

# Alicante News

Up to date information on IP and EUIPO-related matters



Picture: © Valentina Vitali



**William Lobelson talks to James Nurton**

## First Page

---

- The DesignEuropa Awards – winners announced!

James Nurton  
Interviews

William Lobelson

---

## Registered Community Design

---

- Maintenance in an amended form

## Statistical Highlights

---

- October 2016

## ETMDN Updates

---

- ARIPO and SIC (Colombia) join Designview

## More News

---

- Management Board and Budget Committee (MBBC) meets at EUIPO
- EUIPO performance update

## Case Law

---

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



## First Page



### The DesignEuropa Awards – winners announced!

The DesignEuropa Awards finalists in the Industry  
On November 30, the DesignEuropa Awards winners were announced at a ceremony in Milan.

In the Small and Emerging Companies category, the award was won by the Flap sound absorbing panel, owned and manufactured by Caimi Brevetti and designed by Alberto and Francesco Meda. Jurors appreciated the product's blend of visual and tactile elements, and how it bridged industrial and interior design. The jury also pointed to the company's "sophisticated and intelligent use of the RCD system" through its IP management strategy.

The Industry category award was scooped by the Thule Urban Glide, manufactured by Thule and designed by Thule's in-house team with support from Veryday Design.

Thule's designers worked with Veryday to incorporate Thule's design language into the Thule Urban Glide sports stroller ahead of its market launch in 2013. Jurors underlined the design's originality, good technical construction, practicality, social sensitivity and adaptability to different lifestyles.

The Lifetime Achievement Award was presented to legendary designer Giorgetto Giugiaro. Mr Giugiaro has been directly responsible for creating over 300 standard production models and more than 200 research prototypes for numerous different manufacturers.

Approximately 60 million vehicles on the world's roads, produced by leading car makers, are the result of his creativity. Mr Giugiaro's designs include the Volkswagen Golf, the Lotus Esprit, the Fiat Panda, and the Maserati 3200 GT.

The DesignEuropa Awards are organised by the European Union Intellectual Property Office (EUIPO), a decentralised agency of the EU, to celebrate excellence in design and design management among Registered Community Design (RCD) holders. The RCD is a unitary intellectual property right administered by EUIPO and valid throughout the EU-28.

Italian Undersecretary of State Antonio Gentile and the UK's Intellectual Property Minister Baroness Neville-Rolfe joined top designers and industry leaders at the DesignEuropa Awards ceremony at the UniCredit Pavilion for a ceremony that highlighted the importance of design to the EU economy.

According to a study carried out by the EUIPO and the European Patent Office, industries which intensively use design contributed more than 243 billion euros to the EU external trade balance in 2013. Design-intensive companies generated 18% of the EU's GDP, and created 38.7 million jobs.



## The James Nurton Interview



### William Lobelson, partner, Germain & Maureau, Lyon, France

#### What's your background?

I studied law in France and I was involved in an Erasmus programme and went to England, where I had my first course in IP law at the University of Exeter. I felt that this was what I wanted to do. Dealing with IP gives you the opportunity to be in direct touch with the economic world and with innovation and follow how society is progressing on technological and marketing issues. If you do other areas of law, I'm not sure you are so connected to what's happening in the world. That to me was very important.

After that I moved to McGill University in Canada where I also specialised in IP and then I returned to Paris to do a masters in IP. Studying in the UK and Canada as well as France has given me a knowledge of common law and civil law, which has been very helpful in my career.



William Lobelson

#### Where have you worked?

I started my career at the trade mark department of L'Oréal, which is a big trade mark department. Above all it gave me a sense of the importance of listening to the marketing people. They have a vision of trade marks which is totally different from the vision we have as lawyers. That is very helpful in everyday practice – some of my clients are marketing people and I can speak the same language and understand them: I can translate the legal vocabulary of trade marks into marketing terms. You have to speak the language of economics – and explain to the client that this trade mark is not a good choice because it is not unique and it will cost you a fortune or that you will not be able to obtain a significant market share.

Of course clients are always interested in descriptive and generic trade marks, and that is partly because they are interested in having domain names. The marketing people often understand much better than lawyers. With domain names you don't have classification, examination or distinctiveness requirements so it is a bit of a jungle. People choose a domain name and then want the trade mark associated with that domain name and that presents an interesting challenge for trade mark attorneys.

After leaving L'Oreal, I joined an IP firm, where I did trade mark and also patent work. Then I was recruited to Germain & Maureau with the purpose of developing the international part of the firm. I am now a managing partner in charge of the trade mark and design department, also in charge of international clients and supervising the internet and domain name department.

We are the number one EUTM filer in France, and we have a total of 100 people including about 20 trade mark and design attorneys and 30 patent attorneys. We have 11 partners, with headquarters in Lyon, a big branch in Paris, other offices throughout France and one in Geneva for Swiss work. We've



## The James Nurton Interview



been based in Lyon since 1849. We do filing of French, EU and international marks and litigation out-of-court, but when it comes to court we cooperate with avocats.

### What memorable cases have you worked on?

The first French trade mark I remember was for the name of the actress Claudia Cardinale. One of our clients had a trade mark application for a rose with her name and that required getting her consent. I did get to meet her in the end.

I had an interesting case at EUIPO a few years ago relating to the symbols placed on the controller of the PlayStation game consoles. I was thinking about this recently following the recent Rubik's Cube decision as it raised similar issues about 2D and 3D trade marks, technical function and so on. The PlayStation case involved many trade mark issues and was an unusual and interesting case. It was an invalidation action I had to defend and in the end it was settled.

### How well do you think the EU trade mark system works?

The system is smooth – it works pretty well and is cost-effective, no doubt about it. It is also a source of harmonisation of the trade mark laws in the EU, which is still not perfect but is much better than we would have without EUIPO.

However there are some legal issues that are still unclear, such as serious use in a significant part of the EU. The case law goes from one end to the other and it is very difficult to advise clients on whether there is serious use or not.

I also think it's an unfortunate decision of the Office to have pre-formatted lists of goods and services for the applicants, which creates a problem – especially for non-EU applicants with priority based on their home applications. That creates uncertainty and objections and I regret that we do not have the freedom we used to have to draft a lists of goods and services in a more flexible way. I regret that there is not

a difference between professional applicants and other applicants: of course if you don't have a representative, you need a simplified system, but for professionals I think the system could be different.

We do a lot of Community design work too and I'm very happy with the system. If anything, the procedure is too quick. Once you've pushed the button, it's too late to correct a possible mistake! Apart from that, it's cheap and efficient and is a very good tool, and I'm a big fan.

There is also a pretty easy design invalidation procedure at the EUIPO. It's the same system in France except in France you have to go to court to decide if they're valid. At EUIPO, it's better because if you want to invalidate a design you go to the cancellation division.

### How does France compare?

It needs to improve. For example, oppositions are quick – within six months – but the system is not flexible at all. You cannot file a simple notice of opposition so you have to meet the deadline and file your entire opposition with all the arguments. You also can't ground an opposition on more than one trade mark so it becomes very costly if you have several marks. If the adverse party does not respond to your opposition, then you cannot appeal the Office's decision at the Board of Appeal so you have to go to court which is very costly too.

The opposition procedure needs a huge reform, as well as the possibility to introduce non-use cancellation actions at the trade mark office, which are not possible at the moment.

We also have the so-called SVR rule which means that if the Office does not respond, your application or renewal is automatically rejected without a decision. This is a big concern to us at the moment.





## The James Nurton Interview



We expect France will implement the Directive soon, but we are not sure when. We have a new president of the IP Office starting in January, so we expect a lot for him. We also have an election of a new president of the IP association and next year we have a presidential election in France, which might influence policy.

### What changes will arise from the Directive?

The major change in France would relate to the opposition procedure and the opportunity to file non-use cancellations in the Office and that I really look forward to. That will be a big advantage for clients. At the moment, you have to go to court and many clients are reluctant to start such a heavy procedure. We hope the new INPI president will move forward quickly and implement sooner than the seven-year deadline.

The French jurisprudence more or less follows the CJEU jurisprudence and the EUIPO decisions and policies. We have the same issues with 3D marks, colour marks and non-traditional marks. I really believe harmonisation is the key to success for the European system.

I am also a qualified Swiss trade mark agent so I do filings and oppositions. I try to encourage clients to apply in Switzerland simultaneously with EUTMs to get broad protection. But Switzerland has a very different approach to distinctiveness which presents a challenge!

I'm not particularly worried about Brexit in terms of trade marks at least. I'm pretty sure we will find a mechanism to protect trade marks and I expect the UK IPO Office will remain harmonised in trade marks and designs. So I don't expect much to change, except it will be a little bit more expensive: people will probably designate the UK through the Madrid Protocol.

### What do you think of the Madrid System?

Clients find the Madrid System attractive but we have a duty to tell them that it is not harmonised like the EU, and they may face objections in almost each and every country, for example to reword the list of goods or services. While it seems cost-effective at the beginning, it can end up being expensive. I regret that lack of harmonisation in the Madrid System, but I know WIPO is working on it.

### What other challenges do you see?

I'm most involved with internet issues. That is a real challenge. I read somewhere that IP departments' budgets have remained the same but their spend on trade marks has decreased. They are spending more money on defending against cyber attacks, so digital brand management is becoming a hot topic.

Our job is to anticipate clients' needs and this is a hot issue that professionals need to be aware of and involved in. The trade mark world is now shifting from the concrete world to the virtual world. There is so much counterfeiting on social networks now. This is a worldwide issue, and the networks are based all over the world. Global harmonisation of procedures would be nice but I don't expect it soon!



## Registered Community Design



### Maintenance in an amended form

The Invalidation Division has recently delivered a decision, following a remittal by the Boards of Appeal, that confirms its previous conclusion to declare a Community design invalid for lack of individual character after reviewing and rejecting the holder's request for maintaining the design in amended form (**ICD 9019rev of 28/06/2016**).

The contested Community design (shown below) was registered for aerials in 2008 and renewed in 2013. By nature it is embodied in a portable aerial with 360° signal acceptance. In 2014 it faced an invalidity action before the Office and was declared invalid for lack of individual character in view of an earlier disclosed design.

An appeal was filed against the decision. The Third Board of Appeal annulled the contested decision and remitted the case to the Invalidation Division since the latter had not taken into account the holder's request for the contested RCD to be maintained in amended form.

The request is based on Article 25(6) CDR, which stipulates that a registered Community design that has been declared invalid pursuant to Article 25(1)(b) CDR may be maintained in an amended form, if in that form it complies with the requirements for protection, and the identity of the design is retained. 'Maintenance' in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

The Office requires that the amended form should be submitted by the holder of the contested design and that the applicant should be given an opportunity to comment on it.

The disclaimed features for which protection is not sought may be shown in interrupted lines.

According to the Office, the contested design retains its identity if:

- the Community design is incorporated in a product that constitutes a component part of a complex product and the disclaimed features are invisible during normal use of this complex product (Article 4(2) CDR); or
- the disclaimed features are dictated by a technical function or by reasons of interconnection (Article 8(1) and (2) CDR); or
- the disclaimed features are so insignificant in view of their size or importance that they are likely to go unnoticed by the informed user.

In the present case, the RCD holder submitted the contested design in an amended form, showing part of it in interrupted lines, and claimed that the identity of the design was retained because the features disclaimed from design protection were solely dictated by the technical function. In support of this argument, the holder submitted a patent application for the technical solution of an omnidirectional aerial.

The applicant claimed that in court proceedings concerning an alleged infringement of the contested design, the holder had denied that the same features were solely dictated by the technical function.

#### Article 8(1) CDR

According to the Office's practice, Article 8(1) CDR denies protection to those features of a product's appearance that are chosen exclusively for the purpose of allowing a product to perform its function, as opposed to features that are chosen, at least to some degree, for the purpose of enhancing the product's appearance.



## Registered Community Design



Aesthetic considerations are, in principle, relevant only when the designer is developing the product's appearance. Most of the time, the designer will be concerned with both elements of good design: functionality and visual appeal. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution (decision of 06/06/2016, R 1341/2015-3 — 'Light Emitting Diodes', paragraph 18).

Whether Article 8(1) CDR applies must be assessed objectively rather than from the point of view of the informed user, who may have limited knowledge of technical matters.

In the present case the Invalidity Division held that the technical aspect was not the sole factor considered when an aerial like that in the patent application as a whole or its dipole part were constructed, and that there was nothing on file to indicate that this was the case in the development of the dipoles in the contested design. Even the inventor of the solution in the patent application expressed some aesthetic considerations when deciding to show the embodiment of 'the preferred solution having elegant appearance'.

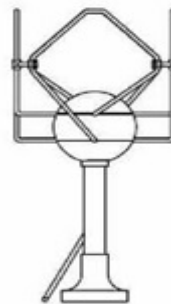
The holder did not submit convincing evidence to demonstrate that the dipole loops in the contested RCD were chosen with a view to constructing the product solely for the purpose of enhancing the product's technical function. As mentioned in the case-law cited above, aesthetic considerations are, in principle, relevant only when the designer is developing the product's appearance. The dipoles, as a substantial visible part of the product, contribute prima facie to its appearance.

As correctly noted by the holder in the Polish court proceedings, these elements comprise some technical considerations, which it is appropriate to take into account when assessing the individual character of the design; however, those elements are not solely dictated by the technical function pursuant to Article 8(1) CDR.

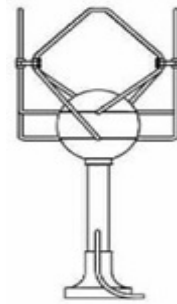
In the light of the foregoing, the amended form submitted for the contested RCD was rejected because accepting it would not retain the identity of the design.

In the appeal proceedings, the parties did not bring any new arguments about aspects other than those dealt with as described above; therefore, the assessment of novelty and individual character was maintained, and the earlier outcome of the invalidity proceedings confirmed.

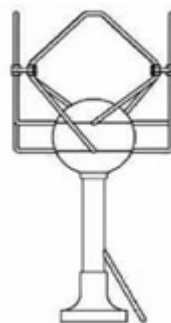
### Contested [RCD 000918677-0001](#)



1.1



1.2



1.3

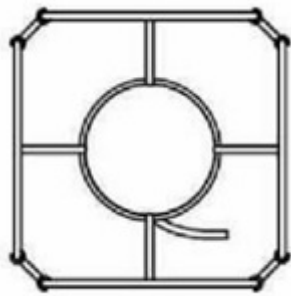


1.4

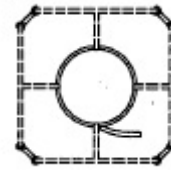




## Registered Community Design

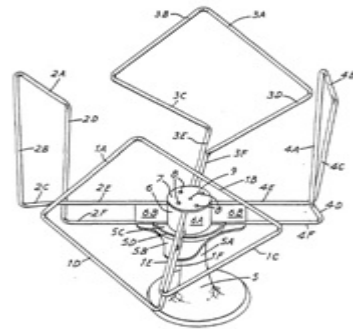
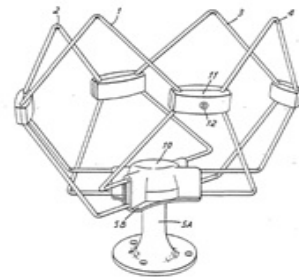
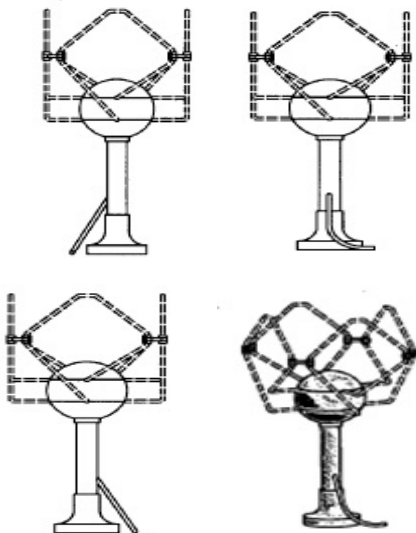


1.5



PCT/GB85/00579 for *omnidirectional antenna array*, filed in the name of MAX-VIEW AERIALS LIMITED [GB/GB] on 12/12/1985, cited by the holder:

Contested RCD 000918677-0001 in amended form submitted by the holder:



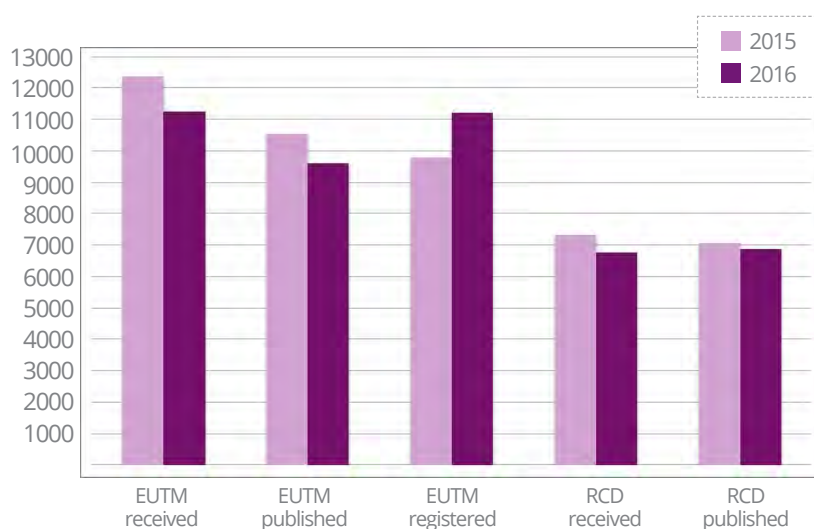


## Statistical Highlights



Monthly statistical highlights October*	2015	2016
European Union Trade Mark applications received	12 352	11 247
European Union Trade Mark applications published	10 539	9 605
European Union Trade Mark registered (certificates issued)	9 768	11 224
Registered Community Designs received	7 324	6 751
Registered Community Designs published	7 057	6 865

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





## ETMDN Updates



### ARIPO and SIC (Colombia) join Designview

On 31 October 2016, the African Regional Intellectual Property Organization (ARIPO) made its industrial design data available to the DesignView search tool. On 21 November 2016, The Colombian Superintendence of Industry and Commerce (SIC) also joined DesignView.

With ARIPO on-board, Designview now contains data from 52 offices.

With the addition of more than 1,100 designs from ARIPO, and 9,000 Designview now provides information and access to nearly 10,2 million designs in total.

Since the introduction of Designview on 19 November 2012, the tool has served more than 2.1 million searches from 146 different countries, with Germany, Spain and the UK among the most frequent users.

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



## More News



### Management Board and Budget Committee (MBBC) meets at EUIPO

The Management Board and Budget Committee (MBBC) of EUIPO met at the Office from November 15-17.

The Management Board and Budget Committee are composed of representatives of the Member States of the EU-28, the European Commission and the European Parliament, with the Benelux Office of Intellectual Property (BOIP), the European Patent Office (EPO), the World Intellectual Property Office (WIPO) and user associations acting as observers.

On November 15, Patricia García-Escudero Márquez, the Director-General of the Oficina Española de Patentes y Marcas, the Spanish Patent and Trade Mark Office, was elected as chairperson of EUIPO's Management Board. Ms García-Escudero's mandate begins on January 1 2017.

On November 17, Sandris Laganovskis, the Director of the Patent Office of the Republic of Latvia, was elected as incoming Deputy Chair of the Budget Committee of EUIPO. His mandate begins on 26 February 2017.

During the three days of meetings, members discussed and approved the Work Programme 2017 of the Office, including the Observatory. The Budget Committee approved the Draft Budget 2017 of the Office.

### EUIPO performance update

EUIPO has published the [2016-Q3 results for timeliness, quality and accessibility](#).

The Office is committed to improving the quality and timeliness of its decisions. Due to a significant rise in the applications received by the Office during last year and the first half of 2016, several indicators' results have deteriorated.

The Office is working intensively to bring those indicators back to the Compliance range. Correspondingly, in the next few months the Office will implement several corrective and preventive actions.

All Office accessibility indicators remain in the Excellence range, reflecting the Office's strong focus on supporting and listening to our users.

For any comment or suggestions, please contact [CGS@euipo.europa.eu](mailto:CGS@euipo.europa.eu).



## Case law

### Luxembourg trade mark and design news

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

**Case C-575/15P; Industria de Diseño Textil, S.A. (Inditex) v EUIPO; Order of 26 October 2016; Language of the case: ES**

**RESULT:** Action dismissed

**KEYWORDS:** Declaration, Proof of Use, Revocation grounds, Right of Defence

**FACTS:** The trade mark ZARA was registered in a number of Classes of the Nice Classification on 3 January 2001. An application for revocation of the EUTM for the goods and services in Classes 39 and 42 was filed pursuant to Article 51(1)(a) EUTMR. The Cancellation Division (CD) upheld the application for revocation in both Classes, but the Board of Appeal (BoA) confirmed the revocation only for the services in Class 39, in so far as the applicant had not provided enough evidence to demonstrate the genuine use of the mark. The applicant filed an application for annulment before the General Court (GC), which dismissed the action. The applicant filed an appeal before the Court of Justice of the European Union (CJ) on the basis of six grounds.

EUTM

ZARA

**SUBSTANCE:** The CJ dismissed all the grounds. It found that the action was partly manifestly inadmissible and partly manifestly unfounded, due to misinterpretation of the judgement by the applicant and the lack of precision in indicating the contested



elements of the judgment which annulment is sought and the legal arguments supporting his claims (paras. 30-31). The CJ also found that distortion of evidence was not manifested in the proceeding since the quantified data provided couldn't prove the genuine use of the mark for services in Class 39 (paras. 20-21). The CJ did not find any evidence of an infringement of the right of defence (paras. 38-39).

**Case C-223/15; combit Software GmbH v Commit Business Solutions Ltd.; Preliminary ruling of 22 September 2016; Language of the case: DE**

**KEYWORDS:** Likelihood of confusion, Infringement

**FACTS:** This request for a preliminary ruling was made in proceedings between combit Software GmbH, proprietor of the German and EU word marks combit for goods and services in the computer industry, on the one hand, and Commit Business Solutions Ltd., who was selling software bearing the word sign Commit in a number of countries including Germany, on the other hand. The proprietor of the earlier mark sought an order for the applicant to refrain from using, in the EU, the word sign Commit for the software it was marketing. In the alternative, it requested, in reliance on its German trade mark, an order that the applicant refrain from using that word sign in Germany.

The Landgericht Düsseldorf (Regional Court) dismissed the applicant's principal claim but upheld its alternative claim. The applicant brought an appeal before the Oberlandesgericht Düsseldorf (Higher Regional Court) regarding its principal claim. The appeal court concluded that there is a likelihood of confusion (LOC) in the German-speaking Member States and there is NO LOC in the English-speaking Member states, since that part of the public is capable of identifying an important conceptual difference between the signs, as 'commit' has a clear meaning in English and 'combit' is made up of two usual terms in the computer industry ('com' for computer and 'bit'





## Case law



for 'binary digit').

The appeal court decided to stay the proceedings and refer it to the Court of Justice of the European Union (CJ) for a preliminary ruling:

<b>EUTMA</b>
<b>Commit</b>
<b>Earlier mark</b>
<b>combit</b>

**SUBSTANCE:** QUESTION REFERRED TO THE CJ: How Article 1(2), Article 9(1) (b) and Article 102(1) of Regulation (EC) N° 207/2009 must be interpreted where an EU trade mark court finds that the use of a

sign creates a LOC with an EU trade mark in one part of the EU whilst not creating such LOC in another? (para. 23)

**ANSWER OF THE CJ:** when the use of a sign creates, in one part of the EU, a LOC with an EU trade mark, whilst, in another part of the Union, that same use does not give rise to such a LOC, the court must find that the function of the trade mark as an indication of origin is adversely affected and, therefore, there is an infringement of the exclusive right conferred by the mark (para. 25). However, the court must limit the territorial scope of prohibition in the part of the EU where there is NO LOC, in particular for linguistic reasons (para. 31). The defendant must submit the arguments and evidence of NO LOC in a certain area, so that legitimate trade arising from the use of the contested sign in that part of the EU cannot be prohibited. As observed by the Advocate General (AG), such prohibition would go beyond the exclusive right conferred by the EUTM (para. 32).

Without prejudice of the unitary character of the EUTM, Article

1(2), Article 9(1) (b) and Article 102 (1) must be interpreted as meaning that, where an EU trade mark court finds that the use of a sign creates a LOC with an EUTM in one part of the EU but not in another part thereof, the EUTM court must conclude that there is an infringement of the exclusive right conferred by the EUTM and issue an order prohibiting the use in question for the entire area of the European Union with the exception of the part in respect of which there has been found to be NO LOC (para. 36).

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

**Case T-367/14; August Storck KG v EUIPO + Chiquita Brands LLC; Judgement of 18 October 2016; Language of the case: EN**

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

**KEYWORDS:** Extent of use, Proof of use, Sales figures, Purpose of the goods and services, Evidence of use, Complementary goods and services, Nature of the goods and services

**FACTS:** The Cancellation Division (CD) had upheld the application for revocation against the EUTM N° 5014519 FRUITFULS (word) covering Confectionary, chocolate and chocolate goods, pastry (Class 30). The decision relied on Article 51(1)(a) and established that the EUTM owner did not prove genuine use of the contested mark during the relevant period. The Board of Appeal (BoA) dismissed the appeal in its entirety and endorsed the CD's conclusions. The BoA took the view that the volume of sales made by the owner, compared to sales made on the European confectionary market, was extremely low and therefore not enough to prove the genuine use of the mark. The decision was appealed before the General Court (GC).



## Case law

EUTM

**FRUITFULS**

**SUBSTANCE:** The GC analysed in the first place the applicant's third complain, by means of which the BoA had been criticised for having compared the volume of sales of products showing the contested mark to sales on the confectionary market as a whole in the entire European Union (para. 18). In particular the applicant stressed that confectionary market is not a uniform market, since it is divided into several branches; therefore it was not correct to compare the sales related to the whole market to the sale referring to a sub-category of confectionary products, namely hard fruit candies (para. 18).

The GC reminded that evidence of genuine use must in principle cover all of the goods covered by the EUTM, but if the evidence refers to only a part of the goods the mark might be revoked just partially (para. 21).

It is to be taken into account that, even though the EUTM covered Confectionary, chocolate and chocolate goods, pastry, the proof of use provided by the applicant concerned just a single type of confectionary, namely hard fruit candies (para. 22). Such evidence of use consisted of a few deliveries of goods to consumer in Slovenia, at the very end of the relevant period.

Since the BoA confirmed the CD's conclusions according to which the volume of sales made by the applicant was extremely low (para. 7), the GC had to investigate whether the CD and BoA were right to compare the applicant's sales of hard fruit candies with the market volume of the wider confectionary category in the entire Europe.

The GC reported that, according to case-law, when a trade mark has been registered for a category of goods which is sufficiently broad to include a number of independent sub-categories, proof that the mark has been put to genuine use in relation to a part of the goods affords protection only for the



sub-category to which those goods for which the mark was used belong (para. 27).

On the contrary, if a trade mark has been registered for goods precisely and narrowly defined, then, for the purposes of the opposition, the proof of genuine necessarily covers the entire category (para. 28).

The GC had to verify, therefore, whether hard fruit candies constitute a coherent sub-category of confectionary or whether these goods are part of a single group of goods.

The applicant put forward that huge differences exist between the different types of confectionary and that hard fruit candies are not interchangeable with any other confectionary product (para. 34).

Nevertheless, the GC assessed that the decisive criterion for defining sub-categories of goods or services is the purpose and intended use of the goods and that the nature and characteristics of these goods was irrelevant. It follows that, even if the nature or characteristics of different types of goods are different and these goods are not interchangeable, to constitute a separate sub-category of goods, it is necessary that their purpose or intended use be different (para. 35). This was not the case.

The GC recognized, however, that it is impossible for a EUTM owner to prove the use of the mark for all conceivable variations of goods belonging to the product category. As a consequence the GC considered that the BoA was wrong to compare sales of a specific type of hard fruit candies, namely candies showing the contested mark, with the production volume and the turnover in the whole confectionary sector in the entire European Union. In doing so, the BoA imposed an excessive burden of proof to the owner (para. 40).

Concerning the extent of the use, the GC reminded that it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine and that the aim of the proof of use is not to assess the commercial success of an undertaking (paras. 42 and 43).

Once it has been proven that a trademark was used in accordance with its essential function and to create or preserve



## Case law



an outlet for the designated goods, it shall be concluded that the mark was genuinely used (para. 44).

In the case at issue, instead, the BoA used a method of reasoning which underestimate the relative scale of the applicant's sales (para. 46). In particular the GC found that the BoA erred not only by comparing the applicant's sales of hard fruit candies with the market volume of confectionery as a whole, but also by comparing the sales made by the applicant in Slovenia with the market volume in the entire European Union (para. 48).

Finally, the CG partially annulled the decision of the BoA as regards the revocation of the mark in relation to confectionery products in Class 30, and dismissed the remainder of the action.

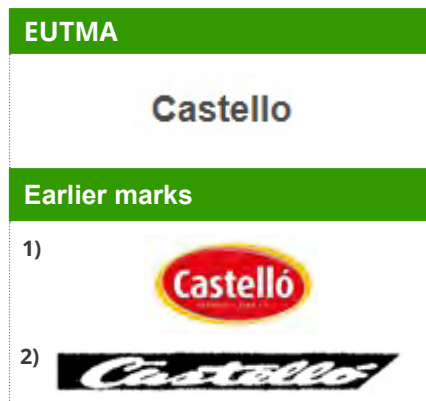
### **Case T-549/14; Lidl Stiftung & Co. KG v EUIPO; Judgment of 4 October 2016; Language of the case: EN**

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

**KEYWORDS:** Conceptual similarity, Dominant element, Evidence of use, Extent of use, Likelihood of confusion, Nature of the goods and services, Nature of use, Packaging, Phonetic identity, Place of use, Proof of use, Purpose of the goods and services, Similarity of the goods and services, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the word mark Castello as an EUTM for goods and services in Classes 29, 30 and 31. An opposition based on, inter alia, the earlier figurative marks represented below (EUTM and Spanish), registered for goods and services in Classes 30, 35 and 39, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in part with respect to certain goods in Classes 29 and 30 and rejected it in respect of the remainder. Both parties filed an appeal. The Board of Appeal (BoA) of the Office

dismissed the appeal brought by the applicant and partially upheld the action brought by the opponent. The BoA found the evidence of use of the earlier Spanish mark sufficient (the earlier EUTM was not subject to proof of use) and the marks in question very similar. The BoA found identity/similarity between all the contested goods in Classes 29 and 30 and concluded that there was a likelihood of confusion for those goods. Goods in Class 31 were considered dissimilar. The applicant filed an action before the General Court (GC) relying on 2 plea(s) in law: (i) infringement of Article 42(2) and (3) of Regulation No 207/2009 and of Rule 22(3) and (4) of Regulation No 2868/95 and (ii) infringement of Article 8(1)(b) of Regulation No 207/2009. The GC partly upheld the appeal. It confirmed the BoA's findings regarding proof of use (POU) and regarding the likelihood of confusion (LOC) in respect of all goods in Classes 29 and 30, however, it found that the contested frozen fruit and vegetables in Class 29 were not similar to any of the goods covered by the earlier trade marks and to this extent it upheld the action.



**SUBSTANCE:** First plea (POU): Use of the earlier Spanish mark without the figurative elements does not alter the distinctive character of the trade mark as registered (paras. 49-50). The same applies for the use of the Spanish mark as the earlier EUTM (para. 56). Printouts from the opponent's



## Case law

invoicing system only demonstrate use within the undertaking concerned, they nevertheless constitute indirect evidence of genuine use (para. 55). The submitted invoices and packaging are sufficient to prove genuine use; the evidence relates to a sufficiently large range of goods to cover all the goods designated by the Spanish mark (paras. 52-53). The first plea is rejected. Second plea (LOC): Comparison of goods: baking ingredients of all kinds, candied fruits, glacier cherries, raisins, sultanas, candied orange peel and candied lemon peel on the one hand and industrial confectionery on the other hand are complementary; there is a similarity between these products. The former are ingredients of the latter; although this is not in itself sufficient to conclude that there is as similarity, it is necessary to take into account that the consumer himself uses the ingredients to make confectionery good or patisserie or baking goods – on that account such goods must be considered interchangeable and in competition (para. 74); thus the average consumer will associate the ingredients with the final goods covered by the earlier mark, even though the latter are industrial goods (para. 72). Another factor for similarity is that both sets of goods are processed products (para. 73). The same reasoning was applied to a rather broad array of contested goods in Class 29 which can be ingredients of patisserie and bakery goods (paras. 77, 79, 86). Nevertheless, there is no similarity between the contested frozen fruit and vegetables and any of the goods covered by the earlier mark. They are sold in specific departments, they are generally not processed, they are closer to fresh or raw goods (para. 82). As regards the contested goods in Class 30, they are all similar to the goods of the earlier marks (paras. 87-96). The GC confirmed the BoA's assessment of the similarity of the signs and other factors for LOC and concluded that there was LOC for the identical and similar goods. The second plea is partially upheld, but only for frozen fruit and vegetables (paras. 97-115).



**Case T-824/14; Eveready Battery Company, Inc. v EUIPO; Judgment of 18 October 2016; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Extent of use, Evidence of use

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods in Classes 3 and 8. An opposition based on the earlier word mark EDGE, registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition, finding that the opponent had proved the genuine use of the earlier mark for shaving gels and that there was a likelihood of confusion in respect of some of the contested goods. The Board of Appeal (BoA) upheld the applicant's appeal and annulled OD's decision. It found that the evidence filed by the opponent to prove use, namely a sworn statement, six invoices and clippings and pictures of labels and displays, was insufficient to establish genuine use of the earlier mark. The opponent filed an action before the General Court (GC) relying on a single plea in law, namely an erroneous assessment of the proof of genuine use of the earlier mark for the purposes of Article 15(1) and Article 42(2) EUTMR. The GC dismissed the appeal, thus confirming the BoA's decision.

EUTMA

Earlier mark

EDGE



## Case law



**SUBSTANCE:** The GC considered, contrary to the opponent's arguments, that the BoA did not fail to take the information contained in the sworn statement into account. However it rightly found that this information (approximate sale figures in EUR) was imprecise and that the number of units sold until the end of the relevant period was unknown. In addition, the fact that the turnover values were formulated as approximations weakens the probative force of the statement, while the number of units shown in the invoices do not give any direct information as to the total of sales in EUR it mentions (paras. 27 and 29). As regards the information contained in the six invoices, neither the quantity of units sold (1872 units, of which 1620 units in a single invoice and the other five for very small amounts), nor the frequency of invoices or the duration of use (covering only four months at the end of the relevant period) is sufficient in this case to establish genuine use of the mark (para. 32). The GC also held that a change in the ownership of the earlier mark (which in this case happened a year before the relevant period) does not affect the requirement that the use of the earlier mark must be genuine, irrespective of the point at which the opponent became the proprietor of that mark. He is not obliged to prove the continuous use of his mark during the relevant period, but to establish in respect of that period that there was real commercial exploitation of that mark in the course of trade (para. 42). The additional documents filed by the opponent (clippings and pictures of labels and displays) did refer to the nature and place of use, but did not contain any information concerning the duration or the extent of use of the goods at issue (paras. 45-48)

**Case T-512/15; Sun Cali Inc. v EUIPO; Judgment of 22 September 2016; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Representative, Likelihood of confusion

**FACTS:** The EUTM proprietor was granted the registration of the figurative mark SUN CALI represented below as an EUTM for goods and services in Classes 18, 25, 35 and 45. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The Cancellation Division (CD) partly upheld the application for invalidity in so far as goods in Classes 18 and 25 were concerned. Both the invalidity applicant and the EUTM proprietor appealed the CD decision. The Board of Appeal (BoA) joined the appeals and (i) dismissed the EUTM proprietor appeal as it considered that it was not duly represented before BoA pursuant to Article 92(2) EUTMR (R1260/2014-5) and (ii) partly upheld the invalidity applicant's appeal (R1281/2014-5). It also declared the EUTM invalid in respect of the services in Class 35. It dismissed the appeal insofar the services in Class 45 were concerned. The proprietor filed an action before the General Court (GC) relying on two pleas in law: (i) alleged infringement of Article 92(3) EUTMR and (ii) alleged infringement of Article 8(1)(b). The GC dismissed the appeal. It found that the EUTM proprietor did not meet the requirements of Article 92 EUTMR and therefore its appeal before BoA was inadmissible. It also confirmed the existence of likelihood of confusion (LOC) as regards the services in Class 35.

EUTM

Earlier mark





## Case law



**SUBSTANCE:** REPRESENTATION OF FOREIGN COMPANIES BEFORE BOA (R1260/2014-5): The GC assessed whether the applicant (a US based company) met the requirements of Article 92(3) EUTMR so it could be represented by its CEO in her alleged capacity as an employee of a commercial establishment in Munich. It confirmed BoA assessment. The GC first assessed whether the applicant had a real and effective industrial or commercial establishment in the EU so it could be represented before the Office by an employee. GC confirmed that the evidence presented before BoA by the applicant (extracts from a website, pictures of an establishment in Munich) was not capable of proving the real and effective commercial establishment in the EU (para. 28). The GC recalls in this respect the case-law in Somafer on the concept of a branch and concludes that the evidence does not show that the establishment in Munich cannot be considered a branch of the US company (para. 30). This is further confirmed by the commercial register extracts submitted by the Other Party (para. 31). Secondly, the GC assessed whether the employee of a legal person having its real and effective establishment in the EU could represent another legal person established outside the EU (the applicant) given their economic connections. The GC confirms that the entries in the commercial register of the establishment in Munich show that it was registered as a 'sole trader' (paras. 33-34). The GC considers that, as a matter of principle, a sole trader, with no legal personality, cannot represent a legal person established outside the EU. In any case, even if the sole trader had legal personality, the applicant had not proven any economic connections between the Munich shop and the applicant: the evidence submitted does not show that the two persons are part of the same group, or that the existing management mechanisms are such that one of those two controls the other (para. 36 in fine). LOC (R1281/2014-5): the GC considered that the applicant was a party as of right to the parallel proceedings R1281/2014-5 brought by the Other Party, even if it had not been duly represented before the BoA and had not submitted observations. Pursuant to Article 65(4) EUTMR, the

applicant was entitled to seek the annulment of the contested decision which invalidated the EUTM also for services in Class 35 (para. 40). The GC confirms that retail services for clothing are connected to clothing in the sense that those goods are indispensable or at the very least important for the provision of services (paras. 55-56). It confirms that the signs coincide partially visually and phonetically on account of the presence of the word element "cali" (paras. 69 and 71) and conceptually similar for the part of the public who would associate "cali" with California (para. 74). In view of the similarity of the goods and services to a certain degree, the similarity of the signs and the average level of attention of the public, the GC concludes on the existence of LOC (para. 79).

**Case T-355/15; Alpex Pharma SA v EUIPO; Judgment of 30 September 2016; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Catalogue, Evidence of use, Packaging, Proof of use, Specialised public

**FACTS:** The applicant sought to register the word mark ASTEX as an EUTM for goods and services in Classes 1, 5, 9, 42 and 44. An opposition was directed against all services in Class 42. It was based on the earlier word mark represented below, registered for services in Class 42, inter alia, and was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on four pleas in law. The first two pleas allege infringement of Article 15 and Article 42(2) EUTMR and of Rule 22(3) and (4) CTMIR in respect of proof of use and genuine use. The third plea alleges infringement of Article 75 EUTMR and the fourth plea alleges infringement of Article 76(1) EUTMR. The GC dismissed the appeal.



## Case law

EUTMA

**ASTEX**

Earlier mark

**ALPEX**

**SUBSTANCE:** PROOF OF USE AND GENUINE USE: The GC confirmed that the evidence filed was not sufficient to prove genuine use of the contested services in Class 42. Conducting research in the field of pharmaceuticals in order to develop an undertaking's own drugs does not constitute an external service for third parties. A service is generally supplied for an economic consideration yet the volume/turnover linked to the external supply of those services is not mentioned (para. 37). The brochures do not make it clear whether the presented lists of equipment, tests and methods form part of offers sent to third parties or whether they are simply a presentation of the applicant's laboratories in the internal context of its pharmaceutical business (para. 38). The applicant's submission that invoices for pharmaceuticals in Class 5 also show genuine use of the earlier trade mark for services in Class 42, given that the pharmaceuticals are the final result of scientific, technological and research services carried out by the applicant was rejected by the GC. There was no evidence that the customers named in the invoices requested the applicant to develop pharmaceutical products for their specific needs or that it actually supplied such services to them (paras. 39 and 40). **OBLIGATION TO STATE REASONS:** The GC confirmed that the BoA provided reasoning why clinical trials in respect of obtaining marketing authorization for pharmaceuticals could not serve as evidence of provision of services to third parties. Marketing authorization is merely part of the process of placing pharmaceuticals on the market. The BoA demonstrated to the required legal standard the reasons why genuine use in respect of services in Class 42 was not proven (para. 47).



**Case T-574/15; Kozmetika Afrodita d. o. o. v EUIPO; Judgment of 28 September 2016; Language of the case: SL**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Complex mark, Conceptual similarity, Descriptive element, Figurative element, Figurative trade mark, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity, Weak element

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark, *inter alia*, represented below and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in part. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on two pleas in law, a violation of Article 8(1)(b) EUTMR and Rule 50(2) (h) CTMIR. The GC dismissed the appeal.

EUTMA

KOZMETIKA  
AFRODITA

Earlier mark

EXOTIC AFRODITA MYSTIC MUSK  
OIL

*et al.*

**SUBSTANCE:** LIKELIHOOD OF CONFUSION: The GC confirmed that a possible allusion of the word 'AFRODITA' (perceived as a Greek goddess of love and beauty by the relevant Spanish public) to beauty products/services does not make the mark descriptive. It is also not a generic term used in the area of



## Case law

beauty care (paras. 36 and 37). Contrary to the applicant's view, 'AFRODITA' is the dominant and the most distinctive element in the contested sign since 'KOZMETIKA' is descriptive and will be understood by the relevant public, whereas the figurative element is a banal representation of 'AFRODITA' and merely reinforces its concept (para. 38). 'AFRODITA' is also the most distinctive and remembered element of the earlier mark since the much shorter albeit also distinctive word 'MUSK' occupies a secondary position (the one before last). The remaining elements 'EXOTIC', 'MYSTIC' and 'OIL' will be understood and are descriptive of the goods and services (para. 41). Due to the common and most distinctive element AFRODITA, the signs are visually, phonetically and conceptually similar to a normal degree (paras. 47-51). In view of the identity and similarity of the goods and services and similarity of the signs which share the most distinctive element 'AFRODITA', likelihood of confusion cannot be excluded (para.57). DUTY TO STATE REASONS: The GC confirmed that it was not necessary to compare the remaining earlier mark because the outcome would be the same since the remaining mark covers the same goods and services and the signs are less similar than those compare. The principle of the duty to state reasons was not violated (paras. 65-67).

**Case T-575/15; Kozmetika Afrodita d. o. o. v EUIPO; Judgment of 28 September 2016; Language of the case: SL**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Complex mark, Conceptual similarity, Descriptive element, Figurative element, Figurative trade mark, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity, Weak element

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods and services in



Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark, *inter alia*, represented below and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in part. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on two pleas in law, a violation of Article 8(1)(b) EUTMR and Rule 50(2) (h) CTMIR. The GC dismissed the appeal.

### EUTMA



### Earlier mark

EXOTIC AFRODITA MYSTIC MUSK  
OIL  
*et al.*

**SUBSTANCE: LIKELIHOOD OF CONFUSION:** The GC confirmed that a possible allusion of the word 'AFRODITA' (perceived as a Greek goddess of love and beauty by the relevant Spanish public) to beauty products/services does not make the mark descriptive. It is also not a generic term used in the area of beauty care (paras. 38 and 39). Contrary to the applicant's view, 'AFRODITA' is the dominant and the most distinctive element in the contested sign since 'COSMETICS' is descriptive and will be understood by the relevant public, whereas the figurative element is a banal representation of 'AFRODITA' and merely reinforces its concept (para. 40). 'AFRODITA' is also the most distinctive and remembered element of the earlier mark since the much shorter albeit also distinctive word MUSK occupies



## Case law

a secondary position (the one before last). The remaining elements 'EXOTIC', 'MYSTIC' and 'OIL' will be understood and are descriptive of the goods and services (para. 43). Due to the common and most distinctive element 'AFRODITA', the signs are visually, phonetically and conceptually similar to a normal degree (paras. 50-57). In view of the identity and similarity of the goods and services and similarity of the signs which share the most distinctive element 'AFRODITA', likelihood of confusion cannot be excluded (para.59). DUTY TO STATE REASONS: The GC confirmed that it was not necessary to compare the remaining earlier mark because the outcome would be the same since the remaining mark covers the same goods and services and the signs are less similar than those compared. The principle of the duty to state reasons was not violated (paras. 67-69).

**Case T-776/15; Meissen Keramik GmbH v EUIPO; Judgment of 18 October 2016 Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Descriptive element

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 11, 19 and 20 such as sanitary devices, building materials or furniture. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(c) and (b) EUTMR, as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the appeal. It found that the German speaking public would understand the terms 'Meissen' (a place in Germany) and 'Keramik' (ceramics) in the sense of ceramics originating from Meissen. The BoA held that the sign is descriptive for goods made of ceramics. For the remaining goods, which did not expressly contain ceramics there exists complementarity to ceramics. The graphical elements of the mark applied for were



found to be minimal and not able to detract the attention of the public from the descriptive content of the sign. Furthermore the blue graphical element alludes to waves and thus also to sanitary installations made of ceramics. The applicant filed an action before the General Court (GC) relying on two pleas in law, namely infringement of Article 7(1)(b) and (c) EUTMR. The GC dismissed the appeal.

### EUTMA



**SUBSTANCE:** In para. 23 the GC found that the BoA did not necessarily have to take a benevolent or applicant friendly approach as the applicant claimed, but rather had to perform a full and stringent examination as had been decided judgments dated 10/03/2011, *Agencja Wydawnicza Technopol*, C-51/10 P, EU:C:2011:139, para. 77, and 08/06/2005, *Wilfer/OHIM [ROCKBASS]*, T-315/03, EU:T:2005:211, Rn. 20; see also in that sense judgement dated 13/09/2013, *Fürstlich Castell'sches Domänenamt/HABM – Castel Frères [CASTEL]*, T-320/10, EU:T:2013:424, (paras. 26 to 29). It dismissed also the argument that the term 'Meissen Keramik' is grammatically incorrect or that various mental steps would be necessary in order that the sign makes sense (para. 24). The graphics is neither characteristic nor striking, but commonplace and in view of the goods descriptive (para. 34). The overall impression is not influenced by the graphics as has been held already by the Court of Justice of the European Union in the judgment dated 15/09/2005, *BioID/OHIM, C-37/03 P, EU:C:2005:547*, (paras. 71 and 74). As regards the goods at issue, the GC confirmed that they are in any event complementary to ceramics, which had not been disputed by the applicant. As the sign is descriptive and one absolute ground is fulfilled, the GC did not have to examine Article 7(1)(b) any further.



## Case law



**Case T-14/15; Lufthansa AirPlus Servicekarten GmbH v EUIPO; Judgment of 20 October 2016; Language of the case: EN**

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

**KEYWORDS:** Figurative trademark, Infringement, Multiple applications, Restitutio in integrum

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for services in Classes 35 and 39. An opposition based on the earlier word mark AirPlus International registered for goods in Class 9 and for services in Class 35, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition in its entirety. On the same date, the OD also issued a decision concerning opposition, brought by Airpas Aviation AG against the mark applied for, at issue in the present case, based on an earlier figurative EUTM registered. The OD upheld the opposition in those proceedings in part and concluded that there was a likelihood of confusion (LOC) for the services in Class 35. The decision adopted was definitive. The Board of Appeal (BoA) dismissed the applicant's appeal and ordered to pay the costs. It found that there was no LOC within the meaning of Article 8(1)(b) EUTMR, as the signs at issue were different. The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 64(1) and Article 76(1) EUTMR, leading to infringement of Article 8(1)(b) of that regulation. The GC partially annulled the appeal. It found that, although the applicant's single plea in law was based on Articles 64 and 76 EUTMR, it is sufficiently clear from the application that the applicant also intended to plea an infringement of Rule 21(3) of Commission Regulation (EC) 2868/95. Due to the decision adopted in the parallel opposition proceeding has become final as consequence of the action brought by the applicant regards the services in Class 35, the action has become devoid of purpose in that

regards; nevertheless, the BoA should have concluded that there was no need to adjudicate in part and therefore freely allocated the costs in that regard.

EUTMA



Earlier mark

AirPlus International

**SUBSTANCE:** The GC emphasized that according to settle case-law, it is not necessary for a party to indicate expressly the provisions on which its pleas are based. It is enough for the subject matter of that party's application and the main elements of fact and law on which it is based to be set out sufficiently clearly in the application, which is the case here (para. 38). The GC recalled that in pursue of Rule 21(2) of Regulation No. 2868/95, in the event of multiple oppositions, if a preliminary examination of one or more oppositions reveals that the trade mark for which an application for registration has been filed is possibly not eligible for registration in respect of some or all of the goods or services for which registration is sought, the Office may suspend the other opposition proceedings. Pursuant to Rule 21(3) of Regulation No. 2868/95, applicable mutatis mutandi to appeal proceeding under Rule 50(1) of the regulation, if the final decision leads to the rejection of the EU trade mark application, the parallel opposition proceedings in which the assessment has been suspended are deemed to be closed. The termination of proceedings is therefore considered to constitute a case which has not proceeded to judgment within the meaning of Article 81(4) EUTMR (para. 42). Although the BoA did not take in consideration the decision of the OD adopted in the





## Case law

parallel proceeding and it had no bearing on the definitive nature of the contested decision, which refused registration of the mark applied for as regards the services in Class 35, that omission had the result of ordering the applicant to pay the costs incurred by the EUTM applicant within the meaning of Article 85(1) EUTMR. However, as it is apparent from the foregoing, the BoA should have concluded that there was no need to adjudicate in part and therefore freely allocated the costs in that regard, pursuant to Article 85(4) of that regulation (paras. 49). As the applicant never have disputed the reasoning underlying the contested decision, but rather dispute his responsibility to assume the costs incurred by the EUTM applicant, the contested decision must be partially annulled.

**Case T-4/15; Beiersdorf AG v EUIPO; Judgment of 7 September 2016; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Descriptive element

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for soaps, perfumery, essential oils, cosmetics, hair lotions in Class 3, adding a disclaimer to the effect that it does not claim any exclusive right as regards the sign 'Q10' as such. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and to be descriptive in relation to the goods at hand. The Board of Appeal (BoA) dismissed the applicant's appeal. It held that the disclaimer cannot be accepted as it seeks to exclude the principal, if not only, component so that nothing remains in the application which can be subject to an exclusive trade mark right. The EUTMA describes within the meaning of Article 7(1)(c) EUTMR that the goods contain the active component 'Q10'. For this reason, the EUTMA also lacks the required



distinctiveness under Article 7(1)(b) EUTMR. The applicant filed an action before the General Court relying on 3 pleas in law, namely an infringement of Article 37(2) of Regulation (EC) No. 207/2009 and of Article 7(1)(b) and (c) EUTMR. The GC dismissed the appeal.

EUTMA



**SUBSTANCE:** The entry of a disclaimer presupposes a distinctive element of the sign applied for (para. 17). It serves to clarify that the exclusive trade mark right does not extend to the non-distinctive elements, which remain in the public domain (para. 18). As to the sign at hand, the figurative elements, namely the yellow colour, the extended stroke of the letter 'Q' and the type face are too simple and banal to be perceived as distinctive elements to be separated from the word 'Q10' and thus do not determine the public's perception. Hence, the BoA was entitled to refuse the disclaimer (paras. 21-26). Furthermore, the figurative elements do not render the sign, which designates the coenzyme 'Q10' contained in the goods, distinctive within the meaning of Article 7(1)(b) EUTMR (paras. 31, 36).

**Case T-625/15; Spa Monopole, compagnie fermière de Spa SA/NV v EUIPO; Judgment of 27 October 2016; Language of the case: FR**

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

**KEYWORDS:** Dominant element, Distinctive element, Reputation, Phonetic similarity, Visual similarity, Conceptual similarity, Similarity of the signs



## Case law



**FACTS:** The EUTMA SPA VILLAGE covers services in Classes 43 (including bar services, restaurant, hotel) and 44 (including beauty treatment). An opposition is filed by the owner of the Benelux mark Spa which has reputation in respect of mineral water. The opposition was based on Articles 8(1)(b) and 8(5) EUTMR. The Opposition Division (OD) upheld the opposition under Article 8(1)(b) EUTMR. The Board of Appeal (BoA) annulled this decision and dismissed the opposition both under Articles 8(1)(b) and 8(5) EUTMR. BoA considered that the goods and services (G&S) were dissimilar and that any risk of unfair advantage was ruled out given that the word 'spa' has a plurality of meanings, including a descriptive one, the signs have a limited similarity and the G&S have only a remote connection. The General Court (GC) annuls the BoA decision under Article 8(5) EUTMR.



**SUBSTANCE:** The reputation of the earlier mark Spa was not challenged and was even already established by the GC case-law (para. 31).

GC finds that the degree of visual and aural similarity of the marks is higher than what BoA found given that 'Spa' is clearly recognisable in the mark applied for (para. 37) and that this term is not descriptive in the context of Class 43 services (para. 38). Conceptually the signs are highly similar because 'Spa Village' does not form a logical unit of its own (para. 40). Overall, the degree of similarity of the signs is average, if not high (para. 41).

There is therefore a link between the marks. Regarding the similarity of the G&S, GC finds that there is a degree of 'proximity' between these G&S which is strengthened by their complementarity (paras. 51-54). GC confirms that, if the uniqueness of a mark is a strong sign of a high distinctive character per se, the polysemy of a sign does not, however, impact adversely a mark's reputation acquired by use (para. 59).

The reputed mark Spa is associated with an image of health, beauty and purity. Such an image would facilitate the sale of the contested services which would be perceived as bringing health and well-being (para. 64). The fact that the image of purity is foreign to bar services and hotel services is irrelevant because a mark can be linked with different images and messages and it is enough for Article 8(5) to apply if an association of the contested mark with only one of them would facilitate its commercial success (para. 66). Given that the appeal is upheld under Article 8(5) EUTMR, there is no need to examine the plea alleging a violation of Article 8(1)(b) EUTMR.



## Case law



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#### **R0789/2016-2 CRISP WILD**

**RESULT:** Decision annulled.

**KEYWORDS:** Descriptive element, Distinctive element, Function of trade mark, Nature of the goods and services, Purpose of the goods and services

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

**FACTS:** The applicant sought to register the word mark 'CRISP WILD' for goods in Class 34. The Office in its decision objected to, and partially refused, the trade mark applied for with regard to the goods 'cigarettes; tobacco; tobacco products' on the basis of Article 7(1)(b) and 7(1)(c) EUTMR. The term 'CRISP' means 'firm, dry, and brittle, especially in a way considered pleasing or attractive', and 'WILD' means (of an animal or plant) living or growing in the natural environment; not domesticated or cultivated'. The examiner found that the relevant consumer would understand the combination of the words 'CRISP WILD' as a meaningful expression, i.e. that the contested goods were firm, dry, and brittle and grown in the natural environment. Therefore, this trade mark conveyed obvious and direct information regarding the texture and natural growing conditions of the contested goods (§ 24).

**SUBSTANCE:** Signs can be allusive to quite a degree and not cross the line into a designation of a characteristic (§ 24).

The term 'CRISP' does not have an immediate meaning in relation to the contested goods. Even if it were assumed that there is a supposedly descriptive link between the term 'CRISP' and tobacco, the term 'WILD' also has no immediately clear meaning in relation to the goods in question or any obvious laudatory connotation. It does not qualify 'CRISP' in any concrete way to reinforce its descriptive or laudatory message. Quite the opposite in fact: the combination of the two words 'CRISP' and 'WILD' introduces a somewhat fanciful combination (§ 25).

It follows that the appeal must be upheld, the contested decision annulled, and the mark may be accepted for publication for all the goods applied for (§ 34).

#### **R2096/2015-2 COYOTE UGLY (fig.) / COYOTE UGLY**

**RESULT:** Decision annulled.

**KEYWORDS:** Likelihood of confusion, Similarity between the goods and services, Similarity of the signs

**NORMS:** Article 8(1)(b) EUTMR, Article 53(1)(a) EUTMR

**FACTS:** A request for a declaration of invalidity was filed against the figurative mark



registered for, among others, goods in Class 9. The invalidity applicant invoked the German word mark 'COYOTE UGLY' registered in Classes 20, 33, 41 and 43. The Cancellation Division partially upheld the invalidity request, declared the contested EUTM registration invalid for 'cultural activities' in Class 41 and allowed it to remain registered for all the remaining goods 'magnetic data carriers and phonograph records' in Class 9.



## Case law

**SUBSTANCE:** Contrary to the contested decision, the Board finds that the contested 'magnetic data carriers and phonograph records' may consist of carriers having a specific content or blank carriers used for recording (§ 23-36). Such goods (containing recorded audio tapes and recorded phonograph records) are similar to the 'production of pieces of music' and 'musical performances, live performances for public entertainment' in Class 41 covered by the earlier mark. Given the high level of similarity between the signs and the similarity between the conflicting goods and services, the Board finds that there is a likelihood of confusion on the part of the public in Germany (§ 40).

Therefore, the appeal is allowed, the contested decision is partially annulled to the extent that it rejected the invalidity request for 'magnetic data carriers and phonograph records' in Class 9 and the contested trade mark registration is declared invalid in its entirety (§ 41).

**R1339/2015-5 Device of a series of upward pointing elements (fig.) / Device of a series of upward pointing elements (fig.)**

**RESULT:** Decision confirmed.

**KEYWORDS:** Dissimilarity of signs, Distinctive element, Figurative element, Figurative trade mark, Identity between the goods and services, Likelihood of confusion, Nature of the goods and services, Purpose of the goods and services, Visual dissimilarity

**NORMS:** Article 8(1)(b) EUTMR

**FACTS:** An opposition was filed against all the goods and services (Classes 21 and 44) based on the earlier figurative EUTM registration represented below, registered, among others, for goods and services in the same classes. The grounds of the opposition were those laid down in Article 8(1)



(a), (b) and Article 8(5) EUTMR. The opponent argued that the signs and goods were practically identical. The Opposition Division rejected the opposition

### Contested EUTM



### Earlier EUTM



**SUBSTANCE:** Taking into consideration the abstract, figurative nature of the earlier mark, its level of inherent distinctiveness must be set below average. The Board considers that, as a general rule, an abstract figurative sign consisting of just a few geometric forms is inherently weak, since it will neither attract the consumer's attention, nor can be monopolized. A lower than average degree of inherent distinctiveness allows for the registration of a sign, but can only grant it a corresponding low degree of protection. The Board, therefore, concludes that the earlier sign is imbued with a weak distinctive character that has not been shown to have been enhanced in any way by use or reputation. It must, therefore, be concluded that the earlier sign enjoys a limited scope of protection. This was also confirmed by the Court, in its judgment of 17 May 2013 (T-502/11, Stripes, EU:T:2013:263, § 56 - 60). Since the trade marks in conflict only have a low degree of visual similarity and bear no similarities phonetically or conceptually, the Board has to conclude that there is no likelihood of confusion (§ 33 -35). The contested decision is confirmed and the opposition is dismissed (§ 37).



## Case law



### [R0793/2015-1 MASSI / MASI et al.](#)

**RESULT:** Decision annulled.

**KEYWORDS:** Database printout, Declaration, Evidence of use, Identity between the goods and services, Likelihood of confusion, Press articles, Res judicata, Similarity of the signs, Well-known trade mark

**NORMS:** Article 8(1)(b) EUTMR, Article 8(2)(c) EUTMR, Article 53(1)(a) EUTMR

**FACTS:** A request for a declaration of invalidity of the EUTM 'MASSI' was filed with respect to the contested goods in Class 12. The request was based, inter alia, on Article 53(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR based on the well-known trade mark 'MASI' for 'bicycles and parts thereof' in the sense of Article 8(2)(c) EUTMR. The Cancellation Division rejected the invalidity request.

**SUBSTANCE:** The cancellation applicant has proven in a clear, convincing and effective manner that the trade mark 'MASI' has a high degree of knowledge and recognition in the relevant sector of the Italian public (§ 34). Taking into account the identity between the goods and the high level of similarity between the signs, the Board concludes that there is likelihood of confusion (§ 40). This conclusion cannot be overturned by the EUTM proprietor's arguments. Specifically, with respect to its argument that the cancellation applicant has acquiesced in use of the contested EUTM, as there is no evidence to sustain that. In order for Article 54(2) EUTMR to apply, the cancellation applicant would have had to have been aware of, and acquiesced, in the use of the contested EUTM in the Member State in which its earlier mark is protected, i.e. in Italy. The EUTM proprietor has not proven any use of its trade

mark in this territory, so the provision of Article 54(2) EUTMR cannot apply (§ 41).

The request for a declaration of invalidity is upheld. Consequently, the contested decision is annulled and the contested EUTM declared invalid in its entirety (§ 42).