

# Alicante News

Up to date information on IP and EUIPO-related matters

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## Editorial



### Trade marks and geographical indications: future perspectives conference at EUIPO

The EUIPO, together with the Directorate General of Agriculture and Rural Development at the European Commission (DG AGRI) is jointly organising a major conference on trade marks and geographical indications, to take place in EUIPO's headquarters in Alicante on 3-4 October.

The conference covers a wide range of topics, with a strong emphasis on the interactions between these two different intellectual property rights.

The conference will hear the experiences of speakers in respect of the ex-officio examination under absolute grounds for refusal of trade mark applications against prior geographical indications, highlighting the important issues involved, including scope of protection, concepts of "evocation" and "comparable products," etc.

Also up for discussion will be oppositions between an earlier geographical indication and a trade mark, highlighting important issues like entitlement to act, scope of protection and reputation, among others.

The case law of the European Court of Justice on the relation between trade marks and geographical indications will also be discussed, in areas like the scope of protection under absolute and relative grounds for refusal, the function of collective trade marks which designate a geographical origin and concepts from geographical indications law that have been litigated.

Other topics to be explored include: the protection of geographical indications in the EU and abroad; non-agricultural geographical indications and the enforcement of geographical indications.

The entire event is designed to encourage active discussion among participants about the challenges and the opportunities they face, either as institutional stakeholders, or as right owners/beneficiaries.

The conference is free of charge, and registration is available through the [conference web page](#). The language of the conference is English. For any additional information or queries, please contact the conference team at [TMGIconference@euipo.europa.eu](mailto:TMGIconference@euipo.europa.eu)

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The legislative reform of the EUTM system has introduced some changes in respect of the procedural aspects of claims under Article 7(3) EUTMR.

As is known, under Article 7(3)EUTMR it is possible to claim the acquisition of distinctive character as a consequence of the use which has been made of a trade mark when it is either devoid of any distinctive character, descriptive and/or have become customary in the current language or in the bona fide and established practices of the trade (for further details, please see the Guidelines Part B, Examination, Section 4, Absolute Grounds For Refusal, Chapter 14, Acquired Distinctiveness Through Use).

First of all, it is important to remind that the Office will only examine the alleged acquired distinctiveness of a trade mark according to Article 7(3) EUTMR when the applicant has made an explicit claim in that regard. Moreover, the claim will obviously be examined only to the extent that the Office considers that the mark is not inherently distinctive. Otherwise, the claim will be disregarded and the mark accepted for registration

### Types of claim

Until the former regime, there was only one type of claim for acquired distinctiveness. The legislative reform has nevertheless introduced the possibility of making either a principal claim or a subsidiary one.

Which are the differences between them?

In a principal claim, the applicant relies on the acquired distinctive character of the mark from the outset. To give an example: the applicant files the mark 'XYZ' which he is convinced that has acquired distinctive character through use.

In turn, in a subsidiary claim, the applicant wishes to focus first on the inherent distinctive character of the mark and only when such distinctiveness has definitely been rejected by the Office he would go through the path of the acquired distinctive character. Again as an example: here the applicant mainly and firstly relies on the inherent distinctiveness of the mark 'XYZ' and only in the event that the Office finally decides that this is not the case, he would then show that the mark has acquired distinctive character through use.

### When and where to submit the claim

Claims under Article 7(3) EUTMR (either principal or subsidiary) can be made at different points in time, but they both must necessarily be made during examination proceedings. Claims of acquired distinctiveness that are raised for the first time before the Boards of Appeal will be dismissed, as they are now expressly excluded by Article 27(3)(a) EUTMDR.

a) The claim that the trade mark has acquired distinctive character through use can be made in

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### Getting your Article 7(3) EUTMR claim right

The EUTM application, together with an indication of whether the claim is meant as a principal or a subsidiary one (Article 2(2) EUTMR). This option is available in the electronic advanced form provided by the Office.

b) However, applicants can still claim acquired distinctiveness at a later stage, as long as the time period to submit observations in reply to the first objection letter of the Office has not expired. It can be done either in a separate declaration or as a part of the response to the objection letter. In that case, the applicant will receive first the opinion of the Office as regards the inherent distinctive character of the mark (through a letter of provisional refusal) before making a claim under Article 7(3).

### Indication of the type of claim

The applicant must specify whether the claim is principal or subsidiary. If the claim or the type of claim is not clear, a deficiency letter will be issued inviting the applicant to clarify this aspect. When the nature of the claim is not clarified within the granted time limit or when the applicant does not reply, the Office will consider that no claim under Article 7(3) EUTMR has been filed.

An applicant who has already submitted a valid claim can change the nature of the claim (principal/

subsidiary) but not later than in the reply to the first objection letter.

### What to expect when a principal claim has been filed?

If the applicant has made a principal claim, the Office will decide on both, the inherent distinctiveness and on the acquired distinctiveness at the same time: the Office's decision will deal with both aspects.

The procedure is slightly different depending on the moment on which the claim is actually made (together with the application or in reply to the objection letter):

a) When the claim has been made in the EUTM application and the mark is objected to according to Article 7(1)(b), (c) and/or (d) EUTMR, then the applicant will be invited through the objection letter both to provide evidence of use and to submit its observations within a specified deadline.

b) When the claim is made in reply to the first objection letter, the subsequent steps will vary depending on whether or not the applicant has already submitted the evidence in support of its claim:

- Where no evidence has been submitted: the Office will issue a communication requesting the applicant to file the evidence within two months. At this stage, the Office will not address any arguments related to the inherent distinctiveness raised by the applicant.
- Where the evidence of acquired distinctiveness has already been filed, no further request will be

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made to the applicant to file evidence.

As soon as the Office has received the corresponding evidence, it will analyse the case as a whole (inherent and acquired distinctiveness).

If the Office is convinced by the applicant's arguments on inherent distinctiveness, the mark will be accepted and it will not enter on examining the evidence of use.

In turn, if the Office is not convinced by the applicant's arguments that the mark is inherently distinctive (or if no arguments have been presented), it will examine the evidence of use:

- If the applicant did not submit any evidence or if the evidence is not sufficient, the Office will issue a refusal decision that addresses the applicant's arguments on inherent distinctiveness as well as the claim of acquired distinctiveness and related evidence. This decision is appealable on both inherent distinctiveness and acquired distinctiveness by use.
- If the Office finds that the evidence submitted is sufficient, it will issue a communication informing the applicant that the mark is acceptable according to Article 7(3) EUTMR. The EUTM application will proceed accordingly to publication.

### What to expect when a subsidiary claim has been filed?

When the claim has been made as a subsidiary one, the examination of the application will be

divided into two phases. First the Office will decide only on the inherent distinctiveness of the sign and subsequently (should it be necessary), it will deal only with the claim of acquired distinctiveness.

a) Phase 1: assessment of inherent distinctiveness. When the Office is not convinced by the applicant's observations on the inherent distinctiveness of the mark, or when no observations were filed in reply to the objection raised by the Office, it will issue a decision of refusal in respect of the inherent distinctiveness of the EUTM application, which can be appealed. At this stage, the evidence of acquired distinctiveness is not examined even if it has already been submitted.

b) Phase 2: assessment of acquired distinctiveness. Once the decision on inherent distinctiveness is final (taking into account all the possibilities for appeal), the Office will proceed with this second phase by informing the applicant of the resumption of the proceedings and setting a time limit for submission of the evidence of use. Any arguments on inherent distinctiveness of the sign at this stage will be dismissed as not pertinent, since the decision on inherent distinctiveness has become final.

- If the evidence of acquired distinctiveness is sufficient, the sign will be accepted pursuant to Article 7(3) EUTMR and the Office will issue a communication informing the applicant. The application will proceed accordingly to publication.
- If no evidence is submitted or if it does not overcome the objection(s), a refusal decision in respect of the acquired distinctiveness will be

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issued. This decision can be appealed.

It is therefore up to the applicant to decide when to claim for acquired distinctiveness and especially under which type of claim. It will depend on its interests, for example the swiftness of the proceedings of registration, the difficulties in gathering evidence or even the importance of having a final decision on the inherent distinctiveness of the mark.

Please note that the Office has updated the [FAQ](#) on its Website and you now have a specific section dedicated to acquired distinctiveness.

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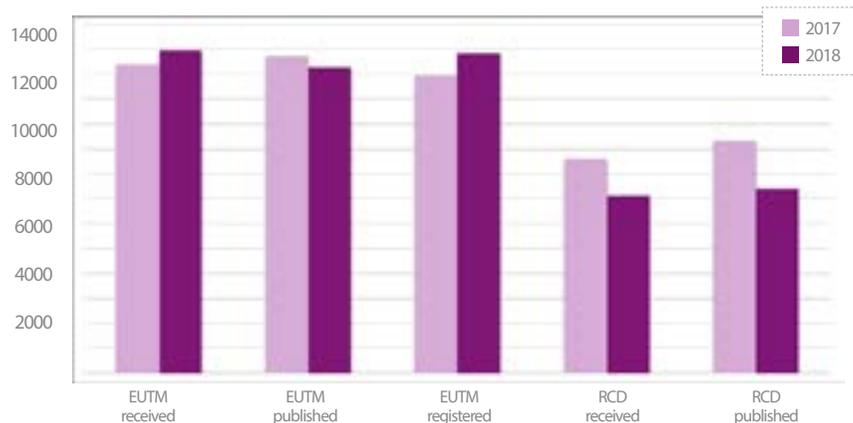


## Statistical Highlights



Monthly statistical highlights May*	2018	2017
European Union Trade Mark applications received	12 943	12 384
European Union Trade Mark applications published	12 288	12 714
European Union Trade Marks registered (certificates issued)	12 834	11 933
Registered Community Designs received	7 110	8 594
Registered Community Designs published	7 407	9 335

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



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## European Cooperation: Implementation and upgrades to ISO 9001:2015

The [Portuguese Intellectual Property Office \(INPI\)](#) and [The Hellenic Industrial Property Organisation \(OBI\)](#) have successfully passed the certification audit which attests that their Quality Management Systems (QMS) have been upgraded to the newest version of the [ISO 9001 \(2015\)](#) standard. [The State Patent Bureau of the Republic of Lithuania \(SPB\)](#) has also carried out the first complete implementation within the project using an IT system in order to support the implementation of the QMS.

The implementation at SPB will also facilitate the QMS maintenance by simplifying documentation, risk management and KPIs.

The audits were carried out by the certification bodies; [APCER, DNV – GL](#) and [EUROCERT](#) respectively. The overall outcome of the process was positive, showing the success of the implementations.

All upgrades were carried out within the framework of the [European Cooperation](#) projects (ECP 5 – “Support for Management Systems for IP Offices”).

The implementations included intensive knowledge transfer among Quality and Risk assessment experts from the [Spanish Patent and Trade Mark Office \(SPTO\)](#), the [Danish Patent and Trade Mark Office \(DKPTO\)](#) and EUIPO, which will also serve to benefit the remainder of the national and regional EU IP Offices participating in the project.

## Joint Statement of the 20th EU-China Summit welcomes launch of IP Key China

The 20th EU-China Summit was held on 16 July 2018, at which the EU and China agreed to further develop the EU-China strategic partnership. H.E. Li Keqiang, Premier of the State Council of the People’s Republic of China, H.E. Donald Tusk, President of the European Council, and H.E. Jean-Claude Juncker, President of the European Commission, met in Beijing for the Summit.

The Joint Statement of the Summit, issued by EU and China, underlined that: “Both EU and China sides welcomed the successful launch of IP Key China and the signature of the Action Plan Concerning EU-China Customs Cooperation on IPR (2018-2020). The two sides agreed to reinforce their joint efforts to fight IPR infringements, in particular in mutually agreed priority areas.”

The 8th EU-China IPR Working Group Meeting took place in Shanghai from 5th- 8th June, in the context of the [Action Plan Concerning EU-China Customs Cooperation on IPR \(2018-2020\)](#).

The IP Key China project was officially launched on the 17th January 2018.

The full version of the Joint Statement can be accessed [here](#).

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### 2017 Case-Law Overview: from the General Court and Court of Justice

The Legal Practice Service of EUIPO has prepared an overview of the Case-Law from the General Court (GC) and Court of Justice (CJ) in Luxembourg with regard to trade mark and design matters. This useful legal resource is published for information purposes, and includes abstracts of judgments, preliminary rulings and important orders rendered by GC and the CJ in 2017.

The information is arranged in categories for easier browsing.

Users can find more detailed information in [eSearch Case Law](#), our search tool for decisions of the Office, GC and CJ judgments and from the national courts.

[Overview of General Court / Court of Justice 2017](#)

### Visual search extended in TMview

TMview's visual search facility, which allows users to search for trade marks in the world's largest free, online trade mark database, has been extended.

Trade marks registered at the national intellectual property offices of Spain, Bulgaria and Lithuania, as well as those of the Greek Trade Mark Office are now all fully searchable using images.

As a result, it is now possible to search nearly seven million trade marks within TMview via visual search.

In 2017, an image search facility was implemented within TMview for trade marks from the UK Intellectual Property Office, the French Intellectual Property Office and the EUIPO on a pilot basis.

The extended visual search is a result of the work undertaken through European Cooperation at the EUIPO.

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

C-85/16 P and C-86/16 P (joined cases); KENZO ESTATE / KENZO; Kenzo Tsujimoto v EUIPO; Judgment of 30 May 2018; EU:C:2018:349; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Due cause, Evidence of use, Proof of use, Reputation, Similarity of the signs, Unfair advantage

FACTS: The IR holder designated the EU for two word marks KENZO ESTATE covering, respectively, goods in Class 33 and goods and services in Classes 29, 30, 31, 35, 41 and 43. Two oppositions based on the earlier word mark KENZO, registered for, inter alia, goods in Classes 3, 18 and 25 were filed by the opponent pursuant to Article 8(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) in respect of all the goods and services applied for. The Opposition Division (OD) dismissed both oppositions. The Board of Appeal (BoA) fully upheld the opponent's appeal to which Case C-85/16 P refers and partially upheld the appeal to which Case C-86/16 P refers. The IR

holder brought two actions before the General Court (GC) for the annulment of the BoA decisions. The GC dismissed both appeals. The IR holder filed two appeals before the Court of Justice of the European Union (CJ) relying on two pleas in law: infringement of Article 76(2) and of Article 8(5) of Regulation (EC) No 207/2009. Cases C-85/16 P and C-86/16 P were joined for the purposes of the procedure and of the judgment. The CJ dismissed the appeals.

SUBSTANCE: REGARDING THE FIRST PLEA IN LAW: the CJ reiterates the case-law whereby the BoA enjoys discretion under Article 76(2) of Regulation (EC) No 207/2009, in connection with Rule 50(1) of the EUTMIR, to decide whether or not to take into account additional or supplementary facts or evidence that were not submitted within the time limits set by the OD (para. 44). The CJ endorsed the findings of the GC according to which proof of use and proof of reputation are indissociably linked and that only an excessive and illegitimate formalism would dictate that the proof of use could not be adduced as proof of reputation (para. 47). REGARDING THE SECOND PLEA IN LAW: the CJ endorsed the finding of the GC, according to which the trade marks were similar (para. 59); the word 'estate' lacked distinctiveness (para. 61); the GC did not make an error in law by taking into account evidence, concerning the

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reputation of the earlier mark, submitted out of time, since the GC's assessment did not relate to the late submission of that evidence (para. 68). Furthermore, the mere fact that a term 'kenzo' corresponds to the appellant's forename is irrelevant to the issue whether the use of that term constitutes due cause within the meaning of Article 8(5) of Regulation (EC) No 207/2009 since the weighing of the different interests involved cannot undermine the essential function of the earlier mark, which is to guarantee the origin of the product (para. 94).

C-519/17 P and C-522/17 P to C-525/17 P (joined cases); Master .../MASTERS COLORS PARIS; L'OréalSA v EUIPO; Judgment of 30 May 2018; EU:T:2018:348; Language of the case: FR

RESULT: Action upheld (GC judgment annulled)

KEYWORDS: Lack of reasoning

FACTS: the General Court (GC) dismissed the EUTM applicant's action for annulment against the decisions of the Board of Appeal (BoA). Previously, the BoA also dismissed the EUTM applicant's appeal against the decisions of the Opposition Division (OD), finding likelihood of confusion between the word marks applied for and the earlier figurative mark, resulting in the protection of identical goods (Class 3: eye makeup products) pursuant to Article 8(1)(b) of Regulation (EU) 2017/1001 of the European Parliament and

of the Council of 14 June 2017 on the European Union trade mark. The EUTM applicant appealed against the GC's orders to the Court of Justice of the European Union (CJ), relying on two pleas in law: (i) distortion of facts and; (ii) infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade mark
<p>Master Smoky Master Shape Master Precise Master Duo Master Drama</p>	

SUBSTANCE: the CJ found a breach of the duty to provide coherent and complete reasoning (para. 74). This related to the GC's finding that the applicant did not submit any argument challenging the BoA's finding that 'masters' constitutes the most distinctive element of the earlier mark. The reasons provided by the GC were equivocal and incomplete, resulting in the EUTM applicant failing to understand the decision's reasoning. Further, the CJ was unable to exercise judicial review (paras 73-74). The CJ also found a lack of reasoning in the GC's orders as they did not fully answer the applicant's complaint and failed to provide an explanation of its response (paras 81,

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82). This regarded the EUTM applicant's argument that the BoA had not examined the conflicting marks as a whole. The decision was annulled and the case was referred back to the GC.

C-32/17P; PARKWAY; Apcoa Parking Holdings GmbH v EUIPO; Judgment of 6 June 2018; EU:T:2018:396; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: the applicant sought to register two marks, PARKWAY and the figurative mark below, as EUTMs for the services in Classes 35, 36, 39, 42 and 45. The Office refused the applications pursuant to Article 7(1)(b) and (c) EUTMR and Article 7(2) EUTMR, finding that they are descriptive and devoid of distinctive character. The applicant appealed against the Office's decision and requested a limitation of the marks' services. The Board of Appeal (BoA) dismissed the appeal, finding that the mark was descriptive and non-distinctive. The BoA considered that these signs could designate the characteristics of the services concerned and that the figurative mark's graphic configuration did not confer distinctive character on the sign. Thus, the BoA confirmed the Office's decisions based on Article 7(1)(b) and (c) EUTMR. The applicant appealed to the General Court (GC), relying on four pleas in law: (i) procedural defect, (ii) infringement of Article 7(1)(c) EUTMR, (iii)

distortion of the facts, and (iv) infringement of the unitary character of an EUTM.

EUTM application



SUBSTANCE: (i) First plea in law. The GC considered that it was sufficiently informed by the submitted documents to decide the appeal and reject it as manifestly lacking any foundation in law (para. 23). (ii) Second plea in law. The GC held that while the term was added to the stations' proper names, it was not fanciful. Rather, this confirmed the descriptive use of the latter regarding the stations' offer for parking (para. 35). The GC, in line with the Office and the BoA, cited examples of the term's use, namely 'East Midlands Parkway', 'Bristol Parkway', 'Southampton Parkway', 'Warwick Parkway', 'Liverpool Parkway', and 'Stratford-upon-Avon Parkway'. This confirmed public understanding, particularly in the United Kingdom, that the term refers to station parking

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(para. 36). The GC held that neither the annex nor the other annexed documents covered the figurative mark's origin or the meaning of its logo. As the applicant's arguments did not identify the annex that they referred to, the GC could not exercise its review powers (para. 39). Then the GC assessed the figurative mark, namely by the way the colours in 'park' and 'way' were written, and the representation of the two arrows using the same colours. Lastly, the GC followed the BoA's finding that the figurative sign was limited to the verbal element 'parkway' through a simple graphic representation (para. 41). (iii) Third plea in law. The GC found that, according to the definitions of the Oxford Dictionary and the Oxford English Dictionary, 'parkway' means a railway station with ample parking space (para. 50). The GC found that it could not be criticised for misrepresenting the definition of 'parkway' as it is precisely the same definition used by the applicant (para. 51). (iv) Fourth plea in law. According to well-established case-law, the EU's trade mark system is an autonomous system that is independent of any national system. Therefore, the registration of an EUTM does not replace national registration in one or more Member States. The EU's trade mark regime coexists with existing systems in all Member States (para. 59).

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

T-760/16; Fahrradkörbe; Basil BV v EUIPO; Judgment of 17 May 2018; EU:T:2018:277; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Catalogue, Disclosure within the EU, Freedom of designer, Individual character, Informed user, Immaterial details, Overall impression, Res judicata

FACTS: the RCD proprietor registered the design shown below as an RCD with the product indication baskets for bicycles in Class 03-01 of the Locarno Classification. An invalidity application was filed pursuant to Article 25(1)(b) CDR in conjunction with Article 52 CDR, relying on the disclosure of an earlier design. The Invalidity Division (ID) upheld the application insofar as it found that the contested design had no individual character. The RCD proprietor appealed and the Board of Appeal (BoA) dismissed the appeal and confirmed the ID's decision. The RCD proprietor appealed to the General Court (GC) relying on three pleas in law: (i) infringement of Article 52(3) CDR, (ii) infringement of Article 7 CDR, and (iii) infringement of Article 6 CDR.

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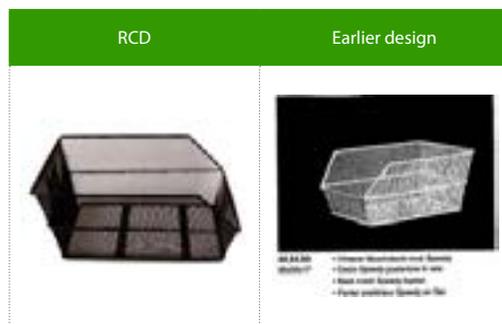
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SUBSTANCE: (i) the application is admissible for the following reasons: (a) according to its wording, Article 52(3) CDR exclusively applies to Community Design courts and not to EUIPO decisions (paras 19-20); (b) the fact that the invalidity applicant in the present case is closely associated with a former applicant (client relationship) and both applications are closely linked does not amount to res judicata (paras 22-24); (c) Article 52(3) CDR cannot be applied in the event of a prior decision by the EUIPO (paras 28-30); furthermore, given the level of control regarding validity of the designs prior to registration, the invalidity proceedings have a different position in the CDR system than the one they occupy in the EUTMR system (substantial control) (paras 29-34). (ii) The earlier design, specifically the bicycle basket designated by the term 'Speedy', is pictured with the item number 34.54.50 in an original submitted copy of the applicant's catalogue. The invalidity applicant

submitted numerous invoices that it had issued to various companies in Italy. These invoices, dated between 2000 and 2002, show the sale of a 'Speedy' bicycle basket with the item number 34.54.50 (para. 43). The same bicycle basket is pictured in four catalogues of other companies from 2001 and 2002, and it also appears in an image of a stand at the Cologne trade fair (para. 44). Therefore, the disclosure of the earlier design was duly proven before the filing date of the application for registration (para. 45). (iii) The contested RCD lacks any individual character given in particular that (a) while the designer's degree of freedom in the case of bicycle baskets is limited by technical specifications (bicycle baskets must be fastened to the bicycle and be able to hold objects without them falling out while cycling), it was possible to choose between a wide variety of colours, materials and shapes for the basket; and (b) the opposing designs coincide in various features (paras 80-85).

T-675/16, T-676/16, T-860/16; mycasrd2go; Wirecard AG v EUIPO; Judgment of 15 May 2018; EU:T:2018:267; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element, Distinctive element, Figurative element, Figurative trade mark, Lack of reasoning, Nature of goods and services

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**FACTS:** the applicant sought to register the word mark mycard2go, and the figurative marks shown below as EUTMs for goods and services in, inter alia, Classes 9 and 36. The Office refused the applications pursuant to Article 7(1)(b) and (c) EUTMR, as these were found to be, as a whole, descriptive. The applicant appealed and the Board of Appeal (BoA) dismissed the appeal, finding that the marks were descriptive and non-distinctive. The applicant appealed to the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR.

EUTM applications

mycar2go

mycard2go

mycard2go

**SUBSTANCE:** (i) Relevant public. As the contested mark is composed of English words, the assessment must take into account the English-speaking public in the EU (paras 22 and 25). The goods and services target both the general public

and also specialist consumers, such as businesses, with a relatively high level of attention. The services are of a financial nature falling within Class 36 and have a certain economic importance to the applicant because they concern their economic and financial assets (para. 26). Meaning of the mark. 'my', 'card' and 'go' are basic English words. The number '2' is often used in advertising as a synonym for 'to' (para. 34). Therefore, the sign will be understood immediately, without further considerations, as 'my card to go'. This means that it is ideal for taking it away to pay for various goods and services, while it presents no originality or contradiction (paras 34-36). There is a sufficiently direct and specific link between the sign and the goods or services concerned from the point of view of the targeted public (para. 37). However, in T 675/16, the BoA's decision lacked reasoning regarding the assessment of the link between the mark and the goods and services concerned. This is despite the other parallel decisions being contained in such reasoning (paras 44-45).

T-803/16; SALMEX; Glaxo Group Ltd v EUIPO; Judgment of 6 June 2018; EU:T:2018:330; Language of the case: EN

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

**KEYWORDS:** Competence of the Boards, Examination of facts ex officio, Right to be heard, Scope of proceedings

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**FACTS:** the applicant sought a declaration of invalidity for the contested EUTM based on earlier national 3D marks registered for goods in Classes 5 and 10. The earlier national marks specifically included the French trade mark registered inter alia for inhalers in Class 10. This was pursuant to Article 60(1)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark in conjunction with Article 8(1)(b) and Article 8(5) EUTMR. The EUTM proprietor requested proof of use of the earlier marks. The Cancellation Division (CD) upheld the application for invalidity as it found: (i) that genuine use of the earlier French mark had been established regarding inhalers and; (ii) likelihood of confusion existed between the conflicting marks. Upon the EUTM proprietor's appeal, the Board of Appeal (BoA) upheld the appeal and annulled the CD's decision on the ground that it found that no genuine use of the earlier mark had been established. However, the BoA examined the issue of genuine use of the earlier marks by its own motion. The applicant filed an action for annulment of the BoA decision before the General Court (GC).



**SUBSTANCE:** the GC confirmed previous case-law, stating that the issue of genuine use of earlier marks is a specific and preliminary question, which must be specifically raised by the parties before the BoA to become the subject matter of the appeal (paras 27, 31). Therefore, by examining and deciding upon the issue of genuine use, in the absence of any request made to that effect by the parties to the proceedings before it, the BoA infringed Article 71(1) EUTMR (para. 17). Thus, the BoA acted outside its competence (para. 31). As this is a matter of public policy, it must be raised by the GC ex officio even in the absence of any request to that effect by the applicant for annulment (para. 21).

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**KEYWORDS:** Evidence of use, Extent of use, License agreement, Nature of use, Place of use, Proof of use

**FACTS:** the word sign DOLFINA was registered as an EUTM for goods in Classes 3, 18 and 25. A revocation application was filed pursuant to Article 58 EUTMR, submitting that the mark had not been put to genuine use within a continuous period of five years. The Cancellation Division (CD) partly upheld the revocation application, namely for all the goods covered with the exception of T-shirts and caps in Class 25. The Board of Appeal (BoA) upheld the revocation applicant's appeal, finding that the evidence regarding the place and extent of use of the mark for T-shirts and caps was insufficient. The EUTM proprietor filed an action before the General Court (GC) relying on two pleas in law: (i) lack of an adequate statement of reasons by the BoA and (ii) wrong appraisal of the evidence of use.

**SUBSTANCE:** (i) Reasoning of decision. A clerical error in the contested decision did not prevent the parties from properly identifying evidence which the reasoning at issue was based on (para. 28). The GC held that this error could not deprive either party of the opportunity to defend its rights (para. 28). (ii) Place of use. From the photographs, it could not be established whether the EUTM had been used in the EU (para. 50). (iii) Extent of use. The submitted evidence relating to

the mass consumption of T-shirts and caps did not establish sufficient extent of use to prove genuine use (para. 76).

T-675/16, T-676/16, T-860/16; mycard2go; Wirecard AG v EUIPO; Judgment of 15 May 2018; EU:T:2018:267; Language of the case: DE

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

**KEYWORDS:** Descriptive element, Distinctive element, Figurative element, Figurative trade mark, Lack of reasoning, Nature of goods and services

**FACTS:** the applicant sought to register the word mark mycard2go, and the figurative marks shown below as EUTMs for goods and services in, inter alia, Classes 9 and 36. The Office refused the applications pursuant to Article 7(1)(b) and (c) EUTMR, as these were found to be, as a whole, descriptive. The applicant appealed and the Board of Appeal (BoA) dismissed the appeal, finding that the marks were descriptive and non-distinctive. The applicant appealed to the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR.

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mycar2go

mycard2go

mycard2go

**SUBSTANCE:** (i) Relevant public. As the contested mark is composed of English words, the assessment must take into account the English-speaking public in the EU (paras 22 and 25). The goods and services target both the general public and also specialist consumers, such as businesses, with a relatively high level of attention. The services are of a financial nature falling within Class 36 and have a certain economic importance to the applicant because they concern their economic and financial assets (para. 26). Meaning of the mark. 'my', 'card' and 'go' are basic English words. The number '2' is often used in advertising as a synonym for 'to' (para. 34). Therefore, the sign will be understood immediately, without further considerations, as 'my card to go'. This means that it is ideal for taking it away to pay for various goods and services, while it presents no originality or

contradiction (paras 34-36). There is a sufficiently direct and specific link between the sign and the goods or services concerned from the point of view of the targeted public (para. 37). However, in T 675/16, the BoA's decision lacked reasoning regarding the assessment of the link between the mark and the goods and services concerned. This is despite the other parallel decisions being contained in such reasoning (paras 44-45).

T-882/16; DOLFINA; Sipral World, SL v EUIPO; Judgment of 7 June 2018; EU:T:2018:336; Language of the case: EN

**RESULT:** Action dismissed

**KEYWORDS:** Evidence of use, Extent of use, License agreement, Nature of use, Place of use, Proof of use

**FACTS:** the word sign DOLFINA was registered as an EUTM for goods in Classes 3, 18 and 25. A revocation application was filed pursuant to Article 58 EUTMR, submitting that the mark had not been put to genuine use within a continuous period of five years. The Cancellation Division (CD) partly upheld the revocation application, namely for all the goods covered with the exception of T-shirts and caps in Class 25. The Board of Appeal (BoA) upheld the revocation applicant's appeal, finding that the evidence regarding the place and extent of use of the mark for T-shirts and caps was insufficient. The EUTM proprietor filed an action

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before the General Court (GC) relying on two pleas in law: (i) lack of an adequate statement of reasons by the BoA and (ii) wrong appraisal of the evidence of use.

**SUBSTANCE:** (i) Reasoning of decision. A clerical error in the contested decision did not prevent the parties from properly identifying evidence which the reasoning at issue was based on (para. 28). The GC held that this error could not deprive either party of the opportunity to defend its rights (para. 28). (ii) Place of use. From the photographs, it could not be established whether the EUTM had been used in the EU (para. 50). (iii) Extent of use. The submitted evidence relating to the mass consumption of T-shirts and caps did not establish sufficient extent of use to prove genuine use (para. 76).

T-419/17; VSL#3; Mendes SA v EUIPO; Judgment of 18 May 2018; EU:T:2018:282; Language of the case: IT

**RESULT:** Action dismissed

**KEYWORDS:** Acronym, Deceptive element, Descriptive element

**FACTS:** The EUTM owner registered the word mark VSL#3 as an EUTM for goods in Class 5. An application for revocation was filed pursuant to Article 51(1)(b) and (c) of Regulation (EU) 2017/1001 of the European Parliament and of

the Council of 14 June 2017 on the European Union trade mark. The Cancellation Division (CD) dismissed the application for revocation. The Board of Appeal (BoA) dismissed the revocation applicant's appeal. It found that the revocation applicant had neither provided sufficient evidence to demonstrate that the sign had become the common name in trade of the products for which it was registered, nor did it prove that the sign was liable to mislead the public concerning the nature or quality of the goods. The revocation applicant filed an action before the General Court (GC) relying on two pleas in law: infringement of Article 51(1)(b) and (c) EUTMR.

**SUBSTANCE:** Relevant public. The relevant circles for probiotic preparation for treating gastrointestinal disorders marketed under the contested mark include, in addition to pharmacists and doctors, the end consumers, given that the product does not require a medical prescription. The scientific community is not part of the relevant circles, playing no role in the communication process between the vendor and the purchaser (para. 40). Descriptive element. It was not proven that 'VSL' should be understood as being the acronym of 'Very Safe Lactobacilli' by the relevant circles, nor that the contested mark has become the common name in trade for the product. Therefore, the contested mark does not convey a clear message concerning the product or its characteristics (para. 61). Deceptive

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element. Given that the mark is not the common name in trade for the product and that it contains no descriptive indication of that product or of its characteristics, it is not capable of giving rise to actual deceit or of a sufficient risk that would deceive the consumer (para. 57).

T-299/17; 1000, T-300/17; 3000, T-301/17; 2000, T-302/17; 6000, T-303/17; 4000, T-304/17; 5000; Sata GmbH & Co. KG v EUIPO; Judgment of 29 May 2018; EU:T:2018:309; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Lack of reasoning, Numerical mark, Principle of legality

FACTS: the EUTM proprietor registered the word marks 1000, 2000, 3000, 4000, 5000 and 6000 as EUTMs for goods in Class 7 (paint spray guns). An invalidity application was filed pursuant to Article 59(1)(b) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The Cancellation Division (CD) upheld the invalidity application and the EUTM proprietor appealed. The Board of Appeal (BoA) dismissed the appeal as it found that the mark was descriptive and non-distinctive. The EUTM proprietor appealed to the General Court (GC) relying on four pleas in law: (i) infringement of Article 94 EUTMR; (ii) infringement of Article 7(1)(c) EUTMR; (iii) infringement of Article 7(1)(b) EUTMR;

and (iv) infringement of the general principles of sound administration and equal treatment.

SUBSTANCE: (i) the first plea in law (violation of the duty to state reasons) is unfounded as the BoA decision contained reasoning. The objections and arguments intended to establish that the statement regarding the definition of the relevant public and the descriptiveness of the mark and its material correctness are irrelevant in the context of the duty to state reasons (para. 68). In any case, the previously mentioned statement is well founded. Although succinct, the reasoning was sufficient (as well as clear and precise), all the more so since the EUTM proprietor was well aware of the context as the issue had already been raised before the CD (paras 71-73). (ii) The relevant public is composed both of professionals and the general public with a higher level of attention. The relevant territory is the EU as '1000', '2000, 3000', '4000', '5000' and '6000' exist in all EU languages (paras 36-37). The consumers, irrespective of whether they are members of the general public or specialists, are accustomed to the required operating pressure being specified on paint spray guns. Pounds per square inch (PSI) is a common unit used in the United Kingdom for measuring pressure (para. 38). There are paint spray guns with an operating pressure of up to 6 800 psi on the market. Irrespective of whether professional consumers possess the technical knowledge and know the detailed technical

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conditions of various types of paint spray guns, '1000', '2000', '3000', '4000', '5000' and '6000' are perceived as a description of the pressure by at least part of the relevant public, no matter what pulverisation technology is used, and regardless of the fact that the pressure indication ('psi') is not present. There is a sufficient link between the signs and the characteristics of the goods (paras 44-46). (iii) The descriptive signs are also devoid of any distinctive character in relation to those goods (para. 53). (iv) As the BoA examined the marks fully and according to the specific circumstances of the cases, there is no breach of the principles of legal certainty or sound administration (para. 60).

## New Decisions from the Boards of Appeal

EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). Decisions of the Presidium of the Boards of Appeal can be found [here](#) and the EUIPO Official Journal [here](#). For best results, please use either the Mozilla Firefox or Google Chrome browsers.

### I. Cases referred to the Grand Board

[07/06/2018, BoA Presidium decision \(referral of case R-1404/2015-5, EL TOFIO El Sabor de](#)

[Canarias \(fig.\), to the Grand Board\)](#)



On 7 June 2018, the Presidium of the Boards of Appeal decided to refer case R 1404/2015-5, EL TOFIO El Sabor de Canarias (fig.), to the Grand Board, after annulment of the BoA decision taken in 2016 by judgment of 25 January 2018 in T-765/16.

This case concerns the assessment of the eligibility for registration of the figurative trade mark applied for. In particular, within such a framework, it involves issues concerning the knowledge of languages within the European Union, namely local vocabulary and local culture, and the type of evidence necessary to support such knowledge.

Therefore, in the light of the importance of the legal issues concerned, the Grand Board will take a decision in order to establish a harmonised approach in similar cases.

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Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the Decision of the Presidium in the [EUIPO OJ - August 2018](#) (language of proceedings: Spanish).

### II. New Decisions from the Boards of Appeal

[23/05/2018, R 1359/2017-1, EUROLAMP Pioneers in new technology \(fig.\)](#)



OUTCOME: Decision confirmed.

NORMS: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(2) EUTMR, Article 7(3) EUTMR.

KEYWORDS: Figurative trade mark, Slogan mark, Non-distinctive Laudatory mark, Distinctiveness acquired by use.

SUMMARY: The examiner refused the above figurative sign with word elements on the basis of

Article 7(1)(b) and (c) EUTMR.

The Board also finds that the sign as a whole is devoid of any distinctive character in relation to all the goods under appeal. The mark applied for as a whole merely implies that the goods originate from the European Union or they comply with the European standards (§ 34, 40). The sign has a promotional or laudatory meaning for all the goods (§ 43-45, 47). The figurative elements are simple and will go unnoticed by consumers (§ 61-65).

The applicant has not established that at least a significant part of the English-speaking public in the Member States of the European Union recognises, by virtue of the mark, that the goods applied for come from the applicant. Therefore, it has not been shown that the trade mark has acquired distinctive character through its use within the meaning of Article 7(3) EUTMR (§ 78-88).

[31/05/2018, R 1435/2017-1, IWATCH](#)

OUTCOME: Decision confirmed.

NORMS: Article 7(3) EUTMR.

KEYWORDS: Word mark, Scope of the appeal, Distinctiveness acquired by use.

SUMMARY: The examiner entirely refused the trade mark applied for, under Article 7(1)(b)

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and (c), in conjunction with Article 7(2), EUTMR for the goods specified in Class 14, namely 'Chronometric instruments, timepieces, and bracelets; accessories, parts, components, and cases for all of the foregoing goods'. The Board is not competent to reassess the application for the goods in Class 9, since the application was not rejected for those goods.

As regards Article 7(1)(b) and (c) EUTMR the Board refers to the reasoning of the contested decision and the relevant case-law. The Courts have previously found that the public may interpret the letter 'i' when prefixed to another word as referring to 'information technology', 'telecommunications' or, in particular, the internet. The letter 'i' is also often used, in combination with other elements, as an abbreviation for 'interactive' (§ 19).

As regards Article 7(3) EUTMR, the Board recalls that two conditions are pivotal for the registration of a trade mark based on acquired distinctiveness: (a) the trade mark must have acquired distinctiveness through use at the relevant date and (b) the trade mark must have acquired distinctiveness in the relevant territory (§ 21). It finds that 'iWatch' by Apple had been applied for as a trade mark long before the announcement of the product's launch, whereby it is impossible to have acquired distinctiveness at the priority or the filing date (§ 25-26). Moreover, the evidence

submitted is obviously not sufficient to show 'use' or, more precisely acquired distinctiveness for all the Member States of the European Union (§ 27-29). The applicant essentially argued that the application should be accepted on the basis of acquired distinctiveness because of its family of marks comprising 'IPHONE' and 'IPAD'. However, the applicant cannot claim acquired distinctiveness for all possible combinations with the letter 'i' and a descriptive technical term (§ 30).

18/05/2018, R 2309/2017-1, Solei (fig.) / SOLEI

EUTM	Earlier EUTM
	SOLEI

Outcome: Decision confirmed.

Norms: Article 8(1)(b) EUTMR, Article 8(2) EUTMR, Article 8(4) EUTMR, Article 53(1) EUTMR.

Keywords: Non-registered trade mark.

Summary: The Cancellation Division rejected the request for a declaration of invalidity in its entirety. The request was based on the existence of a likelihood of confusion with a registered

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Romanian word mark. However, the registration of that trade mark was cancelled by the national court.

The request for a declaration of invalidity under Article 53(1)(a), in combination with Article 8(1) (b), EUTMR was only based on the said Romanian trade mark registration, which was declared invalid by the District Court of Bucharest. Therefore, the request for a declaration of invalidity cannot prosper on the basis of this trade mark registration which was cancelled, that invalidity action having become final, which was reflected on the Romanian trade mark register, as established by the documents filed by the EUTM proprietor (§ 27).

The cancellation applicant's appeal is not well founded. It is true that based on the cancellation applicant's (presumed and undisputed) good faith at the time of acquiring the earlier mark 'SOLEI', the Court of Bucharest partially refused VELICOV's (the EUTM proprietor) subsidiary claim which aimed at prohibiting the cancellation applicant, SC ALL NUTS, from selling products bearing the said trade mark (§ 28). In practice, this could mean that the cancellation applicant could be (or become) the owner of a non-registered mark acquired by use, if the national law foresees this possibility. However, unregistered trade marks (or other rights) acquired through use, can only be relied

upon in combination with Article 8(4) EUTMR, which was not claimed as a basis of the present request for a declaration of invalidity (§ 29).

[24/05/2018, R 1850/2017-5, C FIBROTOUCH \(fig.\) / FIBROSCAN et al.](#)

EUTM	Earlier EUTM
	FIBROSCAN

OUTCOME: Decision confirmed.

NORMS: Article 8(1)(b) EUTMR, Article 8(5) EUTMR.

KEYWORDS: Detriment to earlier mark, Identity of the goods and services, Likelihood of confusion, Proof of use, Reputation, Similarity of the goods and services, Similarity of the signs, Specialised public, Unfair advantage.

SUMMARY: The Opposition Division partially upheld the opposition for part of the contested goods and services on the grounds that there was a likelihood of confusion.

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The Board confirms the conclusion of a likelihood of confusion between the marks and unfair advantage taken of the earlier mark, as established by the Opposition Division.

As regards the proof of use, the applicant has not pointed out to the Board any specific examples of errors in the assessment of the proof of use in the contested decision. The Board endorses the analysis and conclusions reached in the contested decision (§ 18).

As regards a likelihood of confusion, assuming that the earlier mark possesses a minimum degree of distinctiveness, the identity and similarity between the goods and services at issue, as well as the fact that consumers only rarely have the opportunity to compare the signs side by side but must instead rely on their imperfect memory, the Board considers that there is a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR for the goods and services found to be identical or similar (§ 88).

In relation to Article 8(5) EUTMR, as regards, first, the reputation of the earlier mark, the Board agrees with the contested decision's conclusion that the plethora of documents filed, in particular, the sales figures, the international recognition by independent organisations, the increasing number of customers, the various references in the specialised press regarding its success and

the opponent's participation at top trade fairs in the sector, show the established reputation of the opponent's earlier mark (§ 101).

As regards the existence of a link between the marks in conflict the Board considers that precisely because of the reputation of the earlier mark amongst the scientific community, the contested sign's allusive content to the same concept will trigger and establish a mental 'link' with the earlier sign (§ 112).

As regards, the unfair advantage taken of the earlier mark's distinctive character or repute, the opponent has proven that the applicant intentionally seeks to free-ride on the opponent's success and well-established reputation by imitating the sign as closely as possible, not only with its patent infringing device but also by using a confusingly similar trade mark which includes part of the name of the most sold 'FIBROSCAN' model namely the 'FIBROSCAN 502 TOUCH' (§ 130).

As regards the possible due cause for using the trade mark applied for the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists (§ 136).

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