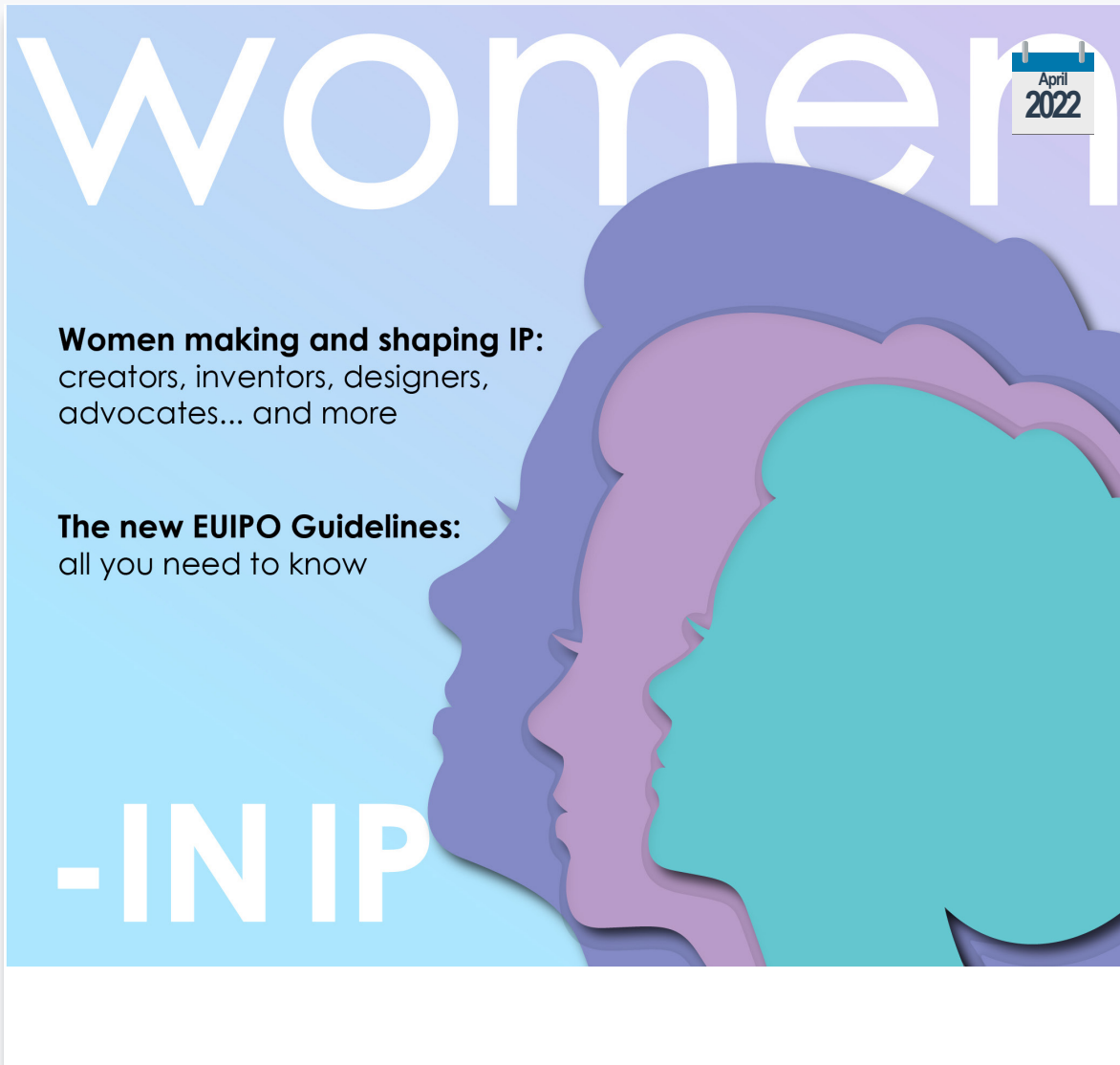


# Alicante News

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### Women making and shaping IP: creators, inventors, designers, advocates... and more

By *Eleonora Rosati*

In her seminal 1929 essay [A Room of One's Own](#), Virginia Woolf submitted that, for women to be able to create, they needed financial independence and a private space.

Despite the hardships and struggles that women have faced throughout history, and which they continue to face today in several societies around the world, their expressions of creativity, inventiveness, and ingenuity have greatly contributed to what the law protects as such, that is: intellectual property (IP).

#### Women as makers of IP

Through the characters that they created, female authors have captured the spirit of their time: from Jane Austen's Elizabeth Bennet to Charlotte Brontë's Jane Eyre, from Louisa May Alcott's Jo March to Astrid Lindgren's Pippi, from Sylvia Plath's Esther Greenwood to Zadie Smith's Irie Jones, generations of readers have been inspired and, with that, also got to know and understand themselves and the world

around them better. Some of them, as the Brontë sisters famously did, wrote their novels under male pseudonyms to cover subjects, ranging from sexual passion to alcoholism and domestic violence, which at the time were regarded as 'unfeminine'.

Female artists have made major contributions to artistic movements and have shed light on the societies they lived in as well as the tensions and changes taking place within them. Instead of traditional religious subjects, Artemisia Gentileschi painted assertive women like Cleopatra and Judith. The works by artists like Frida Kahlo and Cindy Sherman challenge us to reflect on a deeper level on what one's own identity is made of. Illustrators like Tove Jansson have created entire universes, like that of the Moomins, which amuse and entertain generations of young and less young fans.

Women have shaped fields like architecture and design, including fashion, graphic, and industrial design. Rome's MAXXI and Baku's Heydar Aliyev Centre, both designed by Zaha Hadid, are striking examples of 20th century architecture. Female fashion designers have created new visions for and of women: Coco Chanel liberated them from corsets, Mary Quant freed their legs by inventing the mini-skirt, Miuccia Prada made them feel confident through a minimalistic style. Female designers have created some of today's most iconic logos, ranging



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from Carolyn Davidson's Nike 'swoosh' to Paula Scher's Tiffany logotype and packaging. Industrial design creations like the Pipistrello table lamp by Gae Aulenti and the chairs that Ray Eames created together with her husband Charles are iconic (and are well known to IP aficionados too, with the EUIPO also [acknowledging](#) the special value of it and its special place within the history of design).

Women have made seminal contributions to the advancement of science, with discoveries that have subsequently resulted in several inventions and practical applications. Ada Lovelace is regarded as being the first computer programmer, having realised – as early as the 1800s – that a computer could have applications beyond pure calculation. Physicist and chemist Marie Curie conducted pioneering research on radioactivity and was the first person to receive a Nobel prize twice. Despite the lack of proper recognition during her life, Rosalind Franklin made a fundamental contribution to the discovery of the DNA structure.

### Women as shapers of IP law and practice

Women have also played a major role in acknowledging, strengthening, and shaping IP protection. Suffice it to say that it was a female monarch, Queen Anne of Great Britain and Ireland, who passed the first copyright statute of modern history in the early 1700s, the [Statute of Anne](#).

More recently, it was a female US Supreme Court justice, Ruth Bader Ginsburg, who played a pivotal role in shaping US copyright law as we know it today. Advocates General at the Court of Justice of the European Union like Verica Trstenjak, Eleanor Sharpston and Juliane Kokott authored a great number of opinions on seminal EU IP matters.

Women have also made notable contributions as advocates for better protection of those who create and work in IP-related fields. They have used their success and following to bring the condition of creators and performers to the fore, and have also done so at a young age: Taylor Swift has called upon streaming platforms to pay higher royalties to musicians; Emily Ratajkowski has contributed to raising awareness on the condition of models and the ability to control the use of their own image; Jennifer Lawrence is among the actors who have denounced wage disparities between male and female performers in the film industry. Considering that 2022 has been chosen as the [European Year of Youth](#), all this is even more notable.

### Will the future be (more) female?

The examples provided above are just a small glimpse into the foundational role that women have had in the making and shaping of IP throughout history. This said, and while things are improving generally, a lot of the work is yet to be done:

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women should have the security (both personal and financial), time, confidence, and support needed to contribute to the arts and science – whether as makers, shapers, or both. Greater diversity enriches and improves societies, both when it comes to developing solutions and products that [help a wider population](#) and capturing our vision of the world through art and inventiveness. It is high time that, nearly a century after the publication of her book, Woolf's advocated room of one's own finally becomes a reality.

**Eleonora Rosati** is an Italian-qualified lawyer with experience in copyright, trade marks, fashion and internet laws. Dr Eleonora Rosati is a Full Professor of Intellectual Property (IP) Law, Director of the Institute for Intellectual Property and Market Law (IFIM), and Co-Director of the LLM in European IP Law at Stockholm University. She is also Of Counsel at Bird & Bird and is the author of several articles and books on IP issues



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## Alicante News: Your feedback matters!



We have recently launched a short survey to gather your valuable feedback on Alicante News. Alicante News is one of the EUIPO's longest-standing publications and we would like to hear your ideas and suggestions so we can continue to improve its quality and format.

It only takes a few minutes to [complete the survey](#). The feedback received will be used to better understand your interests and preferences while, at the same time, develop a plan to enhance the newsletter.

The closing date for submissions has been extended to **15 April 2022**.

Please note that this survey is anonymous. The record of your survey responses does not contain any identifying information about you.

## About Alicante News

Alicante News is the EUIPO's monthly newsletter containing information on all aspects of trade mark and design law and practice as well as on wider intellectual property issues, case-law summaries and EUIPO-related news. First launched as a printed publication called 'OHIM news' in 1996, the newsletter evolved into an electronic format in 2006 and currently has close to 6 000 subscribers from all over the world.

## Take the survey now

## EUIPO statement on Ukraine



The EU has recently approved measures in response to the unprovoked and unjustified military aggression carried out by the Russian Federation against Ukraine, as well as to the disinformation and information manipulation actions by the Russian Federation and its associated outlets against the EU and its member states. These measures add



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to the restrictive measures that have already been progressively put in place since the illegal annexation of Crimea in 2014.

As the situation in Ukraine continues to unfold, we stand firm on the side of democracy and the rule of law, and with the agreement of the European Commission, the EUIPO has adopted a number of **measures in the field of intellectual property**.

First, we have halted all cooperation actions with Rospatent, the Russian Federal Service for Intellectual Property, and the Eurasian Patent Organisation (EAPO).

Second, we have taken measures to provide our fullest support to our Ukrainian customers and to safeguard their IP rights while this situation prevents normal communication. To this end, we have issued [a one-month extension of time limits](#) from 24.02.2022 for all parties in proceedings before the Office having their residence or registered office in Ukraine, and will review the need for further extensions and additional measures as we move forward.

Thirdly, we are also ensuring that all data regarding parties' addresses in our registries reflect Ukraine's internationally recognised borders, correcting erroneous indications where necessary.



Finally, the EUIPO joins the European Union in condemning, in the strongest possible terms, the Russian Federation's unprovoked and unjustified military aggression against Ukraine, and in demanding that Russia immediately ceases its military actions, unconditionally withdraws all forces and military equipment from the entire territory of Ukraine and fully respects Ukraine's territorial integrity, sovereignty and independence within its internationally recognised borders.

## IP Case Law Conference: Register now!



As previously announced, the EUIPO is organising the fourth edition of the [IP Case Law Conference](#) on **7 and 8 July 2022**. The conference will take place in Alicante, allowing participants to follow the sessions online.

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The Conference marks the 25th anniversary of the Boards of Appeal, and will bring together leading intellectual property experts from multiple jurisdictions, representing a broad range of professional interests.

The [programme](#) focuses on the current global challenges facing the IP community and the latest developments in IP case-law, including areas such as sustainability and the greening of IP; culture, fashion and entertainment; healthcare and wellness; artificial intelligence and blockchain; the automotive and the food and beverages sectors.

Registration is now open. The language of the conference will be English, with simultaneous interpretation in French, German, Spanish and Italian.

[Register now](#)

## IP and the challenges of technology



*Further to the previous articles ranging from the Ancient Age to the 20th century, we continue to delve into the history of IP. This series of articles, each focused on a specific period of time, takes a close look at the lengths taken to protect what we now call Intellectual Property (IP).*

It is probably not an exaggeration to say that intellectual property (IP) is the legal field that has had one of the longest and most interesting relationships with technological advancement. Just think, for example, of how the modern understanding of copyright emerged. It was when it became necessary to regulate the making and selling of copies of books, something that – since the 1400s – had become increasingly easier and cheaper further to... the invention of the printing press! Or, to give another example, think of patent law; this field of IP is specifically concerned with protecting inventions, that is the result of human and technological advancement.

Let's then find out more about the relationship between IP and technology!

### Copyright and technology

Besides the advent of the printing press, throughout history several technological innovations have raised questions under copyright law.

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For example, when photography was invented, it suddenly became easier to portray images of daily life than when paintings and engravings were the main means to capture persons, landscapes, and events. But should photographs be protected at the same conditions as other works? In 1884, the US Supreme Court [answered 'yes'](#) in a famous case relating to a photograph of Oscar Wilde, and ruled that photographs are art that can be protected in the same way as “maps, charts, designs, engravings, etchings, cuts, and other prints”.

Another big moment in copyright history was when, throughout the 20th century, devices facilitating the making of copies – ranging from the photocopying machine to the VHS, from floppy discs to CDs – were introduced. How to regulate their use by consumers? The US Supreme Court answered this question in the famous 1984 [Sony/Betamax case](#), when it ruled that the use of videocassette recorders for the purpose of making copies of complete TV shows to watch them at a later time would not infringe copyright.

## Patents and technology

Patent law has technology in its DNA. But did you know that patents have not always been deemed appropriate to protect technological innovation? Take software as an example.

Among other things, the European Patent Convention provides that “programs for computer”

are not to be considered inventions for the purpose of patent protection. This means that protection is not available under patent law, though a computer program may be protected by copyright.

This said, patents can protect novel and inventive products like physical hardware and they can also protect inventive processes, even if the sequences of steps in these processes are carried out on a computer using software. The latter are known as [computer-implemented inventions \(CIIs\)](#). An example in this sense is the smartphone that you might be using right now to read this article: it is a device that is covered by hundreds of patents relating to the chips, the memory, sensors, receivers, transmitters and batteries inside; it is also covered by patents for the several processes, instructions and operations it carries out, which are all facilitated by software.

## The latest technological advancements

Naturally, the most recent technological innovations have also been raising new issues for IP law and IP professionals alike. While the significance of the internet will be discussed in a separate article, we can have a quick look at Artificial Intelligence (AI), blockchain, and non-fungible tokens (NFTs).

AI has been raising the question of whether, for example, copyright and patent protection is available to AI-generated works and inventions. AI

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has been also prompting a change in how IP work is conducted. In the trade mark and design field, for example, the EUIPO has been using AI to develop its own [image recognition service](#).

Finally, new technologies like blockchain and NFTs have been proving useful to both owners and users of IP to have access to information relating to, for example, the IP status and ownership of an object and, especially when blockchain and NFTs are used in the art world, its authenticity.

### An unavoidable and ever-growing relationship

Since its very inception, IP has been concerned with and affected by technological advancement. Similarly, the way people execute their tasks has constantly changed and mostly improved by the introduction of new technologies. On both fronts, things are not going to change going forward. The task of IP law will be thus that of continuing to react to and regulate the use of such technologies.

### Anti-Scam Network meeting

On 23 March, the EUIPO hosted the 7th Anti-Scam Network meeting, which aimed to highlight the actions being taken to combat the activities of those who send misleading invoices to IP system users, with the intention of defrauding those users.



The focus of the meeting was to assess the current situation in the light of Europol's presentation discussing the recent scam trends and how to address them.

The EUIPO reported on the criminal complaints it has filed against suspected scammers and the notifications of suspected scams it has sent to banks and competent financial supervisory authorities in several jurisdictions. As a result of such notifications, the General Prosecution Service of Georgia has begun criminal proceedings against an individual, and a legal entity, for fraud and the legalisation of an illegal income committed against enterprises operating within the EU. Further details are available in the [press release](#) issued by the General Prosecution Service of Georgia.

The gathering comprised of representatives from national and regional IP offices from the EU, candidate countries and EFTA countries, EPO, WIPO, Europol, Eurojust and various user associations. For the first time, representatives of several national law enforcement agencies with expert knowledge about invoice fraud also attended the meeting. The USPTO also participated as a speaker to share their experience on the fight against scams.

[More information on misleading invoices](#)

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## New African GI registered in the EU



Cameroon's 'Poivre de Penja' has been registered in the EU market as the first geographical indication (GI) from the African Intellectual Property Organization (OAPI) region, and the second from Africa.

The African Intellectual Property Rights and Innovation (AfriPI) Project, in cooperation with OAPI, supported the Poivre de Penja Producers Association to fulfil the conditions required to obtain European recognition.

Poivre de Penja is a tropical peppercorn renowned for its unique seasoning qualities and lingering flavours. Whether green, white, red or black, it is considered one of the best and most highly regarded peppercorns in global cuisine. Poivre de Penja is cultivated on the volcanic slopes of the Mount Kupe, in the Littoral Region of Cameroon, since the 1950s. Its cultivation is a principal activity of local farmers, who apply traditional methods. In 2013, Poivre de



Penja received its first registration by OAPI, making it a pioneer in the OAPI region, which is made of 17 countries.

This is the second African GI to be protected in the EU, after the South African 'Rooibos' tea. The [registration](#) recognises that Poivre de Penja has a specific geographical origin and possesses particular qualities due to this unique origin. It guarantees the protection of the rights of the members of the local farming association to be exclusively entitled to use the name Poivre de Penja, and prevents abuse and unhealthy competition.

The [AfriPI project](#), funded by the European Commission and implemented by EUIPO, is the EU's first intellectual property-related action in Africa.

## New reads from the Observatory

The latest studies from the European Observatory on Infringements of Intellectual Property Rights are available on our [publications section](#). Here are some recent highlights:

- [Dangerous Fakes. Trade in counterfeit goods that pose health, safety and environmental risks](#): This joint OECD-EUIPO report shows that counterfeits not only cause economic damage and job losses, but they also represent a serious threat for consumers.

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## Intellectual Property Crime Threat Assessment:

This joint EUIPO-Europol assessment reveals that the distribution of counterfeit and pirated goods increased during the COVID-19 pandemic.

• [The impact of Artificial Intelligence on the infringement and enforcement of copyright and designs](#): This report analyses the impact of AI technologies on both the infringement and enforcement of copyright and designs.

In other news, the European Anti-Fraud Office (OLAF) and the EUIPO have [agreed new working arrangements](#) aimed at increasing cooperation in the fight against IP crime. The new agreement includes the development of a tool that will make it easier to share and analyse data related to counterfeiting cases at EU level.

## Latest cooperation updates

Stay tuned with the latest news on the EUIPO's European and international cooperation projects:

- The President of the Community Plant Variety Office (CPVO), Francesco Mattina, [visited the EUIPO](#) to discuss ongoing cooperation between both organisations.
- The newly certified 'Authenticity' of Madrid held a [kick-off event](#).
- The EUIPO carried out the [European](#)



## Cooperation Projects Working Groups.

- The Office also held the [Liaison Meetings on Cooperation and on Trade Marks](#).
- Latvia implemented a new [back office admin tool](#) that monitors its services.
- The [Common Tools Integration tool](#) was rolled out in Finland.
- Extension of Common Practices: Montenegro aligned its practice with [CP4](#), and Monaco with [CP9](#).
- The EUIPO also hosted a [Trade Mark Expert meeting](#) with the Japan Patent Office.

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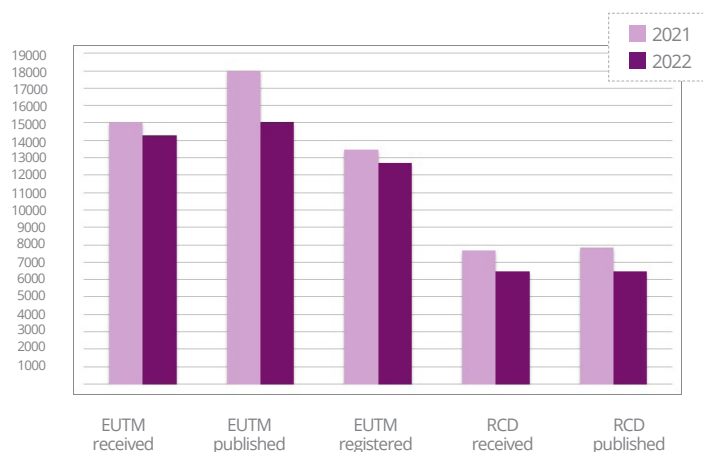
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European Union Trade Mark applications received	15 031	14 315
European Union Trade Mark applications published	17 997	15 047
European Union Trade Marks registered (certificates issued)	13 463	12 724
Registered Community Designs received	7 703	6 489
Registered Community Designs published	7 860	6 477



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## 2.5 million EUTM applications received



On 18 March 2022, the EUIPO received its 2.5 millionth EU trade mark (EUTM) application. This comes shortly after [a record 2021](#), with almost 200 000 EUTM applications received last year.

Back in 2011, the EUIPO received its one millionth trade mark application and since then has seen an increase in demand for EUTMs from nearly every country and region in the world. In particular, in 2020 and 2021, EUTM applications skyrocketed to nearly 177 000 and 198 000 EUTM applications, respectively, which represented a 10 % increase in filings in 2020 and a 12 % in 2021, compared to the previous year.

This record is also closely linked to the remarkable growth of applications from China in the last decade



and, especially, in 2020 and 2021, when **China** became the top filing country at the EUIPO, followed by Germany and the United States. The most recent figures in 2022 show a clear resurgence in EUTMs among EU Member States, with Germany taking the top spot. For more details, check out our [latest statistics](#) on applications and registrations.

### Background

The EUIPO started receiving EU trade mark applications in 1996 and registered Community designs (RCDs) in 2003. Since its foundation, quality has been one of the EUIPO's key priorities. Our customer-centric approach delivers services that place customers, and particularly SMEs, at the heart of the Office's activities. The EUIPO's targets and performance indicators related to the registration of trade marks and designs are continuously measured and are publicly available through the [Service Charter](#).

[More information](#) on how we manage quality.

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These reports are working documents that reflect existing case-law, the results of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report. They should not be considered as having any binding effect, on the Boards of Appeal.



The diagram illustrates the Cyber Security Lifecycle as a continuous loop of five stages, each represented by a numbered horizontal bar and a corresponding set of icons:

- 1. Discover IP:** Includes icons for Digital printers, Mobile Connected devices, Cellular towers, IP Scan, and Pro bots.
- 2. Protect IP:** Includes icons for Physical security, Proxies, Integration with third-party services, and Data stream services.
- 3. Manage IP:** Includes icons for Mobile apps, Device management, and Cloud-based tools.
- 4. Exploit and defend IP:** Includes icons for Malware, Mobile apps, and Mobile device management.
- 5. Recover IP:** Includes icons for Data restoration, Backup, and Disaster recovery.

A central icon labeled **Customer endpoint** is surrounded by these stages, indicating the focus of the lifecycle.

But, how will we deliver on these goals? The use of new technologies will help the EUIPO deliver a higher level of care and attention to customers. By offering multilingual services, everyone can be included without a fear of misunderstanding. And through the strength of our networks, such as the

## ■ Case-law on IPR Infringement and Enforcement



European Union Intellectual Property Network (EUIPN), we will ensure that customers continue to receive the most up to date information.

As such, the Office has created its [Digital Journey Brochure](#), which explains the new services and how they will benefit not only our customers, but the EUIPN and the society at large.

[Download the brochure](#)

## Help SMEs with your IP expertise

In the context of the Ideas Powered for Business initiative, there is the opportunity to support small and medium-sized enterprises (SMEs) during this crisis, significantly contribute to optimising their understanding and use of IP and, at the same time, help to better understand what the needs of SMEs are.

If you are interested in signing up as a pro bono provider or would like to know more, please see the [call for expressions of interest](#) and [how it works](#).

Follow the latest news on our SME-related initiatives on [Twitter](#) and [LinkedIn](#).



## Do you know the Call Back service?



Recently, the EUIPO carried out a survey with customers to evaluate the Call Back service. The Call Back service is offered to all customers who want to speak with an EUIPO examiner. Customers can reach the [information centre](#) from Monday to Friday during business hours (8:30 to 18:30).

### How does it work?

If you need to speak to the EUIPO examiner dealing with your file, you can call the information centre at +34 965 13 9100. In case our First Line staff cannot help you, they will put you through to the examiner. Should the examiner be unavailable at the time you call, your message will be passed on and the examiner will get back to you as soon as possible, normally within 24 hours.

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A total of 177 customers participated in the survey, which was conducted to learn more about our customers perception on the Call Back service and further improve their experience. 94 % of respondents were satisfied with this service. Overall, the survey results were very positive and showed that a vast majority of customers found the service useful.

## Practice tip: Authorisations not always necessary

In general, authorisations do not need to be submitted for changes of representatives in trade marks.

The EUIPO receives a large number of authorisations filed by professional representatives, particularly from user associations.

Many of the authorisations filed are unnecessary since the Office assumes that a representative has been authorised. The unnecessary submission of authorisations can prolong the relevant processes, for example, by stopping the fast-track examination of trade marks. Avoiding unnecessary authorisations offers a range of benefits to users, representatives and the EUIPO, including:

- improving user experience;
- limiting unnecessary delays.



So, when do you need to file an authorisation?

**The EUIPO will contact representatives if authorisation is necessary** and will specify a time limit for filing it. The circumstances in which the EUIPO will invite representatives to file an authorisation can be found in Part A, Section 5 of the [Guidelines](#).

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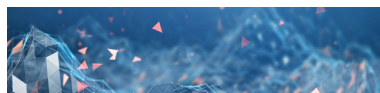
## And the winners are...



On 17 March, the EUIPO held an award ceremony to announce the winning solution of the **Anti-counterfeiting Blockathon Infrastructure Design contest**. The competition, launched in August 2021, aimed to select the best design for a blockchain-based platform that will authenticate products and exchange data between all parties in the supply and logistic chain.

And like any great success, the winning design was down to close cooperation, emerging from a group of talented designers and digital architects. [EY Advisory](#), in consortium with [Eonpass](#) and [Jet Air Service \(JAS\)](#), were announced as winners of the contest during the ceremony held at the EUIPO.

The winners [outlined how their design](#) would boost the fight against counterfeit goods, which pose a considerable risk to consumers and severely



damage the economy and society as a whole. The winning design, which was awarded a prize of EUR 50 000, faced stiff competition from the other companies' proposals. The authentication platform is planned to be finalised by 2024.

[Find out more about the EUIPO's blockchain efforts](#)

## New Chatbot for the Easy Filing form users

In the context of the Strategic Plan 2025, under the Digital evolution programme, the EUIPO has launched its first virtual assistant in the Easy Filing form: the **EUIPO Chatbot**.

The Chatbot was released in December 2021 as a beta version for trade marks. It is available 24/7 on the [Easy Filing](#) form for EU trade marks. It provides general information on basic questions and doubts that users may have when filing online. It can provide faster responses to generic queries than telephone calls and emails. If users are not satisfied with the Chatbot's response, they can choose to chat with a person between 8.30 and 18.30.

The knowledge base of the Chatbot builds on the general [Help and FAQs](#) published on our website and has been enhanced with more content. Responses are based on predefined standard answers and links that are designed to help users find the most

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relevant information according to their needs. The EUIPO is currently monitoring the Chatbot and reviewing questions and answers on a weekly basis, with a view to continuously improve the Chatbot's performance. Additionally, the feedback received from users will facilitate expansion to other e-filing forms in the future.

### Why not try the Chatbot for yourself?

## New AI-based comparison of goods and services

Artificial Intelligence (AI) is set to play a key role on how the EUIPO works. Thanks to the collaborative efforts of the EUIPO's Digital evolution and Effective working tools programmes, the Office has implemented its first **AI-based comparison of Goods & Services (G&S) in the area of Relative Grounds decisions**.

In order to ensure the highest quality of service, our examiners were given the opportunity to test the new tool during several training sessions in January 2022. The feedback received was positive and contributed to further refining the tool.

At its very core, the AI-solution consists of an algorithm, created to assess a given pair of G&S. This, in turn, enables a prediction based on the comparison of historical data, from 420 000 pairs of G&S. In addition, the Similarity Tool is also



searched, allowing the identification of the closest, semantically relevant matches. The search results, which outnumber those of the previous technology, are made available to the decision takers for them to consider when writing a decision. The new system goes even further by providing relevant reasoning from previous decisions, which further helps examiners in drafting decisions. This initiative shows how AI can be used to streamline the EUIPO's work.

## Green is the new Gold!



The EUIPO has won the 2022 edition of the Green World Environment Awards. The Office was listed in the Climate Change category, and was selected as winner due to the achievements in reducing the Office's energy, paper and carbon consumption, which is part of the environmental project – Reduction of the EUIPO's environmental impact.

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Launched in 1994, the awards have become one of the world's most prestigious recognition campaigns for environmental achievements. As a four-time winner of the Green Apple Awards, the EUIPO was nominated for the top prize.

The Green Organisation recognises the EUIPO for offsetting its residual CO2 emissions and becoming a carbon-neutral organisation. Compared with 2015, we reduced our consumption (per on-site worker) of:

- paper by 73 %
- toner by 79 %
- water by 38 %
- electricity by 32 %
- gas by 74 %

Waste generation dropped by 65 % while greenhouse gas emissions were reduced by 33 %. Meanwhile, 30 % of the EUIPO's energy demand is now produced on-site from renewable sources and heating-related fossil fuel consumption was reduced to zero.

More information in the EUIPO's [Environmental Statement](#) and [Carbon Footprint report](#).



## ACADEMY webinars

### Latest webinars

#### Track Case Law: GC/CJEU judgments and EUIPO Boards of Appeal decisions (Q1)

This webinar provides an overview of the most relevant judgments of the General Court (GC) and the Court of Justice of the European Union (CJEU) as well as decisions of the EUIPO's Boards of Appeals during the first quarter of 2022.

The webinar aims to keep you updated on the latest EUTM- and RCD-related case-law developments. It is part of a series that takes place every quarter.

[Watch the webinar](#)

### She (IP) matters!

In honour of International Women's Day, this webinar showcases the stories of a group of inspiring female entrepreneurs.

Our goal with this conversation is to raise awareness of the need for women innovators, and the role of IP protection in closing the gender gap and empowering all types of leaders.

[Watch the webinar](#)

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## Convergence of Trade Mark and Design Practices – Past, Present and Future

This webinar takes a look back at the history of the [convergence of trade mark and design practices in the EU](#) and examines their impact on the IP landscape. It gives you an insight into:

- the background, vision and objectives of the convergence of trade mark and design practices;
- the Common Practices that have been delivered and implemented to date by the EUIPO and the IP offices of the Member States;
- how the Common Practices were developed;
- the new Common Practices currently under development; and
- the benefits of harmonised European guidelines.

[Watch the webinar](#)

## Part I: Overview of the 2022 Edition of the EUIPO Guidelines

In the first part of this webinar, the EUIPO experts provide an overview of the changes implemented in both the EU Trade Mark and Design Guidelines for Examination that entered into force on 31 March 2022.



## Part II: 2022 Edition of the EUIPO Guidelines: focus on register and general rules, absolute and relative grounds

This second part of the webinar focuses on the most important changes in the 2022 edition of the EUIPO Guidelines in the areas of register operations and general rules, absolute and relative grounds.

[Watch the webinars](#)

## The Benefits of Alternative Dispute Resolution Mechanisms – WIPO-EUIPO Webinar

This webinar aims to explain the different Alternative Dispute Resolution (ADR) options and provides some examples on how WIPO and the EUIPO see SMEs taking advantage of ADR procedures.

ADR solutions may go beyond trade mark and design disputes, and beyond the EU Member States, encompassing a more global playing field for companies and users.

[Watch the webinar](#)

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## Upcoming webinars

Webinar: **2022 Edition of the EUIPO Guidelines: Q&A live session**

[Tuesday 12 April](#), 10.00 – 11.00 (CEST)

Webinar: **IP and sustainable economy: the potential of IPRs in driving green fashion. World IP Day – Youth and Sustainability. Webinar in collaboration with EPO**

[Tuesday 26 April](#), 10.00 – 11.30 (CEST)

## On recent case-law

Recently, in T 483/20, the 'moon boots' case, the Court upheld the finding of the Boards of Appeal and described how to ascertain whether a three-dimensional mark departs significantly from the customs or norms of the sector.

If you are interested in how the Court assessed the distinctive character of the three-dimensional mark, do not miss our webinar [Track Case-Law: GC/CJEU judgments and EUIPO Boards of Appeal decisions 2022](#).

Take advantage of the online learning offer in the [EUIPO Academy Learning Portal](#).

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## EUTM & RCD Guidelines

### The 2022 EUIPO Guidelines

As every year, the EUIPO has revised its [Guidelines for examination of EU trade marks \(EUTM\) and registered Community designs \(RCD\)](#), in consultation with stakeholders. The latest edition of the Guidelines entered into force on **31 March 2022**, after approval by the Executive Director of the Office on 22 March 2022 by means of [Decision EX-22-1](#).

As suggested by users, the new edition of the Guidelines has been made more interactive with over 5 000 new hyperlinks to: trade mark regulations, the eSearch Case Law database, learning and other resources. It also incorporates recent case-law from the CJEU as well as changes in practice in a range of areas, including the [public availability of decisions](#) refusing EUTM applications on absolute grounds.

The 'Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal ([CP11](#))' concerning absolute and relative grounds for refusal has been implemented across several chapters.

The new edition also clarifies that the generic use of geographical indications (GIs) in the list of goods and services will be objected to. Furthermore, the EUIPO will apply a more flexible approach to the wording of limitations relating to objections based on GIs.



In the area of registered Community designs, there is further alignment with EUTM practice in invalidity proceedings where the application filing date will no longer be determined by the fee payment date.

The [2022 edition of the Guidelines](#) is available in five languages: English, French, German, Italian and Spanish. The team responsible for the Guidelines has prepared a summary of the main items that have changed.

#### Part A, General rules, Section 1, Means of Communication, time limits

##### 3.1.1 By electronic means (Communications to the Office in writing or by other means)

The amended text includes information on the e-operations available in the User Area, which is aligned with the 'Conditions of Use of the User Area' in Annex I to Decision EX-20-9. The text clarifies that where a party uses an e-operation, this will prevail over any contradictory submissions made later by the party, unless the e-operation is specifically withdrawn on the same day as its submission.

##### 3.1.3 Annexes to communications (Data Carriers)

A new segment clarifies that .EXE (executable files) or encrypted files must not be submitted and will be rejected even if the final executed or unencrypted file is in one of the formats provided for in Decision EX-20-10.

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### 3.1.7 References made to documents or items of evidence in other proceedings

This new paragraph follows the existing text in the opposition proceedings Guidelines and applies it to other areas of proceedings, including absolute grounds examination and RCD invalidity proceedings. The text clarifies, among other issues, that:

- where the original evidence referred to was submitted on a data carrier, the party will be invited to submit a duplicate copy, which must be provided to comply with the new rules on format and file type set out in Decision EX-20-10;
- where the original evidence referred to consists of physical items of evidence for which there is no duplicate on file, the party will be invited to submit a duplicate copy;
- where the original evidence referred to consists of physical items of evidence that were not uploaded into the electronic file, and where the originals have been destroyed (5 years from the termination of the IP right according to Article 115(3) EUTMR), the party will be invited to submit a duplicate copy.

Previously, in those situations, the reference to the earlier evidence would have been rejected without the possibility of remedy. Therefore, the new text introduces a change of practice in these three scenarios.

Part A, General rules, Section 2, General principles to be respected in the proceedings

### 6.3 Public availability of decisions

A new paragraph has been inserted explaining how the Office makes its decisions available pursuant to Article 113(1) EUTMR and Decision EX-21-4. This new paragraph introduces a change of practice, namely, that decisions refusing an EUTM application based on absolute grounds will be made available in the eSearch Case Law database irrespective of whether the decisions become final. Previously, such decisions would not be inserted in the eSearch Case Law database if the EUTM application had been withdrawn before the decision became final.

This will fully align the manner in which the Office's decisions on absolute grounds are made publicly available in its eSearch Case Law database with that of all its other decisions (opposition, cancellation, appeal, etc.). The proposal is intended to comply fully with the EUTMR, specifically with Article 113, which establishes that decisions of the Office must be made available to the general public. It is also made in the interest of greater transparency and predictability for the benefit of all users.

Therefore, this change will alter the consequences of withdrawing an EUTM application during the two-month appeal period following the receipt of a refusal decision, as those decisions will now be publicly available in the eSearch Case Law database.

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Other aspects of the current practice will not be altered by this change. For example, withdrawal of an EUTM application in this period will still be possible (and the EUTM application will appear as 'withdrawn' instead of 'refused' in eSearch Plus database). While the Office will take note of the withdrawal and close the case, the decision itself is not revoked and may still have effects. The practice on conversion remains unaltered.

While the decision itself will be made publicly available in the eSearch Case Law database where the EUTM is totally refused or withdrawn during the appeal period in accordance with Article 113(1) EUTMR, the content of the EUTM file (e.g. observations received, deficiencies issued, etc.) will not be open for public inspection unless consent is granted pursuant to Article 114(1) EUTMR.

**Part A, General rules, Section 3, Payment of fees, costs and charges**

### 2.1.2 Details that must accompany the payment (Bank Transfers)

This section has been completely refreshed and improved. Obsolete examples have been removed and updated, and the text has been improved to clarify that the Payment Transaction Code is the priority for the Office when identifying payments made by bank transfer. Also, two new subsegments have been inserted in this section to explain how the

Office deals with payments received by bank transfer where the information supplied is insufficient for the Office to establish the purpose of the payment or where there is contradictory information in the description field as more than one file or set of proceedings has been identified.

### Part A, General rules, Section 5, Parties to the Proceedings and Professional representation

This section has been renamed 'Section 5, Parties to the Proceedings and Professional Representation'. Moreover, in order to fully harmonise all areas of proceedings, four new paragraphs (2, 3, 10 and 11) that include general information regarding the identification of parties to the proceedings have been inserted in this section.

#### 4.3.4 Exemptions

A clarification under the 'exemption from the EEA nationality requirement' subheader has been inserted. Where a person relies on a qualification obtained in a Member State, the experience shown in support of the exemption request must have been acquired by exercising this national title and not some other qualification.

#### 4.4 Representation by an employee

Non-European Economic Area (EEA) based legal persons that claim and prove a real and effective

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establishment in the EEA can be represented by an employee who is employed at the EEA establishment. Such an establishment is now defined as a branch, agency or any other kind of establishment that is controlled by the non-EEA legal person to such an extent that it can be considered an extension of that non-EEA legal person. This is a change of practice as 'establishment' is now defined broadly, covering subsidiaries and branches, among others.

This paragraph now sets out the different situations in which an employee can represent the applicant. It also identifies the different scenarios that apply depending on whether or not the applicant is from the EEA. The concept of 'indirect employment' sets out the scenario in which a legal person can be represented by an employee even where that employee does not work directly for the legal person.

### Annex 1 & 2

There has been a change in the content of **professional representation for Benelux**; professional qualifications have been added as an exemption to the 5 years' experience rule. The **information about Spain** has been amended to identify the expected future change to national law in the area of legal practitioners. Finally, the United Kingdom has been removed from the list of Member States.

Part A, General rules, Section 6, Revocation of decisions, cancellation of entries in the Register, and corrections of errors

### 2.1 Correction of linguistic errors, errors of transcription and manifest oversights in decisions

Article 102 EUTMR (correction of errors) can apply to the dictum of a decision. This implies a change of practice since, previously, where the dictum contained an error, correction could only take place by revocation of the decision (Article 103 EUTMR).

Further clarification has been inserted on the difference between errors within the meaning of Article 102 EUTMR and errors within the meaning of Article 103 EUTMR.

### Part B, Examination, Section 2, Formalities

This section of the Guidelines has been updated to reflect the 'Common Practice on new types of marks: Examination of Formal Requirements and Grounds for Refusal (CP11)'. Some examples from the common communication are reproduced in the new edition of the Guidelines.

The following paragraphs are affected: Chapter 9, Representation, description and type of mark, paragraph 9.3 Mark type, and Chapter 11, Priority, in particular paragraphs 11.2.2.1 Identity of marks, 11.3.2 Comparison of the marks, and 11.3.5 Claiming priority for marks represented in a different format.

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Chapter 9, Representation, description and type of mark, paragraph 9.2 Description clarifies that the representation of the trade mark always prevails if there is a conflict between the representation and the type and/or description of the trade mark.

Following the clarifications under Part A's general rules regarding owners and representatives that are applicable across all of the Office's procedures, the explanations formerly under this section of the Guidelines have been replaced by cross references to Part A (i.e. Part B, Examination, Section 2, Formalities, Chapter 2, Filing of Applications, paragraph 2.1 Applicants; Chapter 4, Filing Date, paragraph 4.1.3 Applicant; Chapter 7, Owner, Representative and Address for Correspondence, paragraphs 7.1 Applicant, and 7.3 Change of name/address). The same applies to Part B, Section 1, Proceedings, Chapter 5, Amendments to an EUTM application, paragraph 5.3.1 Name and address of applicant or representative.

### Part B, Examination, Section 3, Classification

#### 4.3.6 Geographical indications in lists of goods and services

A new section has been added in the Guidelines to reflect the change of practice that geographical indications cannot be used as generic terms in lists of goods and services.

### 5.2 Objections

A clarification has been added to explain how terms that lack clarity or precision, or those that have been misclassified, can be amended or reclassified.

### Part B, Examination, Section 4, Absolute Grounds for Refusal

This section of the Guidelines has been updated to reflect the 'Common Practice on new types of marks: Examination of Formal Requirements and Grounds for Refusal (CP11)'. It contains guidance on the specificities of examination relating to these marks (including the consumer's perception). Examples from the common communication are reproduced in the relevant chapters of this section of the Guidelines: Chapter 2, EUTM definition (Article 7(1) (a) EUTMR), Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR), Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR), Chapter 6, Shapes or other characteristics Chapter 6, Shapes or Other Characteristics that Result from the Nature of the Goods, are Necessary to Obtain a Technical Result or give Substantial Value to the Goods (Article 7(1) (e) EUTMR).

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Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR)

The practice regarding the examination of sound marks (paragraph 14), is evolving and the Office will no longer apply, by analogy, the practice implemented for shape marks consisting of the goods (i.e. that marks are considered distinctive when they 'depart significantly from the norms or customs of the sector'). A sound will be considered distinctive when it has 'a certain resonance' enabling the target consumer to perceive and consider it as a mark that can indicate origin. Such resonance is lacking where the sound is perceived as a functional element of the goods and services for which protection is sought or as an indicator without any intrinsic characteristic of its own (for example, due to its excessive simplicity or banality).

Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapters 10, 11 and 12, Trade marks in conflict with Geographical indications (Article 7(1)(j) EUTMR), traditional terms for wines (Article 7(1)(k) EUTMR) and traditional specialities guaranteed (Article 7(1)(l) EUTMR)

There has been a simplification of the wording recommended by examiners for limiting the lists of goods and services to overcome deficiencies based on conflicts with geographical indications (GIs) (Chapter 10, paragraph 5.3 Restriction of the list of

goods), traditional terms for wine (TTWs) (Chapter 11, paragraph 5.1 Restrictions of the list of goods) and traditional specialities guaranteed (TSGs) (Chapter 12, paragraph 5.1 Restrictions of the list of goods):

- GIs: '[GI name] (GI) [product covered by the GI]' [e.g. Rioja (GI) wine];
- TTWs: '[traditional term] (TTW) [product]' [e.g. Reserva (TTW) wine];
- TSGs: '[TSG name] (TSG) [product covered by the TSG]' [e.g. Heumilch (TSG) milk].

Additionally, the Guidelines will allow for flexibility in the wording of such limitations. Therefore, different wording will be acceptable as long as the use of (and as) a GI, TTW or TSG is clearly identified by an EUTM applicant within the relevant list of goods and services.

Part C, Opposition, Section 1, Opposition proceedings

### 2.4.1.2 Identification of earlier marks or rights

It has been clarified that an opposition is inadmissible if, during the opposition period, the opponent does not indicate an earlier mark/right protected within the European Union (except for oppositions under Article 8(3) EUTMR).

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### 4.2.4.3 Non-registered trade mark or another sign used in the course of trade

A clearer structure and wording have been introduced to what the opponent must specify and prove. These include, in particular, provisions of the applicable law, official publications of the relevant provisions or jurisprudence, the existence and scope of protection of the earlier right, the right to prohibit the use of a subsequent trade mark, and use in the course of trade of more than mere local significance.

### 4.2.4.4 Geographical indications

Clarifications have been made regarding what the opponent must specify and prove in oppositions under Article 8(6) EUTMR. In particular, the opponent must submit evidence of the existence and scope of protection of the GI invoked proving all the particulars of the GI. The opponent may refer to an online database from the competent authority and also to the Office's Glview portal.

Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 2, Comparison of goods and services

### 3.2.4.3 Types of interrelation between goods/services where complementarity is usually not found

Expansion and clarification of the practice on aesthetic complementarity has been added, along with examples and references to relevant case-law.

## 5 Annex II: Specific Industries

Annex II now contains only the principles that are applied in relation to specific industries. All the specific examples of goods and services comparisons have been removed from Annex II and inserted into the Similarity Tool along with their respective explanations. As the Similarity Tool reflects the Office's practice as regards specific comparisons of pairs, this change is rather of a structural nature.

Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 4, Comparison of Signs

### 3.4 Comparison of signs

The Common Communication on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal on 14 April 2021 (CP11)' (in particular Part C dealing with 'Examination of relative grounds for refusal and/or invalidity') has been implemented. Consequently, motion, multimedia and sound marks have been specifically considered in the sections concerning visual (paragraph 3.4.1.8 for motion marks; paragraph 3.4.1.9 for multimedia marks), phonetic (paragraph

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3.4.2.5 for sound marks; paragraph 3.4.2.6 for motion marks; paragraph 3.4.2.7 for multimedia marks) and conceptual (paragraph 3.4.3.8 for sound and multimedia marks; paragraph 3.4.4.9 for sound marks; paragraph 3.4.4.10 for motion marks; paragraph 3.4.4.11 for multimedia marks) comparison to provide guidance and to highlight their particularities with the support of examples.

### 3.4.3.4 The semantic content of personal names (The semantic content of marks)

This paragraph has been revamped with examples taken from recent case-law. In particular, it highlights that the semantic content of personal names is only relevant for conceptual comparison in situations where both signs share the same first name or surname, or contain mere variants of the same first name or surname. The variants of the same name must be perceived as such by the relevant public.

### 3.4.3.6 The semantic content of numbers and letters (The semantic content of marks)

This paragraph has been revamped with reference to principles established by recent case-law. In particular, it clarifies that, in order to establish a conceptual identity or similarity between signs consisting of single letters, those signs have to be perceived as comprising a single letter (regardless of any possible stylisation). In addition, they have to convey a specific concept other than the generic

concept of the letter in question (bearing in mind that the graphical representation of the single letter may also have an impact on the concept conveyed).

### 3.4.4.8 When the signs share a personal name (Conceptual comparison)

This new paragraph has been introduced to provide guidance on how to compare signs with common elements that are conceptually perceived as personal names. In particular, some of the most common scenarios have been identified and explained in a schematic way with the support of examples.

### 3.4.4.12 Single letters (Conceptual comparison)

This new paragraph has been introduced to provide guidance on how to conceptually compare signs consisting of single letters. In particular, it has been confirmed that, to be relevant for the conceptual comparison, the letter in question must have a meaning in relation to the goods and services at issue or its graphical representation must convey a specific concept.

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Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 7, Global assessment

### 7.2 Names (Specific cases)

This topic has been restructured and analysed in greater detail with specific regard to the comparison between signs made up of personal names (new paragraph 7.2.1, Personal names). In particular, the six scenarios indicated have been more clearly and exhaustively defined. Now each of them corresponds to a specific sub-paragraph, from 7.2.1.1 to 7.2.1.6. The criteria for assessment have been provided for each scenario, with the support of new examples (mostly taken from recent case-law).

Part C, Opposition, Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)

This section has been simplified, and it now takes into account the principles established by the judgment 11/11/2020, C 809/18 P, MINERAL MAGIC, EU:C:2020:902.

### 4.1.3 Territorial scope of the agreement (Agent or representative relationship)

This paragraph reflects that, even if the agreement between the agent and the principal concerns only

a territory outside the European Union, Article 8(3) EUTMR may still apply. This constitutes a change of practice.

### 4.5 Relation between the marks and between the goods and services

This paragraph has been renamed 'Relationship between the marks and between the goods and services'.

It confirms that the scope of application of Article 8(3) EUTMR should not be limited to identical marks but should also extend to similar marks, and that its application should not be precluded just because the goods or services are similar and not identical. The contested mark must be sufficiently close to the earlier mark that, despite any variations, it would still be attributed to the original proprietor. Additionally, the goods and services have to display a close relationship in commercial terms such that the use of the contested mark for those goods or services would pose a serious obstacle for the original proprietor to enter the EU market or continue exploiting its mark on that market.

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Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)

The content of the former version of Section 4, Rights under Article 8(4) and 8(6) EUTMR, has been split into two: the current version of Section 4, Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR), and the newly added Section 6, Geographical indications (Article 8(6) EUTMR). This is a purely structural change to match the current independent position of Article 8(6) EUTMR.

### 4.1 The burden of proof (Proof of the Applicable Law Governing the Sign)

It has been specified that a mere reference to the case-law on which the applicant intends to rely to demonstrate the content of the legislation and the applicable case-law is insufficient. In addition, references to a few recent judgments have been introduced to support certain principles (in particular, the Office's power of verification).

Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR)

### 3.1.4.2 Burden of proof (Proof of reputation)

It is expressly clarified that the burden of proving the reputation claimed in relation to the earlier mark for the goods and services concerned lies exclusively with the opponent, since the reputation of a mark cannot be considered a well-known fact.

### 3.1.4.4 Means of evidence (Proof of reputation)

A specific point on 'evidence of a presence and activity on the Internet' has been introduced.

Part C, Opposition, Section 7, Proof of use

### 6.2 Use of the mark as registered or of a variation thereof

This section illustrates, in a detailed manner and with the support of several examples, the impact of additions and omissions, depending on whether the mark as registered is of an average or low degree of distinctive character. It also highlights the impact of modifications of other characteristics, such as position or proportions.

### 6.3.5 Use of the mark on integral parts, aftersales services and second-hand market of the registered goods (Use in connection with the registered goods and services)

The principle has been introduced that the resale by the proprietor of second-hand goods bearing the trade mark can be taken into account as evidence of use of that mark if the proprietor actually uses that mark in accordance with its essential function, which is to guarantee the identity of origin.

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### Part D, Cancellation, Section 1, Cancellation proceedings

A very small number of changes have been introduced, mostly to mirror changes in opposition proceedings (2.5 Admissibility check - absolute and relative admissibility requirements; 2.5.2.1 Identification of the applicant and/or representative; 3.2 Substantiation with regard to admissibility check of other rights in the course of the proceedings: submission of applicable national law).

### Part E, Register Operations, Section 3, EUTMs and RCDs as objects of property, Chapter 1, Transfer

#### 1.2 Legal effects of a transfer

This paragraph clarifies that where a transfer is based on the implementation of a decision of a national authority, it only becomes relevant before the EUIPO upon its entry into either the EUTM or RCD Register, even if the judgment established proprietorship with previous or ex tunc effect.

#### 4.5 Proof of transfer

This paragraph explains that commercially sensitive data should be removed (blacked out) from the evidence before it is sent to the Office, or full pages could be omitted altogether. Alternatively, the party may invoke confidentiality. For this purpose, a cross reference to the provisions of the Guidelines

explaining the process for invoking confidentiality has been inserted.

### Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property. Chapter 2, Licences, Rights in Rem, Levies of Execution, Insolvency Proceedings, Entitlement Proceedings, or Similar Proceedings

#### New section name

This section of the Guidelines has been renamed to include 'entitlement proceedings'.

#### 8.2 Entitlement Proceedings for RCDs

A new paragraph has been inserted which includes an explanation of RCD entitlement proceedings. Two separate subparagraphs explain the formal requirements for applications and the substance requirements concerning proof in support of the request.

### Part M, International marks

#### 2.1.3 Forms (Examination and forwarding of international applications)

The Guidelines now reflect the obligation to provide e-mail addresses for both the applicant and the representative when filing international applications. Correspondence from the International Bureau is now sent electronically only (i.e. no paper communication).

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### 2.1.3.1 Entitlement to file

An applicant is entitled to file an application with the EUIPO as the office of origin only if it is a national of or has a domicile or a real and effective industrial or commercial establishment in an EU Member State. Therefore, the changes of practice regarding real and effective establishments introduced under Part A, General rules, Section 5, Parties to the Proceedings and Professional Representation, Chapter 4 Representatives: Who May Represent, paragraph 4.4.2, Indirect employment also affect the part of the Guidelines regarding the entitlement to file an international application. Any branch, agency or other kind of commercial establishment (including subsidiaries) in the EU that can be considered an extension of a non-EU legal person is now entitled to file international applications based on an EUTM. Applicants are requested to file evidence to prove the existence and nature of the link between the different entities. Should they not do so, a deficiency will be raised by the Office.

### 4.3.3 (Transformation) Procedure

The Office refuses any EUTM application resulting from an International Registration (IR) transformation filed prematurely, that is to say before the cancellation of the IR is recorded by WIPO.

Examination of applications for registered Community designs

### 11.2.6 Entitlement proceedings

A new paragraph has been created to provide a cross reference to the topic of entitlement proceedings found in Part E, Register Operations, Section 3, EUTMs and RCDs as objects of property, Chapter 2, Licences, rights in rem, levies of execution, insolvency proceedings, entitlement proceedings, or similar proceedings, paragraph 8.2, Entitlement Proceedings for RCDs.

Examination of design invalidity applications

### 3.10.2 Facts, evidence and arguments

This topic has been amended to clarify the facts, evidence and arguments that must be submitted with the application in support of the grounds for it to be deemed admissible. Additional earlier designs or rights or new grounds of invalidity submitted after the filing of the application will be rejected as inadmissible to the extent that they broaden the scope of the original application for a declaration of invalidity.

### 3.13 Payment of fees

A change of practice has been implemented in relation to design invalidity proceedings, aligning with the practice in relation to EUTMs (cancellation

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proceedings). The filing date of the application is no longer determined by the date of payment of the fee.

### 5.8 Conflict with a prior design right

The purpose of Article 25(1)(d) CDR has been clarified and it has been explained that the features of the prior design invoked are to be appreciated within the limits of its scope of protection, as determined by its application or registration, excluding, where applicable, any features that have been disclaimed.

### 7.1 Change of parties (Other procedural issues)

A new topic has been created to address changes of parties during the course of proceedings by way of a cross reference to the opposition proceedings Guidelines.

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### When creative rights do not matter

**Case-law comment by Cinzia Negro, Member of the Second Board of Appeal of the EUIPO**

The Court refuses a sign coined by the applicant to designate a new therapeutic method.

**26/01/2022, T 233/21, Clustermedizin**

On 28 February 2020, Meta Cluster GmbH (the applicant) applied to register the word sign 'Clustermedizin' as an EUTM for medical and health related goods and services in Class 5 and 44 as well as for digital recording media in Class 9. The examiner refused registration of the mark based on Article 7(1)(b)(c) EUTMR. The Board of Appeal (BoA) dismissed the appeal, finding the sign descriptive for the German-speaking public of the EU in respect of all the goods and services at issue and, as a result, devoid of distinctive character. Based on the internet references cited by the examiner, the BoA noted that the term 'clustermedizin' was used to describe a holistic therapeutic method. The applicant's claim of distinctive character acquired through use within the meaning of Article 7(3) EUTMR, filed for the first time on appeal, was rejected as belated.

The applicant appealed the BoA decision before the General Court. The latter dismissed the appeal.



### The judgment

The Court began by confirming the undisputed determination of the relevant public, consisting of both the public at large and a specialised public in the field of medicine and pharmacy. Likewise, as 'medizin' is a German word and the English word 'cluster' has entered everyday use in German, what matters is the perception of the sign by the public in Germany and Austria.

The Court then acknowledged that the term 'clustermedizin' refers to an alternative therapeutic method invented by a person (A) connected to the applicant. However, the Court rejected the applicant's claim that that term is used as a mark in so far as the method is always proposed by doctors and naturopaths with reference to the applicant. As is apparent from the material produced by the applicant itself, as well as from the research carried out in the administrative procedure and communicated to the applicant, 'Clustermedizin' is a particular method of diagnosis and naturopathic therapy and is understood as such. It is not understood as an indication of the commercial origin of the goods and services. Consequently, it has a sufficiently direct and concrete connection with the goods or services to enable the relevant public to perceive them, immediately and without

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further reflection, as an alternative therapeutic method or as relating to that method.

In the Court's view, that assessment cannot be called into question by the fact that, in some of the evidence submitted by the applicant, the mark applied for is accompanied by the symbol ®, indicating that it is a registered mark. This is the case, in particular, because that symbol is not systematically added to all the evidence submitted.

The judgment underlines that the fact that the mark applied for was created by the applicant to designate a particular method cannot mean that the mark should automatically benefit from registration as an EUTM. To qualify for registration, the mark applied for must enable the relevant public to perceive it immediately as an indication of the goods or services offered by the proprietor of that mark and thus to distinguish them from the same goods and services having a different commercial origin. However, this is not the case here.

With regard to the applicant's claims that A is the originator of the 'Clustermedizin' method, that the mark applied for has been registered as a trade mark for 20 years in Germany and that the applicant has a de facto (know-how based) monopoly on that method despite the expiration of the relevant



patent, the Court clarified that those claims can only be relevant to the assessment of distinctive character acquired through use within the meaning of Article 7(3) EUTMR. However, the invocation of that provision was belated and rejected.

The Court concluded that the BoA was right to dismiss the appeal against the examiner's decision refusing registration of the mark based on Article 7(1)(c) EUTMR. It was unnecessary to examine the merits of the second plea, alleging infringement of Article 7(1)(b) EUTMR.

### Practical significance

This judgment confirms the case-law trend of refusing trade marks consisting of the name of new therapeutic methods or health techniques in general, even where those methods or techniques, along with their names, have been created by the applicant itself (see 03/03/2021, T 48/20, Heartfulness (fig.), EU:T:2021:112 and 21/11/2013, T 313/11, Matrix-Energetics, EU:T:2013:603, cited in the judgment itself; but also 07/11/2014, T 567/12, Kaatsu, EU:T:2014:937 and 06/02/2013, T 412/11, Transcendental meditation, EU:T:2013:62).

If the public perceives a sign simply as the (generic) name of a method or technique and not

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as a commercial brand, that sign must be refused registration for any goods and/or services related to that method or technique, irrespective of any 'creative rights' the applicant may invoke. This also applies where the applicant is the only one to use the sign if it uses it in a generic/descriptive manner.

So, how can the applicant avoid this? The only possible way for the creator of an alternative method, technique, discipline, etc., whether in the therapeutic field or in any other sector, to secure trade mark rights, is to use the sign as a trade mark. The more intensive the use the better. The creator must do this not only by always adding the symbol ® to the sign, but by constantly educating the relevant public to perceive the sign as the brand name of the applicant's new method. This includes taking any action necessary to avoid the likely risk that the sign becomes the common name of the new method if it is the only way to refer to the method. Intensive use in that sense prior to the application may, if necessary, entitle the applicant to validly support a subsidiary claim of distinctive character acquired through use of the sign within the meaning of Article 7(3) EUTMR.

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### Luxembourg trade mark and design news

03/03/2021, [C 421/20](#), [Bayrische Motoren Werke](#), [EU:C:2022:152](#)

**Preliminary ruling — Community designs — Article 82(5) CDR — Action brought before the courts of the Member State in which an act of infringement has been committed or threatened — Claims supplementary to the action for infringement — Applicable law — Article 88(2) CDR — Article 89(1)(d) CDR — Article 8(2) Regulation (EC) No 864/2007 on the law applicable to non-contractual obligations (Rome II) — Country in which the intellectual property right was infringed**

Acacia is a company incorporated under Italian law which produces, in Italy, wheel rims for motor vehicles and distributes them in a number of Member States. Taking the view that Acacia's distribution of certain wheel rims in Germany constituted an infringement of its registered Community design, Bayrische Motoren Werke AG brought an action for infringement before a Community design court designated by Germany.

That court held that Acacia had committed the acts of infringement alleged and ordered that the infringement be brought to an end. As regards the 'supplementary' claims seeking damages,

the provision of information, the provision of documents, the surrender of accounts and the handing over of infringing products with a view to their being destroyed, it applied German law and upheld those claims.

On appeal, the Higher Regional Court, Düsseldorf, Germany stated that the jurisdiction of the Community design courts designated by Germany arises, in the present case, from Article 82(5) CDR and that Acacia had committed the acts of infringement alleged. Article 82(5) CDR provides that proceedings in respect of the actions for infringement may be brought in the courts of the Member State in which the act of infringement has been committed or threatened. As regards the supplementary claims, Acacia submitted that the applicable law was Italian law. The Higher Regional Court, Düsseldorf therefore requested an interpretation of EU law from the Court of Justice (CJ), so that it could determine the law applicable to those supplementary claims.

The CJ finds that the court before which an action for infringement of a Community design pursuant to Article 82(5) CDR is brought concerning acts of infringement committed within a single Member State, must examine claims supplementary to that action on the basis of the law of that Member State.

The Community design court before which a case has been brought pursuant to Article 82(5) CDR is to have jurisdiction only in respect of acts of

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infringement committed or threatened within the territory of the Member State in which that court is situated (§ 35-36). Unlike an action for infringement brought pursuant to the other paragraphs of that article, which enables the court before which the case is brought to give a ruling on acts committed within the territory of any Member State. That provision enables the proprietor of a Community design to bring one or more targeted actions, each relating specifically to the acts of infringement committed or threatened within a single Member State (§ 49-50).

The Regulation (EC) No 864/2007 on the law applicable to non-contractual obligations (Rome II) (OJ 2007 L 199, p. 40) [hereinafter: Rome II Regulation] applies, as it is included in the rules of private international law of the Member State concerned (in accordance with Article 88(2) and Article 89(1)(d) CDR). That regulation provides that in the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable is, for any question that is not governed by the relevant Community instrument, to be 'the law of the country in which the act of infringement was committed' (Article 8(2) of the Rome II Regulation) (§ 40-43).

In a situation where the infringement which may be examined is located within a single Member State, the applicable law, according to the Rome II Regulation, is the law which is in force at the place of

such infringement. Accordingly, the applicable law is the same, in the case of an action for infringement brought pursuant to Article 82(5) CDR and which therefore relates to acts of infringement committed within a single Member State, as the law of that Member State (§ 44).

Possible infringements of the Community design in question in other Member States or in third countries are not the subject of the action brought pursuant to Article 82(5) CDR. The words 'country in which the act of infringement [of the Community design relied on] was committed' cannot be interpreted as designating a country in which acts of infringement which are not the subject of action in question took place. Furthermore, interpreting those words as designating the country on whose sole territory the applicant invokes, in support of his action for infringement, the Community design at issue makes it possible to preserve the principle of 'lex loci protectionis', (Law of the country for which protection is claimed) which is particularly important in the area of intellectual property (Recital 26 of the Rome II Regulation) (§ 45-46).

Finally, the holder of the Community design cannot, in relation to the same acts of infringement, bring actions based on Article 82(5) CDR simultaneously with those based on the other paragraphs of that article. There is therefore no risk of a situation occurring in which claims supplementary to an infringement action with the same subject matter would be examined in a number of different proceedings on the basis of different laws (§50).

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23/02/2022, [T-198/21](#), [Code-x / Cody's \(fig.\) et al.](#),  
EU:T:2022:83

### EUTM application

CODE-X

### Earlier trade mark



**No likelihood of confusion — Relevant public — Visual similarity — Phonetic similarity — Conceptual dissimilarity — Action upheld (BoA decision annulled )**

The applicant sought to register the word sign 'CODE X' as a European Union trade mark for goods in Class 32, namely 'Soft drinks; Non-alcoholic beverages, Vitamin fortified non-alcoholic beverages, Essences for making non-alcoholic drinks not in the nature of essential oils, Energy drinks, Energy drinks containing caffeine'. An opposition was filed according to Article 8(1)(b) EUTMR based on the German word mark 'Cody's and the German figurative mark 'Cody's', covering goods in Class 32 corresponding to the following description: 'Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups



and other preparations for making beverages', and an international registration designating the European Union for that figurative mark. The Opposition Division (OD) rejected the opposition.

The Board of Appeal (BoA) upheld the appeal and annulled the OD's decision. It considered, in particular, that importance had to be attached to the degree of phonetical similarity in the global assessment of the likelihood of confusion (LOC), it concluded that there was a LOC between the signs for the relevant public. The General Court (GC) annulled the contested decision.

The GC stated that, in the case of beverages, the phonetic perception of the trade marks is not decisive in all cases.

The opposing signs can be regarded as visually similar to only a low or perhaps average degree (§ 30-37). The signs are phonetically similar to an average degree (§ 41-45). The signs are conceptually different, since they have different specific meanings that are immediately understood by the relevant public (§ 46-47).

As regards the BoA's analysis, according to which particular importance must be given to the degree of phonetic similarity between the signs, first, the GC notes that, in the global assessment of the LOC, the respective weight to be given to the visual, phonetic or conceptual aspects of the signs may

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vary according to the objective circumstances in which the marks may be present on the market. However, in that context, the circumstances in which it is usual to expect the category of goods covered by the marks to be marketed must be taken as a benchmark (§ 57).

Although it is of course not inconceivable that the perception of the phonetic differences between the signs may not be clear in particularly noisy environments, such as in a bar or a nightclub during very busy periods, that cannot be used as the sole basis for assessing whether there is a potential LOC between the signs. An assessment of that kind must be carried out while keeping in mind the perception which the relevant public will have of those signs under normal marketing conditions (§ 58).

It is true that, in certain judgments, the CG attached particular importance to the phonetic similarity of the signs, on account of the fact that the goods in question, belonging to the beverages sector, and more particularly the alcoholic beverages sector, could be ordered orally after their name had been seen on the menu or on the wine list (§ 59). However, it is also clear from the case-law that there is nothing to indicate that, as a general rule, consumers of drinks will buy such goods in the course of a conversation where those goods are being ordered in a busy and noisy bar or restaurant (§ 60).

Even if bars and restaurants are not negligible sales channels for those types of goods, it is common ground that the consumer will be able to perceive the marks visually in those places, inter alia by examining the bottle which will be served to him or her or by other means, such as on a menu or a drinks list, before placing an order orally. Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. Those goods are also sold in supermarkets or other retail outlets where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to that product (§ 61).

Consequently, although preponderant importance has sometimes been accorded to the phonetic perception of marks in relation to beverages, that will not be appropriate in all cases (§ 62).

In the present case, no evidence has been provided to show that the goods are mainly ordered orally. On the contrary, if the relevant public is led to order them orally in bars and restaurants, they will generally do so after seeing their name on a drinks list or a menu, or will be able to examine the product which will be served to them, so that they will be able to visually perceive the mark in order to express what they wish to purchase (§ 63).

The GC therefore finds there to be no LOC, annuls the contested decision and, in exercising its power of alteration rejects the opposition (§ 81).

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8/02/2022, R 1715/2021-5, Antifa

**Non-distinctive – Article 7(1)(b) EUTMR – Well-known facts need no evidence – Decision confirmed – Application rejected**

The applicant sought to register the word mark 'Antifa' as an EUTM for goods and services in Classes 2 (colorants, lacquers), 16 (stationery), 24 (textiles), 25 (headgear and articles of clothing), 35 (advertising and marketing), 41 (publication of material and organisation of events) and 45 (political lobbying, and arbitration services). The examiner refused the application on the basis of Article 7(1)(b) EUTMR (lack of distinctive character) in conjunction with Article 7(2) EUTMR for all the goods and services applied for.

The Board confirms the contested decision. The Board finds that the relevant public is considered to be the German-speaking general public with an average degree of attention regarding the goods in Classes 2, 16, 24 and 25 and the German-speaking general public and German-speaking specialists, both with an increased degree of attention, regarding the services in Classes 35, 41 and 45. The contested decision correctly established that 'Antifa' in German is an abbreviation for antifaschistisch ('anti-fascist' in English). Therefore, the mark as a



whole refers to 'anti-fascism' and multiple attached dictionary definitions show that this meaning existed already at the time of filing the contested EUTM application. Relevant consumers would therefore perceive the sign in a way that all the goods and services applied for relate to the commonly known anti-fascist movement. The examiner furthermore rightly established that there was no distinctive character and that the sign was not capable of distinguishing the goods and services applied for as having a particular commercial origin. The relevant public will perceive the sign as a purely political motto that conveys an ideological message. The anti-fascist movement goes far beyond one specific company or one specific political party, making it impossible for the sign to display any individualising capacity or distinctiveness. Part of the relevant public will furthermore associate 'Antifa' with a left-wing extremist movement.

Moreover, the Board notes that 'Antifa' could also be understood as a message encouraging the relevant public to purchase the goods or services, since the antifascist movement will be perceived to be financially and/or ideologically supported by this purchase. It is furthermore noted that the sign 'Antifa' does not possess any extraordinary, original or striking elements that would require any cognitive process or effort of interpretation. Based on all of the above, the sign 'Antifa' cannot be registered for the goods and services applied for, based on Article 7(1)(b) EUTMR, in connection with Article 7(2) EUTMR.

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14/02/2022, R 1425/2021-5, JUST EGG

### Deceptive element – Article 7(1)(g) EUTMR – Decision confirmed – Application rejected

The applicant sought to register a word mark 'JUST EGG', for goods in Class 29, namely: 'plant-based egg substitute; liquid egg substitute; plant-based processed food'. The examiner refused the application on the grounds of Article 7(1)(g) EUTMR (misleading character), in conjunction with Article 7(2), EUTMR for all the goods, since the relevant English-speaking public would immediately assume that the goods concerned were egg products and not egg-free alternatives.

The Board confirms the contested decision. The Board indicates, first, that an objection according to Article 7(1)(g) EUTMR is generally only to be raised where the mark leads to a clear expectation that is patently contradictory to the nature or quality or geographical origin of the goods so that there is a sufficiently serious risk that the consumer will be deceived. An objection should, therefore, be raised when the list of goods is worded in such a way that a non-deceptive use of the trade mark is not guaranteed and there is a sufficiently serious risk that the consumer will be deceived.

In the present case, the sign applied for will be perceived in the context of the relevant goods at least by a significant part of the English-speaking general

public as meaning 'merely/only egg (of a domestic hen)'. In the context of 'plant-based egg substitute; liquid egg substitute', at least part of the relevant public at large will beyond any doubt understand the contested sign exclusively as referring to eggs (of domestic hens) as an ingredient of the foodstuffs concerned. This finding applies equally in relation to the contested 'plant-based processed food'. It is true that the term 'egg-free' or 'egg-substitute' is not specifically mentioned in the name of this category. However, given the meaning of the contested sign, consumers will erroneously assume that these contested goods are based on eggs (of domestic hens) and, thus, erroneously assume that the goods are not 'plant-based'.

Even if the component 'JUST' were to be perceived by part of the relevant public as 'fair/morally upright/good', as argued by the applicant, – quod non – then the contested sign would be understood as 'fair/morally upright/good egg'. The contested sign would remain deceptive as the consumers would erroneously assume that the contested goods are made of 'fairly produced eggs' or are 'egg-based' using 'fairly produced eggs', which is not the case. Consumers who display at most an average degree of attentiveness in relation to the goods concerned will be deceived. Thus, the Board concludes that the sign applied for falls foul of Article 7(1)(g) EUTMR, in conjunction with Article 7(2), EUTMR for all the goods designated in the application.

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03/03/2022, R 1865/2021-5, Internet of credibility

**Non-distinctive – Article 7(1)(b) EUTMR – Well-known facts need no evidence – Decision confirmed – IR designating EU rejected**

The applicant designated the European Union in its international registration ('IR') for the word mark 'Internet of credibility' in respect of a wide range of services in Classes 38 (telecommunications), 41 (education, providing news in the field of education, publication of electronic journals and blogs) and 42 (computer services, software as a service). The examiner entirely refused protection of the IR on the grounds of Article 7(1)(b) EUTMR (lack of distinctive character), in conjunction with Article 7(2) EUTMR.

The Board confirms the contested decision. As regards the meaning of the sign, the Board endorses the analysis of the contested decision that the expression 'Internet of credibility' is not unusual in light of English syntactic, grammatical or phonetic rules. The sign as a whole has the meaning of 'a global computer network allowing data and other information to be exchanged that offers credibility'. The Board considers it a well-known fact that, for at least a significant part of the relevant English-speaking public, the internet is widely used to disseminate false information. Indeed, there are innumerable attempts to spread so-called fake news and other false and manipulative narratives online that have been brought to the attention

of the relevant public, for instance in relation to the COVID-19 pandemic, the 2016 and 2020 US presidential rounds and the Russia-Ukraine crisis.

The Board considers it equally a well-known fact that, for the relevant public, the largest companies in the field of information technology as well as national and supranational organisations are making continuous efforts – relying on, inter alia, artificial-intelligence driven tools – to combat the spreading of online misinformation and intentional disinformation. Thus, at least a significant part of the relevant public will not need an analytical approach to conclude that the sign in question contains nothing more than a purely promotional message. The Board emphasises that the relevant public does not expect promotional slogans to be precise or to fully describe the characteristics of the services at issue. Rather, it is a common characteristic of promotional slogans to convey only abstract and vague information which allows every consumer to appreciate that his or her individual needs are addressed. Accordingly, case-law has consistently refused the registration of slogans which could appear, a priori, as 'vague and indefinite' when seen in the abstract.

Consequently, being confronted with the sign 'Internet of credibility' in relation to any of the services applied for in Classes 38, 41 and 42, the relevant English-speaking public will immediately, and without further thought required, assume

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that the services are related to online data and information which is credible as opposed to online data and information which cannot be verified and, thus, should not be trusted. The message is purely promotional as it obviously makes the services applied for desirable for the relevant public. The Board, therefore, concludes that the message 'Internet of credibility', taken as a whole, lacks distinctive character vis-à-vis all the services applied for.

10/03/2022, [R 1257/2021-2](#), **Black maiden**

**Invalidity – Article 59(1)(a) EUTMR – Descriptive element – Article 7(1)(c) EUTMR- Distinctive element – Article 7(1)(b) EUTMR – Decision confirmed – Invalidity rejected**

An application for the declaration of invalidity of the EUTM was filed on the grounds of Article 59(1) (a) EUTMR, in conjunction with Article 7(1)(b), (c) and (d), EUTMR in respect of all the goods covered by the registration, namely: 'wine; sparkling wines', in Class 33. It was claimed by the cancellation applicant that in addition to being descriptive and devoid of any distinctive character, the term 'Black Maiden' had become customary in the current language and in the bona fide and established practices of trade regarding wine. The Cancellation Division rejected the request for a declaration of invalidity in its entirety.

The Board confirms the contested decision. It recalls, first, that in invalidity proceedings based on an absolute ground for refusal, the Board of Appeal cannot be required to carry out afresh the examination of the relevant facts which the competent EUIPO bodies conducted, of their own motion, at the time of registration. The Board concurs with the conclusions of the contested decision that the evidence in the form of a few websites which informally and unofficially indicate that 'Black Maiden' is a translation into English of the term Fetească Neagră, a name of a Romanian grape variety, is not enough to prove that the mark 'Black Maiden' is a descriptive term in relation to the contested goods. As correctly found in the contested decision, terms designating grape types are always used in their original form or are referred to by their accepted synonyms. The grape varieties are not translated into the language of the country they are sold in. In this case the grape and wine type would be referred to as Fetească Neagră in the English-speaking Member States, and also in the rest of the Member States, or one of the many official synonyms will be used to refer to this grape variety. The fact that the term may be translated into 'Black Maiden' is immaterial, especially since the English translation has no resemblance at all to the name of the Romanian grape variety Fetească Neagră.

The Board agrees with the contested decision that the cancellation applicant failed to prove that at the

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time of filing the contested mark, it was perceived as describing the goods in question and the additional evidence provided before the Board does not change this. Nor can the mark be regarded as being devoid of distinctive character.

24/02/2022, R 1753/2020-2, AVmall (fig.) / avstore (fig.) et al.

### Earlier trade mark



### Contested sign



**Likelihood of confusion – Article 8(1)(b) EUTMR – Similarity of the signs – Conceptual similarity – Weak trade mark – Restriction of the list of goods and services – Decision annulled – Opposition allowed**

The applicant sought to register the figurative mark, as depicted above, in respect of a wide range of audio and video apparatus, and parts and fittings thereof,



in Class 9. An opposition was filed on the grounds of Article 8(1)(b) EUTMR invoking an earlier Romanian figurative trade mark, as represented above, registered in respect of services in Class 35, inter alia, 'the bringing together for the benefit of others of retail goods (excluding their transport) enabling consumers to conveniently view and purchase them; store chain'. The Opposition Division rejected the opposition in its entirety. It found the contested goods dissimilar to the services of the earlier mark, thus one of the necessary conditions of Article 8(1)(b) EUTMR to apply was not fulfilled.

The Board annuls the contested decision. It finds, first, that the term 'the bringing together for the benefit of others of retail goods (excluding their transport) enabling consumers to conveniently view and purchase them' indicated in the specification of the services of the earlier mark is only acceptable pursuant to the 'Praktiker' judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425) where the types of goods or services to be sold or brought together for the benefit of others are indicated with sufficient clarity and precision. Likewise, following the 'Praktiker' judgment, the term 'store chain' is not acceptable as the goods to be sold are not defined. The earlier mark was registered on 20 January 2009, namely after the 'Praktiker' judgment was issued. Since Romania was already an EU Member State at that time (since 1 January 2007), the list of services in Class 35 of the earlier mark should comply with the 'Praktiker' judgment. Therefore,

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the Opposition Division erred in comparing the contested goods with those services which were not clear and precise. Instead, it should have requested the opponent to specify the type of goods/services to which the terms 'the bringing together for the benefit of others of retail goods (excluding their transport) enabling consumers to conveniently view and purchase them; store chain' applied.

Following the Board's communication, the opponent proceeded with a partial surrender of its mark before the national IP Office. As restricted, the respective services of the earlier mark can be compared with the contested goods. However, the Board notes that the opponent did not specify the term 'store chain'. Therefore, the latter is not sufficiently clear and precise to allow a comparison with the contested goods. Following the amendments of the list of services in Class 35 of the earlier mark, the Board finds that part of the retail services covered by the earlier mark relate to the sale of goods which are identical or highly similar to the goods covered by the contested mark.

As regards the signs at issue, the Board finds that a non-negligible part of the relevant public will understand the meaning of the terms 'store' and 'mall'. Therefore, the signs are conceptually highly similar since they share the concept of a place where people shop and 'audio-visual' if the letters 'AV' are understood as such. The fact that these letters are non-distinctive or weak elements makes

the conceptual similarity less important, however it cannot be neglected. Thus, as the signs are also visually similar to a low degree and aurally similar, and in view of an average degree of similarity between the goods and services concerned, there is a likelihood of confusion.

24/02/2022, [R 524/2021-1](#), Lutamax

### **Revocation – Article 58(1)(a) EUTMR – Proof of use – Nature of use – Decision partially annulled – Cancellation partially rejected**

An application for a declaration of revocation of the EUTM registration was filed on the grounds of non-use pursuant to Article 58(1)(a) EUTMR in respect of all the goods covered by the registration in Classes 5 (medicines for human and animal use, dietetic substances adapted for medical use), 29 and 30 (dietetic foodstuffs and food supplements not adapted for medical use). The Cancellation Division partly rejected the application for revocation maintaining the EUTM registered for the goods 'dietary supplements adapted for medical or dietetic use for the treatment of age-related macular degeneration; eye care preparations (for pharmaceutical purposes) for the treatment of age-related macular degeneration; none of the aforesaid goods for veterinary purposes', in Class 5. Both parties appealed.

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The Board finds that genuine use of the contested mark has only been proven for 'dietary supplements adapted for medical or dietetic use for supporting eye health, none of the aforesaid goods for veterinary purposes'. The Board rejects the cancellation applicant's argument that the goods for which genuine use has been shown at best are 'dietetic food for special medical purposes', which are different from the goods 'dietary supplements for medical use' as registered because they are governed by different EU Directives, namely Directive 1999/21/EC on dietary foods for special medical purposes on the one hand and Directive 2002/46/EC on the approximation of laws of the Member States relating to food supplements on the other. The Board underlines that these Directives bear no relationship with the interpretation of the terms used in the lists of goods and services of trade marks registered under the EUTMR. Such terms have to be interpreted according to their literal meaning as provided under Article 33(5), 1st sentence, EUTMR. Thus, these Directives are not pertinent to the question of whether the EUTM proprietor has proven genuine use of the contested mark for the goods 'dietary supplements adapted for medical or dietetic use' in Class 5 as registered.

However, contrary to the contested decision, the Board finds that genuine use for 'dietary supplements adapted for medical or dietetic use for supporting eye health' in Class 5 cannot suffice to establish that the mark has also been used for the

goods 'eye care preparations (for pharmaceutical purposes), none of the aforesaid goods for veterinary purposes' in the same class. According to their literal meaning, eye care preparations are substances directly applied to the eye in the form of liquids or creams for the purpose of protection and maintenance. The literal meaning therefore does not cover dietary preparations that may indirectly affect the eyes by providing nutrients or vitamins beneficial for their proper functioning. The Board also finds that the principles of partial use necessarily imply that where a mark is used for several broad categories of goods but only genuinely used for a single product with specific properties, this product can only be considered to be encompassed by one of these broad categories (here: 'dietary supplements adapted for medical or dietetic use' with the sub-category 'for eye health') but not by several of these categories at the same time. While it is true that the EUTM proprietor cannot be required to adduce evidence of genuine use for all conceivable variations of goods coming within the homogenous sub-category of 'dietary supplements adapted for medical or dietetic use for eye health', its interest in enjoying protection for broad categories of goods which it may potentially market but has not done so over the relevant period of use cannot prevail over the interests of its competitors. The Board finds that for the same reason, genuine use has not been shown for other goods in Classes 5, 29 and 30.

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24/02/2022, R 904/2021-1, Formula 1 (fig.)

### Contested EUTM



**Revocation – Article 58(1)(a) EUTMR – Proof of use – Legal certainty – Article 63(1)(a) EUTMR – Decision confirmed – Revocation partially rejected**

An application for a declaration of revocation of the EUTM registration was filed on the grounds of non-use pursuant to Article 58(1)(a) EUTMR in respect of part of the goods and services covered by the registration in Classes 14, 16, 25, 28, 30, 41 and 42. The EUTM proprietor argued before the Cancellation Division that the application for revocation was filed in an abuse of law since it was filed as personal revenge and not to safeguard the general interests protected under Article 58 EUTMR. The Cancellation Division partly revoked the EUTM, allowing it to remain on the Register only for 'commemorative coins' in Class 14. The EUTM proprietor appealed.

The Board confirms the contested decision. It indicates that the EUTM proprietor did not bring forward any reasons as to why the assessment of



the evidence concerning proof of genuine use with respect to the goods and services for which the EUTM was revoked and which are the subject of the appeal, was incorrect. As the Board cannot see any reasons either, it confirms the contested decision in this respect by referring to the reasoning therein.

As to the claimed abuse of law on the part of the cancellation applicant when filing the application for revocation, the Board emphasises that filing a high number of applications for revocation against trade marks belonging to the same proprietor does not necessarily lead to an abuse of law. Each case needs to be assessed on its own merits. The facts of the current proceedings do not show that the application for revocation was filed in an abuse of law. Furthermore, the conditions established in the decision of 11 February 2020, R 2445/2017-G, Sandra Pabst, have not been met either. While it is true that the cancellation applicant filed 68 different applications for revocation, and therefore, more than in the 'Sandra Pabst' case, this alone cannot prove an abuse of law.

Contrary to the situation in the latter, all trade marks attacked by the cancellation applicant have common patterns. They either contain or consist of the element 'F1' or 'Formula 1' or the element 'Grand Prix', in English or translated into other languages of the European Union. Furthermore, the EUTM proprietor and its subsidiaries currently hold more than 100 EUTMs; a very large trade mark portfolio

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necessarily runs a higher risk of being faced with revocation requests, in particular when comprising variations of one and the same trade mark. Moreover, applications for revocation were not always filed against all the goods and services for which the EUTMs enjoyed protection but were filed only with respect to specific goods and services; this implies that the cancellation applicant investigated and filed his application only with respect to the goods and services for which he – apparently – could not find any use. It is also the case in the present proceedings. The application for revocation was not filed against all the goods and services, and furthermore, the request was successful with respect to the vast majority of the goods and services attacked.

Having regard to the facts of the case, the Board considers that the current application for revocation, as also the other applications, were not filed as an abuse of law but as a legitimate means of defence and in the public interest, as expressed in recital 24 EUTMR. It is therefore not necessary to address the question of whether the conclusions reached in decision of 11 February 2020, R 2445/2017-G, Sandra Pabst, still apply, namely that the revocation proceedings might have been initiated as an abuse of law, or whether these conclusions were already overruled by the General Court with judgment of 10 June 2020, T 577/19, Leinfelder, EU:T:2020:259, where it held in paragraph 75 that it is ‘irrelevant, when considering the admissibility of an application for revocation [...], whether there has been an abuse of rights’.

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### Cases referred to the Grand Board

16/12/2021, R 0260/2021-G, COVIDIOT (fig.)

#### EUTM application



**Contrary to public policy or principles of morality**  
 – Descriptive – Non-distinctive – Article 7(1)(f)  
 EUTMR – Article 7(1)(c) EUTMR – Article 7(1)(b)  
 EUTMR – No decision on application

On 16 December 2021, the First Board of Appeal decided to refer case R 0260/2021-1, COVIDIOT (fig.) to the Grand Board.

The case concerns the eligibility for registration of a composite mark that may be perceived as conveying a derogatory message in connection with COVID-19 or as trivialising the pandemic. The Grand Board is expected to address the need to balance the application of the absolute ground for refusal based on public policy and the accepted principles of morality (Article 7(1)(f) EUTMR) and the right to freedom of expression under Article 11 of the Charter of Fundamental Rights of the European

Union. It is also expected to assess the capacity of the sign in question to function as an indicator of commercial origin and its potential descriptive character.

In the light of the importance of the legal issues concerned, the case was remitted to the Grand Board which should take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the First Board in the EUIPO OJ on 1 April 2022 (language of the proceedings: German).

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### New cancellation decisions

Each edition of Alicante News includes a new summary in the series of interesting decisions from the EUIPO's cancellation division.

15/03/2022, **C 38 885** (Invalidity), **MS MODE (figurative)/MS (figurative)**

#### Earlier trade marks

MS MODE  


#### Contested EUTM



**Invalidity – Article 60(1)(a) EUTMR – Proof of use – Likelihood of confusion – Reputation – Cancellation upheld and EUTM/IR declared partially invalid**



An application for a declaration of invalidity against the EUTM registration was filed on the grounds of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR and Article 8(5), against all the goods covered by the EUTM in Classes 14, 18 and 25. The request for declaration of invalidity was based on the trade marks 'MS MODE'(word mark) and



(figurative mark), registered in Benelux and as international trade marks designating the EU.

The applicant argued that there was a likelihood of confusion on the part of the public on account of the similarity between the signs and the identity or high similarity between the goods. The applicant further claimed that the earlier marks enjoyed an enhanced level of distinctiveness and reputation amongst the relevant consumers and that use without due cause of the contested EUTM would take unfair advantage of, or be detrimental to, their distinctive character and/or reputation. In response, the EUTM proprietor requested that the applicant provide proof of genuine use of some of the earlier marks.

The Cancellation Division assessed the evidence of use in connection with the earlier international registrations and found that the respective trade marks were genuinely used in connection with some goods.

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The contested goods were found to be partly identical or similar and partly dissimilar to the applicant's goods and to target the public at large. The inherent distinctiveness of the earlier marks was considered normal. The signs at issue were found visually similar to an average degree, aurally highly similar and conceptually dissimilar, although the conceptual difference lay in a non-distinctive element.

Overall, it was considered that the signs' differing elements were insufficient to counteract their visual and aural similarities. Considering all of the above, the Cancellation Division found that there was a likelihood of confusion on the part of the public as regards the earlier Benelux trade mark registration, and on the Dutch- and French-speaking parts of the public in connection with earlier international trade mark registration designating the European Union.

Therefore, the invalidity application was deemed to be partly well-founded on the basis of the word marks 'MS MODE'. Subsequently, the earlier trade marks' reputation was analysed and it was found that the evidence failed to show that the trade marks were known by a significant part of the relevant public.

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### Case-law on IPR Infringement and Enforcement

A new edition of the [Recent European Case-law on the Infringement and Enforcement of Intellectual Property Rights](#) (IPR) is out now.

The new edition reports on the latest significant European decisions related to infringing and enforcing IP rights. The document contains 205 summaries of key judgments from the national courts and preliminary rulings from the Court of Justice of the European Union (CJEU).

The first part features the most recent cases:

- In [Denmark](#), the Court examined whether the use of photos of the little mermaid's statue to illustrate press articles can fall within a **parody exception**.
- In [Sweden](#), in a case concerning a parking apps aggregator, the Swedish Patent and Market Court looked at the scope of the **sui generis database** protection, applying the principles set out by the CJEU in [CV-Online](#).
- In the [Netherlands](#), the Supreme Court assessed who is the **phonogram producer** of a recording, in a dispute between a famous DJ and his record label.
- Still in the [Netherlands](#), the Court of Amsterdam looked at whether the publication of manuscripts of **Anne Frank's diary** in countries where the copyright had expired, using geo-blocking system



to prevent access to the Netherlands (where the work is still protected), amounted to a copyright infringement in this country.

It also includes other national developments, such as:

- a **request for preliminary ruling** from [Poland](#) about the interpretation of Article 8(1) of Directive 2004/48/EC (Enforcement Directive) and the question whether the existence of an IP right (in the case – copyright on graphics) has to be confirmed before a court can order a party to disclose information about an alleged infringement of this IP right;
- a **recent dynamic blocking injunction** order from the [UK High Court](#), involving streaming companies and production studios (Netflix, Disney, Sky, etc.) and UK internet service providers, and providing detailed specifications.

The **second part** covers decisions issued between 2018 and January 2022.

The [document](#) aims to provide practitioners, judges and lawmakers with a meaningful overview of the latest developments and trends in jurisprudence in this field.

[More information about the Observatory initiatives in the area of case-law.](#)

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