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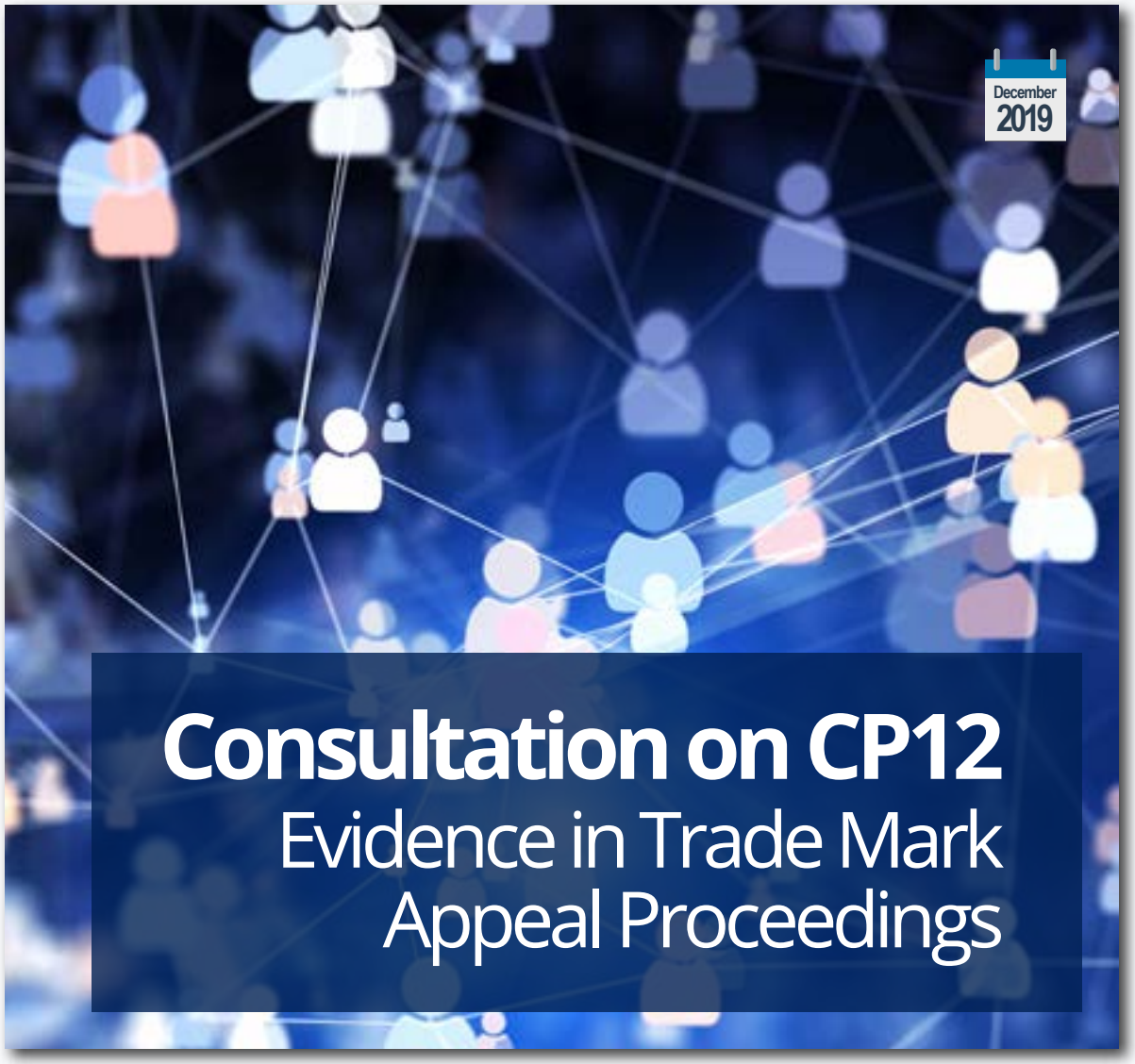
Up to date information on IP and EUIPO-related matters



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Editorial

Consultation on CP12 – Evidence in Trade Mark Appeal Proceedings

The draft Common Practice of the project CP12 'Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence' has been made available in English for comments.

The CP12 Working Group, composed of representatives from five external Appeal Bodies, the Appeal departments of three EU intellectual property offices, three user associations and the EUIPO Boards of Appeal, made significant progress on developing the Common Practice during the course of two Working Group meetings and a workshop in which the representatives shared best practices and expertise to establish the common principles of the CP12 project.

As a result, the draft of the CP12 Common Practice is now available for review by all stakeholders. The Working Group considers this to be a 'living document' and open to discussion, where it would be very appreciated to receive input or feedback.
The scope of the CP12 project covers five main areas:

• General Concepts – definitions and admissibility of evidence

• Means and sources of evidence – documents; online evidence; and genuineness, veracity and reliability of evidence

• Establishing the relevant date of evidence – documentary evidence; online evidence; and the period and timing of a market survey

• Ways to present evidence: structure and presentation – acceptable formats, size and recommended length; structure of the evidence; structure of market surveys; and templates

• Confidentiality of evidence – acceptable ways and point in time to claim confidentiality; the scope of the confidentiality request and criteria for assessing it; and publication of the decision and use of confidential evidence.

The EUIPO welcomes your comments on the draft Common Practice, which should be returned either via email (stating the relevant section or page number) or by completing the Feedback Form and send it to CommonPractices@euipo.europa.eu by Monday, 20 January 2020.

The CP12 project is part of the EUIPO's European Cooperation Projects under the heading 'ECP4 Shared Services and Practices'.

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Third-Party Observations: 2009-2018

Third-party observations (TPOs) enable the general public to intervene in the registration procedure, by informing the European Union Intellectual Property Office (the EUIPO) that a European Union trade mark application (EUTM application) should be refused, in particular, under Article 7 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark (hereinafter EUTMR).

The legal basis for TPOs lies in Article 45 EUTMR and the Communication of the President No 2/09 of 9 November 2009. After receiving TPO, the EUIPO analyses whether the examination of the corresponding EUTM application should be reopened.

The purpose of this news item is to provide an overview of the trends in TPOs filed over the last 10 years (2009-2018).

As a result of the legislative reform of the 1 October 2017, a number of changes were implemented in both examination proceedings and absolute grounds of refusal that affect to some extent the figures on TPOs.

1. TPOs filed

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Chart 1 shows the number of EUTM applications per type filed between 2009 and 2018.

As shown in **Table 1,** during the first few years, there was a dramatic increase in the number of TPOS filed, with the number of TPOs filed in 2009 more than doubling by 2011 when the Office received 249 TPOs, representing the 0.24 % of EUTM applications filed that year. This upward trend suffered a slight decrease in 2012, when a total of 201 TPOs were filed. After some fluctuations, it dropped again to 191 TPOs in 2015, registered a slight up-and-down trajectory during 2016 and 2017, and reached its pick in 2018 when the Office received 297 TPOs.

Against this, it should be understood that the number of EUTM applications filed during the same period nearly doubled, passing from 88 289 in 2009 to 152 495 in 2018. Therefore, the number of TPOs filed, although growing in absolute terms, remained quite stable in relative terms over the years, representing approximately 0.18% of the total EUTM applications filed over the whole period. Furthermore, only once has the number of TPOs filed in a year exceeded 0.20% (2011).

Table 1: Comparison EUTM applications/TPOs filed

	Total EUTMAs	TPOs filed	%
2009	88.289	117	0.13%
2010	98.340	186	0.19%
2011	105.914	249	0.24%
2012	107.962	201	0.19%
2013	114.413	232	0.20%
2014	117.456	230	0.20%
2015	130.407	191	0.15%
2016	135.259	227	0.17%
2017	146.809	216	0.15%
2018	152.496	297	0.19%

Source: EUIPO, TPO database

2. TPOs that reopened examination

Source: EUIPO, TPO database

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Chart 2 shows in absolute numbers and relative terms how many TPOs were filed per year (between 2009 and 2018) and how many of them triggered a reopening of the examination of the EUTM applications.

This shows that the number of EUTM applications reopened for examination has not been constant during the analysed period and it oscillated between 22 % and 31 %, with a peak in 2013 when 83 EUTM applications were reopened for examination (amounting to 36 % of the total TPOs). In total, 2 146 TPOs were received and of these only 601 triggered a reopening of the examination (28 %).

3. Geographical TPOs

Geographical TPOs are TPOs claiming refusal on the basis of Article 7(1)(c) or (j) EUTMR, involving a geographical term, a protected geographical indication or designation of origin. Out of the 2 146 TPOs filed between 2009 and 2018, 43 % involved a geographical term.

The number (and relative part) of TPOs involving a geographic term has increased significantly between 2009 and 2015 (from 34 % to 67 %) (Table 2). Since then it appears to have stabilised at a lower rate (44 % in 2016 and 2017). However, in 2018 it increased in absolute figures but decreased in relative terms (37 %).

Table 2: Geographic and Non-Geographic TPOs 2009-2018

	Total TPOs	Geographic term	Geographic TPOs filed	Non-Geographic TPOs filed
2009	117	40	34%	66%
2010	186	60	32%	68%
2011	249	85	34%	66%
2012	201	100	50%	50%
2013	232	102	44%	56%
2014	230	95	41%	59%
2015	191	128	67%	33%
2016	227	99	44%	56%
2017	216	95	44%	56%
2018	297	111	37%	63%
		Average	43%	

Source: EUIPO, TPO database

4. TPOs filed per absolute ground

Table 3 shows the number of TPOs that the EUIPO received between 2009 and 2018 per absolute ground, also in the light of the reformed Article 7(1) EUTMR.

In 2016, the legislative reform introduced some changes in Article 7(1) EUTMR, that have affected the figures as explained below:

– the previous paragraphs (j) [wines and spirit] and (k) [agricultural GI] were merged into the new paragraph (j);

– new grounds have been added: Article 7(1)(k) EUTMR regarding trade marks in conflict with traditional terms for wines (TTW), Article 7(1)(l) EUTMR regarding trademarks in conflict with

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traditional specialities guaranteed (TSG) and Article 7(1)(m) EUTMR regarding trademarks in conflict with plant variety denominations (PVD).

This shows that there was an irregular number of TPOs filed on the basis of the different articles.

The new grounds for refusal were introduced by the amendment of the EUTMR that entered into force on 23 March 2016. As shown in Table 3, 45 TPOs have been filed based on Article 7(1)(k) EUTMR, TTW, and only one TPO based on Article 7(1)(m) EUTMR, PVD.

No TPOs have been filed on the ground of the new Article 7(1)(l) EUTMR, TSG.

In 2018, the number of TPOs filed on the basis of Article 7(1)(j) EUTMR shows a notable increase, reaching the highest recorded number of TPOs for this ground ever (81). However, the significance of this figure has to be looked at in conjunction with the new wording of Article 7(1)(j) EUTMR which encompasses the grounds that existed previously under Article 7(1)(j) and (k) EUTMR. Therefore, the combination of TPOs filed under both grounds in the years prior to the amendment shows little variation in 2016 and 2017 and only a slight increase in 2018.

Table 3. TPOs filed by absolute ground

	2009	2010	2011	2012	2013	2014	2015	2016	2017	2018	Total
7(1)(a)	1	5	4	3	3	2	1	2	5	7	33
7(1)(b)	41	66	94	79	91	103	86	111	77	115	863
7(1)(c)	78	108	133	97	101	103	97	118	78	106	1019
7(1)(d)	15	26	26	18	14	9	8	43	9	13	181
7(1)(e)	1	1	1	1	1	1	2	1	2	4	15
7(1)(f)	20	27	36	6	14	17	5	5	20	26	176
7(1)(g)	46	70	111	112	122	124	67	99	103	137	991
7(1)(h)	9	11	11	5	3	8	7	1	10	22	87
7(1)(i)	1	8	9	6	4	3	4	1	2	4	42
7(1)(j)	15	17	34	30	43	27	28	36	35	81	346
7(1)(k)	18	29	44	33	34	33	33	22	26	N/A	272
new 7(1)(k)	N/A	N/A	N/A	N/A	N/A	N/A	N/A	2	3	14	19
7(1)(l)	N/A	N/A	N/A	N/A	N/A	N/A	N/A	0	0	0	0
7(1)(m)	N/A	N/A	N/A	N/A	N/A	N/A	N/A	0	0	1	1

Source: EUIPO, TPO database

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Overall, Article 7(1)(c) EUTMR was the most frequently invoked ground between 2009 and 2018, followed by Article 7(1)(g) and Article 7(1)(b) EUTMR.

At the other end of the scale, Article 7(1)(a), (e) and (i) EUTMR were the absolute grounds for refusal that had the lowest number of TPOs filed during the same period (not taking into account the new grounds introduced by the legislative reform).

Overall, the number of TPOs received by the Office between 2009 and 2018 remains relatively small compared to the number of EUTM applications filed over the same period. In addition, out of the TPOs filed, less than one in three (1/3) led to reopening the examination of the EUTM application.

As regards TPOs involving a geographic term, they represent almost half of the TPOs filed during the given period. However, the overall number of cases that were reopened because of these TPOs is below the average of reopened cases (about one in four).

Finally, the new wording of the Article 7(1) EUTMR has not affected to a large extent the TPOs received by the Office. However, it does explain in part the increased number of TPOs received under Article (7)(1)(j) and (k) EUTMR. It should be remembered that these changes entered into force only as from 23 March 2016, which could explain their limited impact so far in the overall results.

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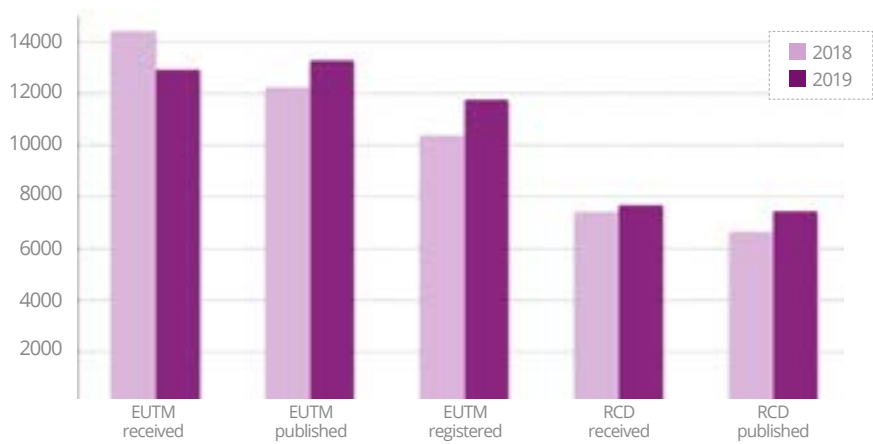
Monthly statistical highlights November*	2018	2019
European Union Trade Mark applications received	14414	12931
European Union Trade Mark applications published	12243	13287
European Union Trade Marks registered (certificates issued)	10377	11769
Registered Community Designs received	7417	7700
Registered Community Designs published	6645	7436

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



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EUIPN Updates

Cuba joins TMview and DesignView

The Cuban Office of Industrial Property (OCPI) made its trade mark and design data available to the TMview and DesignView search tools on 9 December 2019.

TMview now contains data from 72 participating offices, and DesignView contains data from 71 participating offices.

With the addition of more than 50,000 trade marks from OCPI, TMview provides information and access to more than 55.7 million trade marks in total. DesignView contains more than 14.8 million designs, including almost 1,400 designs from OCPI. Since the introduction of TMview on 13 April 2010, the tool has served more than 64.1 million searches from 169 different countries, with Spain, China and Germany among the most frequent users. As to DesignView, it went live on 19 November 2012, and has since then served more than 5.1 million searches from 163 different countries, with users from the UK, Germany and China among the most frequent users.

The integrations of OCPI in TMview and Designview are concrete results of the IP Key Latin America programme, directed by the European Commission and executed by the EUIPO.

You can find out more at www.euipn.org and www.ipkey.eu

European Cooperation: new online services in Austria

The Austrian Patent Office (APO), with the support of the EUIPO's European Cooperation Projects, has improved the service provided to their users through the launch of a set of modern online services for trade mark and design applications.
The new digital services platform became available on 9 December 2019.

This has been the third successful launch at APO of front office tools developed and offered by the EUIPO to the European Union national and regional intellectual property offices, following the introduction earlier this year of online forms to receive digital requests for registration of trade marks and designs.

The new platform includes 44 new online services for trade marks and designs that will help modernise operations in the Austrian IP office, benefitting users across the EU.

The release comes as a result of the work carried out by the EUIPO and its partners under the European Cooperation projects.

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These projects support intellectual property offices in developing more efficient, reliable and user-friendly tools and services for trade marks and designs within the European Union Intellectual Property Network (EUIPN).

EUIPO workshop on tools and practices in EAPO

A Technical Workshop on Tools and Practices took place at the headquarters of the Eurasian Patent Organization (EAPO) in Moscow, Russia from 11-12 December 2019, with the participation of the Industrial Property Offices of Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, the Republic of Belarus, Russia and Tajikistan.

The workshop enabled the exchange of information and experiences and reinforces the cooperation between EAPO and the EUIPO. The agenda included a consultation process to identify specific actions in assisting EAPO in the implementation of their recently acquired competence on industrial designs.

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New EUIPO report shows the value of licensing EUTMs for SMEs

7.5% of SMEs that own EU trade marks (EUTMs) licensed them to others between 2013-2017, according to a new EUIPO report.

The average annual revenue from licensing EUTMs during the same period is estimated at nearly EUR 65 000 per firm – equivalent to 5.7% of the average turnover of EU SMEs. The estimated annual revenue from licensing out EUTMs by all SMEs in the EU is EUR 1.9 billion.

The report also estimates the overall value of the intangible assets represented by EUTMs licensed by SMEs to be EUR 38 billion, equivalent to EUR 1.3 million per licensing firm, based on an average twenty-year lifespan per EUTM.

The report is the first such estimate carried out by the EUIPO into the value of licensing EUTMs. It is based on the findings of an EU-wide survey of SMEs, weighted per SME intensity at Member State level, matched the EUIPO's own databases and the ORBIS database.

User Satisfaction Survey launches on 13 January

Every year the Office carries out a satisfaction survey to identify goals and priorities for improvement, as well as to assess how satisfied users are with the services we provide.

On 13 January, users of our services will receive an email with a personalised link to access a secure web-based questionnaire. The email will be sent from the specialised survey company Berent, which has been contracted by the EUIPO for the purposes of this exercise.

For the first time, the user satisfaction survey can be completed in 23 EU languages. **The deadline for completing the survey is 31 January 2020**.

User feedback will inform future actions carried out by EUIPO and is essential when creating new products and services.

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The 2020 Guidelines

As every year, the Office has revised its Guidelines. The new edition will formally be published in January 2020 and will enter into force on the 1st of February. The Knowledge Circles have prepared a summary of the main items under revision:

Part A, General Rules, Section 5: Professional Representation

[3.4.3 Associations of representatives]

In order for the Office to assign an identification number (ID) to an association of representatives, there must be at least two legal practitioners or professional representatives practicing in the association or partnership that comply with the requirements of Article 120(1) EUTMR or Article 78(1) CDR. Following the entry into force of the new guidelines, each association member must first obtain a valid individual ID number, and only once there are two representatives registered at the same address with valid individual IDs, will the Office grant an ID to the association. This is a change of practice, as previously the Office checked the presence of the representatives at the address, but did not require them to obtain a valid individual (personal) ID prior to granting the ID to the association.

Part B, Examination, Section 2: Formalities

[9.1 Representation of the sign]

Users who want to apply for an EUTM in white against a background or include element(s) of transparency in their sign should choose as a type of mark the option "other" and use the description field to explain this feature.

[11.2.2.1 Identity of the marks] and priorities in relation with the different kinds of marks

A new paragraph highlights the impact of the kind of mark (namely individual, collective or certification) on priority claims. The Office will disregard a priority claim where there is an incompatibility between the kinds of mark, as follows: compatibility may exist between collective and certification marks, however it is excluded between individual marks and collective or certification marks.

Part B, Examination, Section 3: Classification

[5.3 Amendment and restriction of a specification]

The practice on restrictions before registration has been brought into line with that on partial surrenders: if a restriction is only acceptable in part, it will be objected to in its entirety. The Office will inform the applicant and set a time limit to remedy the deficiencies. If these deficiencies are not remedied within the time limit, the restriction

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request will be refused in its entirety, and the proceedings will then continue on the basis of the original list of goods and services.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 4: Descriptive trade marks (Article 7(1)(c) EUTMR)

[2.7 Terms describing subject matter in goods or services]

The assessment of marks consisting of 'Book titles' has been moved from the Chapter 3 (on non-distinctive trade marks) to this part of the guidelines. After a general introduction, it lists some non-exhaustive considerations that can be taken into account to decide if an objection should be raised on the ground that the sign will be perceived as the subject matter of the goods and services applied for (adaptations, cultural heritage and time). It gives some examples of accepted and refused marks that consist of book titles.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 7: Trade marks contrary to public policy and acceptable principles of morality (Article 7(1)(f) EUTMR)

[3. Accepted principles of morality]

The Office has introduced specific guidance (and additional examples) regarding the assessment of signs that contain a reference to drugs. It will refuse any mark consisting of signs that can be perceived as promoting the use of illegal drugs for recreational purposes. An objection will not be raised for signs containing the name of drugs that are intended for medical use.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 10: Trade marks in conflict with designations of origin and geographical indications

[4. Situations covered by the EU regulations and absolute grounds examination] and [5. Relevant goods under EU regulations]

The whole Chapter 10 has been updated with the reference to the new Geographical Indication (GI) Regulation (Spirit Regulation) as well as the new case law. This means that necessary changes were introduced with respect to 'situations covered by the EU Regulations' following the interpretation provided by the European Court of Justice. 'Additional considerations' as well as 'Limits to the scope of protection' have been further elaborated and expanded with inclusion of new examples throughout. Finally, the issue of goods and services and possible limitations have been revisited.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 13: Trade marks in conflict with earlier plant variety denominations

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[4. Situations covered by Article 7(1)(m) EUTMR]

The whole Chapter 13 has been updated as there was a need to clarify different issues with respect to plant variety denominations, e.g. expiry, surrender, termination. In addition the new steps on assessment of the 'essential element' have been introduced to ease the examination on absolute grounds following the recent case law.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 14: Acquired distinctiveness through use (Article 7(3) EUTMR)

[6.3 Extrapolation] Acquired distinctiveness throughout the EU

Following the Kit-Kat judgment (25/07/2018, C 84/17P, C 85/17P & C 95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596), a new scenario has been identified regarding the possibility for the applicant to prove acquired distinctiveness by use in the whole EU or in different Member States. Next to the "traditional" model of extrapolation, the applicant can show that the markets are merged into transnational regions. The EU market can be divided into regional segments in two different cases:

• the economic operators have grouped several Member States together in the same distribution network;

• due to the geographical, cultural or linguistic proximity between Member States.

In both scenarios (regionalization and extrapolation), it is for the EUTM applicant to convincingly explain the relevance of the evidence in the whole relevant territory.

Part C, Opposition, Section 1: Procedural matters

[2.4.2.2 Representation of earlier marks] and [4.2.3.6 Verification of the evidence]

A black and white copy of the official trade mark database extract is not an acceptable evidence of proof for a mark in colour, even if it contains verbal indications of the colours claimed. The only exception is where the official online evidence itself shows the mark in black and white and it is accompanied by a colour claim (translated into the language of proceedings). Regardless that marks were not yet published in colour at a given time, an unofficial colour representation must still be submitted in the notice of opposition for a mark claiming protection in colour.

[5.1.2.2 and 5.1.2.5 Calculation of grace period for non-use (national marks)]

The 'date of completion of the registration proceedings', for the purposes of calculating the 5-year grace period for non-use, must always be determined by reference to national law. It

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cannot be presumed to coincide with the 'date of registration' appearing on the official extract.

[7.2.1.2 Extension of time limits]

A subsequent request for extension, even if consented to by the other party, is also subject to the Office's discretion (no automatic granting).

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

The degree of similarity between the retail of specific goods and the same specific goods has been increased from low to average. And the outcome of comparison between the retail of specific goods and similar specific goods will now depend on whether the goods involved are commonly offered in the same specialised shops, belong to the same market sector, and are of interest to the same consumer. If this is the case, such goods and services may be lowly **similar** and if it is not the case, they are considered dissimilar.

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

[2.3. Identity of signs], [3.4.1.1., 3.4.1.2. Visual comparison of word and figurative marks], [3.4.3.2. The semantic content of parts of words] and [3.4.5.1. Identifiable common element for the purposes of comparing signs]

A combination of upper- and lower-case letters that departs from the usual way of writing words ('irregular capitalisation') may result in word marks not to be considered identical. The irregular capitalisation of a word mark must be taken into account in the comparison of the signs; it may justify breaking down a word visually and conceptually into components.

Part C, Opposition, Section 4: Other earlier rights, Chapter 2: Geographical indications (rights under Article 8(6) EUTMR)

[1.2 Types of GIs falling under Article 8(6) EUTMR] and [1.3. Scope of protection of GIs]

The whole Chapter has been updated. The substantiation of these earlier rights has been clarified. The reputation of GIs has been revisited and distinguished from the reputation of trade marks: the reputation of GIs depends on their image in the minds of consumers, and that image, in turn, depends essentially on particular characteristics and more generally on the quality of the product. It is on the quality of the product that its reputation is based. Therefore, contrary to situation with trade marks, where reputation is quantitatively assessed, the reputation of a GI is linked only to the quality of the product that it designates. Consequently,

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opponents do not have to submit evidence of the reputation of the GI. Nevertheless, opponents must submit convincing arguments and/or evidence regarding the exploitation of the reputation of the GI.

Part D, Cancellation, Section 2: Substantive provisions

[3.2 Defence against a claim of lack of distinctiveness]

It has clarified that in invalidity proceedings the EUTM proprietors can invoke the defence of acquired distinctiveness by use on a subsidiary basis and expressly request the Cancellation Division to decide first on the invoked ground of invalidity.

[4.5.3 Acquiescence]

When relying on the defence of acquiescence, the EUTM proprietor must prove that the invalidity applicant was actually aware of the use of the contested mark for at least 5 years; it is no longer sufficient to prove that the invalidity applicant ought to have been aware.

Part E, Register Operations, Section 3: EUTMs and RCDs as objects of property, Chapter 2: Licences, rights in rem, levy of execution, insolvency and similar proceedings

[2.4.1 Parties to the proceedings (Applicants)]

An application for the registration of a right in rem or of a levy of execution must be accompanied by a formal request. Following the entry into force of the amended guidelines, in the event third parties or administrations (such as national registers, national courts or authorities) send the Office documents that concern any of the above, the Office will incorporate the document into the file, and will forward it as information to the proprietor and the potential beneficiary or pledgee if their contact details are provided, indicating that such a right could be entered in the EUTM or RCD Register upon formal request and the payment of the relevant fees. The Office will not make any entries into the Register unless the documents contain a formal request for an application for the registration of a right in rem or of a levy of execution.

Part M: International marks

[5. Division]

This new point reflects the possibility that exists since 01/02/2019 to request the division of an international registration. It gives information about this novelty in the European system, introduces the procedure to apply (and in particular the need to have an additional page annexed to the MM22 form with the list of goods and services that remain in the original registration) and the fees to be paid (only to WIPO, CHF 177).

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

C 528/18 P**; OUTSOURCE 2 INDIA; Repower v EUIPO; Judgment of 13 November 2019; EU:C:2019:961;**

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Bad faith

FACTS: The proprietor was granted registration of the EUTM for services in Classes 35, 36 and 42.

An invalidity application was filed pursuant to Article 52(1)(b) CTMR. The Cancellation Division (CD) upheld the invalidity application, considering that the proprietor had intentionally sought to appropriate the element 'outsource2india' already used by the invalidity applicant and thus acted in bad faith when filing for registration.

The proprietor appealed before the Board of Appeal (BoA). The BoA upheld the appeal, considering that the proprietor had not acted in bad faith when it registered the contested mark. The proprietor had envisaged establishing a commercial relationship with the invalidity applicant by helping undertakings established in Germany or elsewhere in the EU to outsource their services to India. It was not apparent from the case file that the proprietor intended to appropriate the element 'outsource2india'. Since this term is descriptive and may therefore be used freely by all traders in the sector for outsourcing services to India, the intention of using it cannot be regarded as dishonest intent. It had not been established that the proprietor wanted to undermine the invalidity applicant's interests.

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 52(1)(b) CTMR. The GC dismissed the action (31/05/2018, T 340/16, Outsource 2 India, EU:T:2018:314).

The GC stated that, by filing, shortly after the termination of the pre-contractual relationship, an application for registration as an EU trade mark of a sign similar to that used by the invalidity applicant, the proprietor intended to exploit the economic potential of the element 'outsource2india', which, in view of the correspondence exchanged between the parties and developments in their exchanges, demonstrated that the proprietor had acted in bad faith. The GC stated moreover that this assessment was '[independent] of the question whether the wording 'outsource2india' is descriptive'.

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EUTM	Earlier rights (logo and domain name, respectively)
Outsource 2 India	Outsource India www.outsource2india.com

SUBSTANCE: The CJ confirms the GC's finding that inclusion of a descriptive term in the EUTM does not exclude existence of bad faith on the part of the proprietor.

The CJ reveals **numerous flaws in the GC's judgment**: some of the facts were distorted by the GC (paras 51-56); the GC did not justify its finding that the contested mark is similar to the sign used by the invalidity applicant and that it could be confused with it (para. 59); the GC was wrong to find that the proprietor intended to exploit the economic potential that could be mined from the name of the invalidity applicant's sign, because it is based on an unsubstantiated assertion that the signs in question are similar (para. 66).

However, **despite those flaws**, the CJ upholds the GC's judgment, holding that the GC had highlighted certain objective circumstances and, solely on the basis of these circumstances, **it was entitled to find that the proprietor had acted in bad faith**. These circumstances are: the proprietor's attempt to establish commercial collaboration with the invalidity applicant in Germany, from November 2006; the proprietor's establishment, for that purpose and without prior consent of the invalidity applicant, of a German company named 'Outsource2India', which includes the element 'outsource2india' used by the invalidity applicant; the proprietor's use of that element in the name of its website; the reluctance and subsequent objections expressed between February and May 2007 by the invalidity applicant regarding this situation, which it did not intend to continue unless a collaboration agreement was reached (paras 67-68).

The proprietor acted in **bad faith** when, shortly after the invalidity applicant refused cooperation, it requested registration of the EUTM specifically containing the element 'outsource2india', used by the invalidity applicant in its commercial activities (para. 70). The **potentially descriptive character** of 'outsource2india' **does not prevent the conclusion that there was bad faith** on the part of the proprietor (para. 69).

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

Case T-380/18; INTAS / INDAS (fig.) et al.; Intas Pharmaceuticals v EUIPO; Judgment of 7 November 2019; EU:T:2019:782;

Language of the case: EN

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RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Proof of use, Similarity of the goods and services, Similarity of the signs

FACTS: The applicant sought to register the word sign **INTAS** as an EUTM for goods in Classes 5 and 10.

An opposition based on the earlier EU and Spanish figurative marks 'indas' registered for goods in Classes 5 and 10 was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. Proof of genuine use of the earlier trademarks was submitted upon request. The Opposition Division (OD) upheld the opposition.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that proof of genuine use of the earlier EU trade mark had been furnished in connection with the goods in Class 10 and in connection with gauze dressing and pure cotton which, used together, corresponded to the materials for dressings in Class 5. It further found that, taking into account the average degree of visual similarity, the high degree of phonetic similarity, the lack of impact of the conceptual comparison of the signs, the normal degree of inherent distinctiveness of the earlier marks and the average degree of similarity between the goods, there was a likelihood of confusion (LOC) — even if the relevant public, consisting of the general public and of professionals in the medical field, displayed a high level of attention.

The applicant filed an action before the General Court (GC), relying on a single plea in law consisting of two parts: (i) infringement of Article 47 EUTMR in relation to the assessment of genuine use of the earlier marks, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

EUTM	Earlier trade marks
INTAS	

SUBSTANCE: PRELIMINARY ADMISSIBILITY ISSUES.

The applicant's arguments concerning the proof of genuine use put forward for the first time at the oral hearing can be interpreted as being a development of the argumentation already contained in the application (paras 25 and 28). However, the argument that seeks to challenge the lack of a translation of the evidence into English is inadmissible, as it cannot be considered to be implicitly contained in the statement that the evidence is not 'solid and objective' (paras 25, 28-29 and 32).

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The opponent's plea of inadmissibility, claiming that the legal and factual issues raised by complaints seeking to challenge the proof of genuine use that were already definitively dealt with in a decision which the OD adopted on 16 March 2017 in different opposition proceedings, is rejected since the principle of **res judicata** is not applicable to subsequent opposition decisions, given, inter alia, that proceedings before the Office are administrative and not judicial. A fortiori, the grounds of a decision by the OD in different opposition proceedings do not have the force of res judicata and are not capable of creating acquired rights or legitimate expectations with regard to the parties concerned (para. 35).

The principle of ***ne bis in idem*** is applicable only to penalties. Therefore, it cannot be applied in the context of opposition proceedings (para. 37).

An action against a **confirmatory decision** is inadmissible, as it merely confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier one if it contains no new factors compared with the earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (paras 38-39). However, a decision cannot be regarded as 'confirmatory' of a decision adopted by the OD in the context of different opposition proceedings concerning the same parties and the same trademarks, in particular when it concerns the genuine use of the earlier mark or the conceptual comparison, which can vary depending on the relevant public and also over time (paras 40-42).

(i) ASSESSMENT OF GENUINE USE OF THE EARLIER MARKS.

ALLEGED INFRINGEMENT OF ARTICLE 47.

The BoA correctly determined, on the basis of the invoices, price lists, catalogues and advertisements, that the earlier marks had been used in Spain during the relevant period. The earlier mark 'indas' had been used both as a company name and as a trade mark in the form in which it was registered or in forms which did not alter its distinctive character (para. 70).

WHETHER THE USE OF THE EARLIER EU TRADE MARK IS GENUINE.

According to the **principles laid down by the Leno Merken** judgment (19/12/2012, C 149/11, Onel / Omel, EU:C:2012:816) (paras 74-82), the territorial scope is only one of several factors that have to be taken into account in assessing whether use of an EU trade mark is genuine and a de minimis rule for establishing whether that factor is satisfied cannot be laid down. It is not necessary for an EU trade mark to be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the

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goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (para. 80).

For use of an EU trade mark to be deemed genuine, it is not required that the mark be used in a substantial part of the European Union. The possibility that such a mark may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account (para. 80).

It is thus irrelevant whether an EU trade mark has been used in one Member State or several. What matters is the impact of the use in the internal market: more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a commercially relevant presence of the goods and services in that market. Whether that use results in actual commercial success is not relevant (para. 82).

In the case in question, and having regard (i) to the considerable number of items of evidence provided by the opponent, (ii) to the duration and frequency of use shown by those documents, (iii) to the characteristics of the goods in connection with which that use has been proved and to the normal distribution channels, namely that they are goods relating to the health sector which are provided, in particular, by pharmacies and hospitals, and (iv) to the extent of that use both in terms of the volume of sales and turnover in the light of the principles laid down in the judgment Leno Merken (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816) the BoA did not make an error of assessment when it found that the opponent had proved use of the mark 'indas' in Spain and that, since the borders of the Member States had to be disregarded, that use was sufficient to prove use in the European Union (para. 83).

The GC thus confirmed that **use of an earlier EU trade mark in one Member State is capable of producing effects on the internal market** by, for example, ensuring that the goods are known — in a commercially relevant manner — by participants in a market that is larger than that corresponding to the territory where the mark is used (para. 84)

PROOF OF GENUINE USE OF THE EARLIER NATIONAL TRADE MARK IN CONNECTION WITH MATERIALS FOR DRESSINGS.

The BoA did not err in finding that it was possible to conclude from the proof of genuine use of the earlier national trade mark in connection with gauze dressings and pure cotton that the mark had been used in connection with materials for dressings

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since gauze dressings and pure cotton cannot be considered to be different and independent sub-categories in relation to the category materials for dressings (paras 87-100).

(ii) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR.

The relevant public is the general public and professionals in the medical field (paras 112 and 116).

The figurative element in the earlier marks has a weak distinctive character in relation to the goods in Classes 5 and 10. The use of a red cross to indicate medical or health-related goods is common or even banal (not disputed) (para. 122).

The signs are visually similar to an average degree (not disputed) (para. 123) and phonetically similar to a high degree (para. 124). Neither the word 'intas' nor the word 'indas' have any meaning in the languages of the European Union (Spanish included) and the weakly distinctive figurative element in the earlier marks is not capable of having an influence on the conceptual comparison (para. 126). There is an overall similarity between the signs (para. 128).

The goods in Class 5 covered by the mark applied for and the materials for dressings in that class covered by the earlier national mark are similar to an average degree (para. 138). The goods in Class 10 covered by the mark applied for are similar to an average degree to the materials for dressings in Class 5 covered by the earlier national mark (paras 144 and 150).

Consequently, the BoA was right in finding LOC in spite of the relevant public's high level of attention. The fact that the relevant public will pay more attention to the identity of the producer or supplier of the product which it wishes to purchase does not mean that it will examine the mark before it down to the smallest detail or that it will compare it in minute detail to another mark (paras 156-157).

T-240/19; DEVICE OF A BELL ICON (fig.); A9.com v EUIPO; Judgment of 7 November 2019; EU:T:2019:779;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Lack of reasoning, Non-distinctive

FACTS: The applicant sought to register the figurative sign for goods in Class 9.

The **examiner** refused the application pursuant to Article 7(1)(b) and Article 7(1)(c) EUTMR.

The applicant filed an appeal before the Board of Appeal (BoA), which was dismissed. The BoA found that the sign would be seen by the relevant public

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as an icon signifying an alarm, a reminder or a (bell) sound. In connection with the goods, the relevant public would perceive the mark applied for as an informative symbolic message that represented a feature of the goods. Furthermore, the BoA took the view that the overall impression created by the mark applied for did not appear to be unusual and did not include any characteristic element or eye-catching feature that was likely to confer on it a minimum degree of distinctive character.

The applicant filed an action before the General Court, relying on three pleas in law: (i) infringement of the obligation to state reasons, Article 94(1) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 7(1)(c) EUTMR.

EUTM application

SUBSTANCE:

(i) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS, ARTICLE 94(1) EUTMR

The BoA provided general reasoning for each one of five groups into which it had categorised the goods on the basis of characteristics that they had in common and that were relevant for analysing whether an absolute ground for refusal applied (paras 26-32, 36). The goods within each group are interlinked in a sufficiently direct and specific way, to the point where they form sufficiently homogeneous groups of goods. The BoA was thus entitled to use only general reasoning for each of the groups of goods identified (para. 37).

That finding is not called into question by the fact that the BoA did not expressly state that the goods in question had such a sufficiently direct and specific link to each other to the point that they formed a homogeneous category. Such an omission is not sufficient to hold that there has been infringement of the obligation to state reasons since that sufficiently direct and specific link between the goods is sufficiently clear from the contested decision (para. 38).

(ii) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR

An icon representing a bell will be perceived, in connection with the goods concerned, as a message informing the relevant public of a characteristic of the goods, namely that they contain or may contain an alarm or alert (or notification) function, are or may be equipped with a piece of software containing such a function or with an anti-theft alarm, or are capable of reproducing the sound of a bell (para. 63).

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A sign that is excessively simple and is constituted by a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not capable of conveying a message that consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (para. 65).

The overall impression created by the sign is not unusual and the sign does not have any characteristic element or eye-catching feature that is likely to be remembered by the relevant public (para. 70). The sign is thus **devoid of distinctive character** (para. 80).

Since the legality of decisions must be assessed solely on the basis of the EUTMR and not on the basis of a previous decision-making practice, neither the BoA nor the Court is bound by decisions adopted by the Office's examiners (paras 65-78).

(iii) INFRINGEMENT OF ARTICLE 7(1)(c) EUTMR.

As one of the absolute grounds for refusal applies, the GC does not need to examine the third plea (para. 84).

Case T-568/18; WE (fig.) / WE; Local-e-motion v EUIPO; Judgment of 7 November 2019; EU:T:2019:783;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Common element, Distinctive element, Figurative element, Likelihood of confusion

FACTS: The applicant sought to register the figurative sign 'WE' as an EUTM for services in Class 38.

An opposition based on the earlier German word mark WE, registered for goods and services in Class 38, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. It found that there was likelihood of confusion (LOC).

The applicant filed an appeal which the Board of Appeal (BoA) dismissed. It held that, taking into account the average degree of distinctive character of the earlier trade mark, the above-average degree of visual similarity between the signs, their phonetical identity and the fact that the earlier trade mark was contained in full in the contested trade mark, there was LOC on the part of the public in Germany in relation to the identical services.

The applicant filed an action with the General Court (GC), relying on a single plea: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

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EUTM	Earlier trade mark
WE	WE

SUBSTANCE:
INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

The **relevant public** is the public in Germany. The services concerned targeted end consumers and specialists in the telecommunications sector, with an average level of attention (not disputed) (paras 26-27).

The **services** in question are **identical** (not disputed) (paras 26-27).

The **earlier mark**, a national mark on which the opposition is based, is recognised as having **a certain degree of distinctiveness** (24/05/2012, C 196/11 P, F1-Live, EU:C:2012:314, § 47) (para. 33).

The element 'we' is the **dominant element** of the mark applied for and is **distinctive** for the relevant public (para. 52 and paras 57-64).

There is an **above-average degree of visual similarity** between the signs, since the common element is the sole element of the earlier trade mark (para. 74).

The signs are **phonetically identical** (para. 77).

The **conceptual comparison is neutral** since the sequence of letters 'we' has no meaning in German (para. 78).

Having regard to the identity of the services, the signs' above-average degree of visual similarity, their phonetic identity and the distinctive character of the earlier trade mark — albeit low — and the relevant public's average level of attention, there is LOC (paras 81-82).

Case T 101/19; imot.bg (fig.); Rezon OOD v EUIPO; Judgment of 20 November 2019; EU:T:2019:793;

Language of the case: BG

RESULT: Action dismissed

KEYWORDS: Distinctiveness acquired through use, Non-distinctive

FACTS: The applicant sought to register the figurative sign 'imot.bg.' for services in Classes 36 and 38.

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The examiner partially refused the application pursuant to Article 7(1)(b) and Article 7(1)(c) EUTMR.

The Board of Appeal (BoA) dismissed the appeal on the bases of Article 7(1)(b) and Article 7(3) EUTMR. It found that the mark lacked distinctive character for the Bulgarian-speaking public.

The applicant filed an action before the General Court, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 7(3) EUTMR, in parallel with an infringement of Article 94(1) EUTMR.

EUTM application

imot.bg

SUBSTANCE:
(i) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR.

The relevant public is the Bulgarian-speaking general public and professionals (not disputed) (para. 20).

The term 'imot' in Bulgarian means 'property'; 'real estate' and 'bg' is the country code top level domain for Bulgaria (not disputed) (para. 21). Therefore, the sign applied for immediately informs the consumer that it concerns properties or services relating to real estate (not disputed) (paras 22-23).

The verbal elements are devoid of distinctive character for the services for which protection is sought: for services in Class 36, the word 'imot' immediately informs the relevant users that these services are linked to property, including real estate; for services in Class 38, the sign indicates that they provide or offer real estate services. The verbal element 'bg' will immediately be recognised by the relevant public as a reference to a Bulgarian internet site, indicating that the services in question may be provided online or are linked to the internet; as these services provide the technical environment necessary for the provision of online real estate services, there is a sufficiently direct and concrete link between them to allow a general motivation (paras 6 and 33-34).

The graphic elements of the sign applied for, are not sufficiently stylised to attract the attention of the relevant public or to divert their attention from the descriptive information. Therefore, the relevant public will immediately perceive it as the domain name of an internet site on which products or services related to real estate are marketed, rather than as an indication of the commercial origin of the services requested (paras 6 and 36).

(ii) INFRINGEMENT OF ARTICLE 7(1)(c) EUTMR.

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Since one of the absolute grounds for refusal listed in Article 7(1) EUTMR is sufficient for the refusal of an application, the BoA was not obliged to examine Article 7(1)(c) EUTMR (para. 41).

(iii) INFRINGEMENT OF ARTICLE 7(3) EUTMR.

The evidence provided is not sufficient to prove acquired distinctiveness, since it mainly concerns the use of the sign applied for as a domain name for the advertisement of properties for sale or rent in the Bulgarian territory and not as a trade mark for the services subject to refusal. The reproach as to the insufficient motivation in this regard is rejected partly manifestly unfounded and partly inadmissible according to Article 177(1)(d) RPGC (paras 6 and 47-49).

Case T 642/18; DermoFaes Atopimed / Dermowas; Torro Dr. August Wolff GmbH & Co. KG Arzneimittel v EUIPO; Judgment of 28 November 2019; EU:T:2019:819;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The applicant sought to register the word mark **DermoFaes Atopimed** as an EUTM for goods in Classes 1, 2 and 3. An opposition based on the earlier word mark **Dermowas**, registered for services in Classes 3 and 5, was filed pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) partially upheld the opposition and rejected the registration for some of the goods in Classes 3 and 5.

The opponent filed an appeal. The Board of Appeal (BoA) annulled the OD's decision and rejected the opposition in its entirety. It held that there was no likelihood of confusion (LOC) between the marks given the very weak distinctive character of the prefix 'dermo', common to both marks, the different endings 'was' and 'faes' of their first elements, and the presence of the additional element 'atopimed' in the mark applied for.

The applicant filed an action with the GC, relying on a single plea in law, infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE:

(i) PRELIMINARY OBSERVATIONS

The applicant's evidence, consisting of an extract of a website, was produced for the first time before the GC. It cannot be taken into account within the review of legality of the contested decision and is therefore inadmissible (para. 16).

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(ii) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR.

Relevant public. The goods for which protection is sought in Class 3 are directed at average consumers, whose level of attention is average. As regards the goods in Class 5, some are directed at the general public and others at a specialised public composed of professionals in the medical and pharmaceutical sectors (not disputed). Both categories display **a high level of attention**, since the goods in question are goods affecting health (para. 21). Generally, where the relevant public is made up of two categories of consumers, each having a different level of attention, the public with the lower **level of attention** must be taken into consideration (para. 25). However, in the pharmaceutical, medical and veterinary fields, the general public, much like specialists, display a heightened degree of attentiveness, even for goods without a prescription, since they affect, to a greater or lesser degree, health. Similarly, dietetic substances adapted for medical use may be regarded as products to which a higher than average level of attention is paid (para. 26).

The element 'dermo', appearing at the beginning of the two marks, is perceived by the relevant public as a reference to 'skin' and, because of the nature of the goods concerned, this common element's **distinctive character** is **very weak** (not disputed) (para. 30). The element 'atopimed', which appears in second position in the trade mark applied for, is perceived by the professional public as consisting of the element 'atopi', indicating a predisposition towards developing certain allergic reactions, and the element 'med', which refers to the medical field. The element 'atopimed' possesses **weak distinctive character** for the goods for which protection is sought in Class 5; for the general public it lacks a clear meaning (not disputed) (para. 30).

The marks display a **low degree of visual similarity**: Due to the very weak distinctive character of the element 'dermo' the consumers' attention focuses more on the endings 'was' and 'faes atopimed' of the marks. Those elements differ in the letters 'w', 'f' and 'e' and the different order of the common letters 'a' and 's'; and there is no equivalent of the second element, 'atopimed', of the mark applied for in the earlier mark (paras 31 and 38).

Likewise, the marks display a **low degree of phonetic similarity** (paras 39 and 44).

The marks' **conceptual similarity is restricted** to the element 'dermo', but that similarity has only limited impact given that the element has weak distinctive character for the goods (para. 53).

As the overall assessment shows that the similarities found are weak and the public's attention is either average or high, there is **no LOC**, despite the partial identity and partial similarity of the goods (paras 54 and 62).

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Case T 643/18; DermoFaes / Dermowas; Torro Dr. August Wolff GmbH & Co. KG Arzneimittel v EUIPO; Judgment of 28 November 2019; EU:T:2019:818;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The applicant sought to register the word mark **DermoFaes** as an EUTM for goods in Classes 1, 2 and 3. An opposition based on the earlier word mark **Dermowas**, registered for services in Classes 3 and 5, was filed pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) partially upheld the opposition and rejected the registration for some of the goods in Classes 3 and 5.

The opponent filed an appeal. The Board of Appeal (BoA) annulled the OD's decision and rejected the opposition in its entirety. It held that there was no likelihood of confusion (LOC) between the marks given the very weak distinctive character of the prefix 'dermo', common to both marks, and the different endings 'was' and 'faes' of their first elements.

The opponent filed an action with the GC, relying on a single plea in law, infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE:
(i) PRELIMINARY OBSERVATIONS

The applicant's evidence, consisting of an extract of a website, was produced for the first time before the GC. It cannot be taken into account within the review of legality of the contested decision and is therefore inadmissible (para. 16).

(ii) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR.

Relevant public. The goods for which protection is sought in Class 3 are directed at average consumers, whose level of attention is average. As regards the goods in Class 5, some are directed at the general public and others at a specialised public composed of professionals in the medical and pharmaceutical sectors (not disputed). Both categories display a high level of attention, since the goods in question are goods affecting health (para. 21). Generally, where the relevant public is made up of two categories of consumers each having a different level of attention, the public with the lower level of attention must be taken into consideration (para. 25). However, in the pharmaceutical, medical and veterinary fields, the general public, much like specialists, display a heightened degree of attentiveness, even for goods without a prescription, since they affect, to a greater or lesser degree, health. Similarly, dietetic substances adapted for medical use may be regarded as products to which a higher than average level of attention is paid (para. 26).

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The element 'dermo', appearing at the beginning of the two marks, is perceived by the relevant public as a reference to 'skin' and, because of the nature of the goods concerned, this common element's distinctive character is very weak (not disputed) (para. 30).

The marks are visually similar only to a certain degree: Due to the very weak distinctive character of the element 'dermo' the consumers' attention focuses more on the endings 'was' and 'faes' of the marks. Those elements differ in the letters 'w', 'f' and 'e' and the different order of the common letters 'a' and 's' (paras 32 and 37).

Likewise, the marks are phonetically similar only to a certain degree (paras 38 and 42).

The marks' conceptual similarity is restricted to the element 'dermo', but that similarity has only a limited impact given that the element has weak distinctive character for the goods (para. 53).

As the overall assessment shows that the similarities found are restricted and the public's attention is either average or high, there is no LOC, despite the partial identity and partial similarity of the goods (paras 54 and 62).

The opponent's request that the applicant be ordered to pay the costs of the administrative proceedings before the Office can be allowed only as regards the costs necessarily incurred for the purposes of the proceedings before the BoA and not for the costs incurred in the proceedings before the OD, as per Article 190(2) RPGC (para. 72).

Case T 644/18; DermoFaes Atopiderm / Dermowas; Torro Dr. August Wolff GmbH & Co. KG Arzneimittel v EUIPO; Judgment of 28 November 2019; EU:T:2019:817;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS:

The applicant sought to register the word mark **DermoFaes Atopimed** as an EUTM for goods in Classes 1, 2 and 3. An opposition based on the earlier word mark **Dermowas**, registered for services in Classes 3 and 5, was filed pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) partially upheld the opposition and rejected the registration for some of the goods in Classes 3 and 5.

The opponent filed an appeal. The Board of Appeal (BoA) annulled the OD's decision and rejected the

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opposition in its entirety. It held that there was no likelihood of confusion (LOC) between the marks given the very weak distinctive character of the prefix 'dermo', common to both marks, the different endings 'was' and 'faes' of their first elements, and the presence of the additional element 'atopiderm' in the mark applied for.

The opponent filed an action with the GC, relying on a single plea in law, infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE:

(i) PRELIMINARY OBSERVATIONS

The applicant's evidence, consisting of an extract of a website, was produced for the first time before the GC. It cannot be taken into account within the review of legality of the contested decision and is therefore inadmissible (para. 16).

(ii) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR.

Relevant public. The goods for which protection is sought in Class 3 are directed at average consumers, whose level of attention is average. As regards the goods in Class 5, some are directed at the general public and others at a specialised public composed of professionals in the medical and pharmaceutical sectors (not disputed). Both categories display a **high level of attention**, since the goods in question are goods affecting health (para. 21). Generally, where the relevant public is made up of two categories of consumers, each having a different level of attention, the public with the **lower level of attention** must be taken into consideration (para. 25). However, in the pharmaceutical, medical and veterinary fields, the general public, much like specialists, display a heightened degree of attentiveness, even for goods without a prescription, since they affect, to a greater or lesser degree, health. Similarly, dietetic substances adapted for medical use may be regarded as products to which a higher than average level of attention is paid (para. 26).

The element 'dermo', appearing at the beginning of the two marks, is perceived by the relevant public as a reference to 'skin' and, because of the nature of the goods concerned, this common element's distinctive character is very weak (not disputed) (para. 30). The element 'atopiderm', which appears in second position in the trade mark applied for, is perceived by the professional public as consisting of the element 'atopi', indicating a predisposition towards developing certain allergic reactions, and the element 'derm', which refers to the skin. The element 'atopiderm' possesses weak distinctive character for the goods for which protection is sought in Class 5; for the general public it lacks a clear meaning (not disputed) (para. 30).

The marks display a low degree of visual similarity: Due to the very weak distinctive character of the

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element 'dermo' the consumers' attention focuses more on the endings 'was' and 'faes atopiderm' of the marks. Those elements differ in the letters 'w', 'f' and 'e' and the different order of the common letters 'a' and 's'; and there is no equivalent of the second element, 'atopiderm', of the mark applied for in the earlier mark (paras 31 and 38).

Likewise, the marks display a low degree of phonetic similarity (paras 39 and 44).

The marks' conceptual similarity is restricted to the element 'dermo', but that similarity has only limited impact given that the element has weak distinctive character for the goods (para. 53).

As the overall assessment shows that the similarities found are weak and the public's attention is either average or high, there is no LOC, despite the partial identity and partial similarity of the goods (paras 54 and 62).

The opponent's request that the applicant be ordered to pay the costs of the administrative proceedings before the Office can be allowed only as regards the costs necessarily incurred for the purposes of the proceedings before the BoA and not for the costs incurred in the proceedings before the OD, as per Article 190(2) RPGC (para. 72).

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New Decisions from the Boards of Appeal

A. Cases referred to the Grand Board
03/10/2019, R 2142/2018-1

DIESEL SPORT beat your limits (fig.) / Diesel et al.

EUTM	Earlier trade mark
DIESEL SPORT beat your limits	DIESEL

OUTCOME: No decision on opposition

KEYWORDS: Proof of use

NORMS: 8(1)(b) EUTMR, 10 EUTMDR, 37 EUTMDR

SUMMARY: On 3 October 2019, the First Board of Appeal decided to refer case R 2142/2018-1 DIESEL SPORT beat your limits (fig.) / Diesel et al. to the Grand Board.
This case concerns the interpretation of the requirement contained in Article 10(1) EUTMDR that a request for proof of use must be filed 'in a separate document'.
Various decisions of the Boards of Appeal have applied Article 10(1) EUTMDR in similar cases with different outcomes, which could indicate diverging interpretations of the concept of a 'separate document' or be due to the particular circumstances of each case.
In light of the importance of the legal issue 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 January 2020.

B. Decisions of the Boards of Appeal

13/11/2019, R 1061/2019-2, The Artisanal Movement (fig.)

EUTM Application
The Artisanal Movement

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OUTCOME: Application partially rejected.

KEYWORDS: Figurative trade mark; Descriptive; Non-distinctive.

NORMS: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

SUMMARY: The applicant sought to register the figurative sign 'The Artisanal Movement' for various goods and services. It was found that the relevant English-speaking consumer would understand the meaning of the sign, namely a movement campaigning for, or activities relating to, goods produced on a small scale (e.g. furniture, decorative arts, sculptures, clothing, jewellery, food items, household items, tools or mechanisms for handmade clocks/watches) using traditional methods to achieve a goal, or a group of people aiming to produce goods on a small scale using traditional methods.

The Board takes the view that the examiner correctly refused the registration of the contested sign. Seen as a whole, the sign 'The Artisanal Movement' follows the standard rules of English grammar and is not in any way unexpected or surprising. The consumers targeted will immediately understand the mark in its literal sense, namely as a movement that focuses on the revival of old, handcrafted and small-scale ways of doing things and the products that are manufactured in that way.

Article 7(1)(c) EUTMR does not require actual descriptive use. As evidenced by the listed dictionary definitions, the sign can be used to describe the fact that the relevant goods and services are a part of (or contribute to creating) an artisanal movement that focuses on handmade products, traditional techniques and small-scale production. In addition, the services objected to may very well be offered by using traditional techniques, using handmade products or advertising, commercialising and organising activities concerning traditional techniques and handmade products.

The font used in the sign imitating handwriting and the use of title-case letters do not change or impact on the message conveyed by the sign. Moreover, the Board endorses the examiner's arguments concerning a comparison with an example from Convergence Programme 3 Common Practice regarding stylised 'handwritten lettering', to the extent that in the current case the words 'The Artisanal Movement' are readily intelligible and consumers, without any mental steps, will understand the message conveyed by the words.

As regards inherent distinctiveness, the Board indicates that the contested sign conveys a clearly laudatory message that the goods and services

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offered under the contested trade mark are special because they belong to 'The Artisanal Movement' and thus have been produced (or are offered) with greater care and skill than comparable competing goods and services.

Furthermore, in relation to the remaining goods and services, the Board recommends that the examiner reopen the examination pursuant to Article 30(1) EUTMDR and Article 45(3) EUTMR as they can also be obtained using traditional methods and can be produced on a small scale. The Board also notes that for those goods or services which could have no relationship at all with artisanal production, the sign applied for could be deceptive.

Consequently, the appeal is dismissed and the application is to be partially rejected.

28/11/2019, 1179/2019-4, Pure BIO (fig.)

EUTM Application

OUTCOME: Application rejected.

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

NORMS: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

SUMMARY: The appellant sought to register the figurative mark represented above for goods in Classes 5, 29, 30, 31 and 32. The examiner refused the application in respect of all the goods by decision of 4 April 2019 pursuant to Article 7(1)(b) and (c) EUTMR, because 'Pure BIO' would be immediately understood by relevant English-speaking average consumers in connection with the goods claimed in the sense that the foodstuffs, dietetic preparations, dietary supplements or baby food were pure, i.e. free of harmful elements or amounts, and came from biological production. On account of the descriptive meaning, the sign was also devoid of distinctive character. The graphic design was not sufficient to establish distinctive character. Stylised leaves were used extensively in trade as a reference to organic origin or plant ingredients. The colour used, including the colour green, was a colour that was connected to nature. The font was a standard font.

The Board confirms the examiner's approach and notes that the composition of these two words is no more than the sum of their individual components. As a linguistically common combination of two known terms, the expression

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'Pure BIO' contains nothing more than the meaning of the two components. The word components amount to nothing more than a linguistically usual combination of descriptive terms, which convey direct information about the nature and quality of the goods in a linguistically customary manner. The graphic design does not change this descriptive meaning of the word component 'Pure BIO' in any way. The stylisation of the leaves and the use of different shades of green are also not striking in such a way that they could divert attention away from the descriptive meaning of the word elements.

Consequently the appeal is dismissed.

28/11/2019, R 86/2019-1, LT (fig.)

EUTM Application

OUTCOME: Aplicativo rejected.

KEYWORDS: Figurative trade mark; Abbreviation; Figurative element; Geographical origin; Descriptive; Non-distinctive.

NORMS: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

SUMMARY: The application for the figurative mark 'LT' intended for goods in Class 28 (such as fishing tackle) was rejected on the grounds of Article 7(1)(b) and (c) EUTMR. The decision was based on the findings that 'LT' was the ISO identifier for Lithuania and since fishing and angling were very popular in the Baltic countries, including Lithuania, the contested sign reflected that the goods originated from Lithuania.

The Board shares the examiner's finding that the figurative aspects of the mark applied for are so commonplace and banal that the mark applied for will be perceived as consisting essentially of the letters 'LT'.

The letters 'LT' are the ISO 3166-1 alpha-2 code for Lithuania. This abbreviation, in the same way as other letter country codes, will be familiar to the relevant public consisting of fishing enthusiasts located in the EU from its use in domain names and as an abbreviation on packaging and information leaflets as regards consumer products generally.

Lithuania is one of the Baltic States and has numerous lakes and rivers. Clearly, fishing enthusiasts could expect that the lakes and rivers of Lithuania are ideal places for catching freshwater fish. It is, therefore, likely that the relevant public with an interest in fishing may think that the fishing gear designated by the mark applied for, in which the most striking element is 'LT', originates from Lithuania. Moreover, the Board indicates that it is implausible that consumers will attribute another purpose to the abbreviation when viewed on the products or on their packaging. As the examiner pointed out, the sign provides information on the kind and geographical origin of the goods applied for.

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As regards inherent distinctiveness, the Board indicates that it suffices if consumers do not attribute a distinctive function to this sign. Since such consumers are already familiar with ISO two-letter country codes, and LT as the country code for Lithuania, it is inconceivable that the relevant public for fishing gear would regard a sign consisting of the two letters 'LT' as the trade mark of an entrepreneur.

Consequently, the appeal is dismissed.

19/11/2019, R 856/2019-5, Bluewater

OUTCOME: EUTM cancelled.

KEYWORDS: Word mark; Descriptive; Non-distinctive.

NORMS: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 59(1)(a) EUTMR.

SUMMARY: The EUTM covering different kinds of water was cancelled, because for the average English-speaking public the sign described the kind and quality of the goods.

The Board points out that the meaning of the terms 'blue' and 'water' is a well-known fact. It is further common knowledge that terms referring to a colour may be used in order to designate certain characteristics of beverages, including non-alcoholic beverages (28/04/2016, T 803/14, B'lue (fig.) / BLU DE SAN MIGUEL, EU:T:2016:251, § 28; 12/06/2018, T 375/17, BLUE, EU:T:2018:340, § 31). The goods at issue are water drinks and the sign includes the word 'water'. With regard to the element 'Blue', the first association that springs to mind in the context of water is its colour. Moreover 'Blue' is the natural colour which comes to mind when thinking of large expanses of water. Thus, being confronted with the term 'BLUEWATER', the English-speaking public will simply assume that the water comes from a blue water source.

The Board upholds the Cancellation Division's finding in that the colour 'blue' in relation to water is immediately associated with positive characteristics such as 'freshness', 'pureness', 'coolness' or 'clarity'. It is the same image of natural water as found in lakes, waterfalls or springs which is the reason why the colour blue is associated with water regarding its purity, clarity and coolness (14/01/2015, T 69/14, MELT WATER Original, EU:T:2015:8, § 36).

It is also a well-known fact that water and water-based beverages have been, and are commercialised, in blue coloured vessels. Thus, together with a blue coloured water bottle, the sign 'BLUEWATER' simply underlines the message conveyed by the water producer, namely that the water is from a large blue water source (lake, river, spring) and has the aforementioned positive characteristics.

Finally, it is also a well-known fact that water producers have been offering water in different flavours for many years. These flavours are often directly linked to, and advertised in, their respective colours. Consequently, English-speaking consumers may also understand the mark 'BLUEWATER' as a direct reference to the typical colour of a specific flavour or taste (e.g. 'water with a blueberry flavour') or to the 'classic water' version 'blue' without taste.

As regards inherent distinctiveness, the Board indicates that the sign contains a purely laudatory

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message and merely advertises the waters covered by the registration to be as pure, natural and cool as the blue waters from a fresh spring, lake or alpine river. With regard to beverages, their coolness and freshness, but also their health improving or maintaining qualities are of high importance to the consumer. As foodstuffs and beverages are often genetically modified or otherwise chemically treated, the evocation of purity and naturalness, with the adjective 'BLUE', is bound to raise expectations as to the high quality of the goods thus characterised.

Consequently, the appeal is dismissed and the contested decision is confirmed.

19/11/2019, R 586/2019-4, global star registry since 2002

EUTM Application

global star registry since 2002

OUTCOME: Application partially rejected.

KEYWORDS: Figurative trade mark, Deceptive element.

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

SUMMARY: The applicant sought to register the above figurative mark in black and white for goods and services in Classes 14, 16 and 35. The examiner partially refused the mark applied for on the grounds of Article 7(1)(b) and (c) EUTMR, since the mark lacked any distinctive character for the goods in Classes 16 and 35. It was stated that consumers would consider the sign applied for as an informative message that pointed out the characteristics of the goods and services in relation to a worldwide star registry, but not as an indication of commercial origin. The application was allowed to proceed for the goods in Class 14 (inter alia, precious metal and their alloys, goods in precious metal, etc.).

The Board, however, points out that the sign applied for could be rejected based on Article 7(1)(g) EUTMR, which excludes from registration signs that have a deceiving purpose towards the public. For the application of Article 7(1)(g) EUTMR, it suffices that the sign applied for contains word elements that are deceptive, notwithstanding the other elements in the sign. In this view, the Board notes that the sign 'Global Star Registry' promotes the fact that the consumer would be able to give official names to stars and that the applicant controls a worldwide registry for that purpose. The Board refers to the decision of 04/04/2001, R 468/1999-1, INTERNA¬TIONAL STAR REGISTRY, where the same reasoning applied and the application for the mark was rejected. Furthermore, reference is made to the site of the International Astronomic Union, where it is made clear that private star registries are devoid of any connection with it.

Regarding the applicant's argument concerning the fact that a mark can have both legal or illegal use, the presumption should be that the use would be the legal one, the Board notes that it is not applicable to the case at hand. Firstly, it underlines that the analysis of such a principle should be done

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by way of a prognosis, since there has been no use of the mark yet. Secondly, the deceptive character of the mark comes before the legal or illegal use of the mark. Lastly, the Board underlines that this principle refers to a specific circumstance where the goods and services are written in a generic way and the meaning of the sign is deceptive for part of the goods. It emphasises that this is not the case here, as all the goods and services in Classes 16 and 35 applied for (printed matter) are related to the naming of stars.

Consequently the appeal is dismissed and the application is partially rejected for goods and services in Classes 16 and 35.

See also 19/11/2019, R 588/2019-4, MYSTAR GLOBAL STAR REGISTRY.

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