

Alicante News

Up to date information on IP and EUIPO-related matters

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The New Generation Guidelines



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The New Generation Guidelines

The [New Generation Guidelines](#) were published in the EUIPO webpage on the 4th March 2019.

This publication is, together with the revamping of the revision process and the consultation cycle of the Guidelines, one of the outcomes of a series of surveys that took place during several months of 2016 and 2017 between examiners, owners, representatives, National Offices and User Associations.

One of the main requests of these stakeholders was the necessity of a HTML version of the Guidelines that would replace the cumbersome pdfs and would allow users to take full advantage of web-based technologies including connection to internal and external databases, inclusion of related contents providing additional information or explanations, comments online, and live statistics, among other features.

The first step in order to incorporate all these features has finally become a reality: the New Generation Guidelines have been published in 23 languages, with track changes between the five working languages of the Office.

The remaining languages will have a track changes version as well as soon as they have a previous version to compare with, in January 2020. They



have a friendly-user interface, allowing to easily switch between Trade Marks and Designs, between editions and between languages, as well as a basic search tool, navigation tree, breadcrumbs, etc.

They also allow the possibility to provide direct feedback for all users, access to printable pdfs, and a repository of previous editions of the Guidelines.

During the coming months, new features suggested by our stakeholders, like links to the Regulations and to case-law databases, a feedback tool, advanced search, live statistics, among other issues, will be progressively included in the Guidelines in order to fulfill the expectations of our users.

In sum, we have now received a brand-new house, and the following stages will consist of gradually furnishing it in order to make a home out of it.

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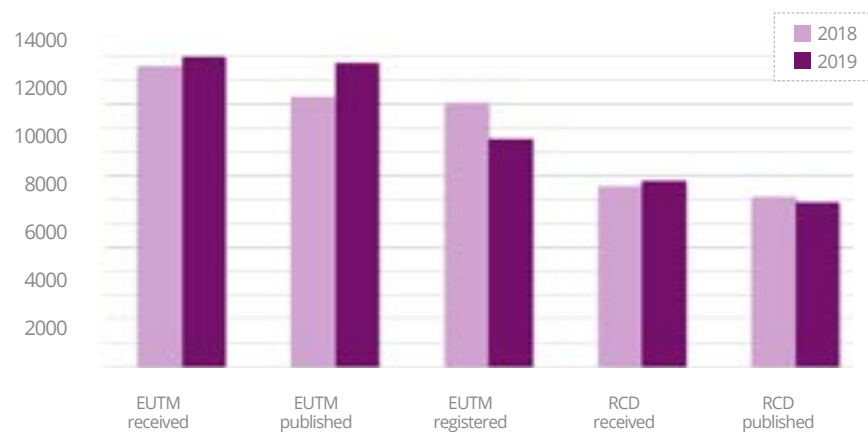


Statistical Highlights



Monthly statistical highlights February*	2018	2019
European Union Trade Mark applications received	12 604	12 971
European Union Trade Mark applications published	11 292	12 731
European Union Trade Marks registered (certificates issued)	11 053	9 546
Registered Community Designs received	7 565	7 764
Registered Community Designs published	7 110	6 892

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



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EUIPN Updates



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

The [draft Common Practice](#) of the project CP10 – ‘Criteria for assessing disclosure of designs on the Internet’ has been made available for comments.

The CP10 Working Group, composed of representatives from EU intellectual property offices, User Associations, the European Patent Office (EPO) and the EUIPO, made significant progress on developing the Common Practice during the Working Group meetings and a workshop held in December 2018. Best practices and expertise were shared among the Working Group members to establish the common principles of the CP10 project.

As a result, the first draft of the Common Practice is now available in English for review and suggestions.

The EUIPO welcomes your comments, which should be addressed to Konstantinos.AMPATZIS@ext.euipo.europa.eu by Wednesday, 8 May 2019.

The CP10 project is part of the European Cooperation Projects under the heading ECP4 Shared Services and Practices.

EUIPO and EAPO strengthen cooperation

On 14 March, a delegation from the [Eurasian Patent Organization](#) (EAPO), visited the EUIPO’s premises and met the Executive Director, Christian Archambeau.

The EUIPO and EAPO signed a Memorandum of Understanding to strengthen cooperation between the two offices.

EAPO is an intergovernmental organisation in which eight member states participate (Turkmenistan, the Republic of Belarus, the Republic of Tajikistan, Russia, the Azerbaijan Republic, the Republic of Kazakhstan, Kyrgyzstan, and Armenia). The collaboration with the EUIPO will focus on training programmes and the exchange of secondment staff, including study visits and the exchange of knowledge related to legal and regulatory practices.

The offices will also share information on tools and will work more closely regarding the publication of industrial design data for the benefit of users.

OEPM implements Capture and Store Historical Files

The [Spanish Patent and Trademark Office](#) (OEPM) has successfully implemented the ‘ECP5 project

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Capture and Store Historical Files'

The project, carried out within the framework of European Cooperation Projects, aims at digitising paper files across the EU intellectual property offices to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

The Spanish implementation started in October 2017 with support from different teams at the EUIPO and the OEPM. Over 70,000 dossiers were digitised within the OEPM.

The OEPM is the fourth office to implement the project, following the implementations of the Lithuanian, Maltese and Cypriot IP offices, bringing the total current number of digitised dossiers to 270,000.

The implementation of this project will deliver concrete benefits to OEPM employees by reducing waiting times for documents and allowing easy access to data.

The project supports the participating offices in creating a paperless working environment, and it helps users interact digitally with EU intellectual property offices.

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Have your say on EU design protection by 15 April

The European Commission has extended the deadline of its stakeholder consultation to gather evidence and views on the current EU legislation on design protection. The consultation now closes on 15 April 2019.

The consultation is launched with the intention of collecting the input of stakeholders on the functioning of the design protection systems in the EU, at Union and at national levels.

This consultation builds on and follows previous research, analysis and targeted surveys conducted as part of two studies on the economic and legal review of those systems.

The consultation activities will help the European Commission to draw conclusions on the need for improvement, modernisation and further harmonisation of the current legal acts. [Access the survey here.](#)

External Audit 2019

The EUIPO has successfully passed an external audit for the follow-up of the ISO 9001 (quality), ISO 27001 (information security), ISO 10002 (complaints handling), OHSAS 18001 (health and safety), UNE 170001 (universal accessibility) and EMAS

(environment) management systems. Overall, no non-conformities were raised by the auditors.

The auditors noted the significant work carried out by the Office in order to resolve all the issues raised in the previous audit. The auditors remarked on the efforts made towards this continuous improvement that highlighted the maturity of all Management Systems implemented at the EUIPO.

In addition to this, the auditors also highlighted the efforts made by the Office in striving to close the gap between the users' perception of the quality of the Office products and the Office's quality indicators through the implementation of the SQAP project.

The EUIPO obtained its first certification (ISO 27001) in 2004 and has since been following a process of continual improvement of its activities. This has led to the achievement of international certifications in quality management, environmental performance, universal accessibility, occupational health and safety and, from 2018, complaints handling.

IP Mediation Conference

The EUIPO Boards of Appeal, together with the EUIPO Academy and the International Cooperation and Legal Affairs Department of EUIPO, are organising the second IP Mediation Conference, which will be held on 30-31 May 2019.

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The conference takes place in EUIPO's headquarters in Alicante, Spain. Leading experts from national and international institutions, academia and from EUIPO itself will gather to address a wide range of topics in the field of intellectual property mediation.

Mediation is a growing trend in intellectual property, and an increasingly sought-after method of dispute resolution. Through panel discussions, audience interaction and real-world examples of IP mediation in practice, the conference will explore the benefits and added value of mediation for all parties.

For more details on the conference, and to register, visit the [IP Mediation Conference registration page](#).

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Luxembourg trade mark and design news

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

T-672/16; C=commodore (fig.); C=Holdings BV v EUIPO; Judgment of 13 December 2018; EU:T:2018:926;

Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Revocation grounds

FACTS: The predecessor in title to the applicant obtained the international registration (IR) of the figurative sign below for goods and services in Classes 9, 25, 38 and 41. The defendant filed an application for invalidation and sought the revocation of the applicant's rights to the IR on the basis that it had not been put to genuine use as an EU trade mark for a continuous period of five years. The Cancellation Division (CD) upheld the application for revocation in respect of all the goods and services covered by the IR. The Board of Appeal (BoA), however, considered that the mark had been used for part of the goods in Class 9 but not for the rest of the goods and services and that there were no proper reasons for this non-use. The applicant filed an action with the General Court (GC), relying on a single plea in law: infringement

of the provisions of Article 15(1) and (2) EUTMR and of Article 51(1)(a) EUTMR and infringement of Article 17 of the Charter of Fundamental Rights of the EU and of Articles 75 and 76 EUTMR.

EUTM application



SUBSTANCE: PARTIAL USE. The BoA did not find in the contested decision that the circumstances relied on by the applicant did not present a sufficiently direct relationship with the contested mark (para. 37). According to the BoA, the applicant did not explain why the use of that registration as an EU trade mark was possible for some goods (in Class 9) and not for the other goods or services in question. Consequently, the applicant itself established that the alleged reason for non-use of its IR did not prevent genuine use (para. 39). The mere fact that genuine use of the contested mark was possible for certain goods did not exclude the existence of proper reasons for non-use of that mark for other goods or services (para. 40). The existence of genuine use in respect of some of the goods and services covered by the contested mark, does not preclude, in law or fact, the presence of proper reasons for non-use of the same mark in relation to the other goods or services covered by it (para. 41). The BoA did not take the chronology of events into account. Indeed, the

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licencing agreement, which established genuine use of the IR for the goods listed, was concluded before the transfer of ownership. The first ground of the contested decision is, therefore, vitiated by an error of law and an error of assessment (para. 42). The BoA criticised the applicant for not having adduced any evidence showing that it was prevented from using the IR at issue. The BoA thereby disregarded the fact that the sole activity of the applicant was in fact the conclusion of licencing agreements (para. 44). The BoA erred in requiring the applicant to demonstrate that the circumstances upon which it relied made negotiations with other potential licence holders 'impossible' (para. 46). Furthermore, it did not take into account the fact that an existing customer had decided to freeze the payment of its royalties to the applicant. Therefore, the BoA could not, without committing an error of assessment, criticise the applicant for failing to adduce evidence of other licence holders, although it had established that an existing trading partner had stopped the payment of royalties (paras 47-48). The third ground put forward by the BoA is vitiated both by an error of law and an error of assessment (para. 49). According to the BoA, it is apparent from the court documents produced that the applicant could not have any serious doubts as to its property rights in respect of the Commodore trade mark (para. 50). However, the BoA failed to examine whether all the manoeuvres in question, which it described as 'fraudulent' and 'intimidatory', could give rise to doubt in the minds of third parties (para. 52). The BoA does not

explain how an obstacle, which it categorised itself as 'considerable', could not, in the normal course of business, seriously undermine the appropriate use of the contested mark (para. 55). The fourth ground is also, therefore, vitiated by errors of law and assessment (para. 57). The manoeuvres described (some of which took place within the EU) were capable of influencing the use of the IR for all the goods and services in question (para. 59). None of the grounds of the contested decision, taken separately or as a whole, provide a basis for that decision, either in fact or in law (para. 61). It follows that it is necessary to uphold the single plea in law without it being necessary to examine the other complaints put forward by the applicant and, on that basis, to annul the contested decision (para. 69).

T-46/17; Pet Cuisine (fig.) / The Pet CUISINE alimento para mascotas felices Genial (fig.) et al.; TDH Group v EUIPO; Judgment of 14 December 2018; EU:T:2018:976;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual dissimilarity, Conceptual similarity, Distinctive element, Dominant element, Identity of the goods and services, Figurative trade mark, Likelihood of confusion, New submission on appeal, Phonetic similarity, Similarity of the

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goods and services, Similarity of the signs, Visual similarity

FACTS: The applicant applied for international registration of the figurative sign Pet Cuisine designating the EU for goods in Class 31. An opposition based on, inter alia, the earlier EU figurative mark below registered for goods in Class 31, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partially upheld the opposition for the following goods in Class 31: *seeds and agricultural products, not included in other classes; seeds, natural plants; foodstuff for animals, malt*, since it found likelihood of confusion (LOC). The applicant filed an appeal and the Board of Appeal (BoA) dismissed the appeal, confirming LOC. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: Relevant public. The relevant public is composed of EU pet owners with an average level of attention (paras 41, 43). The BoA confirmed the OD's assessment and in doing so it gave a sufficient statement of reasons for the contested decision (para. 46). Since it is not proven that the contested goods are similar, complementary or in competition with medical or veterinary products, it cannot be demonstrated that the relevant public would display a high level of attention due to the impact of animal foodstuffs on the health of pets (paras 48-49). In any case, the BoA found that likelihood of confusion (LOC) exists even in situations in which consumers pay 'considerable attention' to the goods (para. 52).

Comparison of the goods. *Foodstuffs for animals and seeds, agricultural products, not included in other classes and natural plants* are identical, whereas foodstuffs for animals and malt are similar: malt is frequently added to pet foods in order to increase its protein content, and, moreover, malt and foodstuffs for animals share the same distribution channels and are sold in the same outlets (paras 62-63).

Comparison of the signs. Distinctive and dominant elements of the marks. The term 'pet cuisine' is more distinctive than the other figurative elements of the sign covered by the IR, which are directly descriptive, since 'pet cuisine' alludes to the nature and purpose of the goods for the part of the relevant public that understands English, while it remains fanciful for the non-English speaking part of the relevant public (paras 84, 86). For the Spanish-speaking part of the relevant public, the word 'genial' is a laudatory term,

IR designating the
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Earlier trade mark



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lacking distinctiveness (para. 88) and the expression 'alimento para mascotas felices' means 'food for happy pets'. It has a weak distinctiveness, and is descriptive of the nature and intended purpose of the goods covered (para. 89). Therefore, at least for the Spanish-speaking part of the relevant public, the term 'pet cuisine' is the most distinctive element of the earlier mark, even if the meaning of that term is not understood (paras 91, 98). 'Pet cuisine' is also the most dominant element of the marks because of its central position and because of its size in relation to the other elements (para. 102).

Visual similarity. Despite the visual differences in the word and figurative elements and in their colour, the signs are mostly visually similar due to the common, dominant and distinctive element 'pet cuisine', at least for the Spanish-speaking public (para. 108). **Phonetic similarity.** The expression 'alimento para mascotas felices' in the earlier mark will not be pronounced; as it is significantly smaller and set apart beneath the term 'pet cuisine' (paras 117, 121). The marks have an average degree of phonetic similarity for the part of the relevant public that will pronounce the earlier mark by using the expression 'pet cuisine genial' and a high degree of phonetic similarity for the part of the relevant public that will pronounce that mark by using the term 'pet cuisine' (para. 126). **Conceptual comparison.** For that part of the relevant public that understands the term 'pet cuisine', the marks are conceptually similar and, for that part of the relevant public that does not understand the word elements of the marks,

those marks are conceptually different (para. 141) **LOC.** The BoA did not err in finding LOC (para. 153). Notwithstanding the conceptual difference for the part of the relevant public that does not understand the word elements of the marks, the average degree of visual and phonetic similarity, first, and the identity or similarity of the goods, second, are sufficient to establish LOC (para. 147). As the covered goods are sold, inter alia, in self-service stores, where the visual aspect takes precedence, LOC seems all the more probable (para. 148). The consumer may consider they come from the same undertaking or economically-linked undertakings because they are accustomed to seeing several versions of the same mark in the marketplace, owned by one proprietor (paras 149, 150)

T-801/17; ORIGINAL excellent dermatest 3-star-guarantee.de (fig.); Dermatost Gesellschaft für allergologische Forschung u. Vertrieb von Körperpflegemitteln mbH v EUIPO; Judgment of 14 December 2018; EU:T:2018:970

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive, Distinctiveness acquired by use, Non-distinctive, Survey

FACTS: The applicant sought to register the

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figurative mark below as an EUTM for services of a medical and bacteriological laboratory; medical research; production of expertise in the field of allergology (scientific services); all the aforementioned services exclusively for companies developing and/or manufacturing and/or distributing cosmetics in Class 42. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant appealed. The Board of Appeal (BoA) dismissed the appeal finding that the mark was descriptive and non-distinctive and that the evidence provided by the applicant did not prove the acquisition of distinctive character through the use of the mark applied for. The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 7(3) EUTMR.

EUTM application



SUBSTANCE: Relevant public. Since the mark applied for is composed, in its word elements, of English terms, the existence of an absolute ground for refusal must be assessed in relation to the English-speaking public specialised in the cosmetics sector of the European Union (EU) (paras 25, 30).

Descriptiveness. The word elements of the mark would be understood to mean 'original skin test, excellent, three-star guarantee' and the relevant specialist public would perceive the suffix '.de' as part of the address of a German website indicating that the services in question were available on the internet (para. 39). Having regard to the nature of the services and the immediate meaning of the word elements, the mark as a whole is descriptive of those services (para. 41). Because of their banality and extreme graphic simplicity, the figurative elements of the sign would not divert the attention of the relevant public from the descriptive message conveyed by the word elements, and that public would perceive the mark, taken as a whole, as a description of the purpose of the services and not as indicating their origin (paras 45-46). The term 'dermatest' preceded by the term 'original' and followed by the symbol '@' cannot constitute an indication of the origin of the services, as the element 'original' designates a characteristic of the service concerned and the symbol '@', as follows from the case-law, does not have any characteristic enabling the relevant public to distinguish the services covered by the application from those of another commercial origin (paras 49-50). The specialised

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public, whose linguistic knowledge encompasses both everyday and specialised language, will understand straight away that the word elements of the mark applied for and, in particular, the word element 'dermatest' is a description of the services, meaning 'skin test', rather than a reference to the applicant (paras 52-55). The applicant cannot rely on the fact that it owns an earlier word mark 'dermatest®' and a figurative mark corresponding to the mark applied for, but with the word elements in German, since the principles of equal treatment and good administration must be reconciled with respect for legality (paras 56-58). **Lack of distinctive character.** Since the mark is descriptive, this is sufficient to conclude that it is also devoid of distinctive character bearing in mind the overlap between the absolute grounds for refusal provided for in Article 7(1)(c) and (b) EUTMR (paras 63-65). **Acquired distinctiveness.** A survey conducted in Belgium, Germany, the Netherlands and Austria is not sufficient to demonstrate that the mark applied for has acquired distinctive character in the whole EU. The survey submitted by the applicant does not cover the rest of the territory of the Union, including, at the very least, the United Kingdom and Ireland, for which the descriptive character of the mark applied for was retained (para. 75). The action must be dismissed in its entirety (para. 77).

T-802/17; ORIGINAL excellent dermatest 5-star-guarantee.de CLINICALLY TESTED; *Dermatest Gesellschaft für allergologische Forschung u. Vertrieb*

von Körperpflegemitteln mbH v EUIPO; Judgment of 14 December 2018; EU:T:2018:971;

Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Complex mark, Descriptive, Distinctiveness acquired by use, Non-distinctive, Survey

FACTS: The applicant sought to register the figurative mark below as an EUTM for *services of a medical and bacteriological laboratory; medical research; production of expertise in the field of allergology (scientific services); all the aforementioned services exclusively for companies in the cosmetics sector, in particular for companies developing and/or manufacturing and/or distributing cosmetics* in Class 42. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant appealed. The Board of Appeal (BoA) dismissed the appeal finding that the mark was descriptive and non-distinctive and that the evidence provided by the applicant did not prove the acquisition of distinctive character through the use of the mark applied for. The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(b), (ii) infringement of Article 7(1) (c) and (iii) infringement of Article 7(3) EUTMR.

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EUTM application



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Descriptiveness. The word elements of the mark would be understood to mean 'original skin test, excellent, five-star guarantee, clinically tested' and the relevant specialist public would perceive the suffix '.de' as part of the address of a German website indicating that the services in question were available on the internet (para. 39). Having regard to the nature of the services and the immediate meaning of the word elements, the mark as a whole is descriptive of those services (para. 41). Because of their banality and extreme graphic simplicity, the figurative elements of the sign would not divert the attention of the relevant public from the descriptive message conveyed by the word elements, and that public would perceive the mark, taken as a whole, as a description of the purpose of the services and not as indicating their origin (paras 45-46). The

term 'dermatest' preceded by the term 'original' and followed by the symbol '®' cannot constitute an indication of the origin of the services, as the element 'original' designates a characteristic of the service concerned and the symbol '®', as follows from the case-law, does not have any characteristic enabling the relevant public to distinguish the services covered by the application from those of another commercial origin (para. 50). The specialised public, whose linguistic knowledge encompasses both everyday and specialised language, will understand straight away that the word elements of the mark applied for and, in particular, the word element 'dermatest' is a description of the services, meaning 'skin test', rather than as a reference to the applicant (paras 52-55). The applicant cannot rely on the fact that it owns an earlier word mark 'dermatest®' and a figurative mark corresponding to the mark applied for, but with the word elements in German, since the principles of equal treatment and good administration must be reconciled with respect for legality (paras 56-58). **Lack of distinctive character.** Since the mark is descriptive, this is sufficient to conclude that it is also devoid of distinctive character bearing in mind the overlap between the absolute grounds for refusal provided for in Article 7(1)(c) and (b) EUTMR (paras 63-65). **Acquired distinctiveness.** A survey conducted in Belgium, Germany, the Netherlands and Austria is not sufficient to demonstrate that the mark applied for has acquired distinctive character in the whole EU. The survey submitted by the applicant does

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T-803/17; ORIGINAL excellent dermatest (fig.); *Dermatest Gesellschaft für allergologische Forschung u. Vertrieb von Körperpflegemitteln mbH v EUIPO*; Judgment of 14 December 2018; EU:T:2018:973;

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evidence provided by the applicant did not prove the acquisition of distinctive character through the use of the mark applied for. The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 7(3) EUTMR..

EUTM application



SUBSTANCE: Relevant public. Since the mark applied for is composed, in its word elements, of English terms, the existence of an absolute ground for refusal must be assessed in relation to the English-speaking public specialised in the cosmetics sector of the European Union (EU) (paras 25, 30). **Descriptiveness.** The word elements of the mark would be understood to mean 'original skin test, excellent' and the relevant specialist public would perceive the suffix '.de' as part of the address of a German website indicating that the services in question were available on the internet (para. 40). Having regard to the nature of the services and the

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immediate meaning of the word elements, the mark as a whole is descriptive of those services (para. 42). Because of their banality and extreme graphic simplicity, the figurative elements of the sign would not divert the attention of the relevant public from the descriptive message conveyed by the word elements, and that public would perceive the mark, taken as a whole, as a description of the purpose of the services and not as an indication of their origin (paras 46-47). The term 'dermatest' preceded by the term 'original' and followed by the symbol '®' cannot constitute an indication of the origin of the services, as the element 'original' designates a characteristic of the service concerned and the symbol '®', as follows from the case-law, does not have any characteristic enabling the relevant public to distinguish the services covered by the application from those of another commercial origin (paras 50-51). The specialised public, whose linguistic knowledge encompasses both everyday and specialised language, will understand straight away that the word elements of the mark applied for and, in particular, the word element 'dermatest' is a description of the services, meaning 'skin test', rather than a reference to the applicant (paras 53-56). The applicant cannot rely on the fact that it owns an earlier word mark 'dermatest®' and a figurative mark corresponding to the mark applied for, but with the word elements in German, since the principles of equal treatment and good administration must be reconciled with respect for legality (paras 57-59). **Lack of distinctive character.** Since the mark

is descriptive, this is sufficient to conclude that it is also devoid of distinctive character bearing in mind the overlap between the absolute grounds for refusal provided for in Article 7(1)(c) and (b) EUTMR (paras 64-66). **Acquired distinctiveness.** A survey conducted in Belgium, Germany, the Netherlands and Austria is not sufficient to demonstrate that the mark applied for has acquired distinctive character in the whole EU. The survey submitted by the applicant does not cover the rest of the territory of the Union, including, at the very least, the United Kingdom and Ireland, for which the descriptive character of the mark applied for was retained (para. 76). The action must be dismissed in its entirety (para. 78).

T-471/17; EDISON (fig.); Edison SpA v EUIPO; Judgment of 7 December 2018; EU:T:2018:887;

Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Lack of reasoning, Nature of the goods and services, Principle of legality, Restriction of the list of goods and services, Right of defence, Right to be heard

FACTS: The EUTM proprietor applied in 2003 for the figurative mark below as an EUTM for all the goods covered by the general indications in Class 4. The mark was registered in 2013. In 2015, 15

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the EUTM proprietor requested that the Office modify the previous list of goods by limiting it. The examiner partly upheld the limitation request except for *electrical energy*, because no such product existed in the list of goods in Class 4 of the 8th Nice Classification, applicable in the case concerned. The EUTM proprietor appealed and the Board of Appeal (BoA) endorsed the examiner's conclusion, stating that by accepting *electrical energy* the scope of protection of the sign would be unduly widened. The EUTM proprietor filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 57 EUTMR in conjunction with Article 111 EUTMR and (ii) infringement of Article 94 EUTMR.

of the Nice Classification. There is no doubt that the expression 'electrical energy' does not appear anywhere under Class 4 in the eighth edition. That expression was included in the alphabetical list of goods in Class 4 only from the ninth edition onwards (para. 36). 'Electrical energy' is of an intangible nature, which is difficult to reconcile with the common and ordinary meaning of the concept of 'illuminants' (para. 39). Although, undeniably, lamps and electric arcs produce light, that argument alone does not suffice to conclude that *electrical energy* can be considered as part of illuminants (para. 40). *Electrical energy* is an intangible good that cannot be included in the category fuels since that category consists of combustible materials (in solid, liquid or gaseous form) used to produce the 'electrical energy'. Therefore, *electrical energy* is the result of the combustion and not a material that provokes the combustion (para. 43). The fact that 'electrical energy' is analogous to other 'fuels', according to a recent WIPO declaration, means that it is similar from a functional point of view, but not that it is included in the concept of 'fuels' (para. 44). Regarding the concept of 'fuels', it must be considered that in 2003, the use of electrical energy as a means for powering motors was negligible in the context of the EU, since it is a technology that, although contemplated and researched in the past, has only been perfected, and thus made accessible to the wider public, in the last decade (para. 53). **Failure to state reasons.** The EUTM proprietor was given the opportunity to be heard regarding all points of fact and law on

EUTM



SUBSTANCE: Scope of protection of Class 4 of the 8th Nice Classification. The BoA rightly considered that the scope of protection of Class 4 comprises both the everyday and usual meaning of the general indications constituting its heading, and the alphabetical list of classes featuring in that edition

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which the BoA based its decision. The continuity in terms of their functions between the different units of the Office enables the BoA to complement the examiner's reasoning or dismiss the appeal on the basis of a slightly different reasoning that that used in the first instance decision (para. 62). The contested decision contains an explanation of the reasons which led to the dismissal of the limitation request, and which is sufficiently detailed to allow the EUTM proprietor to understand the reasoning of the BoA and the GC (para. 71).

T-665/17; CCB (fig.) / CB (fig.) et al; China Construction Bank Corp. v EUIPO; Judgment of 6 December 2018; EU:T:2018:879;

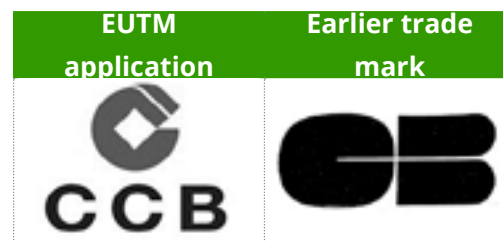
Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Acronym, Distinctive element, Enhanced distinctiveness, Evidence of use, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Similarity of the signs, Phonetic similarity, Relevant territory, Reputation, Right of defence, Visual similarity

FACTS: The applicant sought to register the figurative mark below as an EUTM for services in Class 36. An opposition based on the earlier EU figurative mark below registered for services in Class

36 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition, as it found likelihood of confusion (LOC). The applicant filed an appeal, which was dismissed by the Board of Appeal (BoA). The applicant filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 94(1) and Article 95(1) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR.



SUBSTANCE: Rights of defence. Having been a party to the proceedings, the applicant was in a particularly good position to effectively make known its views on the previous BoA decision on CCB/CB referenced by the intervener, including all of the elements taken into account (para. 25). The BoA did not exceed the limits of the factual basis of its examination in relying on the absence of regular use of the services at issue, and was not under an obligation to hear the applicant on the finding (para. 29). **Relevant public.** The relevant public consists of professionals and the general public, with a high level of attention (para. 35). **Enhanced distinctiveness.** For the purposes of assessing whether the earlier mark

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had enhanced distinctiveness, the BoA properly relied on the elements put forward to establish its reputation (para. 41). The BoA was not obliged to assess whether the earlier mark had enhanced distinctiveness for all of the services it covered in Class 36. The BoA therefore correctly examined the reputation of the earlier mark in relation to *financial affairs, monetary affairs and banking* (para. 45). The BoA's assessment of the earlier mark's distinctiveness was correct (para. 48). **Comparison of the signs.** The BoA was able, without erring in law, to rely on the reputation of the earlier mark in France and, therefore, to rely on the significance of the awareness of the link that mark establishes with the bank cards of the Groupement des cartes bancaires, described by the acronym CB, in order to correctly deduce that the relevant public will perceive the earlier mark as being the word element consisting of the acronym 'CB' (para. 54). The BoA acted correctly in relying mainly on the word element 'cb' of the earlier mark when comparing the signs (para. 58). The visual similarity between the signs due to them both including the upper-case letters 'CB' is not offset by the differences resulting from the additional upper-case letter 'C' in the contested mark and the different figurative elements of the two signs (para. 61). There is a high degree of phonetic similarity, as the distinctive elements of the signs ('CCB' and 'CB') are pronounced letter by letter in a very similar manner, with the only difference being the repetition of the letter 'c' in the contested mark (para. 62). It is not possible to make a conceptual

comparison (para. 63). **LOC.** Given the identity of the services concerned, the reputation of the earlier mark in France, and the similarity of the signs, there is LOC (para. 67). Even if the BoA erred in finding that there was no regular use of the services covered, and wrongly took that into account, that finding merely corroborates, as a supplementary ground, the general consideration that the relevant public retains an imperfect image of the trade marks, a matter not disputed by the applicant (para. 68).

T-821/17; VITROMED Germany (fig.) / Vitromed; Vitromed GmbH v EUIPO; Judgment of 12 December 2018; EU:T:2018:912

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Common element, Complementary goods and services, Conceptual similarity, Distinctive element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Similarity of the signs, Specialised public, Suspension of the proceedings, Visual similarity, Word mark

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods in Classes 5 and 10. An opposition based on the earlier European Union word mark Vitromed, registered for

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goods in Class 10, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition, and the applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal insofar as it found that there was likelihood of confusion (LOC) for the relevant English-speaking professional public in the EU. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

EUTMA	Earlier mark
	Vitromed

SUBSTANCE: Relevant public. The relevant public is to be determined on the basis of the goods as registered (para. 29). It consists of a specialised public within the EU with specific professional knowledge or expertise, such as specialists in the medical field (paras 30-31). **Comparison of the goods and services.** There is identity between the contested Class 10 goods and the Class 10 goods of the earlier mark, since the former are included in the latter (paras 37-42). The contested biological preparations and tissue cultures in Class 5 are similar to the Class 10 goods of the earlier mark: they relate to the medical field and are intended for medical use. In

addition, they may be complementary. They may also be aimed at the same specialists and have the same origin and distribution channels (paras 43-49). **Distinctive and dominant element.** The element 'VITROMED' is the most important element in the overall impression of the contested sign. However, the smaller figurative element at the beginning of the contested mark is not negligible, unlike the small, non-distinctive word element 'Germany' underneath the word 'VITROMED' (para. 69). **Comparison of the signs.** (i) The signs are visually similar to a high degree. They coincide in 'VITROMED', which is the only component of the earlier trade mark. Although the figurative element of the contested sign is not negligible, it will not be able to divert the public's attention away from the word element (paras 73-74). (ii) Phonetically, the pronunciation of the signs coincides in the sound of the letters 'VITROMED', present identically in both signs. Given its size, position and lack of distinctiveness, the word element 'Germany' will be negligible in the contested mark (para. 80). The figurative element of the contested sign will have little or no impact phonetically (para. 81). (iii) The signs are conceptually similar to a high degree, since it is likely that the relevant public will associate the common term 'VITROMED' with the meaningful words 'in vitro' and 'medical' (para. 84). **Distinctiveness of the earlier mark.** The inherent distinctiveness of the earlier mark is weak (para. 87). **LOC.** Due to the identity/similarity of the goods, and the high visual and conceptual similarity and phonetic identity of

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the signs, and despite the high level of attention of the relevant public and the weak distinctiveness of the earlier mark, there is LOC (paras 94, 96).

T-743/17; CARACTÈRE; *Bischoff GmbH v EUIPO*; Judgment of 12 December 2018; EU:T:2018:911;

Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element

FACTS: The word sign **CARACTÈRE** was registered for goods and services in Classes 9, 14, 18, 24 and 35. An application for a declaration of invalidity was filed against the contested mark for all the abovementioned goods and services on the basis of Article 59(1)(a) EUTMR read in conjunction with Article 7(1)(b) and (c) EUTMR. The Cancellation Division (CD) granted the application for a declaration of invalidity for all of the goods in Class 9, with the exception of *mechanisms for prepaid devices and fire extinguishers*. Regarding the goods and services in the other classes, the CD rejected the application. The EUTM proprietor appealed, filing a declaration under Article 33(8) EUTMR for the goods in Classes 9, 14, 18 and 25, which was accepted by the Office. The invalidity applicant indicated that its application for a declaration of invalidity also concerned the goods for which protection had been extended. The Board of Appeal (BoA) rejected the appeal finding

that the contested trade mark was sufficiently distinctive to fulfil the function of a trade mark in respect of the goods in question. The applicant filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

SUBSTANCE: (i) The BoA identified the French-speaking consumer of everyday consumer goods and services as the relevant public. This finding was confirmed (para. 28). The invalidity applicant argued that the contested mark pointed to the originality of certain goods. In the context of the definitions provided by the invalidity applicant, the element whose originality is underlined is systematically presented as having '*du caractère*' or as being '*de caractère*' (para. 30). However, the contested mark is composed of the term '*caractère*' and not of the expressions '*du caractère*' or '*de caractère*' (para. 31). The term '*caractère*' is a common term that can be used to refer to any characteristic or attribute specific to something (para. 32). In principle, the term '*caractère*' is followed by an adjective that may have a meliorative, depreciative or neutral meaning and may relate to all types of goods and services (para. 33). It is a common term without any particular meaning or connotation in relation to the goods and services covered. In other words, the term '*caractère*' is neutral and is not sufficient to identify the goods or services to which it refers nor is it a characteristic or other attribute specific to those goods and services (para. 34). The mere fact that the

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term 'caractère', associated with the preposition 'de', may evoke the originality of the product or service to which it relates, is not sufficient to conclude that this would also be the case for the sign 'caractère'. Indeed, even if the expression 'de caractère' could point to the originality of a product, the term 'caractère' is neutral and does not convey any positive qualities (paras 36-37). The BoA rightly considered that the invalidity applicant had not established the descriptive character of the contested trade mark within the meaning of Article 7(1)(c) EUTMR (para. 42). (ii) The contested trade mark is composed of the sole term 'caractère', which is neutral and devoid of any positive connotation. There was no indication that the contested mark was perceived as a synonym of the expression 'de caractère' (para. 53). The BoA rightly rejected the invalidity applicant's arguments based on the lack of distinctive character of the contested trade mark (para. 54).

T-274/17; MONSTER DIP (fig.) / MONSTER ENERGY (fig.) et al.; *Monster Energy Company v EUIPO*; Judgment of 13 December 2018; EU:T:2018:928;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Complementary goods and services, Detriment to earlier mark, Dissimilarity of the goods and services, Distinctive element, Dominant element, Figurative

element, Figurative trade mark, Likelihood of confusion, Nature of the goods and services, Non-registered trade mark, Passing off, Purpose of the goods and services, Reputation, Similarity of the signs, Specialised public, Unfair advantage

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 2, 37 and 40. An opposition based on the EU word marks **MONSTER ENERGY** and **MONSTER**, the EU figurative mark (below) and the unregistered UK mark **MONSTER ENERGY**, inter alia, was filed pursuant to Article 8(1)(b) EUTMR, Article 8(4) and Article 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition. The opponent appealed, which the Board of Appeal (BoA) dismissed, finding that the goods and services were dissimilar. It stated that reputation had only been established for the earlier EU figurative mark **MONSTER ENERGY** and that it would only, therefore, take that earlier mark into account. It found that the marks were similar 'to at least a certain extent', but taking all the circumstances of the case into account, there was no link between the marks. The opponent filed an action before the General Court (GC), relying on five pleas in law: (i) the BoA wrongly held that the goods and services were different, (ii) the BoA wrongly rejected the existence of a conceptual similarity between the contested mark and the earlier EU figurative mark **MONSTER ENERGY**, (iii) the BoA wrongly held that the relevant public would not establish a link between those marks, (iv) the BoA wrongly concluded

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that the distinctive character of the earlier marks was not undermined, (v) the BoA erred in failing to analyse the application of Article 8(4) EUTMR.

SUBSTANCE: Relevant public. The relevant public is composed of the general public with an average level of attention and professionals with a high level of attention (para. 27). **Comparison of the goods and services.** The goods in Class 16 covered by the earlier EU figurative mark **MONSTER ENERGY** and the goods and services covered by the contested mark are generally not supplied or manufactured by the same undertakings, due to the different kinds of expertise needed, nor do they share the same distribution channels or points of sale. Moreover, they are not complementary in the sense that one is indispensable or important for the provision of the others (para. 41). Even in the rare event that the paint were used to decorate a vehicle, it could not be substituted for stickers or decals. Moreover, the goods stickers, decals or transfers in Class 16 cannot be regarded as ‘substitutes’ for the customised manufacture and prefabrication of coating preparations services covered by the contested mark, nor do they share the same purposes (para. 45). **Article 8(5) EUTMR.** The condition of reputation was met only as regards the earlier EU figurative mark **MONSTER ENERGY** and only regarding non-alcoholic beverages (para. 60). As the degree of similarity between the marks was not high and the goods and services were dissimilar, the BoA correctly found that, despite the strong reputation of the earlier mark in respect of non-alcoholic drinks, the relevant public would not establish any link between the earlier EU figurative mark **MONSTER ENERGY** and the contested mark

EUTM application	Earlier rights
	 <p>MONSTER ENERGY MONSTER UK non-registered TM “MONSTER ENERGY”</p>

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(para. 83). **Article 8(4) EUTMR.** The goods non-alcoholic drinks, identical to those covered by the unregistered UK mark **MONSTER ENERGY**, and the goods and services covered by the contested mark, were so dissimilar that the relevant public would not establish any link with the world of alcoholic drinks covered by the unregistered UK mark **MONSTER ENERGY** (para. 95). Therefore, the reasoning of the BoA also covers the fact that one of the conditions laid down in UK law regarding the action for passing off is not fulfilled in the present case (para. 96).

T-253/17; EIN KREIS MIT ZWEI PFEILEN (fig.); *Der Grüne Punkt - Duales System Deutschland GmbH v EUIPO*; Judgment of 12 December 2018; EU:T:2018:909;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Collective mark, Proof of use

FACTS: The EUTM proprietor registered the collective figurative mark below as an EUTM for goods and services in Classes 1 to 42. The regulations governing use of the mark that had been submitted with the application for registration state, inter alia, in point 6, that the mark had been created 'to enable consumers and businesses to recognise packaging included in the dual system and for which a sum had been paid towards financing the system, as well as

goods packaged in this way, and to distinguish them from other packaging and goods ...'. A revocation application was filed pursuant to Article 58 EUTMR. The Cancellation Division (CD) partially upheld the revocation application, namely in respect of all the goods in Classes 1 to 34 with the exception of those consisting of different forms of packaging in Classes 6, 17, 18, 20, 21, 22 and 24. The proprietor filed an appeal, which the Board of Appeal (BoA) dismissed, finding that the owner had not proved that it had used the contested mark in accordance with its basic function (namely to guarantee the origin of the contested goods) in relation to the goods, except packaging. Furthermore, the owner had not succeeded in proving that the purpose of use of the contested mark was to create or maintain an outlet for those goods. All the documents produced related to use of the contested mark exclusively with regard to sales packaging. The proprietor filed an action before the General Court (GC), relying on a sole plea in law: infringement of Article 18(1) EUTMR in conjunction with Article 74 EUTMR.

EUTM



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SUBSTANCE: Proof of use. Proof of genuine use of the contested mark on packaging may constitute proof of genuine use of the mark in respect of the packaged goods themselves, provided that the proprietor proves that the relevant public perceives such use of the mark on the packaging as constituting use as a mark, that is, as an identifier of the commercial origin for the packaged goods (paras 34-35). **Relevant public.** The contested goods primarily targeted the general public, but also, to some extent, specialists in the fields of agriculture, commerce and industry. This target public would pay a normal to high level of attention when purchasing the goods (para. 36). From the point of view of the relevant public, the proprietor had not proved that it had used the contested mark in accordance with a mark's basic function of guaranteeing the identity of origin of the contested goods (para. 37). Rather, the relevant public understood the use of the mark on the packaging as an indication that the packaging could be collected and reused according to a certain system, namely the 'dual system' (para. 38). The relevant public was perfectly capable of distinguishing between a mark that indicated the commercial origin of goods and a mark that indicated the recovery of empty and used packaging after the consumer had unpacked, used or consumed the goods themselves, even if packaging and goods appeared to be a 'unit' at the time of sale. Moreover, the evidence adduced by the proprietor showed that the goods themselves were regularly designated by marks belonging to

different companies (para. 41). It followed that use of the contested mark as a collective mark designating the goods of the members of an association to distinguish those goods from those of undertakings that were not part of that association would be perceived by the relevant public as use relating to packaging. The intangible quality claimed by the proprietor and attributed to the contested mark, that is to say, the ecological behaviour of the undertaking by virtue of its affiliation to the proprietor's licence agreement system, would be attributed by the relevant public to the fact that the packaging could be ecologically treated and not to such treatment of the packaged goods themselves (para. 42). Consequently, how the contested mark was understood by the relevant public did not relate to an intangible quality of the contested goods, but to an intangible quality of the packaging of those goods, namely that the packaging belonged to the dual system administered by the proprietor (para. 43). Since the mark was known to the consumer only as an indication that the packaging waste designated by the mark could be disposed of through local collection facilities, the affixing of the contested mark on the packaging simply expressed the fact that the company concerned, and all other economic operators using the same mark on their packaging, complied with the requirements laid down in Directive 2008/98/EC on waste management (para. 44). In the unlikely event that the offers of competitors' goods were identical, and the consumer were to decide his or

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her purchase merely on the basis of the quality of the packaging, the contested mark would not be creating or maintaining an outlet vis-à-vis other economic operators for the packaged goods, but only for the packaging itself (para. 45). The proprietor had therefore not proved genuine use of the mark for the contested goods; consequently, the action had to be dismissed (para. 46).

T-115/18; KINDERPRAMS / Kinder (fig.) et al; *Tomasz Kawalko Trofeum v EUIPO*; Judgment of 6 December 2018; EU:T:2018:882;


Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complementary goods and services, Cross appeal, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Nature of the goods and services, Phonetic similarity, Purpose of the goods and services, Similarity of the goods and services, Similarity of the signs, Visual similarity, Word mark

FACTS: The applicant sought to register the word mark **KINDERPRAMS** as an EUTM for services in Classes 35 and 38. An opposition based on the earlier Italian figurative marks below, registered for, inter alia, Classes 35 and 38, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition with the exception of

the services business brokerage and wholesaling and retailing vehicle safety seats for children in Class 35. The applicant appealed and the Board of Appeal (BoA) annulled the OD's decision insofar as it had upheld the opposition in respect of auctioneering services in Class 35, since those services differed from the goods and services covered by the earlier marks. It found likelihood of confusion (LOC) regarding all the other identical or similar services. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade marks
KINDERPRAMS	

SUBSTANCE: Relevant public. The relevant territory was Italy and the relevant public included the public at large and the professional public, with an average to above average level of attention (paras 25-26).
Comparison of the services. (i) *Advertising services* in Class 35, covered by earlier mark No 1 525 361, include *the marketing and presentation of goods, etc.*, 25

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covered by the contested mark and were, therefore, considered identical (para. 30). *Import-export agency services* and *accepting orders for goods via means of telecommunication* covered by the contested mark, were similar, at least to an average degree, to the *business administration services* covered by the earlier mark, which are provided by specialised companies who study their clients' needs and provide all the necessary information and advice in order to help them with the organisation and running of their businesses. These services all served the same purpose, targeted the same professional clients and could be provided by the same service providers (para. 31). (ii) The goods that were the subject of the services covered by the contested mark were identical to the goods protected by the earlier mark. They could be offered in the same places as those in which the goods covered by the earlier mark were sold. Furthermore, there was a complementary nature between the services covered by the contested mark and the goods covered by the earlier mark (para. 32). There was a strong link between certain services designated by the contested mark and certain goods designated by the earlier mark in the sense that the services consisted of the sale of those goods, which were, therefore, complementary (para. 34). (iii) The BoA found that the services in Class 38 covered by the contested mark, that is, *news agencies; radio and television broadcasting, communications and data transmission via the internet, computer networks and other means of communication, electronic mail,*

electronic mail accounts belonged to the broader category of telecommunication services in Class 38, covered by the earlier mark. Furthermore, the services *providing user access to information on computer networks, setting up and providing computer services relating to discussion lists and forums; electronic advertising* were similar to the *telecommunication services* in Class 38 covered by the earlier mark, since those types of services are provided by the same undertakings and intended for the same users (para. 39). **Comparison of the signs.** (i) The signs were found to be visually similar to an average degree, given that the element 'kinder', the sole component of the earlier mark, is included in its entirety within the contested mark, making the marks partially identical (paras 48, 52). The fact that several undertakings use the word 'kinder' to designate their goods does not preclude that the relevant public, when confronted with a sign, will pay more attention to the first part thereof (para. 51). (ii) The signs were found to be phonetically similar to an average degree due to the presence of the same series of letters in both signs, which are placed at the beginning of the signs and, therefore, more likely to attract the consumer's attention (para. 56). (iii) The applicant failed to prove that the two word elements were part of basic German and English vocabulary and would, on that basis, be understood by the Italian public. Furthermore, the GC had already ruled that, for the public at large in Italy, the word 'kinder' had no meaning, and therefore, the marks wouldn't convey any concept for the relevant

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public (para. 60). **LOC.** In light of the identical nature of some of the services, the similarities between the other goods and services covered by the marks, the visual and phonetic similarities between the signs, the average level of distinctiveness of the earlier mark, and notwithstanding the average to above average level of attention of the relevant public, there is LOC (para. 67).

T-30/18; Support pillows; Yado s.r.o. v EUIPO; Judgment of 13 December 2018; EU:T:2018:962;

Language of the case: SK

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Admissibility.

FACTS: The applicant applied for registration of the Community design (RCD) below. A declaration of invalidity of the RCD was filed pursuant to Article 25(1)(b) CDR. The Invalidity Division (ID) rejected the application because of its lack of novelty. The applicant appealed against the ID's decision, but the Board of Appeal (BoA) dismissed the appeal as inadmissible due to the fact that the written statement setting out the grounds of appeal was received after the time-limit, expiring on 17 July 2017. The applicant filed an action with the General Court (GC), relying on three pleas in law: (i) infringement of Article 57 CDR and Article 65(1) CDR and infringement of the principles of legal certainty and

proportionality, (ii) infringement of the fundamental right to be heard and the deprivation of the possibility of legal proceedings and, (iii) infringement of the fundamental principles laid down in the CDR.

RCD



SUBSTANCE: The GC annulled the BoA decision, finding in substance that there is no legal obligation for the parties in the procedure before the Office to send documents in the relevant proceedings to the Office's official general fax number (paras 27-28). According to the GC, in the case at hand, the applicant had established that it sent a five-page document on 17 July 2017 to a fax number from which the ID had sent its decision. The Office does not dispute that it received a five-page document on this fax number on 17 July 2017 (para. 25). The GC concluded that the transmission report of 17 July 2017 demonstrated to the requisite legal standard that the applicant had filed the written statement setting out the grounds of appeal within the prescribed period. The date of dispatch of this document was 17 July 2017, the fax number of

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the addressee was used for the notification of the ID's decision, the number of pages sent was five, which corresponds to the number of pages of the written statement of grounds of appeal, received two days later at the official general fax number. The result of the transmission was indicated as 'OK', without any error messages having been reported (paras 32 and 34). From a legal point of view, the burden of proof that the Office had become acquainted with the content of the documents sent on 16 and 17 July 2017, should be borne by the applicant. However, the factual evidence on which the applicant relies in this case is such that it is up to the Office to provide an explanation or justification of not having received the documents concerned, failing which it is permissible to conclude that the burden of proof had been discharged (para 35). Consequently, the written statement setting out the grounds of appeal was filed within the prescribed period, so the BoA wrongly concluded that the appeal was inadmissible (para. 36).

T-98/18; MULTIFIT; *Multifit Tiernahrungs GmbH v EUIPO*; Judgment of 13 December 2018; EU:T:2018:936;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark **MULTIFIT** as an EUTM for goods in Classes 5, 28 and 31. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR. The applicant appealed, which was dismissed by the Board of Appeal (BoA). The applicant went on to file an action with the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(b) EUTMR.

SUBSTANCE: The BoA considered that the products covered by the trade mark applied for were intended for both the general public, in particular animal owners, and specialists, in particular, pet shop owners. The relevant public consisted of English-speaking consumers in the European Union, since the trade mark applied for was composed of English terms. The degree of attentiveness was taken to be that of a consumer with experience in the sector in question, reasonably well informed and reasonably observant and circumspect. The applicant did not dispute these findings (para. 19). The products covered by the trade mark applied for are intended to promote animal welfare (para. 20). The trade mark is composed of two common English terms, namely 'multi' and 'fit'. The term 'multi' is a verbal element that means 'many' and is used as a prefix in a large number of English words. The term 'fit' has several meanings, such as 'suitable, correct' or 'in good physical condition' (para. 21). The BoA rightly considered that the trade mark applied for, as a whole, would be easily understood

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by the relevant public as meaning 'suitable in many respects' or 'in good physical shape in many respects' (para. 23). As rightly considered by the BoA, the trade mark applied for is of a laudatory nature, since it emphasises positive aspects of the goods concerned and can be considered as an indication of quality or an incentive to purchase said goods (para. 25). The trade mark applied for is an ordinary advertising message that is not likely to trigger a cognitive process in the public concerned (para. 28). The BoA was right when it considered that the trade mark applied for was devoid of distinctive character (para. 32). The BoA considered that the absolute grounds for refusal related to lack of distinctiveness and descriptiveness each had a separate scope of application and were neither interdependent nor mutually exclusive (para. 35). It must be noted that the BoA decision cited by the applicant was taken on the basis of Article 7(1)(c) EUTMR and not on the basis of Article 7(1)(b) EUTMR (para. 45). It should be recalled that proof of genuine use of the mark applied for is not a relevant factor in the application of Article 7(1)(b) EUTMR (para. 47). The applicant did not invoke Article 7(3) EUTMR or argue that the trade mark applied for had acquired distinctive character through use (para. 49). The action must therefore be dismissed (para. 51).

T-7/18; Business and technology working as one; *Inforsacom Logicalis GmbH v EUIPO*; Judgment of 14 December 2018; EU:T:2018:974;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive, Laudatory mark, Non-distinctive, Principle of legality, Slogan mark, Specialised public, Word mark

FACTS: The applicant sought to register the word mark **Business and technology** working as one as an EUTM for goods and services in Classes 9, 16, 35, 37, 38, 39, 41 and 42. The Office refused to register the EUTM application pursuant to Article 7(1)(a) and (b) EUTMR, and Article 7(2) EUTMR. The applicant appealed, but the Board of Appeal (BoA) dismissed the appeal finding that the mark was descriptive and devoid of distinctive character. The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 7(1) (b) and (c) in conjunction with Article 7(2) EUTMR.

SUBSTANCE: Relevant public. As the mark is made up of an English statement (two English components), the relevant public consists of English-speaking consumers, or ones that at least have a sufficient knowledge of English, particularly knowledge of essential specialist English vocabulary. The level of attention is high, as specialist computer programmes and computer services, training and related consultancy and practices are relatively expensive consumer goods and services (para. 7). **Meaning of the mark.** The slogan states that

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business aspects and technological solutions are closely linked to one another (para. 7). **Descriptiveness.** Regarding the goods in Class 9, it is already apparent from the description that, for instance, a single piece of software combines various aspects, namely finance functions, as well as production and sales functions of a business. This corresponds precisely to the meaning of the trade mark, namely that technological and business aspects are combined in one solution. Hardware is likewise particularly suitable for this purpose (para. 24). Without any particular reflection, the public will associate the technological aspects with the functioning of commercial aspects (para. 25). Regarding the goods in Class 16, *printed matter*, may also be used for normal business operations together with technologies/technological innovations. *Photographs* may likewise more precisely constitute this specialisation when used for explanation in handbooks. *Stationery* and *office requisites* may also use modern technology to ensure smooth operations in everyday business life (para. 26). All the services at issue can be used in a technically- and business-oriented manner. In this context, *business* and *technology* work together as one, that is to say the services use the technological means in such a way that the economic objectives are achieved without obstacles (para. 29). Therefore, there is a clear and direct connection between the mark at issue and the goods and services (para. 32). Since the mark is descriptive, there is no need to assess if the relevant public would perceive the contested

mark as a slogan (para. 35). It is sufficient that one of the absolute grounds for refusal applies in order for the sign not to be registrable as an EUTM; therefore, there is no need to assess distinctiveness (para. 40).

T-94/18; fit+fun; Multifit Tiernahrungs GmbH v EUIPO; Judgment of 13 December 2018; EU:T:2018:933;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Laudatory mark, Non-distinctive, Principle of legality, Slogan mark, Word mark

FACTS: The applicant sought to register the word mark **fit+fun** as an EUTM for goods in Classes 3, 5, 18, 19, 20, 21, 28 and 31. The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal, which the Board of Appeal (BoA) dismissed, finding that the mark was devoid of distinctive character, as it comprised common advertising terms that, by their laudatory nature, encouraged consumers to purchase the goods in question. The overall impression produced by the mark was no different from that produced by the sum of its parts. The applicant filed an action with the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(b) EUTMR.

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SUBSTANCE: Relevant public. The relevant public is both the general public, in particular pet owners, and experts, in particular, specialist traders in the pet industry. As the contested trade mark is made up of two English words, the relevant public consists of English-speaking consumers in the EU. Depending on the type of goods concerned, the degree of attention is average to high (para. 19). All the contested goods are intended for animals and most of them promote animal welfare (para. 20).

Meaning of the mark and laudatory character. The trade mark will be understood as 'fit and fun' or as 'suitable and fun' (para. 22). 'Fit+fun' does not contain any elements that are unexpected or surprising. Rather, it brings together simple and common terms that are particularly popular in the world of advertising; it also lacks originality. It certainly does not trigger a cognitive process or require interpretative effort, nor would the relevant public perceive a contradiction between the two terms (paras 25, 28). The mere fact that the word mark does not convey any information about the nature of the goods concerned or describe the characteristics of the goods is not sufficient to make that sign distinctive (paras 28, 52). Although a slogan can have a number of meanings, constitute a play on words or be perceived as imaginative, surprising and unexpected, the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character (para. 47). The ruling cited (02/12/2008, T 67/07, Fun, EU:T:2008:542) is irrelevant in the

present case since it essentially inferred that the sign 'FUN' had no distinctive character as it was descriptive, but no ruling was made regarding the distinctiveness of the sign per se (para. 45).

T-102/18; upgrade your personality; *Martin Knauf v EUIPO*; Judgment of 13 December 2018; EU:T:2018:932;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Laudatory mark, Slogan mark

FACTS: The applicant sought to register the word mark **upgrade your personality** as an EUTM for goods and services in Classes 9, 28 and 42. The Office refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR for part of the goods, namely those in Classes 9 and 28, as it was devoid of distinctive character in respect of those goods. The applicant appealed. The Board of Appeal (BoA) dismissed the appeal, finding that the word sign had a purely laudatory and promotional purpose and was not able to fulfil the basic function of a trade mark, that of indicating the origin of the goods. The applicant filed an action with the General Court (GC), relying on one sole plea in law: infringement of Article 7(1)(b) EUTMR.

SUBSTANCE: Relevant public. The products for 31

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which registration was refused belong to the field of software and video games and are primarily intended for the average consumer. Since the trade mark consists of basic English words and this language is commonly used in the field of computing, account should be taken of the English-speaking consumers in the European Union including those residing outside the United Kingdom or Ireland (para. 22). **Distinctiveness.** The slogan 'upgrade your personality' includes an invitation to the consumer to improve or develop his or her personality through the goods covered by the mark applied for, implicitly accompanied by the promise that the goods will facilitate said improvement or development (para. 28). The term 'upgrade' is currently used in contexts that go far beyond the field of computing, and the goods covered by the mark applied for belong to the computing sector, so the use of this term appears normal and the relevant public will not find it surprising (para. 29). It is irrelevant whether it is impossible to improve someone's personality in the technical sense (upgrade), since this is an advertising slogan in which the proximity to reality is not a pertinent assessment. Consumers are used to advertising messages that make tacit or explicit unrealistic promises (para. 30). Insofar as the applicant relies on the registration by the Office of word signs allegedly similar to the mark applied for, it should be recalled that the BoAs' decisions are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality

of those decisions must be assessed solely on the basis of the EUTM Regulations as interpreted by the courts and not on the basis of previous decisions by the Office (para. 33). The action brought against the examiner's decision concerned only his refusal to register the mark for certain goods. The fact that the examiner did not raise objections concerning the other goods and services applied for was not part of the dispute before the BoA. Consequently, there was no reason for the BoA to comment on the reasons why the examiner did not raise objections to certain goods or services, or on the question of why the goods and services the examiner did not raise objections for differed from those for which he refused registration (para. 39). The applicant's sole plea in law, and therefore the action as a whole, must be dismissed (para. 40).

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A. Cases referred to the Grand Board

15/02/2019, R 1650/2018-2, Representation of a cotton boll (fig.)

https://euipo.europa.eu/eSearchCLW/#basic/*/number/1650%2F2018

EUTM application



On 15 February 2019, the Second Board of Appeal decided to refer case R 1650/2018-2 Representation of a cotton boll (fig.) to the Grand Board. This case concerns the assessment of the eligibility

for registration of the figurative sign represented above, applied for as an EU certification mark, pursuant to Article 7(1)(b) EUTMR. Given that the possibility to apply for EU certification marks only exists as of 1 October 2017, the question of the distinctiveness standards required for this kind of mark has not yet been clarified by case-law. Furthermore, the present case is the very first appeal filed on the subject of the registrability of an EU certification mark. In the light of the importance of the legal issues concerned, the case was remitted to the Grand Board which should take a decision in order to establish a harmonised approach in similar cases. 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 interim decision of the Second Board in the EUIPO OJ on 1 April 2019.

B. New Decisions from the Boards of Appeal

30/01/2019, R 958/17-G, BREXIT

Keywords: Distinctive element, Figurative element, Figurative trade mark

Norms: Article 7(1)(b) EUTMR, Article 7(1)(f) EUTMR

Facts: The case concerns the eligibility for registration of the figurative sign "BREXIT" for

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'energy drinks containing caffeine; beer' in Class 32. The application was refused by the examiner on the basis of 7(1)(f) and 7(1)(b). The case was remitted to the GB by interim decision.

Substance: the GB pointed out that the relevant public includes all consumers in the EU as they frequently encounter the term through the mass media and the internet. As regards Article 7(1)(f) EUTMR, the GB found that 'Brexit' denotes a sovereign political decision, that was taken legally and has no negative moral connotations; it is neither an incitement to crime, nor an emblem for terrorism or a byword for sexism or racism. The word alone does not express an opinion. The fact that part of the UK public may have been upset by a controversial decision taken democratically does not constitute an offence. The GB therefore concluded that the sign cannot be said to be contrary to the accepted principles of morality, in and of itself, nor when used as a brand for the goods applied for. Nevertheless, the term was, already at its filing date, so well-known to consumers as the name of an event of a historical and political nature that it would not be associated, prima facie, with specific goods originating from a specific trader. It may only acquire distinctiveness if consumers are sufficiently exposed to it in a trade context. Moreover, the colours and font are unable to divert the attention of the public away from the non-distinctive message conveyed by the word. The background evoking the Union

jack accentuates this message. For the above reason the GB refused the application pursuant to Article 7(1)(b) EUTMR and dismissed the appeal.

15/01/2019, R 1870/2017-1, Colour Purple - 2587C (col.)

EUTM application



Outcome: Decision confirmed.

Norms: Article 7(1)(b) EUTMR, Article 7(3) EUTMR.

Keywords: Colour mark, Non-distinctive, Evidence of use, Survey, Distinctiveness acquired by use (no).

Summary: The application was rejected according to Article 7(1)(b) EUTMR; however, in view of the evidence provided to show acquired distinctiveness under Article 7(3) EUTMR, it was published (§ 4). After receiving several third-party observations, the Office re-examined the trade mark applied for on the grounds that some observations gave rise to serious doubts concerning the evidence provided to prove its acquired distinctiveness (§

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7). It resulted in the refusal of the mark applied for in its entirety under Article 7(1)(b) and Article 7(3) EUTMR (§ 11).

As regards Article 7(1)(b) EUTMR the Board finds that in the pharmaceutical market colours may serve to decorate the packaging or to describe certain characteristics (§ 25). Colours are often used for 'pharmaceutical preparations for the treatment of asthma and/or chronic obstructive pulmonary disease and inhalers' as an indication of their function, ingredients or as a description of the strength of the drug (§ 36). In addition, there is a specific public interest, on the pharmaceutical market, in keeping colours available for competitors (§ 38). The Board establishes that the EUTM applied for is devoid of any distinctive character (§ 39).

As regards Article 7(3) EUTMR the Board emphasises that the acquisition of distinctiveness through the use of the mark requires that at least a significant proportion of the relevant class of persons identify the goods in question as originating from a particular undertaking (§ 44).

In principle, surveys may well represent good evidence, however, first, there were no surveys conducted at all in certain Member States (§ 52-54). Second, the surveys do not refer to all the relevant public. The relevant public consists of pharmacists and medical practitioners prescribing the medicine. In addition, the persons affected by asthma or a similar respiratory disease may be part of the relevant public, as their expectations and feedback

may influence the perception of the professionals (§ 53-57). The number of persons who took part in the surveys is too low to give a reliable result (§ 60). Furthermore, the applicant has not demonstrated that the markets in certain Member State covered by the surveys are comparable to others and that the results of those surveys could be extrapolated to them (§ 63). The lack of consistency in the surveys submitted suggests that there has been no conscious establishment of the use of the single colour in question as a reference to the commercial origin of the sign (§ 64).

Consequently, the appeal is dismissed.

15/02/2019, R 1417/2018-4, DEVICE OF A BLUE SQUARE

EUTM application



Outcome: Decision annulled.

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

Keywords: Figurative trade mark, Distinctiveness (yes), Descriptiveness (no).

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Summary: The examiner rejected the application for registering the sign as represented above for Classes 9 and 42 finding that it was descriptive and non-distinctive within the meaning of Article 7(1)(b) and (c) and Article 7(2) EUTMR.

The relevant goods and services in this case are computer software, image files and mobile applications for designing and printing clothes and bags and the provision of such software and applications. They address the end consumer who wishes to print clothes and bags with individual images, as well as professionals who offer printing services (§ 9). The figurative elements of the sign in question, even if they were to be qualified as pictograms, do not convey – neither on their own, nor in their combination – any clear message that the relevant public could understand as a description of the goods and services at issue. As regards Article 7(1)(c) EUTMR, the Board considers that it would require several mental steps to arrive at the understanding that the sign describes the purpose of the goods and services at issue, which consumers are unlikely to perform. In the absence of any meaning, the sign cannot serve in trade to describe any characteristics of the goods and services applied for (§ 11).

In relation to Article 7(1)(b) EUTMR, the Board notes that the examiner based the refusal of the mark as being non-distinctive on its descriptive nature (§ 14). Other reasons to deny the sign protection were not brought forward by the examiner and are

not apparent to the Board. The stylised depiction of a T-shirt and a bag cannot be considered as simple geometric shapes which consumers will not be able to remember; there is also no reason to assume that the relevant public would perceive the mere depiction of a T-shirt and a bag as a laudatory message to highlight the quality of the software which is designed for printing on clothes and bags (§ 15). Consequently, the appeal is upheld and the application may proceed to publication for all the goods and services applied for (§ 16).

07/02/2019, R 1489/2018-2, RAPPRESENTAZIONE DI UNA FORMA DI UN PACCHETTO DI PASTA (fig.)

EUTM application



Outcome: Decision confirmed.

Norms: Article 7(1)(b) EUTMR, Article 7(3) EUTMR.

Keywords: Three-dimensional mark, Non-distinctive, Distinctiveness acquired by use (no).

Summary: The examiner refused the registration

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of the EUTM application as represented above because of its lack of distinctive character (§ 4) in relation to pasta in Class 30.

It is established case-law that a trade mark which diverges significantly from the standard or customs of the sector and is thus able to fulfil its original essential function of indicating origin is distinctive within the meaning of Article 7(1)(b) EUTMR (§ 13). In the present case the Board finds that the form of the packaging is absolutely standard (§ 22), its colour of light brown is typical for raw packaging (§ 23), and the transparent window is also widely used in the sector (§ 24). The minor variations applied to the mark are incapable of being perceived by the relevant customers as distinguishing features (§ 27). The absence of a trade mark's distinguishing character cannot be called into question by more or less similar configurations on the market, or by the absence on the market of identical configurations. The Boards also notes the applicant's argument concerning the fact that the consumer would be able to recognise the trade mark in question, which has been in use for a long time and on a large scale in the European market and belongs to a leading company in the pasta sector (§ 29). However, even as an implicit claim for the possible application of Article 7(3) EUTMR the Board cannot, in the absence of any evidence of any kind, accept such a claim (§ 30).

The appeal is dismissed.

06/02/2019, R1215/2018-4, Premium Blend DUBAR IMPERIAL RON DOMINICANO DUPUY BARCELO & COMPAÑIA (fig.) / RON BARCELÓ (fig.) et al.

Contested EUTM



Earlier marks



3. RUM
BARCELO

Outcome: Decision annulled.

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

Keywords: Figurative trade mark, Proof of use, Nature of use, Dissimilarity of signs, Likelihood of confusion (no), Reputation (no).

Summary: An opposition was submitted against the EUTM applied for as represented above in relation to 'Rum' (Class 33) on the basis of Article 37

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8(1)(b) and Article 8(5) EUTMR. The Opposition Division allowed the opposition and rejected the EUTM applied for in its entirety (§ 6).

On the proof of use: The findings of the contested decision that the evidence provided is sufficient to establish that earlier mark 3) has been used effectively in Spain for the contested goods has not been challenged by either party. The applicant claims, however, that the evidence does not demonstrate the use of earlier mark 1) (and that earlier marks 2) and 3) are similar to the contested sign) (§ 11-12). The Board finds that the separate use of the different elements ('RON BARCELÓ IMPERIAL Premium Blend', 'RON BARCELÓ IMPERIAL' and 'RON BARCELÓ IMPERIAL') of a complex sign cannot be regarded as usage which differs insignificantly from the registered form of the EUTM, therefore the evidence provided is not suitable as regards earlier mark 1) (§ 22-27). As regards earlier right 2) the variation of using the word 'IMPERIAL' in a larger form than as it is registered cannot be considered as a change in its distinctive character, because the word 'IMPERIAL' has a weak character and the used form contains all the other registered elements (§ 31). With regard to earlier mark 1) the Board concludes that the evidence submitted is not suitable (§ 27). In relation to earlier mark 2), although in the evidence submitted (cf. § 30) the word 'IMPERIAL' is written in a much larger font than in the registered form and the name 'RON BARCELÓ IMPERIAL' appears

on two lines instead of three, this variation can be considered as a change in a word which does not change the mark's distinctive character, therefore, the evidence is suitable for indicating use of earlier mark 2) (§ 31). Consequently, the assessment of a likelihood of confusion should be done on the basis of earlier rights 2) and 3).

On Article 8(1)(b) EUTMR: The contested goods are identical to the earlier rights' goods (§ 36). The Board concludes, as a result of the comparison of the relevant signs, that the common element 'BARCELÓ' is not a dominant element in the contested sign. There is indeed a black rectangle on the bottom of which the words 'DUPUY BARCELÓ' appear in a light brown colour, apart from a number of other words, which, because of their small size, cannot be clearly perceived (§ 41). In the contested sign, the words 'DUBAR IMPERIAL' clearly stand out because of their position and size, and given the complexity of the label, they can be considered as visually co-dominant with the figurative components of the sign (§ 44). Overall the Board considers that the signs are not similar (§ 58); they are visually (§ 50) different in overall structure, picture and composition; the dominant elements of the signs have no similarities), phonetically (§ 55-56 in the hypothetical and remote case that the words 'DUPUY BARCELÓ' were also expressed in the contested sign, the signs will be expressed with a very different rhythm, intonation and length) and conceptually dissimilar (§ 57). 38

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Therefore the opposition based on a likelihood of confusion should be rejected (§ 63-64).

On Article 8(5) EUTMR: Taking into account that the signs are dissimilar, the application of Article 8(5) EUTMR is excluded, therefore the opposition should also be rejected on this ground (§ 68).

The appeal is upheld.

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