarity of the goods and services, Dissimilarity of sign, Figurative Element, Figurative trade mark, Geographical origin, Likelihood of confusion, Nature of the goods and services, Sign used in the course of trade, Substantiation of earlier right; Article 15(2)(b) CTMIR, Article 15(2)(b)(iii) CTMIR, Article 8(4) CTMR.

FACTS: The applicant sought to register the figurative mark 'PORTOBELLO ROAD NO 171' as represented above for 'gin' in Class 33. The opponent filed an opposition based on the appellation of origin protected in Portugal for the sign 'PORTO / PORT' claimed to be used in trade for 'fortified wine'. The Opposition Division upheld the opposition.

SUBSTANCE: The Board does not share the Opposition Division's opinion and notes that the opponent failed to substantiate an earlier right.

It is totally unclear whether the opponent sought to rely on an earlier Portuguese right or a right under EU law or both (§ 14). The only thing which is clear is that the opponent invoked the term 'PORTO' in relation to (fortified) wine as a protected geographic indication with its origin in Portugal. For this it can rely on EU legislation, for which it was not under the duty to submit the text of the relevant legislation, and it is common ground that 'PORTO' is actually registered as a geographical indication for wine at EU level (§ 18).

The opposition is unfounded because the conditions for protection under Article 103(2) of Regulation No 1308/2013 are not fulfilled. This is so for two reasons - firstly, the contested goods 'gin' are not 'comparable' goods to wine (and do not fall under the goods for which Regulation No 1083/2013 establishes protection, and secondly, the contested sign is dissimilar to the protected geographical indication and in any case there is no 'use', 'imitation' or 'evocation' of the protected geographical indication (§ 20-21).

The contested sign refers to a road, the name of which is 'Portobello Road'. It contains a series of further elements both word and figurative. Even if one were to take into account only 'Portobello', the syllable(s) 'Porto' or 'Port' would not be split up from the rest. 'Portobello' is a unique expression and not the combination of the words 'Porto' and 'Bello'. Any reference to an origin from 'Port'-ugal or 'Porto' and any connection with the applicant's 'gin' to 'port wine' is furthermore excluded by the numerous references to the city of London (where Portobello Road is actually situated), the country of England. Moreover it is clearly stated that the product in issue is 'gin' (§ 31-32).

Taking into account the abovementioned findings the Board allows the appeal and rejects the opposition.



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R1490/2015-2



DEVICE OF A SYMMETRICAL FIGURE WITH THREE CONVEX CURVES (fig.)

RESULT: Decision confirmed.

KEYWORDS: Figurative trade mark, Filing date, Function of trade mark, Shape of the products; Rule 71(1) CTMIR, Article 7(1)(b) EUTMR.

FACTS: The application for registering the above figurative mark was rejected because it did not comply with Article 7(1)(b) EUTMR. The applicant filed a notice of appeal. The Board sent the applicant a Communication giving it two months to file comments. The applicant requested an extension of the time-limit that was rejected by the Board since no justification for the necessity of the extension was given.

SUBSTANCE: On substance, the Board confirms the refusal of the sign applied for because of its lack of distinctiveness for all the goods specified.

Rule 71(1) CTMIR provides the Office with discretion whether or not to grant an extension of a specified term (§ 12).

The Board sent the applicant a Communication mentioning that: ‘...it seems that the figurative mark is no more than a simple geometrical figure which is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use. However, it seems that the applicant did not claim the applicability of Article 7(3) EUTMR’ (§ 13).

The Board notes that it was the applicant who argued in the statement of grounds that the contested mark was a unique two-dimensional figurative mark, in a particular colour red, which would be perceived as a logo placed on goods or



packaging. In light of this, the Board is competent to decide upon the matter without further hearing the applicant. Whereas the right to be heard covers all the factual and legal evidence which forms the basis for the act of making the decision, it does not apply to the final position which the administration intends to adopt (§ 14).

The applicant was given two months to file its comments. On the day when the time-limit expired, the applicant requested a two-month extension of the time-limit for ‘documenting incorporation’. The Board does not consider such a mere statement as proper justification for an extension of a time-limit. The content of the Board’s Communication as well the fact that the applicant has had ample time to claim and provide Article 7(3) EUTMR evidence, if it deemed such to be appropriate, the Board rejects the extension request (§ 15).

If the request had been made before the expiry date, the Board might have considered granting the applicant the possibility to file its comments or even file a motivated extension request. This ‘extended’ time-limit, if granted, would start from the date the applicant was notified of the extension request refusal. The period granted would be established by calculating the period between the applicant’s request and the expiry date. However, the applicant filed the extension request on the very last day (§ 16).

With regard to the absolute ground for refusal, the Board concludes that the contested mark is no more than a simple geometric figure. The sign as a whole will be perceived as a mere decorative element which is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark, including the colour red since it is a commonly used signal colour (§ 30-31).

The Board also notes that the contested mark is devoid of distinctive character to the extent it is the graphic appearance of the contested goods. (§ 37).

Consequently, the appeal is dismissed.



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R0043/2016-4 AEROLOGY

RESULT: Decision confirmed.

KEYWORDS: Fee, Renewal, Representative, Restitutio in integrum; Article 47(2) EUTMR, Article 47(3) EUTMR, Article 81 EUTMR, Article 81(1) EUTMR, Article 92 EUTMR, Article 92(2) EUTMR, Article 93 EUTMR, Article 29 CTMIR, Article 77 CTMIR.

FACTS: The EUTM proprietor lodged a request for restitutio in integrum as regards the time-limit for requesting a renewal and paying the renewal fee in respect EUTM No 8 692 678 'AEROLOGY'. The Register Department rejected this request and confirmed the cancellation of the mentioned EUTM.

SUBSTANCE: The Board finds that the request for restitutio in integrum is not well founded, as the EUTM proprietor failed to prove that all due care required by the circumstances was exercised, or that there was even an obstacle at all, which prevented it from paying the renewal fee.

When the EUTM proprietor is represented by a professional representative, the standard of due care under Article 81 EUTMR lies on the representative (28/06/2012, T-314/10, 'Cook's', EU:T:2012:329, § 18) (§ 13).

In the present case, the representatives did not deny that they had received the communication from the Office of 4 August 2014. Nor did they indicate how they had acted on this communication. This conclusion is not affected by the letter the representatives sent on 31 May 2006 – that letter does not contain any resignation of Kilburn & Strode LLP as representatives. Moreover, they could not have resigned since the EUTM proprietor, a US company, was obliged to have a professional representative with its seat in the EU pursuant to Article 92(2) EUTMR. Simply, they remain the EUTM proprietor's representatives and act on its behalf to this day (§ 14-16).

With respect to the abovementioned facts, the Board dismisses the appeal.



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The entry and nomination period for the [DesignEuropa Awards 2016](#) has now closed.

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We would also like to thank our stakeholders and partners in this new award initiative, which aims to celebrate and promote design as a key driver of innovation and growth.

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