

Alicante News

Up to date information on IP and EUIPO-related matters



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On Sunday 1 October 2017



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Second phase Legislative Reform

On Sunday 1 October 2017, the second phase of the Legislative Reform process entered into force.

The changes, which include the abolition of the graphical representation requirement, the introduction of the EU Certification mark and other procedural changes linked to the simplification and modernisation of the EUTM system, have been under preparation at EUIPO since the last wave of changes came into force on 23 March 2016.

Users were at the heart of EUIPO's preparation for the changes. The first priority was to provide the user community with as much information as possible before the changes came into effect. To this end, EUIPO updated the Office website with a summary of the changes, plus a detailed questions and answers section, and launched a series of webinars aimed at users as and from September 2017.

The [Office's Guidelines](#) had to be revised in the light of the second phase, to include the changes and additions brought about by the legislative reform.

As a result, on 22 September 2017, the Executive Director of the EUIPO signed the Decision adopting the revised Office Guidelines, which received a favourable opinion from the EUIPO's Management Board earlier in September ([Decision No EX 17-1 adopting the Guidelines](#)).

They are available on the EUIPO website under the [Current trade mark practice](#) and [Current designs practice](#) pages, and a [webinar recording](#) focusing on the changes has been made available for users. EUIPO has also created a [learning resource](#) for users on the changes, which is available through the EUIPO Academy Learning Portal.

In the context of the changes, a number of Decisions of the Executive Director of EUIPO have been published. [Decision No EX-17-4](#) sets out the accepted means of electronic communication with the Office, including an Annex setting out the technical requirements, size and formats for attachments to electronic filing and communication.

From 1 October 2017, along with the User Area (e-filing), fax falls within the definition of communication by 'electronic means', meaning that the discounted fee for EUTM applications and renewals by electronic means in Annex I EUTMR will apply to fax.

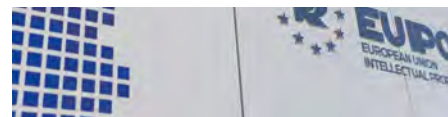
From 1 January 2018, however, fax will no longer be accepted for filing EUTM applications or renewals except as a backup system if technical malfunctions prevent e-filing. In such a case applicants can secure a filing date by fax if: (i) for EUTM applications, they resubmit the same application by e-filing within three working days; (ii) for EUTM renewals, they submit the renewal application by fax no more than three working days before the expiry of the initial or extended statutory time limit for renewal.

This change recognises the massive shifts away from fax for EUTM applications and renewals (less than 1% and 2% of the totals, respectively), but also recognises the reassurance that fax provides as a 'backup' system even for users who have switched to e-filing. Moreover, the change is a further step towards the Office's objective of becoming fully electronic by the end of the Strategic Plan 2020.

Finally, users are also reminded that, as of and from 1 October 2017, applications for trade marks where the representation has a colour component (including figurative marks) cannot be filed by fax because there are no legal provisions that facilitate the subsequent filing of a representation in colour.



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In addition the following Decisions were also published on 26 September 2017 and can be consulted [on the Office's website](#):

- [Decision No EX-17-3](#) concerning the formal requirements of priority and seniority claims for EUTMs and IRs designating the EU setting out the requirements where information is available online, when documentation is required and rules on translations;
- [Decision No EX-17-5](#) concerning the formal requirements of priority claims for registered Community designs including the relaxation of requirements for a copy of earlier filing certificate;
- [Decision No EX-17-6](#) concerning technical specifications for annexes submitted on data carriers setting out the specific media accepted as data carriers, file formats and sizes, the treatment of incomplete or illegible annexes and the consequences of non-compliance;
- [Decision No EX-17-7](#) concerning methods of payment of fees and charges covering issues such as the priority of administrative charges over other fees, lack of funds, the minimum amount to open an account, 'insignificant amounts' for refunds, the misuse of accounts and payments by credit/debit cards and current accounts.



The James Nurton Interview



Interview: Luigi Sansone, Salomone Sansone, Malta

Tell me about your firm?

Our firm was set up in 1947 by my great-grandfather. He ran it as a one-man operation until my grandfather joined in 1967. However, he only worked in IP part-time as he was also general manager of a car import firm. He had a meticulous, analytical mind and had fought in the Second World War – and was often working on IP in his study at home after office hours. He managed the work very well.

I studied law and went to the University of Buckingham in the UK where I obtained an LL B in 1989. As he knew I was studying law, my grandfather asked me to learn about what he did and it was then that I realised how interesting the IP world was, as well as how much potential there was in the firm. I was only 22 years old at the time, and not yet a qualified lawyer, but I joined the firm. In 1994 we bought our first premises in Valletta and in January 1996 I became fully qualified.



Luigi Sansone

Until that point, we had been farming out the legal work but then I started handling it myself. For a while I was also practising as a general commercial law firm but by 2001 I was pretty much only doing IP.

On 1st May 2004 Malta became an EU member state, which made it much more relevant for IP rights holders, and there was a large influx of work. There was a fall in demand for local trade mark filings, but legal issues, including around conversion and enforcement, became much more frequent.

What issues in particular did you see?

Probably the most significant thing was that in February 2000, when it was gearing up for EU membership, Malta passed a law allowing us to stop counterfeit goods in transit. This enabled Customs to inspect goods passing through the free trade zone in Malta, and we would be informed on behalf of our clients so that they could take a legal action in Malta. Many of these goods are en route from China to north Africa.

When we joined the EU it was natural to carry on this practice, even though we realised that there was a lack of harmonised legislation on this subject, and there were decisions from the CJEU which cast doubt on whether such seizures were possible at all.

What was interesting was that our law focused on the nature of the goods, rather than what was use in the course of trade – if the goods bear an identical mark for infringing goods, then those goods themselves infringe the trade mark rights. Importantly, the law was part of the Customs legislation, rather than the Trademarks Act.

EU law was silent on this issue. It was at this point in 2009 that the Nokia case reared its ugly head in the UK courts, and was then referred to the CJEU, so I took a particular interest in that. Mr Justice Kitchin's conclusion was that the goods could not be



The James Nurton Interview



seized in that case. I realised that Malta could be an example for other countries in this area, and I became involved in the lobbying around reform of this issue, and defending the legitimacy of the Maltese law.

The Maltese law was firmly based on GATT and TRIPS, which protect freedom of trade but also give members the right to legislate if goods in transit are counterfeit goods. I was involved with various trade mark associations, and my view was that – despite the Nokia case – European law did not prevent member states from having laws allowing the seizure of goods in transit.

Later, in March 2013, the EU Commission published proposals regarding seizing goods in transit, which showed the foresight of Malta's legislators back in 2000. There were some questions about this from some member states, and high-level discussions took place at the European Parliament and within the Council. The outcome was that the legislative reform within the EU provides that rights holders can seize goods in transit unless the counterparty can prove that in the country of destination the rights owner cannot prevent the marketing of the goods. So there is a heavy burden on the defendant. I think it is a well-balanced legal provision which should go a long way towards easing concerns among the sceptics. It already applies to EU trade marks and now member states must implement it in their national laws by January 2019. I think it gives good opportunities to rights owners to stop goods in transit.

Will the changes have any impact on Malta?

It is business as usual in Malta. We welcome the EU reforms as it makes things even clearer and gives IP rights holders the level of protection and peace of mind they deserve to have. There is a very good system where Customs make random searches, and take photos and samples. The rights owner then has 10 working days, plus another 10 days if necessary, to build their case and file a lawsuit if they wish. It works very

well and shows that even though we are by far the smallest EU member state we can have effective IP rights enforcement.

Despite its small size, Malta is among the top countries for counterfeit items seized, and we see huge numbers of seizures each year. Customs have an IPR Enforcement Unit with three officers, and they work incredibly hard and are very efficient and proactive.

What kind of work does your firm do now?

We are the only firm in Malta that focuses almost exclusively on IP, and most of our work is trade mark and patent law. We have grown from just one person to 11 now – including three lawyers and one paralegal – and we are still growing.

What do you most like about working in IP?

I think it's important to be enthusiastic about whatever you do, and IP is something I really enjoy. Being at peace in your professional work means you don't mind working long hours! I am also always learning new things, and we have a lot of foreign clients, which makes the work interesting.

Having said that, we are seeing more and more Maltese-registered companies among our clients due to the economic miracle in Malta, which has led to a huge increase in all sectors. Malta has much to attract investors, including a tax-friendly environment, the English language and a great climate!

Do Maltese companies understand about IP?

They do more and more. We also see a lot of investment from foreign companies, for example in the gaming industry. It's very important that these businesses pay attention to IP.



The James Nurton Interview



We have a very solid infrastructure and an efficient court system, though we don't yet have specialised judges. All IP cases are assigned to the same judge, who over time becomes more and more knowledgeable on the subject. The court of first instance delivers judgments in a reasonable time, which is important for litigants.

The only problem is that the court of appeal is troubled by a backlog of work, so appeals take longer than one would like. The Ministry of Justice is working on this and we hope the situation can be improved soon.

The James Nurton Interview is produced monthly for Alicante News, and contains the personal views of the interviewee.



Registered Community Design



Capacity to act before the Office in design proceedings extended to parties and representatives from EFTA States

As of 1 October, the Office will accept parties and representatives from EFTA States (Iceland, the Principality of Liechtenstein and the Kingdom of Norway) to act in design proceedings pursuant to the requirements set by Articles 77 and 78 CDR.

Whilst these provisions refer to the European Union and its Member States, their territorial references shall be interpreted to include the European Economic Area and the EFTA States. This new practice is called for in particular by the EEA-Agreement stipulating the principle of freedom to provide services within the European Economic Areas, as enshrined in Article 36 EEA-Agreement (see judgement of 13 July 2017, T-527/14, Paul Rosenich/EUIPO, ECLI:EU:T:2017:487).

It also prevents an unwarranted divergence between trade mark and design proceedings. Following Regulation (EU) 2015/2424 of 16 December 2015 amending the former CTMR, parties and representatives from EFTA States are entitled to act in trade mark proceedings pursuant to the requirements set. For trade mark proceedings, this technical adaptation confirms the obligations arising from the EEA-Agreement, which may be directly applicable (see judgement of 13 July 2017, T-527/14, Paul Rosenich/EUIPO, ECLI:EU:T:2017:487).

For design proceedings the new Office practice avoids an unequal treatment between legal practitioners and representatives entered on the Office's list of professional representatives. This list instituted for trade mark proceedings and thus now open for representatives from EFTA States is equally valid for design proceedings by virtue of Article 78(1)(b) CDR. The Office's new practice thus puts legal practitioners within the meaning of Article 78(1)(a) CDR from EFTA States on par with professional representatives from this list.

This new practice is reflected in the new Guidelines and subject to [Communication No 2/17 of the Executive Director](#).

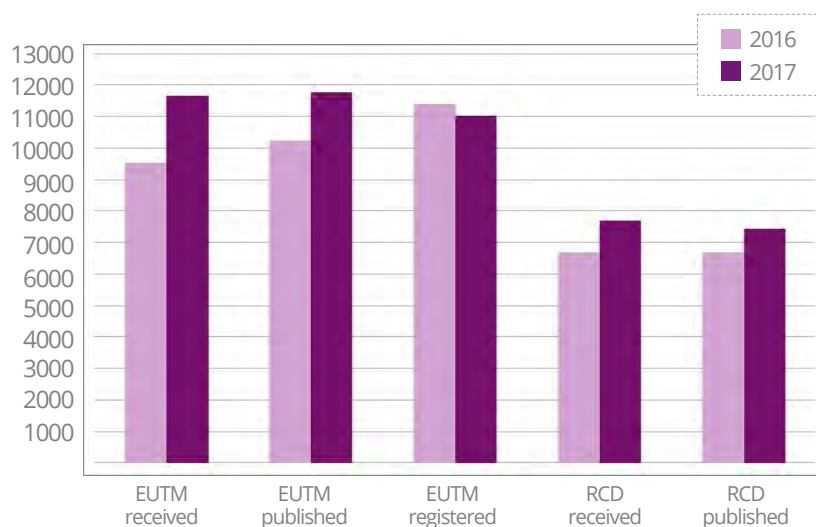


Statistical Highlights



| Monthly statistical highlights August* | 2016 | 2017 |
|--|--------|--------|
| European Union Trade Mark applications received | 9 532 | 11 668 |
| European Union Trade Mark applications published | 10 224 | 11 782 |
| European Union Trade Mark registered (certificates issued) | 11 385 | 11 006 |
| Registered Community Designs received | 6 672 | 7 679 |
| Registered Community Designs published | 6 685 | 7 441 |

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





EUIPN Updates



Peru joins DesignView

The National Institute for the Defence of Free Competition and the Protection of Intellectual Property of Peru (INDECOPI) made its industrial design data available to the DesignView search tool.

With INDECOPI on board, DesignView now contains data from 57 offices. With the addition of almost 5,000 designs from INDECOPI, DesignView now provides information on and access to almost 12.4 million designs in total.

DesignView is available in 35 languages.

Since the introduction of DesignView on 19 November 2012, the tool has served more than 2.9 million searches from 148 different countries, with Germany, the UK and Spain among the most frequent users.

Workshop to facilitate the extension of EUIPN tools to non-EU IP Offices

From 11-15 September, EUIPO hosted a workshop to facilitate the extension of tools developed through the European Union Intellectual Property Network to non-EU IP Offices.

Experts from Albania, Bosnia and Herzegovina, Former Yugoslav Republic of Macedonia, Georgia, Iceland, Liechtenstein, Montenegro, Norway, Serbia, Switzerland and Turkey attended the workshop, held at EUIPO's headquarters in Alicante.

The workshop took place under the framework of the Office's Strategic Plan 2020 and its Line of Action "Intensify Network Engagement" (Line of Action 4), and contributes towards the development of the "Extension of tools and support to Observatory in non-European countries" Project.



More News



Legislative Reform (Phase II) course now available

The new course, available at the [EUIPO Academy Learning Portal](#), provides an overview of the changes that will come into effect on 1 October, including the elimination of the graphical representation requirement and the introduction of EU certification marks, as well as other procedural changes. The course can be accessed [here](#).

IP Case Law Conference 7-8 May 2018: save the date!

Almost a year ago, the [IP Case Law Conference](#) took place at EUIPO's headquarters in Alicante.

As a result of the success of the first edition, the Office is preparing a second edition of the IP Case Law Conference, which is open to all. This conference will again focus on a variety of selected, essential and relevant legal trade mark and design related topics.

Please save the date. More information and registration details will follow soon.

e-Communication: delivering results for users

In 2016, users saved EUR 24 million in administrative fees and EUR 3.7 million in administrative costs by using eCommunication, according to an analysis carried out by the EUIPO.

The analysis assesses and quantifies the impact of its eCommunication services on the user filing process in 2016. In terms of time and money spent, users saved up to 15 minutes and EUR 8 per file, and the equivalent of one tree was saved (70 kg of paper) for every 1 000 online filings made. The risk of incurring a formality deficiency was found to be halved when taking the electronic route.

More than 75 000 users are now registered in the EUIPO User Area and use of electronic interactions continues to grow:

| Q4 2016 | e-filing |
|---------|--------------------------|
| 99.4% | EUTMs |
| 98.3% | RCDs |
| 97.7% | Renewals EUTMs |
| 98.4% | Renewals RCDs |
| 94.3% | Oppositions |
| 87.7% | Change of name/address |
| 81.8% | Recordals |
| 53.7% | Inspections |
| 70.0% | Outgoing eCommunications |
| 58.8% | Incoming eCommunications |



Case law

Luxembourg trade mark and design news

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

Case T-343/14; Arrigo Cipriani, v EUIPO; Judgment of 29 June 2017, EU:T:2017:458; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Bad faith, Personal name mark, Reputation

FACTS: An application for invalidity was filed against the EUTM CIPRIANI pursuant to Article 53(2)(a) EUTMR in conjunction with Article 8(3) of the Italian Industrial Property Code (IPC), which make reference to personal name rights, and Article 52(1)(b) EUTMR. The Cancellation Division (CD) found inadmissible the claims related to the infringement of the Article 52(1)(b), in so far as a national court had already given a definitive ruling on that issue. The CD considered inadmissible also the part of the application related to Article 53(2)(a) EUTMR as regards the use of the contested sign for services in Class 42, in so far as the applicant had knowingly acquiesced to the use of the contested mark for more than five years. As regards the goods and services in Class 16 and 35, the CD held that there was no infringement of the applicant's right to its name. The Board of Appeal (BoA) dismissed the applicant's appeal. As to the infringement of Article 52(1)(b), it found that the predecessor in title of the intervener, who had lawfully run Hotel Cipriani for years, was entitled to seek registration of the contested mark. As to the infringement of Article 53(2)(a) EUTMR, first, it found that the evidence supporting the invalidity request always makes reference to the name and surname of the applicant, Arrigo Cipriani, and that the use of the surname CIPRIANI on its own did not constitute an infringement of the applicant's right to its name; secondly,



it found that an usurpation by a third party of the name of a well-known person cannot take place where the mark was registered by a person who bears the same surname, i.e. Giuseppe Cipriani, father of the applicant and predecessor in title of the intervener.

The applicant filed an action before the General Court (GC) relying on two pleas in law: infringement of Article 53(2)(a) EUTMR read in conjunction with Article 8(3) of the IPC and infringement of Article 52(1)(b) EUTMR.

EUTM

CIPRIANI

SUBSTANCE: The GC dealt first with the second plea in law, alleging infringement of the Article 52(1)(b) EUTMR and found that the registration of the contested mark may be regarded as part of the commercial strategy of the intervener's predecessor in title (para. 45), who simply wished to extend the protection of its national mark to the EU level, behaviour which could not be assimilated to an act of bad faith (para. 50). As to the English Court's judgement, which the BoA had referred to, the GC considered that consistent case law allowed the BoA to take into account that judgement as one of the indicia when assessing the facts at issue (para. 38), in particular to establish whether the right over the use of the name CIPRIANI of the intervener's predecessor in title was limited to a period of five years and to the hotel sector. Consequently, the BoA cannot be criticised for having referred to the 2008 judgment (para. 38). Therefore, the BoA did not err in holding that there was no bad faith on the part of the intervener's predecessor in title (para. 69).

As to the first plea, alleging infringement of Article 52(1)(b) EUTMR read in conjunction with Article 8(3) of the IPC, the GC agreed that the contested mark could be declared invalid if its use could be prohibited under Italian law for a well-known name protected by Article 8(3) of the IPC (para. 78). The



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applicant was therefore required to prove that the renown of the Cipriani name, used only, having regard to the contested mark, in the form of that single name, was attached to his person (para. 91). This was not the case, since the name Cipriani could also evoke the intervener's predecessor in title, who filed the application for the contested mark, and thereafter the intervener, or even the intervener's Italian word mark Cipriani (para. 100). In conclusion, the fact that, under Article 8(3) of the IPC, the applicant could not rely on the renown of the Cipriani name without it being accompanied by his first name means that that provision could not be relied on in order to dispute the validity of the contested mark (para. 103). The action was therefore dismissed.

Case T-521/15; Diesel SpA. v EUIPO; Judgment of 20 July 2017, EU:T:2017:536; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic identity, Conceptual identity, Identity of the goods and services

FACTS: The applicant filed an application for the registration as an EU trade mark of the figurative mark represented below in respect of the goods in Classes 18, 25 and 28. An opposition based on, inter alia, the earlier EU trade mark represented below registered for goods in Classes 18 and 25 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition because it was considered that the signs were not sufficiently similar for a likelihood of confusion. The Board of Appeal (BoA) fully endorsed OD's decision and dismissed the opponent's appeal. The opponent filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 8(1)(b) EUTMR. The GC upheld the appeal and the BoA's decision was annulled.



EUTM application



Earlier trade mark



SUBSTANCE: The GC endorsed the BoA's findings that the relevant public in the present case consists of the general public in the European Union, the level of attention of which is average (para. 27). Moreover, the GC confirmed that the earlier mark will be perceived by the relevant public as a capital letter 'D' (para. 32). However, it found that the BoA erred in finding that only a small part of the relevant public will perceive the mark applied for as a capital letter 'D' (para. 38). The GC considered that despite the slanted stem which is not attached to the bowl and the absence of a serif in the lower part of the contested trade mark, a non-negligible part of relevant public will perceive the trade mark applied for as a capital letter 'D'. In respect of the visual comparison, differently from the BoA, the GC considered that the stylistic minor differences between the signs cannot dispel the impression of similarity which is apparent from the overall visual comparison of the marks at issue. Therefore, there is a high degree of visual similarity between them (para. 50). As both signs at issue are capable of being perceived by a significant part of the relevant public as a capital letter 'D', they will be pronounced in the same way and thus are phonetically identical (para. 54). Likewise, they are conceptually identical given that they refer to the same letter



Case law

of the alphabet (para. 55). Consequently, the GC held that even if it is accepted that the earlier mark is weakly distinctive, as stated by the BoA, there was a likelihood of confusion between the signs at issue in respect of the identical goods (para. 68), at least for the part of the relevant public who will perceive both signs as capital letters 'D' (para. 69).

Case T-55/15; Certified Angus Beef LLC v EUIPO; Judgment of 14 July 2017, EU:T:2017:499; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Weak element, Likelihood of confusion

FACTS: The contested EUTM application is the figurative mark CERTIFIED ANGUS BEEF AUSTRALIAN for goods and services related to meat derived from Angus Beef (Classes 29, 30 and 43).

The opposition was based on a word mark CERTIFIED ANGUS BEEF BRAND and the figurative mark below amongst others. Both marks were claimed to be well known within the meaning of Article 8(2)(c) of Regulation No 207/2009 in all Member States of the European Union for the goods and services covered by the mark applied for and for certification services, licensing services and quality control services in the field of meat and beef products. The opposition was based on Article 8(1)(b) of Regulation No 207/2009 amongst others. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) upheld the OD's decision. It found that the signs at issue could not be regarded as similar, thus excluding the application of Article 8(1)(b) of Regulation No 207/2009 and the other opposition grounds. The coinciding elements (the word elements, the image of a bovine animal and the frame) were considered non-distinctive so that they could not lead to a likelihood of confusion regardless of the degree of similarity between the conflicting goods and services and the distinctiveness of the earlier mark.



The opponent's application before the GC was merely based on an infringement of Article 8(1)(b) EUTMR.

EUTM application



Earlier trade marks



CERTIFIED ANGUS BEEF BRAND

SUBSTANCE: The GC confirmed that the distinctive character of an earlier mark and the distinctive character of its elements are to be differentiated. Where a mark has distinctive character, that distinctive character must be ascribed to the mark as a whole and not automatically to all the elements of which it is composed. Consequently, the applicant's argument that the word element 'certified angus beef' has acquired distinctive character because the earlier marks are, in its view, well known cannot succeed (para. 22). Since the BoA found that the marks at issue are dissimilar overall, any likelihood of confusion must be ruled out. The possible distinctiveness of the earlier marks, acquired through use, cannot offset the lack of similarity between the marks at issue (para. 24). The fact that a mark is well known or has a reputation has no bearing on the assessment of the likelihood of confusion where the signs at



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issue are different overall (para. 25). The BoA can therefore not be criticised for not having examined the distinctive character which the earlier marks had allegedly acquired through use before or at the same time as it assessed the similarity between the signs at issue (para. 26). Since the BoA did not find that the elements common to the marks at issue were even weakly distinctive and the applicant does not validly call that conclusion into question, the applicant's arguments that the BoA should have examined whether the other elements of which the marks at issue consist were of a lower degree of distinctiveness and whether the overall impression created by those marks was highly similar are irrelevant (para. 27). The BoA cannot therefore be criticised for not having taken into account the OD's findings relating to the well-known character of the earlier figurative mark (para. 29). Since the applicant does not dispute the BoA's findings relating to the dissimilarity of the marks at issue other than by claiming that the earlier marks, as well as the element 'certified angus beef', have acquired distinctive character because those marks are well known, its arguments relating to the comparison of the signs, to the possibly identical nature of the goods and to the existence of a likelihood of confusion are also irrelevant (para. 30). Since there is no similarity between the marks at issue, it is not necessary to analyse whether the goods are similar and whether there is a likelihood of confusion (para. 31).

Case T-541/15; Industrie Aeronautiche Reggiane Srl v EUIPO; Judgment of 20 June 2017, EU:T:2017:406; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Evidence of use, Extent of use, Nature of use, Proof of use, Sales figures, Used in the course of trade

FACTS: The applicant sought to register the word mark represented below as an EUTM for goods in Class 12. An opposition based on the earlier national German word mark represented below, registered for goods and services in Classes 7, 8 and 12, was filed pursuant to Article 8(1)(a) and (b) EUTMR. The Opposition Division (OD) partly upheld the opposition in relation to certain goods of Class 12. The Board of Appeal (BoA) dismissed the applicant's appeal and upheld the opponent's ancillary appeal. It found that use of the earlier right was proven for more goods than originally concluded by the OD. The applicant filed an action before the General Court

EUTM application

NSU

Earlier trade mark

NSU

(GC). The GC dismissed the appeal.

SUBSTANCE: The GC found that the BoA was right to find that genuine use of the earlier mark had been shown both for bicycles in Class 12 and parts of machines in Class 7, and for accessories for automobiles and bicycles, parts of vehicles in Class 12. In this regard the GC clarified that there is no requirement for the evidence of use to be authenticated. Furthermore, the GC concluded that the BoA did not err when it concluded that parts of vehicles in Class 12 and vehicles of the same class were similar goods. Taking into account the identity of the marks at issue and the similarity between the goods in question the BoA correctly concluded that there exists a likelihood of confusion on the part of the relevant public.



Case law



Case T-699/15; City Train GmbH v EUIPO; Judgment of 21 June 2017, EU:T:2017:409; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Force majeure, Restitutio in integrum, Descriptive element, Distinctive element

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 12, 37 and 42. The Office refused the registration of the EUTM application (EUTMA) pursuant to Articles 7(1)(b)(c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC), which however only arrived one day after the end of the appeal period

EUTM application

SUBSTANCE: The GC dismissed the request of the Office to dismiss the appeal as it arrived late. According to the GC the application was late due to unforeseeable circumstances. The applicant did send the application via fax and courier on the very same day, more than two weeks ahead of the end of the appeal period. While the fax was received by the GC on the same day it was sent off, the hard copy of the appeal only arrived one day after the end of the appeal period. According to the GC, the applicant did send off the hard copy version of the application at a time when it could have expected that the delivery would arrive on time. As regards the substance, the GC endorsed the findings of the BoA according to which the EUTMA is merely descriptive for the goods and services and

thus lacks distinctive character. The graphical elements of the EUTMA are negligible and won't change the perception of the relevant public.

Case T-519/15; myToys.de GmbH v EUIPO; Order of 13 July 2017, EU:T:2017:502; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for services in Classes 35, 41 and 45. An opposition based on the earlier word as well as figurative marks represented below, registered for goods in Classes 3, 5, 10, 16, 25, was filed pursuant to Article 8(1) (b) EUTMR. The Opposition Division (OD) partly upheld the opposition in relation to the services retailing, in particular via the internet, of babies' napkins of cellulose in Class 35. The applicant as well as the opponent filed appeals, which were dealt with by the Boards of Appeal (BoA) in two individual proceedings. The BoA dismissed the applicant's appeal in its entirety and partially upheld in a separate decision the opponent's appeal. The applicant filed an action before the General Court (GC) claiming inter alia to annul the contested decision and to revoke the decision relating to the opponent's appeal. The GC dismissed the appeal as being inadmissible.

SUBSTANCE: The GC concluded that the decision of the BoA in the separate appeal proceedings filed by the opponent became final and the applicant's claim, as far as it requests the revocation of said decision, is inadmissible. Furthermore, the GC found that the contested decision merely confirms the earlier decision of the BoA in the appeal proceedings



Case law



EUTM application

myBaby

Earlier trade marks

MAYBABY

MAY BABY



implemented by the opponent. According to the GC, the applicant did not put forward any other arguments capable of calling into question the merely confirmatory nature of the contested decision and the resulting inadmissibility of its action.

Case T-856/16; Rare Hospitality International, Inc. v EUIPO; Judgment of 21 June 2017, EU:T:2017:412; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The applicant sought to register the word mark LONGHORN STEAKHOUSE, represented below, as an EUTM for services in Class 43. The Office refused the registration

of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal pursuant to Articles 58 to 64 EUTMR. The Board of Appeal (BoA) dismissed the appeal. It found that the mark applied for was descriptive of the services in Class 43 and devoid of distinctive character. The applicant filed an action before the General Court (GC) relying on three pleas in law: alleging, first, infringement of Article 7(1)(c) EUTMR, second, infringement of Article 7(1)(b) EUTMR and, third, breach of the principles of equal treatment and sound administration. The GC dismissed the appeal.

EUTM application

LONGHORN STEAKHOUSE

SUBSTANCE: In regard to the first plea, the services covered by the mark applied for are directed at the general public (para. 31). The GC emphasised that the term 'longhorn' may designate specific breeds of cattle, and, in particular, the Texas Longhorn breed of cattle, or it may have a more generic meaning and designate, consequently, without referring to a specific breed of cattle, beef cattle with long horns (para. 27). Therefore, on the one hand, a not insignificant part of the general public which consists of consumers who particularly enjoy red meat, and beef in particular, and who have, consequently, extensive knowledge of the field concerned, will be aware of the Texas Longhorn breed of cattle (para. 32). On the other hand, even if the average English-speaking consumer in EU does not perceive the term 'longhorn' as designating a specific breed of cattle, they will nevertheless be led to regard the term 'longhorn' as constituting a juxtaposition of the words 'long' and 'horn', everyday words commonly used by the English-speaking public, designating an animal with long horns (para. 40). As to the meaning of the term 'steakhouse', it designates a 'restaurant that specialises in serving steaks', namely slices of meat for grilling intended for human consumption, and it is widely and commonly used by



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the English-speaking public. Consequently, a not insignificant part of the relevant public will perceive the mark applied for as being descriptive of the services covered by it (para. 33). In the light of all the above, the average English-speaking consumer, including one who is not necessarily a connoisseur or lover of red meat, will be led immediately to perceive one of the characteristics of the services that the mark applied for covers, within the meaning of Article 7(1)(c) EUTMR, namely their specialisation in beef from animals with long horns (para. 42). As to the third plea, the GC stated that the BoA' assessment cannot be called into question on the sole ground that it did not follow the Office's supposed decision-making practice in the present case (para. 58). Furthermore, specifically as regards the assessment of the term 'longhorn' carried out by the BoA, the applicant's line of argument is based on a misreading of the contested decision (para. 59). Consequently, all the pleas must be rejected.

Case T-179/16; L'Oréal / EUIPO – Guinot; Order of 26 June 2017, EU:T:2017:445; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion

FACTS: The Board of Appeal (BoA) dismissed the applicant's appeals against the decisions of the Opposition Division confirming the finding of a likelihood of confusion for the relevant French public between the contested five EUTMA and the earlier mark protecting identical goods eyes make-up preparations on account of the near-identity between their common word element 'Master'. The BoA found, in particular, that the additional verbal ('colors' and 'Paris') and figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal elements only present in the contested mark MASTER SMOKY not to be sufficient to neutralise the similarities between the marks stemming from the common element 'Master'. The General



Court (GC) dismissed the applicant's appeals as manifestly unfounded (Article 126 GC-RoP).

EUTM application

MASTER SMOKY

Earlier trade mark



SUBSTANCE: The applicant merely contested the BoA's comparison of the conflicting signs and its overall assessment of the likelihood of confusion. The General Court (GC) found, however, that the BoA had (i) analysed the opposed marks as a whole (paras 23-25), (ii) correctly found that the earlier mark was not dominated by its figurative

elements (paras 28-30), which were as weak as its further word elements 'colors' and 'Paris' (para. 32), and (iii) not put forward any argument which would question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed (iv) that the presence of the additional elements in the contested marks – including that of the non-descriptive word 'Drama' – would not neutralise the important similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect based on a lack of reasoning and violation of the right to be heard were dismissed as manifestly unfounded (paras 36 and 37). The GC also confirmed (v) the BoA's global assessment of likelihood of confusion (paras 48-53). Finally, it is worth noting that the



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GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of likelihood of confusion (para. 44). (References above are made to the paragraphs of the order delivered in case T-183/16).

Case T-180/16; L'Oréal / EUIPO – Guinot; Order of 26 June 2017, EU:T:2017:451; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion

FACTS: The Board of Appeal (BoA) dismissed the applicant's appeals against the decisions of the Opposition Division confirming the finding of a likelihood of confusion for the relevant French public between the contested five EUTMA and the earlier mark protecting identical goods eyes make-up preparations on account of the near-identity between their common word element 'Master'. The BoA found, in particular, that the additional verbal ('colors' and 'Paris') and figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal elements only present in the contested mark MASTER SHAPE not to be sufficient to neutralise the similarities between the marks stemming from the common element 'Master'. The General Court (GC) dismissed the applicant's appeals as manifestly unfounded (Article 126 GC-RoP).

SUBSTANCE: The applicant merely contested the BoA's comparison of the conflicting signs and its overall assessment of the likelihood of confusion. The General Court (GC) found, however, that the BoA had (i) analysed the opposed marks as a whole (paras 23-25), (ii) correctly found that the earlier



EUTM application

MASTER SHAPE

Earlier trade mark



mark was not dominated by its figurative elements (paras 28-30), which were as weak as its further word elements 'colors' and 'Paris' (para. 32), and (iii) not put forward any argument which would question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed (iv) that the presence of the additional elements in the contested marks – including that of the non-descriptive word 'Drama' – would not neutralise the important similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect based on a lack of reasoning and violation of the right to be heard were dismissed as manifestly unfounded (paras 36 and 37). The GC also confirmed (v) the BoA's global assessment of likelihood of confusion (paras 48-53). Finally, it is worth noting that the GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of likelihood of confusion (para. 44). (References above are made to the paragraphs of the order delivered in case T-183/16).



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Case T-181/16; L'Oréal / EUIPO – Guinot; Order of 26 June 2017, EU:T:2017:447; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion

FACTS: The Board of Appeal (BoA) dismissed the applicant's appeals against the decisions of the Opposition Division confirming the finding of a likelihood of confusion for the relevant French public between the contested five EUTMA and the earlier mark protecting identical goods eyes make-up preparations on account of the near-identity between their common word element 'Master'. The BoA found, in particular, that the additional verbal ('colors' and 'Paris') and figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal elements only present in the contested mark Master PRECISE not to be sufficient to neutralise the similarities between the marks stemming from the common element 'Master'. The General Court (GC) dismissed the applicant's appeals as manifestly unfounded (Article 126 GC-RoP).

EUTM application

MASTER PRECISE

Earlier trade mark



SUBSTANCE: The applicant merely contested the BoA's comparison of the conflicting signs and its overall assessment of the likelihood of confusion. The General Court (GC) found, however, that the BoA had (i) analysed the opposed marks as a whole (paras 23-25), (ii) correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were as weak as its further word elements 'colors' and 'Paris' (para. 32), and (iii) not put forward any argument which would question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed (iv) that the presence of the additional elements in the contested marks – including that of the non-descriptive word 'Drama' – would not neutralise the important similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect based on a lack of reasoning and violation of the right to be heard were dismissed as manifestly unfounded (paras 36 and 37). The GC also confirmed (v) the BoA's global assessment of likelihood of confusion (paras 48-53). Finally, it is worth noting that the GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of likelihood of confusion (para. 44). (References above are made to the paragraphs of the order delivered in case T-183/16).

Case T-182/16; L'Oréal / EUIPO – Guinot; Order of 26 June 2017, EU:T:2017:448; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion



Case law



FACTS: The Board of Appeal (BoA) dismissed the applicant's appeals against the decisions of the Opposition Division confirming the finding of a likelihood of confusion for the relevant French public between the contested five EUTMA and the earlier mark protecting identical goods eyes make-up preparations on account of the near-identity between their common word element 'Master'. The BoA found, in particular, that the additional verbal ('colors' and 'Paris') and figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal elements only present in the contested mark MASTER DUO not to be sufficient to neutralise the similarities between the marks stemming from the common element 'Master'. The General Court (GC) dismissed the applicant's appeals as manifestly unfounded (Article 126 GC-RoP).

EUTM application

MASTER DUO

Earlier trade marks



SUBSTANCE: The applicant merely contested the BoA's comparison of the conflicting signs and its overall assessment of the likelihood of confusion. The General Court (GC) found, however, that the

BoA had (i) analysed the opposed marks as a whole (paras 23-25), (ii) correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were as weak

as its further word elements 'colors' and 'Paris' (para. 32), and (iii) not put forward any argument which would question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed (iv) that the presence of the additional elements in the contested marks – including that of the non-descriptive word 'Drama' – would not neutralise the important similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect based on a lack of reasoning and violation of the right to be heard were dismissed as manifestly unfounded (paras 36 and 37). The GC also confirmed (v) the BoA's global assessment of likelihood of confusion (paras 48-53). Finally, it is worth noting that the GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of likelihood of confusion (para. 44). (References above are made to the paragraphs of the order delivered in case T-183/16).

Case T-183/16; L'Oréal / EUIPO – Guinot; Order of 26 June 2017; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion

FACTS: The Board of Appeal (BoA) dismissed the applicant's appeals against the decisions of the Opposition Division confirming the finding of a likelihood of confusion for the relevant French public between the contested five EUTMA and the earlier mark protecting identical goods 'eyes make-up preparations' on account of the near-identity between their common word element 'Master'. The BoA found, in particular, that the additional verbal ('colors' and 'Paris') and



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figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal elements only present in the contested mark MASTER DRAMA not to be sufficient to neutralize the similarities between the marks stemming from the common element 'Master'. The General Court (GC) dismissed the applicant's appeals as manifestly unfounded (Article 126 GC-RoP).

EUTM application

MASTER DRAMA

Earlier trade mark



SUBSTANCE: The applicant merely contested the BoA's comparison of the conflicting signs and its overall assessment of the likelihood of confusion. The General Court (GC) found, however, that the BoA had (i) analysed the opposed marks as a whole (paras 23-25), (ii) correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were as weak as its further word elements 'colors' and 'Paris' (para. 32), and (iii) not put forward any argument which would question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed (iv) that the presence of the additional elements in the contested marks – including that of the non-descriptive word 'Drama' – would not neutralise the important similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect based on a lack of reasoning and

violation of the right to be heard were dismissed as manifestly unfounded (paras 36 and 37). The GC also confirmed (v) the BoA's global assessment of likelihood of confusion (paras 48-53). Finally, it is worth noting that the GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of likelihood of confusion (para. 44). (References above are made to the paragraphs of the order delivered in case T-183/16).

Case T-430/16; Intercontinental Exchange Holdings, Inc. v EUIPO; Judgment of 22 March 2017, EU:T:2017:198; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The applicant sought to register the word mark BRENT INDEX as a EUTM for goods and services in Classes 9, 36 and 42. 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 any distinctive character. The applicant filed a notice of appeal pursuant to Articles 58 to 64 EUTMR against the examiner's decision. The Board of Appeal (BoA) dismissed the appeal. It found that the mark applied for was descriptive of the goods and services at issue and devoid of any distinctive character. The applicant filed an action before the General Court (GC) relying on two pleas in law, namely infringement of Article 7(1)(c) and infringement of Article 7(1)(b) EUTMR. The GC dismissed the action.



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EUTM application

BRENT INDEX

SUBSTANCE: As to the infringement of Article 7(1)(c) EUTMR, first, the GC emphasised that the word sign 'BRENT INDEX' consists solely of the two elements 'brent' and 'index', without any addition (para. 28). As correctly stated by the BoA, the term 'brent' refers to a certain type of crude oil but it is also commonly used by professionals in the financial sector. Moreover, the applicant does not really dispute that that term is used in the financial sector (paras 29-30). Secondly, the term 'index' is used in certain parts of the financial sector, namely the stock market, to compare the values and prices of shares. In this regard, the applicant does not dispute the BoA's finding (paras 31-32). Furthermore, the GC stated that the juxtaposition of the terms 'brent' and 'index', which are separated by a space, is consistent with English lexical and grammatical rules and does not contain any unusual element in its syntax which would make it possible for that expression to be anything other than the mere combination of the words 'brent' and 'index' (para. 34). Therefore, associated with the goods and services at issue, the mark applied for will inform the professionals concerned immediately, without any thought being necessary, of the intended purpose of those goods and services, namely the fact that they are linked to finance (para. 35). With regard to the goods and services, the GC pointed out that the BoA did not err in finding that all the goods and services in Classes 9, 36 and 42, were linked to the financial sector (para. 41). In the light of all above, the two pleas in law were rejected (paras 48 and 50).



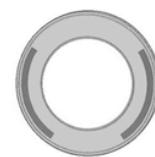
Case T-81/16; Pirelli Tyre SpA, v EUIPO; Judgment of 4 July 2017, EU:T:2017:463; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative element, Figurative mark, Position mark, Distinctiveness acquired by use

FACTS: An application for registration of the figurative mark represented below as an EU trade mark was filed for the following goods in Class 12, tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels. The application was made for a position mark described as 'a pair of essentially equal curved strips positioned on the side of a tyre and running along its circumference'. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. The First Board of Appeal (BoA) dismissed the appeal filed against the examiner's decision and confirmed that the mark applied for fell within the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the General Court (GC). The applicant presented three pleas in law, alleging an infringement of Articles 75 and 76 EUTMR, an infringement of Article 7(1)(b) EUTMR and an infringement of Article 7(3) EUTMR. The GC dismissed the appeal.

EUTM application



SUBSTANCE: Infringement of Article 75 EUTMR. The GC dismissed the applicant's argument that the BoA infringed the duty of statement of reasons in that it did not examine the distinctive character of that mark for each of the goods



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in question. The GC recalled firstly that the Board may give a general reasoning given that those goods form a sufficiently homogeneous category or group of goods. Secondly, the GC noted that, in any event, the applicant applied for the registration of a 'position mark', intended to be affixed to the side of a tyre. Therefore, as a direct consequence of the nature of the mark applied for, even though the applicant has claimed protection for additional goods, namely, rims and covers for the wheels of vehicles, the sign for which registration is sought is necessarily limited to tyres, being affixed to these, and not to any other goods (paras 23 and 24). The GC also dismissed the applicant's argument that the BoA infringed the duty of statement of reasons inasmuch as it did not explain why the consumer will perceive the mark applied for as a mere frame for technical information provided on the sidewalls of tyres and not as an indication of origin (para. 26). The GC found in this respect, that the marking of technical specifications on tyre sidewalls is a matter of common knowledge which requires no specific reasoning to be taken into account by the BoA. Furthermore, contrary to what the applicant claims, it is apparent from the wording used in paragraph 16 of the contested decision that the BoA relied on that reason for the sake of completeness in relation to the reason relating to the extreme simplicity of the mark applied for (paras 26-28). Moreover, the above question concerns the validity of the reasons, which is the subject of the second plea, and not the adequacy of the statement of reasons of the contested decision as an essential procedural requirement (paras 28 and 29).

Infringement of Article 76 EUTMR. The GC dismissed the applicant's argument that the BoA infringed the principle of examination of the facts by the Office of its own motion, provided for in Article 76(1) EUTMR. The GC found that the applicant did not indicate in which way the BoA failed to examine the facts, arguments or evidence before it. Furthermore, it is for the applicant to present evidence to the Office showing that the mark applied for had acquired a distinctive character in the European Union, despite the

Office's analysis (paras 31-37). Thus, the BoA did not fail to fulfil its obligations under Article 76 EUTMR.

Infringement of Article 7(1)(b) EUTMR. The GC confirmed the finding of the contested decision that the mark applied for is extremely simple and does not display any particular characteristics or an aspect easily and immediately perceived by the relevant public as indicating the commercial origin of the goods at issue. Consequently, consumers will perceive the contested sign as a mere decorative element affixed to the sidewall of tyres or any other goods covered by the application for registration. It follows that the BoA was correct in finding that the mark applied for was devoid of distinctive character (paras 56-58).

Infringement of Article 7(3) EUTMR. The GC confirmed the finding that the applicant has presented none of the necessary information, such as the market share held by the mark, the duration, extent or geographic area of use, which would make it possible to prove the use of the mark applied for. In addition, the GC noted that hardly any of the evidence relates specifically to the mark applied for. Thus, none of the evidence submitted makes it possible to show that the relevant persons or, at least, a significant proportion of these, identify, thanks to the mark applied for, the goods covered by it (paras 79-81).

Case T-57/16; Chanel SAS v EUIPO; Judgment of 18 of July 2017, EU:T:2017:517; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Design, Conflict of design with other right, Freedom of designer, Overall impression

FACTS: The RCD proprietor was granted the registration of the design represented below as an RCD for the product indication ornamentation.

An application for invalidity was filed pursuant to Article 25(1) (b) RCD. The Invalidity Division (ID) dismissed the application



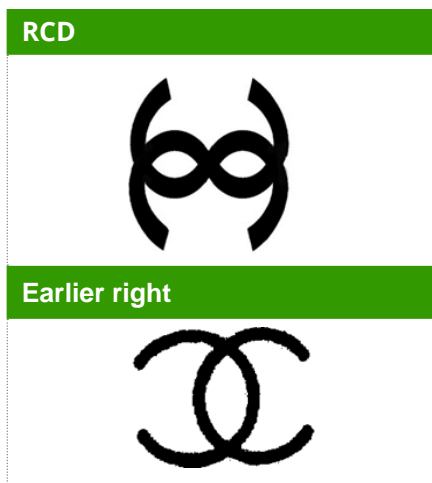
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for invalidity in so far as, regarding the assessment of the individual character of the contested RCD, the signs produced a different overall impression.

The Board of Appeal (BoA) dismissed the invalidity applicant's appeal, confirming the ID conclusions.

The invalidity applicant filed an action before the General Court (GC) relying on one plea in law: infringement of Article 25(1)(b) CDR. The GC upheld the appeal. It found that the contested RCD did not create a different global impression to that of the earlier right invoked by the invalidity applicant and therefore, it lacked individual character.



SUBSTANCE: it is common ground that the applicant's right is earlier, that the contested design is an ornament in Class 32, that the informed users are both professionals and end-users and that the degree of freedom of the author of the design in the present case was large. The GC focuses its assessment on two questions. On the one hand whether, as argued by the invalidity applicant, the BoA should have identified the product on which the design is applied to; on the other hand, on the impact of the use of the design on the comparison of the general impression created by the designs in conflict. **NATURE OF THE PRODUCTS:** The GC confirmed that, contrary to the invalidity

applicant's arguments, the BoA is not obliged to identify the exact product on which the design for ornamentation is going to be applied as it has not been registered for any particular good (para. 44). **GENERAL IMPRESSION:** The GC indicates that the evidence of use of the sign on products (per the evidence submitted by the invalidity applicant) as well as examples of the rotation of the contested design on products can be taken into account when assessing the individual character of the design. However, they do not serve as the only point of reference for the assessment as the design has been applied to 'ornamentation'. Therefore, it can be applied to multiple goods (paras. 46-50). After this preliminary remark, the GC performs a detailed factual analysis on the similarities of the designs. It considers that despite the differences in their central elements, the designs are similar in the external parts and in their oval forms. This is reinforced by the possibility to rotate the design 90 degrees and in various sizes (para. 55). **CONCLUSION:** in light of the large degree of freedom of the author, the fact that the products are 'ornamentation' and the lack of technical restrictions, the GC comes to the conclusion that the differences between the designs do not create a different global impression on the informed user. Therefore, the contested sign lacks individual character (paras 58-61).

Case T-189/16; Migros-genossenschafts-Bund (Switzerland) v EUIPO; Judgment of 13 July 2017 EU:T:2017:488; Language of the case: EN

RESULT: Action upheld (BoA decision partly annulled)

KEYWORDS: Similarity of the signs, Ending of mark, Weak element

FACTS: The EUTM proprietor was granted the registration of the figurative mark CREMESSPRESSO [represented below] as an EUTM for goods in Classes 7, 11 and 30. An application for invalidity was filed pursuant to Article 8(1)(b) in conjunction



Case law



with Article 53(1)(a) EUTMR. The Cancellation Division (CD) invalidated the mark for all the goods in Classes 7 and 11 and for some goods in Class 30. The Board of Appeal (BoA) upheld the EUTM proprietor's appeal in part: it annulled the cancellation decision in part, namely as regards the goods in Classes 7 and 11. The EUTM remained registered for these goods, as well as for the goods found dissimilar by the CD. The BoA dismissed the appeal for the remaining goods in Class 30. The invalidity applicant filed an action before the General Court (GC) stating that the level of attention of the relevant public with respect to the goods in Classes 7 and 11 covered by the marks at issue had been wrongly defined by the BoA, that BoA had incorrectly classified the degree of similarity between the signs at issue as low and that BoA had wrongly concluded that there was no likelihood of confusion. The GC annulled the BoA decision for all the goods in Classes 7 and 11. As regards Class 30 the application was considered as inadmissible/mistaken.

EUTM application

CREMESPRESSO

Earlier trade mark

CREMESSO

SUBSTANCE: The GC annulled BoA's decision for all the goods in Classes 7 and 11 (therefore the GC considered that there is likelihood of confusion (LOC) for the goods in Classes 7 and 11). The GC upheld the majority of the findings of the BoA (relevant public and the high degree of attention for the goods at issue, the comparison of the goods and that the visual similarity carried more weight than the aural one). As regards the scope of the action – the request to invalidate the EUTM also for Class 30 in its entirety, the GC stated that either the applicant had made a mistake in requesting the cancellation

of the mark for this entire class or, assuming that the claim was indeed what the invalidity applicant meant, it should be rejected as inadmissible (as the Office requested) because the invalidity applicant did not appeal before BoA the partial cancellation of the mark for Class 30 so it cannot request it now before the GC (paras 18-23). Relevant public and degree of attention: BoA correctly held that the goods at issue are directed to both the public at large and professionals. The GC makes an extensive assessment of the degree of attention of the relevant public for the goods in Classes 7 and 11 agreeing with the findings of the Office that the level is high. The Office is correct when it states that coffee machines sold at a very low price are more the exception than the rule in that sector (paras 24-38, especially paras 30, 33, 35, 38). The GC rejects the applicant's claim that the Office Guidelines do not consider the goods electric kitchen machines as being valuable goods or technically complicated machines for which consumers would apply a higher level of attention. It explains that the legality of the BoA decisions concerning the registration of trade marks must be assessed solely on the basis of the Regulation No 207/2009 and not on the basis of the Office Guidelines (para. 37). The comparison of the goods was correctly done by the BoA (no objections were raised by the parties). Comparison of signs: The GC disagreed with the BoA in the comparison of the signs and carried out another comparison of the signs. The marks are visually (paras 42-58), and aurally similar (paras 59-67) to a high degree and not only to a 'certain' degree as the BoA said, because all the letters of the earlier mark are included in the contested sign and the beginning and ending of the marks are the same. Conceptually, the marks are similar to an average degree (and not only to a 'certain' degree as the BoA said) due to the common element 'CREM' and because both marks will be associated with a creamy drink based on espresso coffee (paras 68-74 and especially 72, 73). The common word 'CREM' cannot be considered as dominant in a word mark. The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the graphic or stylistic



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characteristics which that mark possesses. The claim that the protection of the earlier word mark held by it would also apply with respect to the variations of stylisation similar to the one of the contested mark (therefore CReMESSO or CREMESSO) was rejected (para. 56). ESPRESSO is descriptive for the goods at hand and the ending ESSO of the mark CREMESSO is highly likely to be associated with a creamy drink based on espresso coffee by the consumers who don't speak Italian, Spanish or Portuguese. While it is true that it is necessary to examine the distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs in order to determine any dominant element of the sign, the degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the LOC (para. 74). The BoA was right when it held that the visual similarity carried more weight than the aural one because the trade marks will generally be perceived visually prior to purchase of the relevant goods in Classes 7 and 11 (paras 83-84). A high degree of attention does not permit an automatic conclusion that there is no LOC since all the other factors must be taken into account (identity and similarity of the goods at hand, degree of similarity between the marks) (para. 87).

Case T-45/16; Nelson Alfonso Egüed v EUIPO; Judgment 18 July 2017, EU:T:2017:518; Language of the case: EN

RESULT: Action dismissed

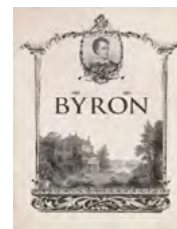
KEYWORDS: Non-registered trade mark, Passing off, Use in the course of trade

FACTS: The applicant filed an application for the registration as an EUTM of the figurative mark represented below for goods in Class 33. An opposition based on inter alia the earlier non-registered trade mark represented below used in the course of trade in the United Kingdom to designate wines was filed pursuant to Article 8(4) EUTMR. The Opposition Division



(OD) upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the applicant's appeal. It endorsed the OD's findings that the evidence submitted by the opponent was sufficient to demonstrate that the non-registered trade mark was used in the course of trade and that its use was not merely of local significance in the United Kingdom. Moreover, it was concluded that the wine sold under the earlier mark had acquired goodwill and there was a likelihood that the applicant's goods would be confused with those of the opponent, as a result of which the latter would suffer damage. The applicant filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 8(4) EUTMR. The applicant did not contest the BoA's findings that the earlier non-registered trade mark was used in the course of trade in the United Kingdom for wine and that the use was of more than mere local significance. A single plea in law put forward by the applicant related to one of the three conditions making up the 'classic trinity' of the tort of passing-off, namely goodwill. The GC dismissed the appeal.

EUTM application



Earlier trade mark

BYRON

SUBSTANCE: The GC endorsed the BoA's findings that the opponent was engaged in genuine trading activities concerning the wines sold under the BYRON trade mark in the United Kingdom. Consequently, it had acquired goodwill



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as at the date of application for registration of the figurative mark BYRON as an EUTM. The fact that the opponent was established in the United States and sold its wine through its distributor could not alter the BoA findings that the applicant had goodwill in the United Kingdom. Likewise, although the sales were not particularly high, they were sufficient to

create goodwill. Moreover, even if the opponent did not present any evidence that the earlier mark was used between the filing of the contested EUTM and the date when the opposition was filed, this five-month period is not long enough for the goodwill to have been capable of being extinguished solely on account of the passage of time. The GC confirmed that the BoA correctly relied on the 'classic' form of the action for passing off, concluding that there was a likelihood of confusion that the applicant's goods would be taken for those of the opponent. In the present case, there was no need to apply the 'extended' form of the tort of passing-off, therefore, the applicant's arguments concerning the low price and average quality of the opponent's goods are ineffective. As to the acquisition of the goodwill, the GC confirmed that although the goods were sold in the United Kingdom through the sole distributor, it was the opponent who actually owned the goodwill. Finally, the fact that the opponent had an identical registered EUTM which was let to expire some five years before the filing of the contested EUTM, cannot disprove the existence of goodwill generated by the non-registered trade mark BYRON and acquired by the opponent. Therefore, in the absence of arguments put forward by the applicant concerning misrepresentation and damage, the GC upheld the BoA's conclusion that, given the identical nature of the goods at issue and the similarities between the signs, there was a likelihood that the applicant's goods would be confused with those of the opponent, a misrepresentation which would cause the opponent damage.



Case T-479/16; Colgate-Palmolive Co. v EUIPO; Judgment of 28 June 2017, EU:T:2017:441; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Laudatory mark

FACTS: The applicant sought to register the figurative mark represented below for goods in Class 3. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the term aromasensations will be perceived as a promotional laudatory message, the function of which is to describe a characteristic of the goods. The applicant filed an action before the General Court (GC).

EUTM application

AROMASENSATIONS

SUBSTANCE: The GC dismissed the action. It referred to the standard case-law as regards distinctive character of trade marks and slogans. The GC emphasised that it is sufficient if a mark is non-distinctive in one of its several possible meanings. The BoA correctly defined the meaning of aroma as 'distinctive, usually pleasant smell, especially of spices, wines and plants'. The GC confirmed that this characteristic is an important feature of the goods in Class 3. The term 'sensations' was also correctly defined by the BoA and the two words together would be perceived as, in connection with the goods concerned, 'experiences resulting from the stimulation of one of the sense organs [olfaction] by a certain [in principle] pleasant scent'. It is irrelevant that the combination may have other meanings as well. The graphical elements do not add anything unusual to the perception of the sign by the relevant public and cannot divert the attention of the public



Case law



concerned away from the purely laudatory and non-distinctive message. The combination of the two words which are simply juxtaposed does not add anything unusual or striking, given that it merely combines the meanings lent by the words of which it is composed. The BoA was correct to conclude that the sign lacks distinctive character in relation to the relevant goods.

Case T-243/16; Freddo SA v EUIPO; Judgment of 18 July 2017, EU:T:2017:522; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Dominant element, Likelihood of confusion, Similarity of the signs, Weak element

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 30 and 43. An opposition based, inter alia, on the earlier figurative represented below, registered for goods and services in Classes 29, 30 and 43 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA took account of French- and Spanish-speaking consumers and found that their degree of attention would be average at most. It found inter alia that 'FREDDO FREDDO' was particularly eye catching in the contested mark and that 'TENTAZIONE' will be associated by the relevant consumers with the corresponding (very similar) French- and Spanish words 'tentation' and 'tentación' (temptation) a laudatory term alluding to the attractive power of the goods and services in question. The ice-cream cones under also have a weak distinctive character.

The BoA found the marks to be visually similar to a low degree, aurally similar to an average degree and conceptually not

similar. The earlier mark had an average degree of inherent distinctiveness. Overall, the BoA found that there was likelihood of confusion. Furthermore, the BoA pointed out that it is also common for a trader to use sub-brands (signs that derive from a principal mark and which share with it a common distinctive element) in order to distinguish its various lines from one another.

The applicant filed an action before the General Court (GC) relying on one plea in law, alleging infringement of Article 8(1) (b) of Regulation No 207/2009. This plea was divided into five grounds of challenge (i) failing to consider the marks at issue each as a whole; (ii) failing to take adequate account of the word element 'tentazione' in the earlier mark; (iii) considering the distinctive character of the marks at issue when comparing them, when this element should have been taken into account during the assessment of the likelihood of confusion; (iv) adopting contradictory approaches as to the meaning or absence of meaning of the terms 'tentazione' and 'freddo' in the earlier mark in the perception of French-speaking and Spanish-speaking consumers; and (v), considering that the mark for which registration is sought could be mistaken for a sub-brand of the earlier mark.

EUTMA



Earlier trade mark





Case law



SUBSTANCE: The goods at issue are in part identical and in part highly similar (not disputed).

The GC held that the BoA did not wrongly focus on particular elements of the mark rather than consider the marks as a whole. It pointed out that all elements of the marks were considered visually, aurally and conceptually and that the BoA did not, therefore, only consider the word element 'freddo freddo' in the earlier mark as claimed. (paras 35-43)

The applicant's second claim was that the element 'tentazione', at the top and in the centre of the earlier mark had a particular importance which the BoA ignored. The GC rejected this and endorsed the BoA view that 'freddo freddo' is the central eye-catching element of the earlier mark because of the fanciful character, the size of the letters and the use of a stylised typeface when compared with the element 'tentazione', in markedly smaller standard black letters. In addition, 'freddo' lacks meaning for French- and Spanish-speaking consumers whereas 'tentazione' will mean 'temptation' – a laudatory term (paras 51-53).

The applicant's third claim was that the BoA erred when considering the distinctive character of the marks at issue during the comparison of marks because distinctiveness should be taken into account during the assessment of the likelihood of confusion. The applicant argued that the 'Flexi Air' (Case C-235/05 P L'Oréal v OHIM) could be interpreted in this way. The GC disagreed and stressed that it was crucial to distinguish between: (i) the distinctive character of the earlier mark, which determines the protection granted to that mark and is not a factor in assessing the similarity of the marks and (ii) the distinctive character of an element of a composite mark, namely the greater or lesser capacity of that element to identify the goods or services for which the mark was registered as coming from a particular undertaking which is a factor in assessing the similarity of the marks (paras 54-61).

The applicant's fourth claim that the term 'freddo' can be understood by French- and Spanish-speaking consumers as meaning cold and so it is weak was also rejected. The GC referred to the marked differences between the Italian 'freddo'

and the French and Spanish equivalents, 'froid' and 'frío'. 'Tentazione' on the other hand was only slightly different in Spanish and French and, consequently, would be understood. Finally, the applicant claimed that the BoA erred in law by raising the possibility that the contested mark could be considered a sub-brand of the earlier mark. The GC considered it to be clear that the BoA's statement was not a necessary finding for the conclusion on likelihood of confusion, such that, even if it were incorrect, that statement would not be sufficient to invalidate the BoA's decision.

Case T-3/16; Allstate Insurance Company v EUIPO; Judgment of 5 July 2017, EU:T:2017:467; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The EUTM applicant sought to register the word mark DRIVEWISE, represented below, for goods in Class 9 and services in Class 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, and the Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on three pleas in law: Infringement of Article 7(1)(c) and 7(1)(b) EUTMR and Article 75 EUTMR. The GC dismissed the appeal.

EUTM application

DRIVEWISE

SUBSTANCE: The GC endorsed the finding of the BoA that the relevant public is made up average consumers and professionals in the English-speaking countries of the European Union (paras 15-18). The BoA was correct in finding



Case law

that the relevant public would see the mark as a whole as descriptive of the intended purpose of the goods and services i.e to assist (in) the efficient, safe and optimum performance of a vehicle, perceiving the term 'DRIVEWISE' as a combination of the terms 'drive' and 'wise' (para. 20). As one of the possible meanings of the mark designates a characteristic of the goods and services within the meaning of Article 7(1)(c) EUTMR, and is no more than the sum of its parts according to case-law, the BoA correctly upheld the decision to refuse to register the mark (paras 21-23). The expression 'drivewise' may be immediately understood as the expression 'drive safely', equivalent in meaning to the expression 'drive safe', it being common knowledge that some adverbs and adjectives may be used interchangeably in the English language. This particular descriptive meaning is unambiguous and may be attributed without any effort of interpretation by the relevant public (paras 24-38). It is consequently devoid of distinctive character pursuant to Article 7(1)(b) EUTMR (para. 41). The BoA was also right to conclude that the other marks relied upon by the applicant were either not comparable or irrelevant. (paras 47-50). The GC further found that the decision of the BoA was sufficiently reasoned in accordance with the requirements set out under Article 75 EUTMR. The GC recalled the case-law according to which the Office has in principle to reason the refusal in relation to each of the relevant goods and services. However, a global reasoning is permitted when it refers to goods that show a sufficiently direct and objective link to the extent that they form a homogeneous category or group (para. 52). In the present case, the BoA sufficiently reasoned the connection between the mark and all the goods and services (paras 54 and 55).



Case T-150/16; Ecolab USA Inc., v EUIPO; Judgment of 13 July 2017, EU:T:2017:490; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Legitimate expectations, Principle of legality, Distinctiveness acquired by use

FACTS: The applicant sought to designate the European Union (EU) on foot of its international registration for the word sign ECOLAB, represented below, for an extensive range of goods and services. The Office partially refused protection pursuant to Article 7(1)(b) and (c) EUTMR for the services in Class 42, and the applicant appealed the partial refusal. The Board of Appeal (BoA) dismissed the appeal on those grounds, and also on the basis that the applicant had not demonstrated acquired distinctive character through use pursuant to Article 7(3) EUTMR. The applicant filed an action before the General Court (GC) relying on infringement of Article 7(1)(c), 7(1)(b) and 7(2) EUTMR in conjunction with 7(3) EUTMR; breach of the principles of equal treatment and the protection of legitimate expectations; and Article 75 EUTMR. The GC dismissed the appeal.

IR designating the EU

ECOLAB

SUBSTANCE: The GC endorsed the undisputed finding of the BoA that the relevant public is made up professionals in the English-speaking countries of the EU (paras 30, 31). The BoA was correct in establishing, by reference to an English dictionary, that the mark was made up of the known abbreviations 'eco' and 'lab', standing for 'ecology' or 'ecological' and 'laboratory', respectively (para. 33). The BoA



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did not commit any error of assessment in finding that the relevant public would perceive the neologism as a mere combination of descriptive terms which, together, is no more than the sum of its parts within the meaning of established case-law (para. 34). To the extent that the services concerned are scientific and technological services, industrial analysis and research services and environmental services, it is reasonable to hold that the professional public would perceive the mark as describing an 'ecological laboratory', as opposed to any of the other meanings ascribed by the applicant (para. 35). The mark as a whole will be perceived as designating services offered by an environmentally friendly laboratory, for example. As one of the possible meanings of the mark designates a characteristic of the services within the meaning of Article 7(1)(c) EUTMR, the BoA did not err in law in finding that the mark applied for was descriptive (paras 39-44). These findings may not be called into question on the basis of decisions from other jurisdictions. The EU Trade mark framework is an autonomous system, made of a body of rules and pursuing objectives that are specific to it, its implementation being independent of any national system (paras 43 and 44). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR (para. 48).

The GC went on to hold, in respect of the second plea, that proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes, advertising material or documentation in respect of global turnover which does not specifically identify the services provided under the mark applied for (paras 52 and 53).

As to the third plea concerning breach of the principles of equal treatment and the protection of legitimate expectations, the GC stated that the application was fully examined and rightly found to be descriptive. Therefore, the stated principles were correctly reconciled with the principle of legality, and the applicant cannot rely on previous decisions of the Office in order to challenge those findings.

In relation to the fourth plea, the GC found that the BoA

sufficiently reasoned the connection between the mark and all of the services at issue, and that the imputed decision accorded with the requirements set out under Article 75 EUTMR (paras 70-72).

Case T-110/16; Savant Systems LLC v EUIPO; Judgment of 18 July 2017, EU:T:2017:521; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Proof of use, Extent of use, Lack of reasoning, Nature of use

FACTS: The EUTM proprietor was granted the registration of the word mark SAVANT for goods and services in Classes 9, 16, 41 and 42.

An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) partly upheld the application for revocation for all the goods and services registered with the exception of computer software services; computer programming services, consultancy services relating to computer software in Class 42, for which the application for revocation was rejected.

The Board of Appeal (BoA) partly upheld the EUTM proprietor's appeal. It found that the genuine use was proved not only for computer software services; computer programming services, consultancy services relating to computer software in Class 42 not covered by the appeal but also in respect of the other services in Classes 41 and 42 and for computer software in Class 9.

The invalidity applicant filed an action before the General Court (GC) relying on 2 pleas in law: (i) infringement of Article 51(1)(a) EUTMR in conjunction with Article 15 EUTMR; (ii) infringement of the duty to state reasons.



Case law

EUTM

SAVANT

SUBSTANCE: The GC dismissed the claim that the evidence demonstrates the use of the company name rather than the use of the mark or that there is no link between the sign used and the relevant services. The GC stated that the use of the trade name in invoices may be such as to establish genuine use of the registered mark (para. 31). In addition, the representation of the contested mark alongside the other sub-brands corresponds to the situation where a number of signs are used simultaneously without changing the distinctive character of the registered sign (para. 32). Furthermore, as the mark may not be affixed to services, the link between the sign and the services shall be established through other indirect means. In the case at hand such a link may be established in that the mark appears at the top of each invoice, in brochures, advertisements and articles in newspapers. These documents inform the customer of the origin of the goods and services. The GC also dismissed the arguments as regards alleged insufficiency of evidence to establish genuine use for all the claimed goods and services.

Finally, the GC considered that the BoA provided a complete and precise set of reasons for its decision and the fact that it did not comment on a specific report produced by the invalidity applicant does not mean that it did not fulfil its duty to state reasons. The duty to state reasons does not amount to an obligation to respond to every argument and every piece of evidence submitted.



Case T-309/16; Café' Pont SL v EUIPO; Judgment of 20 July 2017, EU:T:2017:535; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Revocation grounds, Distinctive element

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 30. An application for revocation was filed pursuant to Article 51(1) (a) and Article 56(1) EUTMR. The Cancellation Division (CD) revoked the mark in so far as it had not been genuinely used in a form which did not differ from the registered mark by elements altering its distinctive character. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on a single plea in law alleging infringement of Article 51(1)(a) EUTMR read in conjunction with Article 15(1)(a) EUTMR. The GC dismissed the action

EUTM

SUBSTANCE: The GC stated that the BoA did not err in concluding that the evidence provided by the applicant was not capable of demonstrating the genuine use of the mark at issue from the point of view of its nature during the relevant period (para. 21). In particular, the BoA found a lack of genuine use of the mark at issue because the evidence produced by the applicant for that purpose does not show the mark either in the form in which it was registered or in a form which does not alter its distinctive character within the meaning of Article 15(1)(a) EUTMR. Furthermore, the evidence did not satisfy the criterion relating to the nature of the use of the



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mark at issue within the meaning of Article 51(1)(a) EUTMR (para. 19). Additionally, the GC pointed out that the figurative element of the mark at issue, whose graphic presentation is neither negligible nor trivial, is a distinctive element of it, such that the use of a word mark without that element cannot constitute use of the mark at issue within the meaning of Article 51(1)(a) EUTMR, read in conjunction with Article 15(1)(a) EUTMR. Considering the descriptive character of the word 'café' for that product, the figurative element of the mark at issue must be regarded as an important element of that mark (para. 20). As a result, the mark had to be revoked.

Case law

New Decisions from the Boards of Appeal

EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). For best results, the use of Mozilla Firefox or Google Chrome browsers is recommended.

07/07/2017, R 2450/2011-G, GOLDHASE (LINDT) (3D)

EUTMA



Result: Decision confirmed.

Keywords: Admissibility, Distinctiveness acquired by use, Evidence of use, Function of trade mark, Shape of the products, Substantial value, Three-dimensional mark.

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

Facts: The examiner refused registration of the trade mark applied for on the grounds that it was devoid of distinctive character. The General Court (17/12/2010, T-336/08, Hase, EU:T:2010:546) had already confirmed the refusal to register the same mark. The case was referred to the Grand Board.

Substance: The appeal against the refusal of the application on the basis of Article 7(1)(b) EUTMR is not admissible. The contested decision is a mere confirmatory decision of the Fourth Board of Appeal's final decision of 11 June 2008 in Case R 1332/2005-4 which found the identical shape for identical goods, as in the present case, to lack distinctiveness within the



meaning of Article 7(1)(b) EUTMR (§ 11).

The Grand Board had already ruled that an appeal directed against a decision which merely confirmed a previous decision (a confirmatory decision) was inadmissible (see 16/11/2015, R 1649/2011-G, SHAPE OF A BOTTLE (3D) (§ 12).

As regards Article 7(1)(b) EUTMR the Board states that the applicant has not put forward any essential new facts in support of the second application that could alter the assessment of the first decision (§ 16). In relation to Article 7(3) EUTMR the Board finds that the evidence submitted merely relates to a seasonal product which only represents an insignificant part of the European market in connection with the vast categories in respect of which the application was filed (§ 26). Even if the Board were to come to a different conclusion, the application has to be refused on the basis of Article 7(e)(iii) EUTMR (§ 28). The shape and features of a typical Easter bunny determine, to a large extent, the consumer's behaviour when buying the product. The traditional shape and appearance of an Easter bunny gives substantial value to the chocolate goods, in comparison to other kinds of chocolate goods (§ 43-44).

19/06/2017, R 452/2017-1, Cubes (3D)

EUTMA



Result: Decision annulled.

Keywords: Three-dimensional mark, Technical result.

Norms: Article 7(1)(e)(ii) EUTMR, Article 65(6) EUTMR, Article



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57(5) EUTMR.

Facts: The cancellation applicant applied for a declaration of invalidity of the mark because it consisted of a shape which was necessary to obtain a technical result. The Cancellation Division rejected the application. The cancellation applicant requested that the decision be annulled. The Second Board of Appeal upheld the contested decision and ruled that the mark was not objectionable under Article 7(1)(e)(ii) EUTMR (01/09/2009, R 1526/2008-2, CUBES (3D)). In case T-450/09 (25/11/2014, T-450/09, CUBES (3D), EU:T:2014:983) the General Court upheld the Second Board's decision. However, the Court of Justice set aside the General Court's judgment (10/11/2016, C-30/15P, CUBES (3D), EU:C:2016:849) and annulled the decision rendered by the Second Board of Appeal on the ground that Article 7(1)(e)(ii) EUTMR had been incorrectly applied. The Presidium of the Boards remitted the case to the First Board of Appeal for a decision on substance.

Substance: The appeal is well founded and shall be upheld. The contested decision shall be annulled and the contested EUTM shall be declared invalid (§ 17). The correct application of Article 7(1)(e)(ii) EUTMR requires, as a first step, the identification of the 'essential characteristics' of the three-dimensional sign (06/03/2014, C-337/12 P, C-338/12 P, C-339/12 P and C-340/12 P, Surface covered with circles, EU:C:2014:129, § 46) (§ 21). The second step is the assessment of whether these characteristics are necessary to obtain a technical result for the product. The Board finds that the purpose of the product at issue is that of a game which consists of completing a cube-shaped three-dimensional colour puzzle by generating six differently coloured faces. This purpose is achieved by axially rotating, vertically and horizontally, rows of smaller cubes of different colours until the nine squares of each face of the cube show the same colour (§ 32). After analysing the essential characteristics of the sign the Board comes to the conclusion that each of the them represents features that are necessary for the product represented by the sign to perform its technical function, therefore the sign as a whole



falls within the prohibition set out in Article 7(1)(e)(ii) EUTMR. The registration must be declared invalid, in accordance with Article 57(3) EUTMR, in respect of all the goods (§ 45-46).

28/06/2017, R 2244/2016-2, BREXIT

EUTMA

BREXIT

Result: Decision annulled.

Keywords: Contrary to public policy or principles of morality, Distinctive element.

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

Facts: The examiner refused the EUTM applied for, for the word mark 'BREXIT' under Article 7(1)(b) and (f) EUTMR claiming that the citizens of the United Kingdom, in particular those who voted in favour of staying in the EU, would be offended by the registration of such a sign.

Substance: The departure of a Member State from the European Union is foreseen in the Lisbon Treaty (Article 50). On this basis the Board finds that 'BREXIT' denotes a sovereign political decision (of the United Kingdom), legally taken and morally irreproachable, nothing more; it is not a provocation or incitement to crime or disorder (§ 36). It cannot be found immoral (§ 37). The examiner failed to provide evidence to support the refusal based only on mere personal suppositions, therefore the contested decision is to be annulled insofar as the mark was rejected under Article 7(1)(f) EUTMR (§ 43). The Board also finds that the term 'BREXIT', with respect to the goods in question, satisfies all the established criteria of distinctiveness set out by the Courts. The mark is memorable; it is not laudatory; it is invented, coined, playful, and is not commonplace (§ 50-54).



Case law



28/06/2017, R 2117/2016-2, TWISTPOT / QuickPot (fig.)



Result: Decision confirmed.

Keywords: International registration, New submission on appeal, Substantiation of earlier right.

Norms: Rule 19(2) CTMIR, Rule 20(1) CTMIR, Article 151 EUTMR, Article 152 EUTMR.

Facts: The Opposition Division rejected the opposition against the above EUTM applied for stating that the opponent had not substantiated its earlier right upon which the opposition was based.

Substance: The opposition is based on an earlier international registration designating the European Union. Contrary to the opponent's argument since the earlier right is not an EUTM it has to be substantiated (§ 22-23). The opponent did not submit any evidence (§ 27), consequently the Opposition Division did not err in rejecting the opposition pursuant to Rule 20(1) CTMIR (§ 29). Before the Board the opponent belatedly filed a copy of the relevant trade mark as recorded

in the Office's eSearch Plus database (§ 45). However, the Board finds that a copy of an Office database cannot be considered valid evidence to substantiate the opponent's earlier right (26/11/2014, T-240/13, Alifoods, EU:T:2014:994, § 26-32) (§ 46), as such an extract does not constitute a copy of the relevant registration certificate or any other equivalent document issued by the administration through which the mark was registered, namely the World Intellectual Property Organization (WIPO).

21/07/2017, R 428/2017-4, Buffalo Chik'n Wings

Result: Decision confirmed.

Keywords: Admissibility, Ratio legis, Scope of proceedings,

Norms: Article 1 EUTMR, Article 112(1) EUTMR, Article 133(1) EUTMR.

Facts: The EUTM was refused by a decision of the First Board of Appeal in Case R 1483/2015-1 in respect of all the goods, on the basis of an opposition based on an earlier international registration. The First Board of Appeal stated that the earlier trade mark was an EU trade mark. For reasons of procedural economy, the Opposition Division took into account the public in Poland, Lithuania, Slovakia, the Czech Republic, Slovenia, Croatia and Bulgaria. The applicant requested conversion into national trade mark applications in Austria, the Benelux countries, Finland, Italy, Sweden, Greece and Denmark. The applicant argued that the application for conversion only related to countries which, owing to a lack of knowledge of English, had not been taken into account in the decision of the First Board of Appeal. The Register refused the application and added that the First Board of Appeal had expressly found there to be a likelihood of confusion 'at least' for the Member States listed, and it was incorrect to conclude that



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there was no likelihood of confusion in the other Member States. The applicant filed an appeal claiming that a likelihood of confusion was not expressly established for the 'other' Member States, with the result that the conversion should be allowed in respect thereof.

Substance: The present case concerns the conversion of the EUTM applied for on the basis of an opposition from an international registration, and not the conversion of an international registration designating the EU (§ 11). The application for conversion was rightly refused, as conversion is excluded under Article 113(4) EUTMR (§ 12). The applicant should be given the opportunity to obtain national applications in countries where the ground for refusal does not exist, while maintaining its priority. In the case of an earlier EUTM or an IR with effect in the EU, however, the ground for refusal necessarily obtains throughout the EU, because the earlier right has equal effect throughout the EU pursuant to the EUTM's unitary character. Article 113 EUTMR only permits conversion with regard to relative grounds for refusal if the opposition was based on an earlier national mark, and then, consequently, only for Member States where that earlier right is not protected (Article 112(2)(b) EUTMR) (see, in respect of all of the above, 29/04/2015, R 1490/2014-4, ROOM SEVEN) (§ 15). If the conversion were to be allowed, the successful opponent could file another opposition on the basis of its earlier trade mark in the Member States designated, respectively, against the national trade mark applications resulting from the conversion. It would be unacceptable for the opponent to then be saddled with the bother and costs of legal action, despite it having succeeded before the Office in a final decision. With the final refusal of the EUTM applied for, however, there is no longer any basis for such a further examination of other grounds for refusal (§ 20). The application for conversion is refused as inadmissible and the appeal remains unsuccessful (§ 21).