

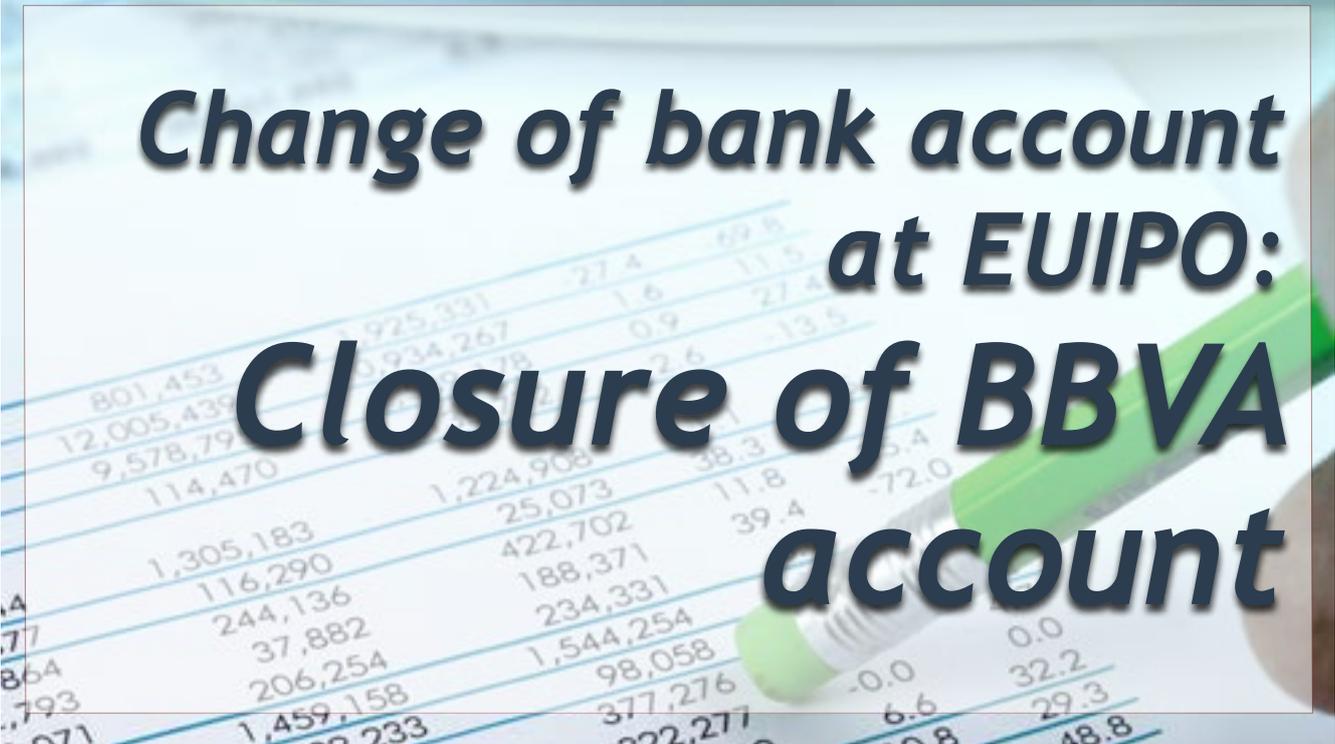
Alicante News

Up to date information on IP and EUIPO-related matters

Sept
2018



***Change of bank account
at EUIPO:
Closure of BBVA
account***



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Editorial



Change of EUIPO bank account: closure of BBVA account

On 17 February 2018, one of the two bank accounts used by EUIPO to which users can transfer fees, current account replenishments and charges changed.

The two bank accounts used by the Office for this purpose are now managed by CaixaBank and Banco Santander.

EUIPO's online e-filing application is fully up to date with this change.

In order to facilitate users, EUIPO has been accepting payments into the old bank account, administered by BBVA, since the changeover date, on an interim basis.

However, from 17 September 2018, the BBVA bank account has been closed.

The Office has instructed BBVA to block all incoming payments to the account from that date.

Since 17 February 2018, the date of the changeover, the Office has communicated extensively on this issue.

More than 1 000 letters have been sent to users who continued to pay through the BBVA account, informing them of the change, with the result that only 2% of payments received are currently coming through the old account.

Users are kindly asked to take note that, with the definitive closure of the BBVA account, all payments made to it after 17 September will be automatically rejected.

Details of this change are contained in the [Communication No 1/2018 of the Executive Director of the Office of 16 February 2018](#).



Registered Community Design



RCD: priority assessment

The new Guidelines on the examination of applications for RCDs and on the examination of RCD invalidity applications stipulate a revised practice for the priority assessment effective as of 1st October this month.

According to the previous practice, in the course of the RCD application procedure, the EUIPO examined a number of formal requirements when a priority was claimed, namely:

- Claiming within first six months of first application;
- Priority claimed when filing or within one month;
- Filing of details and certified copy within three months of filing date / priority claim;
- Previous application = design or utility model;
- Previous application from PC or WTO country;
- Previous application a first filing;
- Same proprietor.

The EUIPO did not examine, however, whether the RCD applied for related to the same design right or utility model as the one for which priority was claimed.

Furthermore, it should be noted that the EUIPO is not competent to examine the priority claim for international registrations designating the EU at application stage. The International Bureau, in turn, confines its examination to whether certain particulars are indicated without verifying them and consequently without requesting any priority documentation.

The new practice for RCD applications is aligned with the formerly revised practice for European Union Trade Mark applications in that the examination at application stage is limited to the minimum legal requirements to allow for the publication of a "claimed" priority, which are:

- priority claim filed together with the Community design application or within 1 month of the filing date;

- file number, filing date and country of the previous application indicated when claiming priority;
- copy of the entire priority documents submitted in due time (within 3 months of either the filing date or, as the case may be, receipt of the declaration of priority); and translations, where applicable.

The EUIPO will perform a complete examination of the requirements only during invalidity proceedings if contested by one of the parties and where necessary with regard to the outcome of the proceedings. This will include an examination whether the RCD in question relates to the same design right or utility model as the one for which priority is claimed.

Furthermore, when an issue of law which the EUIPO must correctly apply (see, for the priority claim in opposition proceedings: T-186/12, 25.05.2015 – LUCEA LED / LUCEO), the EUIPO is not prevented from examining, of its own motion, whether a priority claim is valid.

In the EUIPO's estimation, this complete examination will materialise in less than 10 RCD invalidity proceedings per year. It is important to note that this examination, in principle, will be based exclusively on the priority documents submitted by the RCD applicant at application stage.

In accordance with the new practice, priority claims will be published as "claimed" instead of "accepted".

This new practice will make it more transparent that the EUIPO's examination of a priority claim is limited at application stage and that the party concerned should challenge the claim when there are reasonable doubts on the validity of the priority claim and when it may have an impact on the invalidity decision.

It approximates the practice for RCDs with that of international registrations designating the EU with respect to the publication of a priority claim only.

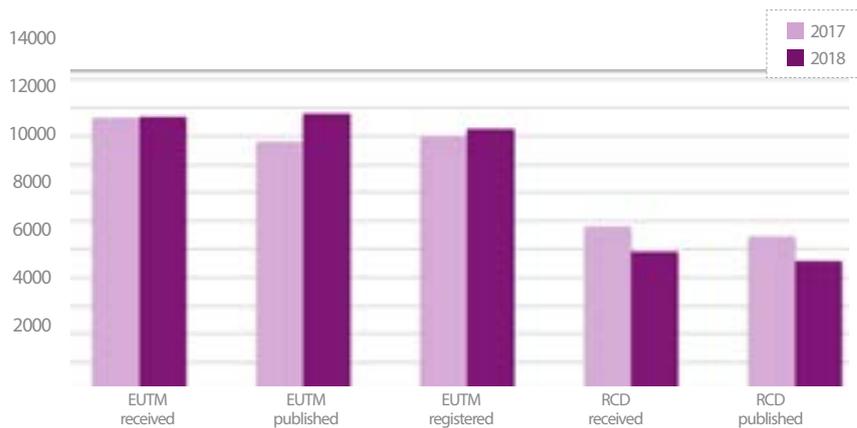


Statistical Highlights



Monthly statistical highlights September*	2017	2018
European Union Trade Mark applications received	11 666	11 700
European Union Trade Mark applications published	10 803	11 783
European Union Trade Marks registered (certificates issued)	11 002	11 267
Registered Community Designs received	7 806	6 895
Registered Community Designs published	7 449	6 581

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





ETMDN Updates



European Cooperation: The Patent Office of the Republic of Bulgaria implements ECP2 Front Office

The Patent Office of the Republic of Bulgaria (BPO) has successfully completed the implementation of ECP2-Front Office Release 1, bringing improved trade mark and design e-filing services to Bulgarian users.

The release replaces the existing Front Office tools implemented by the Cooperation Fund with a newer version, developed by the European Cooperation Programme. As well as enhanced e-filing, the system also includes 29 e-services for trade marks and designs.

The new systems were made available through the [BPO portal on 14 September 2018](#).

The implementation of the new Front Office version started in February 2017 within the framework of [the European Cooperation projects \(ECP 2 – “Major improvements to existing tools”\)](#), for which BPO was a pilot office. The project has been carried out with support of different teams from EUIPO and BPO.

This new version of Front Office includes a technology upgrade, which will make the tool faster, more secure and easier to maintain. Additionally, the new system includes six new e-services as well as functional improvements.

BPO is the fourth pilot IP office to implement the Front Office release under the ECP2 project. The other three pilot offices were Finland (implemented December 2017), Sweden (implemented January 2018) and Portugal (implemented February 2018).

User Satisfaction Survey tool implemented in Peru and Serbia

On 17 September 2018, both the National Institute for the Defence of Free Competition and Protection of Intellectual Property of Peru ([INDECOPI](#)) and the [Intellectual Property Office of the Republic of Serbia \(IPORS\)](#), implemented the User Satisfaction Survey (USS) tool.

The USS tool provides participating offices with a single, common approach to carrying out surveys among IP office users.

This implementation is part of the activities undertaken under Line of Action 4 of EUIPO's Strategic Plan 2020, and part of the extension of EUIPN tools to IP offices outside the European Union.

With the inclusion of both INDECOPI and IPORS, this brings to seven the total number of non-EU IP offices to implement USS.



More News



Launch of Identification and Analysis of Malware on Suspected Copyright Infringing Websites

Some websites and mobile applications illegally share copyright protected content publicly, sometimes even free of charge and without any registration.

Along with this content, the websites commonly distribute various kinds of malware and potentially unwanted programs (PUPs), luring users into downloading and launching these files.

These programs use deceptive techniques and social engineering — such as empty game installations and ostensibly ‘useful’ software — to trick end users into disclosing their sensitive information.

A new research study into this phenomenon has been released by the EUIPO. The research was carried out in cooperation with the United Nations Interregional Crime and Justice Research Institute (UNICRI).

In the research a variety of PUPs were discovered such as either ‘useful’ software, fake game installers and clients for video streaming platforms. This software does not necessarily pose direct dangers to the user’s software or hardware. However, a user might be convinced to disclose sensitive personal information or payment card details. In addition, information about the computer itself might be leaked to other parties without explicit user consent.

The full text of the ‘Identification and Analysis of Malware on Suspected Copyright Infringing Websites’ is [available here](#).

IP Statistics for Decision Makers Conference: 23 & 24 October 2018

The EUIPO and the Organisation for Economic Co-Operation and Development (OECD) will jointly organise the 2018 edition of the IP Statistics for Decision Makers (IPSDM) Conference.

The conference will take place at the EUIPO’s headquarters in Alicante on 23 & 24 October 2018. The IPSDM Conference is one of the most important events related to IP statistics and research worldwide.

The conference format was initiated by the European Patent Office (EPO) and the OECD in Vienna in 2006. Since then, the conference has been organised annually by the OECD together with co-operating national or regional IP offices.

The last three conferences have taken place in:

- Mexico in 2017, co-organised by the OECD, the United States Patent and Trademark Office (USPTO), the Canadian Intellectual Property Office (CIPO) and the Mexican Institute of Industrial Property (IMPI);
- Sydney in 2016, co-organised by the OECD and IP Australia,
- Vienna in 2015, co-organised by the OECD and the EPO.

The conference focuses on how IP statistics and analysis could be used to better shape IP policies, both at the macro (policy) and micro (firm) level.

Each year the event gathers leading academic researchers and practitioners representing IP offices, other public bodies, academia and businesses from all over the world.

This year’s conference will focus on IP data and empirical evidence related to:

- IP and the digital transformation: the role of IP in Artificial Intelligence, the Internet of Things, Blockchain and Fintech;
- P bundles and the knowledge economy;
- IPR, standards and standard setting mechanisms;
- The role of IP for branding and for service and creative industries;
- International IP systems and IP in the EU single market;
- IP valuation methods and the market for IP rights;
- Science-industry links, university technology transfer and the



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role of IP;

- IPRs as a barrier to entry and growth or as a performance enabler for SMEs;
- Violation of IP rights: counterfeiting, piracy and copyright infringement;
- Creative Commons and open source as a challenge or complement to the IPR system;
- IP Offices' practices and their impact on the efficiency and outcomes of IP systems.

Participation at the conference is free of charge and is subject to prior registration using the following [link](#).



Case law

Luxembourg trade mark and design news

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

C-564/16 P; DEVICE OF A JUMPING ANIMAL / PUMA et al.; EUIPO v Puma SE; Judgment of 28 June 2018; EU:C:2018:509; Language of the case: EN

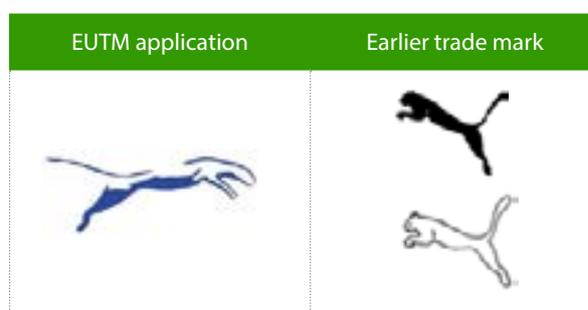
RESULT: Action dismissed

KEYWORDS: Lack of reasoning, Principle of legality

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods in Class 7. Puma filed an opposition based on the earlier international figurative marks below for goods in Classes 18, 25 and 28, on the basis of Article 8(5) EUTMR. In support of its claim that the earlier marks were reputed, Puma had, inter alia, relied upon three previous decisions of the Office in which its reputation had been recognised. The Opposition Division (OD) dismissed the opposition, finding that the relevant public would not establish a link between the marks, without first examining whether Puma had established the reputation of its earlier marks. The Board of Appeal (BoA) also dismissed Puma's appeal, finding that it had not established the reputation of its earlier marks. In addition, it also found that, even assuming that the reputation of the earlier marks were to be regarded as proven, the condition of the existence of an unfair advantage taken of the distinctive character or repute of the earlier marks or of detriment to their distinctive character or repute, had not been satisfied either. Puma appealed to the General Court (GC), which annulled the Board's decision for reasons of infringement of the principles of legal certainty and sound administration, inasmuch as the BoA had rejected the evidence relating to the reputation of the earlier trade marks and found that their reputation had not been proved. The Office appealed to the Court of Justice (CJ), relying on two pleas in law: (i) infringement of Article 123(1) EUTMR and of the principle



of sound administration, read in conjunction with Article 7(2)(c) EUTMDR and Article 8(5) EUTMR and (ii) infringement of Rule 50(1) CTMIR and of Article 123(1) EUTMR.



SUBSTANCE: (i) The opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office. Therefore, nothing precludes earlier Office decisions from determining the existence of reputation in other inter partes proceedings and being relied on in that context as evidence in support of the reputation of that earlier mark, particularly when they are identified in a precise manner and their substantive content is set out in the notice of opposition in the language of the case (para. 69). The GC did not err when it found that the three previous decisions had been 'duly relied on' by the opponent (para. 75). The GC was right to examine whether the BoA, by merely stating in the decision that the Office was not bound by its decision-making practice, had satisfied its obligation to state reasons, in view of the context in which that decision had been made and in view of the legal rules governing the matter, including the principles of sound administration and equal treatment (para. 79). Merely stating that the lawfulness of the Office's decisions must be assessed solely on the basis of EUTMR and not on the basis of its earlier decision-making practice (para. 82) did not satisfy the Office's bodies' obligation to state reasons. The previous decisions, insofar as they had recognised the reputation of the earlier marks, were a strong indication that those marks could also be regarded as having a reputation in the current opposition proceedings (para. 95). The Office was required to take into account the three previous decisions relied



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on by the opponent, and had to provide an explicit statement of its reasoning in the present case insofar as it had decided to depart from the approach adopted in those decisions on the reputation of the earlier marks (para. 96). Therefore, the GC did not err in concluding that it was incumbent on the BoA, in accordance with the principle of sound administration, either to provide the reasons why it considered that the findings made by the Office in the three previous decisions relating to the reputation of the earlier marks had to be disregarded in the present case, or to request that the opponent submit supplementary evidence of the reputation of the earlier marks (para. 100).

C-84/17P, C-85/17P and C-95/17P (joined cases); SHAPE OF A FOUR-FINGER CHOCOLATE BAR; Mondelez UK Holdings & Services Ltd v EUIPO - Société des produits Nestlé SA; Judgment of 25 July 2018; EU:C:2018:596; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Burden of proof, Distinctiveness acquired by use, Res judicata, Three dimensional mark

FACTS: The EUTM proprietor was granted registration of the 3D mark below as an EUTM for goods in Class 30. An application for invalidity was filed pursuant to Article 59(2) EUTMR in conjunction with Article 7(1)(b) EUTMR. The Cancellation Division (CD) upheld the application insofar as the mark was devoid of any distinctive character. The Board of Appeal (BoA) upheld the EUTM proprietor's appeal. It found that although the mark was devoid of any inherent distinctive character, it had acquired such character through use. The invalidity applicant appealed to the General Court (GC). The GC annulled the BoA's decision in its entirety, as it found that the BoA had not correctly assessed the mark's distinctive character acquired through use, since it had not adjudicated on the relevant public's perception of the mark in, inter alia, Belgium, Ireland, Greece and Portugal, and had failed to analyse the evidence submitted by the EUTM proprietor with regard to those Member States. The invalidity applicant appealed to the Court of Justice (CJ).



EUTM



SUBSTANCE: Admissibility of the invalidity applicant's appeal. Since the invalidity applicant does not request that the operative part of the judgment be set aside, but only certain grounds of that judgment, the appeal is inadmissible (paras 43, 50). The force of res judicata extends only to the grounds supporting the operative part of a judgment (para. 52). Consequently, when a decision of the Office is annulled by the GC, the grounds upon which that court dismissed certain arguments relied upon by the parties cannot be considered to have gained the force of res judicata (para. 53). Distinctiveness acquired by use. Although it would be unreasonable to require proof of acquired distinctiveness through use for each and every individual Member State (para. 77), it is not sufficient to prove that the mark has acquired distinctive character through use in a significant part of the EU (para. 78). There is a distinction to be made between the facts to be proved, namely the acquisition of distinctive character through use, and the means of proving such facts (para. 79). Although it is not necessary that evidence be submitted for each individual Member State, the evidence must at least be capable of establishing such acquisition throughout the Member States of the EU (para. 83). The distinctive character acquired through use must be shown throughout the European Union, not only in a substantial part or the majority of its territory. Consequently, although such proof may be submitted globally for all the Member States concerned, or separately for different Member States or groups of Member States, it is not sufficient that the party with the burden of providing such evidence merely submits evidence of the acquisition that does not cover part of the European Union, even a part consisting of



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only one Member State (para. 87). The BoA erred in finding that the mark had acquired distinctive character through use without adjudicating on the perception of that mark in Belgium, Ireland, Greece and Portugal (para. 88).

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

T-537/15; InPost-POST et al.; Deutsche Post AG v EUIPO; Judgment of 26 June 2018; EU:T:2018:384; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual dissimilarity, Dissimilarity of the goods and services, Enhanced distinctiveness, Figurative element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Visual similarity, Weak element.

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 6, 9, 35 and 39. An opposition was filed based on, inter alia, the earlier German word mark POST (Classes 35 and 39) and the EU figurative mark below (services in Classes 35 and 39). The Opposition Division (OD) partly dismissed the opposition for goods and services in Classes 9, 35 and 39 except for business enquiries, research surveys, and organisation of exhibitions for commercial purposes. The opponent appealed, but the Board of Appeal (BoA) dismissed the appeal, finding no likelihood of confusion (LOC). The opponent filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR.



EUTM application	Earlier trade mark
	POST

SUBSTANCE: (i) Regarding POST. Relevant public. This consists of both the general public and professionals in Germany (para. 34). Comparison of services. The services concerned are similar or identical, with the exception of advertising space rental services of the contested mark, which are different (para. 36). Comparison of signs. (a) Visually, the signs are similar as they coincide in the common element 'post', but differ as the contested mark has a black and yellow envelope symbol, begins with the word element 'in', and arranges the elements of the figurative mark differently (para. 54). (b) Aurally, they are similar to a low degree, since the pronunciation of the marks coincides in the pronunciation of the term 'post' and differs in the additional word element 'in' of the contested mark (para. 48). (c) Conceptually, the signs are similar to a low degree, since they convey the meaning of the word 'post', but differ significantly in that the word element 'in' at the beginning of the contested mark, unlike the term 'post', does not refer to the services (para. 51). No LOC. Given the low degree of distinctive character of the earlier mark and the differences between the signs, and despite the identity of the services, there is no LOC. The mere fact that the earlier national word mark, POST, reached the threshold required to be registered as a national trade mark does not mean that the element 'post' has acquired enhanced distinctiveness or a reputation (paras 66, 67 and 80). (ii) Regarding INFOPOST. Relevant public. This consists of consumers in the EU (para. 81). Comparison of services. Most of the services in Classes 35 and 39 are identical (para. 82). Comparison of signs. (a) Visually, the signs are similar to a low degree: despite their common element 'post', they differ



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due to the black and yellow envelope symbol and because the first word element of the earlier EU figurative mark is 'info', whereas the first word element of the contested mark is 'in'. Furthermore, they use different colours and typefaces, and their figurative elements are arranged differently (paras 87-88). (b) Aurally, the signs coincide in the pronunciation of 'in' and 'post'. They also differ as the earlier figurative EU mark has an additional syllable 'fo'. This additional syllable changes the pronunciation, forming the independent word 'info', which conveys its own meaning (para. 89). (c) Conceptually, they are different, since the word element 'info' in the earlier EU figurative mark will be understood by the relevant public as meaning 'information' (para. 90). No LOC. Given the different overall impressions made by the marks, and the fact that the common element, 'post', has a low degree of distinctiveness, LOC cannot be substantiated (para. 97). (iii) The relevant public will not make any link between the contested mark and POST, since 'post' is generic and likely to be perceived as merely a reference to postal services (para. 112).

T-739/16; COSIMO / COSIFLOR; Akant Monika i Zbigniew Harasym sp.j. v EUIPO; Judgment of 26 June 2018; EU:T:2018:387; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Proof of use, Similarity of the goods and services, Visual similarity

FACTS: The applicant sought to register the word mark COSIMO as an EUTM for goods in Classes 20, 22 and 24. An opposition was filed pursuant to Article 8(1)(b) EUTMR, based on the earlier EU word mark COSIFLOR, registered for goods in Classes 6, 19 and 24. The Opposition Division (OD) dismissed the opposition, finding no likelihood of confusion (LOC). The opponent successfully appealed to the Board of Appeal (BoA), which found LOC for Dutch- and German-speaking consumers, at least. The applicant appealed to the General Court (GC), relying on two pleas in law: (i) infringement of Article 47(2) EUTMR and (ii) infringement of Article 8(1)(b)

EUTMR.

SUBSTANCE: No request for proof of use. The applicant merely stated, in its observations before the OD, that the opponent had not provided any evidence of use of the earlier mark. That declaration was not worded as an explicit and unambiguous request for proof of use, and is more of a simple observation on the probative value of the documents produced. There is, moreover, no other material in the file capable of constituting such a request. The BoA acted correctly in taking the view that the applicant had not made a request for proof of genuine use of the earlier mark. Relevant public. The relevant public consists of EU professional consumers and the general public with a high level of attention, since the choice of the goods concerned requires a process of reflection on the part of the average consumer, who will have to verify, in particular, their dimensions and will not purchase them on a daily basis (paras 38-39). Comparison of the goods. The goods concerned are identical or highly similar (para. 49). Comparison of the signs. (i) Visually, the signs are similar: they coincide in the element 'COSI' and in the vowel 'o' in the third symbol of each sign. The fact that five of the six letters of the contested mark are included in the earlier mark counteracts the visual differences between the signs, namely the letters 'f', 'l' and 'r' of the earlier mark and the letter 'm' of the contested mark (para. 55). (ii) The signs have a certain phonetic similarity: consisting of a single word, they have the same number of syllables and the same sequence of vowels, namely 'o', 'i', 'o'. Since the letters 'f', 'l' and 'm' are located in the middle of the signs, the difference in pronunciation arising from the presence of those consonants will be minor from the point of view of members of the relevant public who hear those word elements spoken with a view to purchasing the goods concerned (paras 57-59). (iii) Since neither of the marks has any clear and specific meaning, the conceptual difference between the marks cannot be assessed in this case, at least with regard to the German- or Dutch-speaking part of the relevant public (para. 66). LOC. Given the normal degree of distinctive character of the contested mark, the identity or high similarity of the goods, the visual similarity and a certain degree of phonetic similarity of the signs, there is LOC (para. 68).



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T-707/16; ANTONIO RUBINI; Enoitalia SpA v EUIPO; Judgment of 11 July 2018; EU:T:2018:424; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Distinctive element, Dominant element, Figurative element, Figurative trade mark, Likelihood of confusion, Nature of the goods and services, Visual similarity

FACTS: The applicant sought to register the mark ANTONIO RUBINI for alcoholic beverages (except beers), wines in Class 33. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, based on the earlier mark below for alcoholic beverages (except beers); wine, sparkling wine, fortified wine in Class 33. The Cancellation Division (CD) upheld the application for invalidity due to the likelihood of confusion (LOC) between the marks, as the goods in question were identical and the signs were visually, phonetically and conceptually similar.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found there was a significant risk that average consumers of the goods could believe that the marks had the same commercial origin because the dominant element of the contested mark, 'RUBINI', is almost identical to the single word element of the earlier mark 'RUTINI'. The applicant appealed to the General Court (GC), relying on a single plea in law: infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR.



EUTM application	Earlier trade mark
ANTONIO RUBINI	

SUBSTANCE: Relevant public. The decisive factor in determining the relevant public's level of attention is not how the goods are purchased (in this case, according to the applicant, by reading the label) but the nature of the goods. As wines are everyday consumer goods, the level of attention is expected to be normal, not high (para. 24). Distinctive element. In a mark comprising a common forename, like Antonio, and a surname that is uncommon throughout the relevant territory, i.e. the EU, the forename has a lower level of distinctiveness than the surname (para. 43). Dominant element. In the context of marketing wines, the grape leaves and ribbons do not dominate the image the relevant public retains of the earlier mark. The same is true for the presence of a coat of arms. It is rather the word element 'RUTINI' that dominates the perception of the earlier mark (paras 49–50). Conceptual similarity. Even though the surnames 'RUBINI' and 'RUTINI' are probably both of Italian origin, this is not sufficient for consumers to associate them and believe that the goods in question come from the same undertaking; thus they are not conceptually similar (paras 64–68). Likelihood of confusion. For identical goods, the visual and phonetic similarities between the signs, based on the similarity between the dominant and distinctive elements 'RUTINI' and 'RUBINI', suffice to conclude that there is LOC on the part of the relevant public (paras 73–76).



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T-619/16; GiCapri a giachett'e capri / CAPRI et al.; Pasquale Sicignano v EUIPO; Judgment of 26 June 2018; EU:T:2018:385; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual similarity, Distinctive element, Dominant element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Scope of proceedings, Similarity of the goods and services, Visual similarity

FACTS: The applicant sought to register the figurative mark below as an EUTM for goods and services in Classes 18, 25 and 35. An opposition based on the earlier EU figurative mark below, registered for goods in Class 25, and the earlier Italian word mark CAPRI (goods in Class 25) was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition as there was no likelihood of confusion between the earlier EU figurative mark and the contested mark. Further, the opponent had not proven the existence and validity of the earlier Italian word mark. The opponent appealed and the Board of Appeal (BoA) upheld the appeal, finding likelihood of confusion (LOC), given the similarity of the signs. The applicant appealed to the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.



SUBSTANCE: Relevant public. The relevant territory is the EU. The relevant public is the general public with an average level of attention regarding the goods concerned. However, services in

Class 35 also refer to both the general public and professionals with a higher level of attention (para. 36). Comparison of goods and services. The goods are partly identical and partly similar to the earlier trade mark's goods, whereas the services concerned are moderately similar (para. 36). Comparison of signs. (i) Visually, the marks are similar to a moderate degree: owing to its central position and clear visibility, the common and somewhat dominant element 'CAPRI' is perfectly recognisable and discernible from the element 'GI' in the contested mark; that similarity is attenuated by the difference in the arrangement, size and graphic appearance of the verbal elements (para. 61). (ii) Phonetically, the similarity between the signs is moderate, given that the trade marks coincide in the pronunciation of the syllables 'CA-PRI' and that the different purely figurative elements will not be pronounced by the public (para. 62). (iii) Conceptually, for those members of the relevant public who will recognise the presence of the word 'CAPRI' in the contested sign and know the Italian island, the trade marks will be conceptually similar to a certain extent. The remaining word and figurative elements of the contested trade mark have a conceptual content that would be identified by only a proportion of the Italian public (para. 63). Distinctiveness of the sign. Since the distinctive character of the word 'CAPRI' was not raised before the BoA, it was not examined and therefore cannot be raised before the GC (para. 47). Furthermore, the applicant did not provide proof that the above word would be evocative and suggestive of fashion, clothing or a specific style of clothing (para. 52). Therefore, the earlier mark has a normal degree of distinctive character. Scope of proceedings. The applicant cannot raise absolute grounds regarding geographical origin during opposition proceedings (para. 64). In any event, it has not been demonstrated that the relevant public could believe that the goods concerned originate from Capri, since this island is not renowned for being a clothing production hub. Instead, it is famous as a tourist destination in southern Italy (para. 67). LOC. Given the identity or similarity of the goods and services, the similarities of the signs and the normal distinctive character of the earlier mark, there is LOC. The alleged coexistence in the Office's Register, and probably in the Italian Register, of several trade marks including the word 'CAPRI' is not a valid argument for ruling out



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LOC (paras 91-92).

T-227/16; FOOT MAT; Haverkamp IP GmbH v EUIPO; Judgment of 21 June 2018; ECLI:EU:T:2018:370; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Freedom of designer, Individual character, Informed user, Overall impression

FACTS: The RCD proprietor registered the design below as an RCD with the product indication foot mat in Class 6-11 of the Locarno Classification. An invalidity application was filed by the intervener pursuant to Article 25 CDR in conjunction with Article 106(f) CDR. It was based on the intervener's earlier Swiss registered design for health mats in the same class of the Locarno Classification. The Invalidity Division (ID) upheld the invalidity application as the design lacked individual character. The Board of Appeal (BoA) dismissed the RCD proprietor's appeal. The RCD proprietor appealed to the General Court (GC), relying on a single plea in law: infringement of Article 6(1)(b) CDR on individual character.



SUBSTANCE: Disclosure to the public of an earlier design. An invalidity applicant is not confined to specific, predetermined means of evidence to prove disclosure to the public of an earlier design, but is free to choose the form of evidence to submit. The invalidity applicant is not confined to submitting documents in one given language. Consequently, the Office examines all the elements submitted to assess whether they constitute evidence of disclosure (paras 26-28). Informed user. The informed user

regularly purchases foot mats and uses them for their purpose, which is not confined to massage mats, but includes shower mats or car mats for instance, regardless of the filed description. Moreover, the Office is not bound by the coinciding declarations of the parties regarding use of the products (paras 47-50). Saturation of the state of art. Saturation of the state of the art in a given sector cannot be presumed: it must be sufficiently proved by the party alleging it. In that respect, six prior design registrations are insufficient to establish saturation of the state of the art (para. 66). Global impression of conflicting designs. The barely perceptible differences on the upper surfaces of the mats and the negligible differences on their lower surfaces do not alter the fact that the global impression they make is the same. This is particularly true where the conflicting designs possess common characteristics concerning elements that a designer can freely modify (paras 72-78).

T-228/16; Pebble beach surface pattern; Haverkamp IP GmbH v EUIPO; Judgment of 21 June 2018; EU:T:2018:369; Language of the case: DE

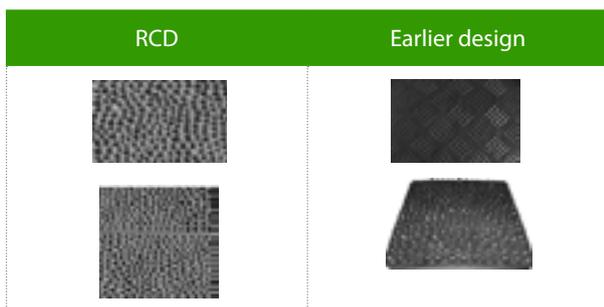
RESULT: Action dismissed

KEYWORDS: Evidence of use, Novelty, Overall impression, Representation of a design

FACTS: The RCD proprietor registered the design below as an RCD with the product indication pebble beach surface pattern in Class 32-00 of the Locarno Classification. An invalidity application was filed by the intervener pursuant to Article 25 CDR in conjunction with Article 106(f) CDR. The application was based on the intervener's earlier Swiss registered design for health mats in Class 6-11 of the Locarno Classification. The Invalidity Division (ID) upheld the invalidity application as the contested design lacked novelty. The Board of Appeal (BoA) dismissed the appeal on the grounds that the design was not new and lacked individual character. The RCD proprietor appealed to the General Court (GC), relying on two pleas in law: (i) lack of novelty and (ii) lack of individual character. Since the GC found that the RCD was not new, the Court did not find it necessary to examine the second plea.



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SUBSTANCE: Disclosure to the public of the earlier design. An invalidity applicant is not confined to specific, predetermined means of evidence to prove disclosure to the public of an earlier design, but is free to choose the form of evidence. The invalidity applicant is not confined to submitting documents in one given language. Consequently, the Office examines all the elements submitted to assess whether they constitute evidence of disclosure (paras 25-27). Identity of the designs. The comparison must be based on the features disclosed by the contested design; additional features of the earlier design are irrelevant (para. 38). When assessing novelty, it is irrelevant that the earlier design constitutes a health mat whereas the contested design relates to a surface pattern that may be applied to any type of product (para. 42). The conflicting designs are identical. Possible differences in the form, height and size of the pebbles are immaterial. Moreover, any height difference may result from different viewing angles (paras 45-46).

T-774/16; CAVA DE TAIN; Consejo Regulador del Cava v EUIPO; Judgment of 12 July 2018; EU:T:2018:441; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual dissimilarity, Figurative trade mark, Geographical origin, Phonetic dissimilarity, Visual dissimilarity

FACTS: The EUTM proprietor registered the figurative mark below as an EUTM for wines with a registered designation of origin and vin de pays in Class 33. An invalidity application was filed pursuant

to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(j) EUTMR, read together with Article 103(2)(b) of Regulation No 1308/2013. The latter refers to the misuse, imitation and evocation of a protected designation of origin (PDO). The Cancellation Division (CD) rejected the invalidity application as the signs were not visually or phonetically similar and the contested mark did not evoke the PDO CAVA. The Board of Appeal (BoA) dismissed the invalidity applicant's appeal, finding that the mark did not bring to mind the PDO. The invalidity applicant appealed to the General Court (GC), claiming that the decision be annulled in part insofar as it did not invalidate the contested mark with regard to sparkling wines with a registered designation of origin. The invalidity applicant relied on a single plea in law, alleging infringement of Article 52(1)(a) EUTMR in conjunction with Articles 102(1)(b) and 103(2)(b) of Regulation No 1308/2013.



SUBSTANCE: Essential function of a PDO. The essential function of a PDO is to guarantee to consumers the geographical origin of goods and their inherent special qualities. This does not alter the fact that a PDO identifies a product on the basis of a specific geographical origin, where particular qualities or characteristics are attributable to that origin (para. 35). CAVA as a reference to geographical area. The PDO CAVA refers to a geographical area consisting of several non-contiguous provinces within Spain. This forms, under the PDO rules, a whole possessed of a unity, giving the goods from those provinces an identity based both on a particular geographical environment and on the qualities or characteristics unique to that area (para. 31). Visual comparison of the signs. The particular features of the contested mark result in a very specific



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appearance, meaning that there is a low degree of visual similarity between the two signs (paras 44-49). Phonetic comparison of the signs. There is a low degree of phonetic similarity. While the signs have the initial syllable 'ca' in common, followed by a syllable starting with the consonant 'v', this is largely offset by the aural differences arising from the respective number of syllables (seven and two) and phonemes (seven and four). This influences the respective rhythm of pronunciation and intonation used when the signs are pronounced (paras 50-52). Evocation of the PDO. 'Cave' is commonly used in the wine sector, whether or not the wine is a sparkling wine (para. 88). Further, considered as a whole, 'cave', 'de' and 'tain' sound French. Therefore, those words would be understood by consumers as referring to a wine cellar in France (para. 92). The contested mark will be understood by consumers, regardless of their language, as referring to a wine produced in a French region or town that appears in the mark, irrespective of whether the wine is sparkling or not. Further, the association made by the consumer between the product and its French origin precludes any possible evocation of the PDO CAVA (paras 91-95).

T-71/17; FRANCE.COM / France; France.com, Inc. v EUIPO; Judgment of 26 June 2018; EU:T:2018:381; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Similarity of the signs, Visual similarity

FACTS: The EUTM applicant sought to register the figurative sign below for the services in Classes 35, 39 and 41. An opposition based on the earlier trade mark depicted below was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition. The opponent appealed against the OD's decision, which was then annulled by the Board of Appeal (BoA). The latter found that the services applied for were aimed at the general public and professionals, that the level of attention of the relevant public was average to high and that the likelihood of confusion



(LOC) should be assessed in the European Union. The BoA upheld the OD's finding that the services were in part identical and in part similar. It also found that the signs had an average degree of visual similarity and were phonetically and conceptually identical, so they were highly similar overall. A LOC within the meaning of Article 8(1)(b) EUTMR could not be ruled out. The EUTM applicant appealed to the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(2) and 41(1) EUTMR and of Article 2(2)(b) and Article 5 EUTMDR and (ii) infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade mark
	

SUBSTANCE: The first plea in law. The only rights to be taken into consideration in the opposition proceedings in question are the mark applied for and the earlier mark (para. 32). However, that does not mean that a mark registered in accordance with the 'first to file' principle is automatically protected. On the contrary, that protection requires constant vigilance on the part of the first person to file the mark (para. 35). If the applicant holds rights that predate the EU mark on which the intervener relies, it is for the applicant to seek protection of those rights by means of opposition or cancellation proceedings. As long as the earlier EU mark on which the intervener relies is in fact protected, the existence of earlier rights is irrelevant where an EU trade mark application is opposed (para. 36). Consequently, any decision by national courts concerning EU figurative marks is irrelevant to the present dispute (para. 37). Accordingly, as the first plea in law is unfounded, it must be rejected (para. 39). The second plea in law. Comparison of the signs. The BoA found that the stylised images of the Eiffel tower were as important as the word element 'France'. The applicant is therefore obviously incorrect in its claim that the BoA found that the



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word element 'france' is the main element of the signs at issue (para. 49-50). The word element 'france' corresponds to the shortened name of the French Republic (para. 52). The BoA was correct to find that the signs at issue have three elements in common: the word element 'france', a stylised image of the Eiffel tower and the colours red, white and blue, (para. 63). The mark applied for contains a pentagon and the abbreviation '.com', elements that are not present in the earlier mark. By contrast, the earlier mark contains a figurative element depicting a black Eiffel tower and a red, white and blue scarf, which do not appear in the mark applied for (para. 65). The figurative element depicting the Eiffel tower is represented differently in the signs at issue. In the earlier mark, it is a large, black, standalone element that is immediately apparent. In contrast, the same element in the mark applied for is depicted in white, inside a pentagon, and is smaller (para. 66). The font of the word element 'france' is also different. In the mark applied for, it is written in bold upper case letters, whereas it is written in lower case letters and in a font reminiscent of handwriting in the earlier mark (para. 67). Although the signs at issue share the colours red, white and blue, the way in which they are represented differs. The colour blue is dominant in the mark applied for, whereas the colour black, which is not present in the mark applied for, is the dominant colour in the earlier mark (para. 69). It is clear that the signs at issue, considered as a whole, have only a low degree of visual similarity (para. 70). Phonetic comparison. The applicant is incorrect to claim that the earlier mark will be read by an English speaker as 'Eiffel tower — france' and by a French speaker as 'tour Eiffel — france'. As the Eiffel tower is a world-famous French monument, consumers will likely regard it as a mere illustration of the word element 'france' without saying its name (para. 75). The signs at issue are almost identical. As the BoA observed, it can be assumed that many consumers will refer to the mark applied for by the word 'france' alone (para. 76). In those circumstances, the Court found that the signs at issue are almost identical phonetically (para. 77). Conceptual comparison. It is clear that the signs at issue contain almost exclusively elements that refer to the same concept. The word element 'france' refers to the French Republic. The figurative elements in the signs at issue refer to a symbol widely known,

namely the Eiffel tower, and the colours red, white and blue. The same holds true for the figurative element, present only in the mark applied for, depicting a pentagon, the shape of which brings to mind the 'Hexagon', an expression designating the continental part of metropolitan France (para. 82). The element '.com', present only in the mark applied for, is not sufficient to enable those signs to be differentiated conceptually (para. 83). Thus, as the elements of the signs at issue convey the same concept, the presence of the word element '.com' cannot have any bearing on whether those signs are conceptually identical (para. 85). Therefore, it must be concluded that the signs at issue are conceptually identical (para. 86). LOC. Taking into account the identity of the goods and services, the GC found LOC to exist despite the low degree of visual similarity between the signs since they are identical conceptually and almost identical phonetically (paras 94 and 96).

T-556/17; STAROPIILSEN; STAROPLZEN / STAROPRAMEN; Staropilsen s. r. o. v EUIPO; Judgment of 26 June 2018; EU:T:2018:382; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The EUTM proprietor registered the word mark STAROPIILSEN; STAROPLZEN as an EUTM for goods in Class 32 for beers, aerated waters and other non-alcoholic drinks, drinks and fruit juices, and syrups and other preparations for making beverages. An invalidity application was filed pursuant to Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR, based on the earlier EU word mark STAROPRAMEN for beers in Class 32, and two earlier Czech word marks STAROPRAMEN for alcoholic and dealcoholic drinks of all kinds, nonalcoholic beer, beer, extraction, essence for drink production, colorific beer, and fruit juices and beers of all kinds in Class 32 respectively. The Cancellation Division (CD) upheld the invalidity application, finding likelihood of confusion (LOC). The EUTM proprietor appealed, but the Board of Appeal (BoA) dismissed the appeal. The EUTM proprietor appealed to the



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General Court (GC), relying on a single plea in law: infringement of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR.

SUBSTANCE: Relevant public. The relevant public is the EU general public with an average degree of attention, since the goods concerned are everyday consumer goods, bought at affordable prices, which are normally widely distributed, ranging from the food section of a department store to bars and cafes (paras 24-26). Comparison of the goods. The goods are partly identical and partly similar to a varying degree (para. 17). Comparison of the signs. (i) The signs are visually similar to a high degree: firstly, due to the semicolon and the repetition of the contested mark in two languages, the relevant public will split the mark into two, focusing its attention on one of the two words. Therefore, the verbal elements of the signs share the same visual structure. Additionally, the beginning 'STAROP' and the ending 'EN' of both signs are identical (paras 38-39). (ii) Phonetically, the signs are highly similar: the pronunciation of the signs corresponds insofar as the first two syllables are identical, the letter 'p' is central to the two signs and the grouping of the final letters 'EN' is identical. Furthermore, in many EU official languages, the signs have the same rhythm and are pronounced with the same intonation (para. 41). (iii) Conceptually, the marks have no meaning for a substantial part of the relevant public (those who do not speak a Slavic language). Therefore, it is not possible to conduct a conceptual comparison of the signs (para. 45). **LOC.** Considering the identity or similarity of the goods, the above-average visual and phonetic similarity, and the normal level of distinctiveness of the earlier marks, there is LOC even for the relevant public with an average degree of attention (paras 47 and 51).

T-294/17; Lion's Head / LION CAPITAL et al.; Lion's Head Global Partners LLP v EUIPO; Judgment of 14 June 2018; EU:C:2018:345; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual similarity, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS: The IR holder designated the EU for the word mark Lion's Head covering, inter alia, insurance, financial affairs, monetary affairs and real estate affairs in Class 36. An opposition based on the earlier EUTM LION CAPITAL, registered for the same services, was filed by the opponent pursuant to Article 41 EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the IR holder's appeal. The IR holder appealed to the General Court (GC) to annul the BoA's decision, relying on a single plea in law, namely, infringement of Article 8(1)(b) EUTMR, submitting that the marks at issue were not visually, phonetically or conceptually similar.

SUBSTANCE: Visual similarity. As 'lion' is the first word of both marks, the marks are visually similar (para. 25). The fact that the pronunciation of 'head' in the IR is emphasised does not alter the visual similarity (para. 26). Phonetic similarity. The fact that the marks at issue do not have exactly the same number of syllables does not in itself exclude the possibility that those marks may be phonetically similar (para. 32). Conceptual similarity. Since both marks refer to lions, it cannot be disputed that they are conceptually similar (para. 35). The reference of the earlier mark to a lion, in its entirety, includes the head and the other body parts of the animal, resulting in the conceptual similarity of the two marks (para. 36).

T-310/17; LION'S HEAD global partner / LION CAPITAL et al.; Lion's Head Global Partners LLP v EUIPO; Judgment of 14 June 2018; EU:C:2018:344; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Distinctive element, Figurative element, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS: The IR holder designated the EU for the word mark Lion's Head covering, inter alia, insurance, financial affairs, monetary affairs, and real estate affairs in Class 36. An opposition based on the earlier EUTM LION CAPITAL, registered for the same services, was filed by the opponent pursuant to Article 41 EUTMR. The



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Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the IR holder's appeal. The IR holder appealed to the General Court (GC) to annul the BoA's decision, relying on a single plea in law, namely, infringement of Article 8(1) (b) EUTMR, submitting that the marks at issue were not visually, phonetically or conceptually similar.

IR designating the EU

Earlier trade mark



LION CAPITAL

SUBSTANCE: Dominant and distinctive elements. In the IR, the non-descriptive verbal element 'Lion's Head' is the most distinctive element. It is also the dominant element given its distinctive character, larger size and central position (paras 25-27). The non-descriptive word 'lion' constitutes the sole distinctive element of the earlier mark (para. 38). Visual similarity. The presence of the dominant and distinctive word 'lion' in both marks suffices to conclude that the marks are visually similar (para. 32). The fact that the pronunciation of the word 'head' in the IR is emphasised does not alter the assessment that visual similarity exists (para. 33). Phonetic similarity. The fact that the marks at issue do not have exactly the same number of syllables does not in itself exclude the possibility that those marks may be phonetically similar (para. 39). Conceptual similarity. Since both marks refer to lions, it cannot be disputed that they are conceptually similar (para. 42). The reference of the earlier mark to a lion, in its entirety, includes the head and the other body parts of the animal, resulting in the conceptual similarity of the two marks (para. 43).

T-362/17; FEEL FREE; NCL Corporation Ltd v EUIPO; Judgment of 27 June 2018; EU:T:2018:390; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Slogan mark

FACTS: The applicant sought to register the word mark FEEL FREE as an EUTM for arranging of cruises and cruise ship services in Class 39. The Office refused to register the mark on the grounds of Article 7(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the mark was non-distinctive for the services as it merely consisted of a laudatory slogan devoid of any elements that could, in addition to its promotional purpose, enable the public to memorise it easily and immediately as an indication of the commercial origin of the services. The applicant appealed to the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(b) EUTMR.

SUBSTANCE: Relevant public. Since the mark consists of English words and the services are offered to the public in general, the relevant public for examining the mark's distinctiveness consists of average English-speaking consumers (para. 35). Distinctiveness of the sign. The conjoined words 'feel' and 'free' constitute a banal, commonplace and grammatically correct expression with a simple, clear and evident meaning in English. Therefore, the mark does not trigger any particular cognitive process and is perceived simply and directly as a promotional slogan. It is not endowed with even a minimum degree of distinctive character (paras 37-40). There was no need to differentiate the services in Class 39 as the arguments to exclude the understanding that the mark has a minimum distinctive character apply to all of the application's services for identical reasons (para. 41). The fact that both words of the sign contain a double 'e' is not capable of conferring a distinctive character as this is very frequent in English. Furthermore, the consonantal alliteration of 'f' is unlikely to be noticed by consumers. Regardless, it will not be perceived as conferring distinctive character (para. 46). The allegation that the public is used to seeing slogans as trade marks has not been substantiated. Further, it is not decisive, as it does not explain why the sign would be perceived as more than a slogan, but as an indication of the commercial origin of the services (para. 48).

T-165/17; EMCURE / Emcur et al.; Emcur Gesundheitsmittel aus Bad



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Ems GmbH v EUIPO; Judgment of 14 June 2018; EU:T:2018:346; Language of the case: EN.

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Complementary goods and services, Dissimilarity of the goods and services, Likelihood of confusion, Nature of the goods and services

FACTS: The applicant sought to register the word sign EMCURE for services in Classes 35, 41, 42, 44 and 45. The opponent filed an opposition pursuant to Article 8(1)(b) EUTMR, based on the EU word mark EMCUR registered for goods in Classes 5 and 10 and the German word mark EMCUR registered for goods in Class 5. The Opposition Division (OD) upheld the opposition in part, rejecting registration of the mark for pharmacy advice services in Class 44, on the basis that there was a likelihood of confusion (LOC) regarding the earlier German mark. The opponent appealed, but the Board of Appeal (BoA) dismissed the appeal. Despite the high degree of similarity between the signs, there was no LOC because none of the remaining contested services was similar to the goods of the earlier marks. The opponent appealed to the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: Comparison of the goods and services. Classes 35 and 41. Insofar as the opponent's goods and the contested services in Classes 35 and 41 are used by professionals, the relevant public overlaps to some extent (para. 39). However, contrary to the opponent's position, the complementary connection between the opponent's goods in Class 35 (pharmaceuticals and healthcare preparations) and the contested services in Classes 35 and 41 (services for commercial, advertising, training and educational purposes in the area of healthcare) was not established. Therefore, there is no similarity between those goods and services (paras 40 to 44). Class 42. The services in Class 42 are closely connected to pharmaceutical products (paras 49 and 50). The BoA erred in finding that the goods in Class 35 covered by the earlier German mark and the contested services in Class 42 were not similar

(para. 53). Class 44. Medical services and pharmaceutical products target and are used by both professionals and the general public. Accordingly, those goods and services target the same consumers, have the same aim, have the same distribution channels, and are complementary (paras 56 to 60). The BoA erred in finding that the services in Class 44 and the goods covered by the earlier German mark were not similar (para. 61). Class 45. The opponent did not submit any argument challenging the contested decision's legality for services in Class 45. Accordingly, the Court cannot uphold the annulment of the contested decision (paras 64 and 65). The BoA did not err in finding that there was no similarity between the services in Classes 35 and 41 and the goods in Class 35. Therefore, there was no LOC (para. 66). However, the BoA erred in finding that there was no LOC within the meaning of Article 8(1)(b) EUTMR on the part of the relevant public, solely on the basis of the incorrect finding that there was no similarity between the services in Classes 42 and 44 and the goods in Class 35 (para. 67).

T-694/17; SAVORY DELICIOUS ARTISTS & EVENTS; Link Entertainment, S.L.U v EUIPO; Judgment of 11 July 2018; EU:T:2018:432; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The EUTM proprietor was granted registration of the figurative mark below as an EUTM for services in Classes 35 and 41. An application for invalidity was filed pursuant to Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR and Article 8(5) EUTMR and based on the word mark AVORY for services in the same classes. The Cancellation Division (CD) upheld the application for invalidity and the Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that there would be a likelihood of confusion between the marks for the relevant public considering the identity or similarity of services and the visual and phonetic similarities between the signs. The EUTM proprietor appealed to the General Court (GC), relying on a single plea in law:



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infringement of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR.

EUTM	Earlier trade mark

SUBSTANCE: Relevant public. The services in Class 35 are aimed at a professional public, while those in Class 41 are aimed at both a professional public with a high level of attention and the general public, which has a normal level of attention (para. 22). Comparison of services. Neither party has questioned that the services are all either identical or similar (para. 24). Visual comparison of the signs. The word 'savory' is the dominant element of the contested mark that will remain in the consumer's memory because of its size and the fact that it is in bold characters. The other elements are small and occupy a secondary position in the sign. In addition, these secondary word elements describe some of the services covered by the contested mark, namely the event organisation services included in Classes 35 and 41. However, these elements are insignificant in the overall impression produced by the contested mark (para. 33). Given that the earlier mark and the dominant word element of the contested mark are formed by four visually identical letters (V, O, R, Y) appearing in the same order in the middle and at the end of the sign and with one similar letter (A), it can be concluded that the signs are visually similar to an average degree (paras 38-40). Phonetic comparison. For the same reason, the signs are phonetically similar (paras 43, 44). Conceptual comparison. No conceptual comparison can be made by the non-English speaking public, without first examining whether the conceptual comparison is neutral for English speakers, who would attribute a meaning to the term 'savory' (para. 47). Likelihood of confusion. There exists a likelihood of confusion at least as far as the non-



English speaking public is concerned (para. 55).

T-657/17; HPC POLO / POLO; *Gidon Anabi Blanga v EUIPO*; Judgment of 20 June 2018; EU:T:2018:358; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual similarity, Detriment to earlier mark, Distinctive element, Enhanced distinctiveness, Similarity of the signs, Unfair advantage

FACTS: The applicant sought to register the word mark HPC POLO for goods in, inter alia, Classes 18 and 25. An opposition was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR, based on the EU word mark POLO for goods in Classes 18 and 25. The Opposition Division (OD) upheld the opposition for goods in Classes 18 and 25 on the grounds of likelihood of confusion (LOC). The Board of Appeal (BoA) dismissed the applicant's appeal, finding LOC for all the identical or similar goods except whips, harness and saddlery, for which the earlier mark POLO was considered to have weak inherent distinctiveness. The opposition against these goods was, however, upheld on the grounds of Article 8(5) EUTMR. The applicant appealed to the General Court (GC) for the annulment of the decision, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: Admissibility. Although the applicant sought annulment of the contested decision in its entirety, its action is inadmissible insofar as the BoA's application of Article 8(5) EUTMR is concerned, since the applicant did not submit a plea in law in support of that specific head of claim (paras 14-16). Comparison of the signs. The signs HPC POLO and POLO were rightly held to be visually, phonetically and conceptually similar to an average degree as the earlier mark is fully replicated in the mark applied for. The BoA obviously considered the element 'HPC' in the comparison as, otherwise, the result would have been that the signs were identical (para. 29). Inherent distinctive character. Even if the word 'polo' corresponds in some languages of the European Union to a very specific type of clothing, it retains minimum distinctive character for goods in Classes 18 and 25 that are not specifically linked



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to the game of polo. Furthermore, 'polo' corresponds to a sign registered as an EUTM, the validity of which cannot be challenged in opposition proceedings (paras 33 and 34). Enhanced distinctive character. Although the evidence of use submitted included the mark RALPH LAUREN, it also proved intensive use of the earlier mark POLO, which, while being associated with the mark RALPH LAUREN, played an independent role, given that it was positioned above the other mark and was in a larger font (para. 35). Global assessment. As the goods were identical and the level of attention of the public was average, the fact that the similarity of the signs might play a less important role for certain goods was amply offset by the enhanced distinctive character acquired by the earlier mark through the public's familiarity with it (para. 39).

T-797/17; STAR; Star Television Productions Ltd v EUIPO; Judgment of 13 July 2018; EU:T:2018:44169; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Evidence of use, Proof of use

FACTS: The figurative sign below was registered as an EUTM for goods and services in Classes 9, 38 and 42. An application for revocation was filed pursuant to Article 58 EUTMR on the grounds that the mark had not been put to genuine use. The Cancellation Division (CD) upheld the application for revocation. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal as it found, firstly, that the proof of use submitted corresponded to services in Class 41 and not to the goods and services for which the mark was registered and, secondly, the evidence concerning the extent of use of the mark was insufficient. The EUTM proprietor appealed to the General Court (GC), relying on a single plea in law: infringement of Article 58(1)(a) EUTMR.



EUTM



SUBSTANCE: Extent of use. The evidence relating to the production of contents for broadcasting companies does not serve to prove use of the mark for telecommunications services in Class 38; those services fall under Class 41, which is not at issue (paras 49-50). The evidence submitted, which the Board did consider as a whole, does not contain quantified elements enabling the Office to establish the importance or extent of the use made of the mark for the goods and services for which the mark was registered (paras 29-31, 45, 61, 62, 66). Statements in writing. Since the statements in writing were submitted by someone bound by an employment relationship with the EUTM proprietor, namely the Director General, other items of evidence needed to be submitted and examined in order to corroborate the contents of the statements. These subsequent documents were not sufficient to illustrate the use of the mark in question Examination of evidence. The evaluation of whether the use of the mark was duly proven does not need to include an individual examination of each piece of evidence since the assessment takes into consideration all the available evidence as a whole (para. 58).

T-402/17 and T-403/17 (joined cases); VIENNA HOUSE; Vienna International Hotelmanagement AG v EUIPO; Judgment of 3 July 2018; EU:T:2018:401; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, New submission on appeal

FACTS: The applicant sought to register the figurative mark below and



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the word mark VIENNA HOUSE as EUTMs for services in Classes 39, 41 and 43. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR for all services in Class 43 and certain services in Class 39. The Board of Appeal (BoA) dismissed both of the applicant's appeals, since it found that the marks were descriptive and devoid of distinctiveness. The applicant filed two actions before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

EUTM applications

VIENNA HOUSE

VIENNA HOUSE

SUBSTANCE: Relevant public. The relevant public is the English-speaking general end consumer in the EU (para. 13). Meaning of the mark. The average consumer targeted will perceive the word combination VIENNA HOUSE as a grammatically correct combination meaning a Viennese house. Reference can also be made to a typical Viennese style in the hotel and catering industry, embodied, for example, by Viennese coffee houses. It appears unlikely that, when faced with an accommodation establishment designated VIENNA HOUSE, a consumer will assume that the establishment in question has no specific atmosphere whatsoever and/or an ambience completely unrelated to Vienna (paras 29-30). Descriptiveness. The mark VIENNA HOUSE describes the following: (a) a hotel, restaurant or coffee house designed in the typical Viennese style, which may be anywhere in the world but is distinguished by certain objective characteristics that cause consumers to seek it out specifically owing to its specific atmosphere (arranging temporary accommodation or arranging accommodation in hotels, boarding houses and holiday homes; hotels); (b) services organising travel to such a hotel or café or reserving accommodation in such an establishment (travel agency

services, namely arranging and booking of travel; hotel reservations) or providing appropriate information required in preparation for such a trip (providing of travel information); (c) campsites that also have permanent facilities, for example, with attached catering or even in the form of a 'house', with the result that the meaning of the words mentioned above also applies to the services arranging temporary accommodation or arranging accommodation in camping sites (para. 31). Moreover, the graphic elements of the figurative mark are limited to the design of the letters in red standard script in the shape of an arch raised in the middle. These are extremely simple effects, which do not endow the mark with any distinctive character and are not enough to rule out descriptiveness (para. 32). Therefore, the contested marks are descriptive (para. 48). Since the absolute ground of descriptiveness is met, there is no need to assess lack of distinctiveness (para. 52).



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[08/06/2018, R 2661/2017-5, MOTION OF A CHEF ADDING SALT TO A PIECE OF MEAT](#)

EUTM application



OUTCOME: Decision partially annulled.

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

KEYWORDS: Motion mark, Descriptive, Non-distinctive Distinctiveness acquired by use.

SUMMARY: The examiner partially refused the above EUTM applied for under Article 7(1)(b) EUTMR claiming that the motion mark applied for, portraying a chef salting a piece of meat, was distinctive for services except for those related to food.

The Board agrees with the applicant that for some of the services objected, to which relate to the provision of food, the mark is nevertheless distinctive. This is the case for 'services for providing of



drink; rental of food service equipment used in services providing food and drink; reservation of temporary accommodation, rental of banquet and social function facilities for special occasions, namely, wedding receptions, conferences and meetings' (§ 17-22). Services of providing drink are not the same as the provision of food, therefore the Board considers that the mark applied for is distinctive for those services (§ 24).

As regards Article 7(3) EUTMR the Board agrees with the contested decision: the evidence required is either not provided at all or, in the case where it is provided, it is far too scant to establish acquired distinctiveness (§ 45). Consequently the appeal is partially founded and partially dismissed (§ 47).

[10/07/2018, R 240/2018-2, CAFFÈ NERO THE ITALIAN COFFEE COMPANY \(fig.\)](#)

EUTM application



OUTCOME: Decision confirmed.

NORMS: Article 7(1)(g) EUTMR.

KEYWORDS: Figurative trade mark Deceptive element,

SUMMARY: The examiner partially refused the above EUTM applied for, under Article 7(1)(b), (c) and (g), in conjunction with Article 7(2) EUTMR (§ 4).

The Board finds that the trade mark is a descriptive indication for the goods in Class 30 (inter alia, tea, coffee and cocoa) and related services in Class 43 and that a significant part of the relevant public will understand the expression 'CAFFÈ NERO THE ITALIAN COFFEE



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COMPANY' as a reference to the nature of those goods and services (§ 43).

The Board also finds, pursuant Article 7(1)(g) EUTMR, that consumers are likely to believe that the goods at issue are made of or contain black coffee while this would not in fact be the case. Consumers may often buy these goods rather hastily and will not indulge in analysing the wording on the packaging. It is therefore likely that they will choose these goods from the shelf in the erroneous belief that they are, or contain, coffee. Therefore, the Board concurs with the analysis of the contested decision with regard to the refusal under Article 7(1)(g) EUTMR (§ 60).

[16/07/2018, R 2110/2017-1, PIEMONTINO \(fig.\) EUTM application](#)

EUTM application



OUTCOME: Decision confirmed.

NORMS: Article 7(1)(j) EUTMR.

KEYWORDS: Figurative trade mark, Geographical origin, Non-distinctive,.

SUMMARY: The examiner partially rejected the figurative mark above for cheese (Class 29).

'Toma Piemontese' is a protected designation of origin (PDO) for a cheese (§ 13). The Court has held that there could be an evocation of a protected name even in the absence of any risk of confusion between the products in question (see, by analogy, 21/01/2016, C-75/15 Viinverla, EU:C:2016:35, § 33, 35, 45 and the case-law cited) (§ 19). In order for the application of the requested mark to be exercised as referred to in Article 7(1)(j) EUTMR, it is sufficient if the mark requested contains elements referring to the

designation of origin (§ 21). It is unnecessary for there to be a risk of confusion for the consumer if that image is generated, but it is sufficient if there is an association of ideas concerning the origin of the products (R 674/2017-1 Yorkshire Provender, 25/01/2018, § 47) (§ 22). The Board finds that a cheese bearing the 'PIEMONTINO' mark will generate in the minds of European consumers the image of the Piedmont DOP device, so that the requirement of evocation comes into effect (§ 24).

[12/07/2018, R 1929/2017-1, Kordes' Rose Monique](#)

OUTCOME: Decision confirmed.

NORMS: Article 7(1)(m) EUTMR.

KEYWORDS: Dominant element.

SUMMARY: The examiner refused the above EUTM applied for on the basis of Article 7(1)(m) EUTMR after receiving third-party observations.

The trade mark application at issue meets the two fundamental conditions for its refusal under Article 7(1)(m) EUTMR: It contains an earlier registered plant variety denomination, 'Monique', which is protected for a variety of rose, and secondly that it corresponds to the goods requested, 'roses and rose plants, and rose propagating stock' (§ 11). The trade mark applied for is therefore refused under Article 7(1)(m) EUTMR (§ 13).

[12/07/2018, R 155/2018-5, Emdamed / Erdomed et al.](#)

OUTCOME: Decision confirmed.

NORMS: Article 8(1)(b) EUTMR, Article 27(4)(a) EUTMDR, Article 27(4)(b) EUTMDR.

KEYWORDS: Likelihood of confusion, Reasons of equity, Similarity of the signs, Substantiation of earlier right.

SUMMARY: An opposition was filed for part of the goods and services against the registration of the above EUTM applied for. The opposition



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was based, among others, on international registration No 649 438 (hereinafter referred to as the IR).

During the opposition proceedings the opponent failed to submit the renewal certificate as regards the earlier IR. However, taking into account that the Office told the opponent that the opposition had been found admissible, at least insofar as it was based on the earlier IR, the Board therefore considers it likely that the opponent might not have considered it necessary to provide said renewal certificate at a later date (§ 19-20, 24). In this regard, the Board for reasons of equal treatment, in line with Article 27(4) (a) and (b) EUTMDR, finds the earlier IR duly substantiated for the present appeal proceedings (§ 25).

As regards the merits of the case, the Board finds that there is no likelihood of confusion between the marks on the part of a highly attentive public, even in the presence of goods and services that are identical or similar. Therefore the opposition is rejected (§ 60-61).

02/07/2018, R 2174/2017-2, UP UltraProperty (fig.) / UP upmarket properties (fig.)



OUTCOME: Decision annulled.

NORMS: Article 60(1)(a) EUTMR, Article 8(1)(b) EUTMR, Article 95(2) EUTMR.

KEYWORDS: Database printout, New submission on appeal, Substantiation of earlier right.

SUMMARY: A request for a declaration of invalidity was filed against

the above EUTM. The grounds were those laid down in Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The only evidence of the existence, validity and scope of protection regarding the earlier IR, submitted by the cancellation applicant, consisted of an extract from the EUIPO's eSearch plus database.

Later the cancellation applicant submitted an extract from Madrid Monitor, the WIPO portal for following the status of international applications or trade mark registrations, giving detailed information on all the earlier trade marks registered through the Madrid System, therefore it clearly rectified the deficiency in the substantiation of the earlier right (§ 24).

The Board has taken into account the fact that the data extracted from eSearch plus included all the relevant information on the earlier trade mark. Furthermore, the cancellation applicant appears to have been misled by the fact that the Office used to accept data drawn from its own in-house system (namely, CTM-Online) as sufficient for substantiating an international registration with an EU designation. That policy was discontinued in July 2012 (§ 27). The Board emphasizes the fact that the extract is not 'new', but 'supplementary', since the cancellation applicant provided, in due time, all the data to substantiate the earlier mark in documents, the probative value of which the Cancellation Division did not question. Taking into account all the facts surrounding the late submission, the Board considers it equitable to exercise its discretion under Article 95(2) EUTMR to admit the extract from the WIPO database filed on appeal (§ 28).

The appeal is accordingly allowed and the contested decision, rejecting the invalidity request because of the failure to substantiate the earlier mark, is annulled (§ 30).