

# Alicante News

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Up to date information on IP and EUIPO-related matters



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### Supporting SMEs in the EU

Small and medium sized enterprises (SMEs) are the backbone of the EU's economy. There are approximately 25 million SMEs in the EU, which together support two out of every three jobs here. They account for more than half of Europe's GDP, and play a vital role in adding value in every sector of the economy.

Innovation is at the heart of many successful SMEs, and intellectual property is key to protecting that innovation. IP rights can be an important business asset for SMEs; even though only 9% of all EU SMEs own IP rights, those that have registered their IP have almost a third more revenue per employee than SMEs that do not, according to [research carried out by the EUIPO](#).

However, the widespread economic disruption caused by the coronavirus pandemic has brought challenges for many SMEs. As a result, a new EUR 20 million grant fund ([Ideas Powered for Business SME Fund](#)) has been launched, which aims at helping small and medium-sized enterprises based in the EU to access and benefit from their intellectual property (IP) rights.

Open to all enterprises in the EU that fit the [official definition of a SME](#), the new scheme offers financial support in the form of reimbursements for trade mark and design application, **up to a maximum amount of EUR 1 500 per business**. It opens for applications on **11 January 2021** in the first of five application windows that will run throughout 2021.



The new scheme is run through [the Ideas Powered for Business programme](#) at the EUIPO, and forms part of the European Commission's [IP Action Plan](#). It is carried out in cooperation with the national and regional intellectual property offices of the EU.

As part of the post-COVID-19 recovery action plan for EU SMEs, the action – [the Ideas Powered for Business SME Fund](#) – encompasses reimbursements for trade mark and design applications at national level, at regional level (in the Benelux) and at EU level, through the EUIPO.

The [Ideas Powered for Business initiative](#) is part of the EUIPO's activities to support small and medium enterprises to unlock their IP potential, and forms an integral part of its [Strategic Plan 2025](#). Through Ideas Powered for Business, the EUIPO offers a [full range of services to help SMEs benefit from IP protection](#), including a pro-bono scheme, effective dispute resolution mechanisms for smaller companies, and from January 2021, a simplified trade mark and design application process for SMEs (EasyFiling).

The requirements, timing and other relevant information can be consulted ahead of the 11 January opening of the scheme through the [Ideas Powered for Business hub](#).

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## European Cooperation: new online service at the Austrian Patent Office

The Austrian Patent Office (ÖPA – Österreichisches Patentamt) has launched a new 'Trade Mark Opposition' eService, a modern online service for trade marks.

The new digital service became available on 15 November 2020.

This latest launch by the ÖPA of an additional front office tool completes the set of 44 services that are already active after having been developed as a result of work carried out by the ÖPA, the EUIPO and its partners within the framework of the European Cooperation Projects.

The new online service for trade marks will help modernise related operations in Austria and benefit all related users across the EU.

## European Cooperation: new online services in Greece

The Industrial Property Organisation in Greece (OBI), with the support of the EUIPO's European Cooperation Service, has improved the service it provides to its users with the launch of a new online



platform to file applications for design registrations electronically.

The new front office platform, available via the OBI website, now allows users to take advantage of a set of new features, such as:

- user authentication, using a custom authentication mechanism provided by the Greek General Secretariat of Information Systems for Public Administration (GSIS / taxisnet);
- integration with an external e-payment system, supported by one of Greece's four primary banks;
- seamless integration with the existing OBI back office system for designs;
- compliance with General Data Protection Regulation (EU) 2016/679.

The new platform will allow significant gains in efficiency and an improved user experience, and will **help modernise the filing of applications for design registrations in Greece.**

These digital service improvements became available on 1st December 2020.

The launch at OBI is another successful implementation of the Software Package, a set of tools developed and offered by the EUIPO to the EU's national and regional intellectual property offices.

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## European Cooperation: visual search for TMview extended to Germany

TMview's visual search facility, which allows users to search for trade mark images in the world's largest online trade mark database, continues to be extended with the addition of the German Patent and Trade Mark Office (DPMA).

As of 30 November 2020, the DPMA has made its trade mark images available via the TMview visual search tool. Since 2017, when the first image search facility was implemented in TMview, different intellectual property offices have incorporated this capability into their search facilities.

With this successful implementation the DPMA joins the intellectual property offices of Austria, the Benelux, Bulgaria, Croatia, Cyprus, the Czech Republic, Estonia, Finland, France, Greece, Hungary, Ireland, Italy, Lithuania, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK, as well as the EUIPO. This brings the total number of participating offices to 25.

The image search function can be used on trade marks from the above countries that have an image, further enriching TMview as a whole.

## European cooperation: fast track for trade marks in Latvia

On 10 December, the Patent Office of the Republic of Latvia, with support of the EUIPO's European Cooperation Projects, launched a fast track function for new trade mark applications in both its front and back office systems. Users will now be able to benefit from this service via the office's web page.

The fast track function is designed to make the filing of trade mark applications, and the registration process itself, faster and more efficient. The fast track smart guide, which is built into the front office system, will help users meet fast track criteria when filing a new trade mark application. In addition, the automated validation mechanism (in the back office system) means examination will now take considerably less time, thus speeding up the application and examination process as long as the fast track criteria are adhered to.

The fast track function will speed up the application process and will be much easier to use, which is expected to improve user satisfaction.

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## European cooperation: adoption of the CP11 and CP12 Common Practices

The CP11 Common Practice (New types of trade mark – examination of formal requirements and grounds for refusal) and CP12 Common Practice (Evidence in trade mark appeal proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence) were adopted by the Management Board through a written procedure in November 2020, following acknowledgement at the Liaison Meeting on Trade Marks in October.

The CP11 Common Practice establishes general principles on the examination of formal requirements and grounds for refusal and/or invalidity of new types of trade mark, namely sound, motion, multimedia and hologram marks, and the new ways of representing them.

The CP12 Common Practice provides recommendations regarding evidence in trade mark appeal proceedings, in particular, its types, means, sources and identification of relevant dates, as well as its structure and presentation, and the treatment of confidential evidence.

The documents are the result of consultations and contributions submitted by European Union Intellectual Property Network (EUIPN) stakeholders

over the past 2 years, as well as the fruitful collaboration of the Working Groups, composed of experts from national and regional IP offices of the EU and user associations, and, in the case of CP12, internal and external Appeal Bodies.

The Common Practices will be implemented by IP offices in Spring 2021 and made available through the publication of the corresponding Common Communications.

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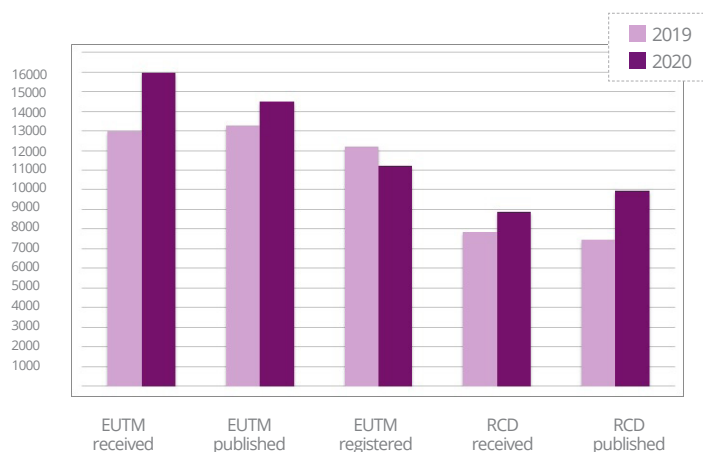
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## Statistical Highlights

Monthly statistical highlights November*	2019	2020
European Union Trade Mark applications received	12 969	15 957
European Union Trade Mark applications published	13 929	14 476
European Union Trade Marks registered (certificates issued)	12 212	11 197
Registered Community Designs received	7 834	8 895
Registered Community Designs published	7 436	9 965



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## The EUIPO signs a collaboration agreement with 4iP Council

The recent collaboration agreement between [4iP Council](#) and the EUIPO enables both organisations to join forces in pursuit of a common goal: to empower SMEs and promote the benefits of intellectual property (IP) protection.

4iP Council, a non-profit organisation with the aim to deliver academic insight and empirical research on topics related to IP, recognises the gap between entrepreneurship and the invention process and the decisions underpinning European policy, job creation and growth. One of 4iP Council's principal areas of activity is to give guidance to innovators and investors to improve their understanding of intellectual property.

As part of [EUIPO's Strategic Plan](#), the SME Programme, under the 'Ideas [Powered for business](#)' brand aims to support and empower SMEs on their business journey. The recently launched 'Ideas Powered for business' hub offers made-to-measure information for SMEs, as well as the possibility to [sign up for free personalised legal advice](#) on their intellectual property questions.

Both organisations aim to unite their efforts and create synergies in the benefit of SMEs. This agreement covers activities such as generating educational content and promoting joint webinars on intellectual property among SMEs, as well as sharing information on IP on the respective websites.

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## Faster, more secure digital improvements to benefit users

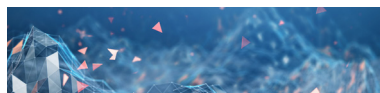
The EUIPO has deployed new digital technology to radically improve its data storage capacity and increase the performance of its online tools and services.

Migration to the new technology is now completed, with the result that the EUIPO's storage capacity has effectively doubled, and its network speed has increased by a factor of ten. This means that implementation and security speed have both increased.

With the implementation of the new technology, the Office's energy dependence for storage will drop from hundreds of kilowatts per year to a few dozen in the near future.

EUIPO users will now be able to benefit from faster digital applications and online services while completing tasks more effectively and rapidly as a result of the new implementation.

Virtually every aspect of the EUIPO's operations now relies on advanced digital tools and services.



The Office continues to modernise its digital infrastructures and services through two digital transformation programmes in its [Strategic Plan 2025](#): 'Robust Digital Backbone,' and 'Digital Evolution'.

## Payment Service Directive 2, Increased Security for Online Payments

New security requirements for online payments will come into effect in the European Economic Area in January 2021 as consequence of the second Payment Services Directive ([PSD2](#)).

In line with this directive, from January 2021, all online payments by credit card to EUIPO will have an additional layer of security involving strong customer authentication (SCA). Customers will be asked to confirm payments by entering a secret number received by SMS or a code generated by a smartphone app or with a biometric identifier like a fingerprint or facial recognition. These customers will be informed about the elements needed to confirm the payment by their financial institution (personal telephone number, smartphone app, etc.).

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## ACADEMY webinars

### Latest webinars

#### Leading digital transformation

Digital Transformation is a very relevant topic in most organizations fostered by technological drivers as well as market drivers. Topics well-known by EUIPO managers as AI and current pandemic responses by many industries are defining a “Second Wave of Digital Transformation”. The relevance and wide spread of this topics hides some lack of precision about its real meaning, its strategic role and the true nature of its management. Additionally, some critical issues are ignored such as the cognitive nature of digital transformation or the relevance of organizational contexts, creating opportunities for failure. In short, this course aims to provide a clearer vision of what means digital transformation and a first attempt to avoid the most common blind spots from a practical perspective, suited for EUIPO managers view.

Watch the webinar [here](#).

#### Decisions of the Trimester of the GC and the CJEU

This webinar provides an overview of the most relevant decisions of the GC and the CJEU issued so far during the fourth quarter of 2020.

Watch the webinar [here](#).



### Digits and numbers: When do they COUNT as trade marks?

In this webinar the concept of digits and numbers as trademarks will be analyzed. We shed some light on the conditions of registrability and in particular on the assessment of descriptiveness and distinctive character using invented examples as well as relevant Court decisions. The webinar will be wrapped up with an insight into the national approach in some EU Member States and in the US.

Watch the webinar [here](#).

### The new services offered by alternative dispute resolution

Resolving legal disputes, including IP disputes, can take a lot of time and money. For many, going all the way to the end of the litigation process is simply not feasible because of the cost in time and money. ADR can provide parties with the opportunity to avoid the delays and costs associated with court proceedings. Since 1 July 2020 the EUIPO has been providing additional ADR mechanisms, besides mediation and conciliation, and offering a service to support SMEs that have suffered the devastating economic repercussions of Covid 19.

Watch the webinar [here](#).

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## Decisions of the Trimester of the EUIPO Boards of Appeal

This webinar will analyse the area of refiling of trade marks. It will focus on the case-law that allows trade marks to be refiled, as well as on case-law relating to the refiling of trade marks considered to have been carried out in bad faith.

Watch the webinar [here](#).

### Upcoming webinars

Webinar: **Digital Single Act: new rules of the game**  
[Tuesday, 12 January](#), 10.00 AM – 11.00 AM

Webinar: **Ideas Powered for Business Support Services for SMEs: What's new in 2021** [Tuesday, 19 January](#), 10.00 AM – 11.00 AM

Webinar: **Fax Phased out (eComm Roadmap)**  
[Tuesday, 26 January](#), 10.00 AM – 10.30 AM

### On the Digital Services

As part of the 'European Digital Strategy', the European Commission proposed to upgrade the rules governing digital services in the EU through two legislative initiatives: the Digital Services Act (DSA) and the Digital Markets Act (DMA). Read more information [here](#).



For a closer look at this ambitious reform, set aside some time for our upcoming webinar on the '**Digital Single Act: new rules of the game**', where the deputy head of unit of DG CONNECT, who is dealing with the file, will be our speaker via zoom.

Watch the webinar [here!](#)

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

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### Overview of CJ/GC Case-law (Status: 01/01/2019 – 31/08/2020)



The last updated version (to 31.08.2020) is now available on the e-Search Database (Overview of CJ/GC Case-law).

The Overview of CJ/GC Case-law contains a systematic compilation of the key points of judgments and of orders rendered by the Court of Justice and the General Court of the European Union on actions brought against decisions taken by the Office's Boards of Appeal (BoA) in trade mark and design matters. It also contains key points of judgments rendered by the Court of Justice in preliminary rulings on IP rights and their enforcement. The key points consist of new or infrequent statements or statements that, while not new, are relevant in confirming established case-law.

The hyperlinks in the case reference lead to the Office's eSearch Case Law database, giving the user easy access to the full text of the judgment or order and any relevant information and documentation



(translations, summaries, first instance and BoA decisions, link to the InfoCuria Database of the CJEU).

### Luxembourg trade mark and design news

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

**11/11/2020, T 25/20, DEVICE OF A HORN (fig.) / DEVICE OF A HORN (fig.), EU:T:2020:537**

**RESULT:** Action dismissed

**KEYWORDS:** Conceptual similarity, Figurative element, Likelihood of confusion, Similarity of the goods and services, Similarity of the signs, Visual similarity, Weak element

**NORMS:** Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR]

**KEY POINTS:** Because of its historical connection with the delivery of mail, the stylised device of a post horn has been used by several postal operators throughout the EU and the public will not necessarily see it as an indication of the origin of the postal services (§ 46).

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The degree of distinctiveness of the earlier mark determines the extent of the protection conferred by it. Where its distinctiveness is significant, this is likely to increase the likelihood of confusion (LOC) (05/03/2020, C 766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 70 and the case-law cited). Where the distinctiveness of the earlier mark is low, the extent of the protection conferred by that mark is also low, even if the existence of a LOC is not precluded (§ 49).

Where the signs coincide in an element that is weakly distinctive regarding the goods and services, the global assessment of the LOC does not often lead to a finding that such a likelihood exists (18/06/2020, C 702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 53) (§ 50).

**FACTS:** The applicant sought to register a figurative mark representing a stylised horn as an EUTM for, inter alia, goods and services in Classes 6, 16, 19, 20, 35, 38 and 39.

An opposition based on an earlier EU figurative mark representing a post horn on a yellow background, registered for services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition. It found that the post horns and yellow rectangles used by the marks had very limited, if any, distinctive character, and that there were significant differences between those marks. Consequently, there was no LOC between



the marks.

The opponent appealed to the Board of Appeal (BoA). The BoA dismissed the appeal on the same grounds as the OD.

The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) CTMR. The GC dismissed the action.

### EUTM Application



### Earlier trade mark



**SUBSTANCE:** INFRINGEMENT OF ARTICLE 8(1)(b) CTMR

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### THE RELEVANT PUBLIC

The relevant public is made up of professionals (for example, for certain goods in Class 16 such as franking machines; addressing machines or services in Class 35 such as direct mail advertising) and the public at large (for example, for letter boxes of metal in Class 6 and letter boxes of masonry in Class 19) (§ 20).

### COMPARISON OF THE GOODS AND SERVICES

The opponent's services in Class 39 (such as postal, freight and courier services) are either identical or similar to all the goods and services covered by the EUTM in Classes 6, 19, 20 (letter boxes, of different materials), 16 (such as stamps; postcards; greeting cards; packets), 35 (such as retailing of postcards, stamps (seals), greeting cards, packets), 38 (such as message sending; transmission of electronic mail) and 39 (such as parcel delivery; mail delivery and courier services), except for the wholesale services in Class 35 which are different (§ 23).

### COMPARISON OF THE SIGNS

The signs have an average degree of visual similarity (and not a low one, as stated by the BoA (§ 34)) and they are also conceptually similar because they both contain a post horn device on a yellow rectangular background (§ 36).

Phonetic similarity is not relevant, since the signs do not contain any verbal elements (§ 35).

The overall degree of similarity between the signs should be described as average (§ 37).

### THE DISTINCTIVENESS OF THE EARLIER MARK

The earlier mark has low distinctiveness for the goods and services concerned (§ 47). Because of its historical connection with the delivery of mail, the stylised device of a post horn has been used by several postal operators throughout the EU and the public will not necessarily see it as an indication of the origin of the postal services (§ 46).

### GLOBAL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

The degree of distinctiveness of the earlier mark determines the extent of the protection conferred by it. Where its distinctiveness is significant, this is likely to increase the LOC (05/03/2020, C 766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 70 and the case-law cited). Where the distinctiveness of the earlier mark is low, the extent of the protection conferred by that mark is also low, even if the existence of a LOC is not precluded (§ 49).

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Where the signs coincide in an element that is weakly distinctive regarding the goods and services, the global assessment of the LOC does not often lead to a finding that such likelihood exists (18/06/2020, C 702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 53) (§ 50).

The two signs are in line with a tradition in the sector concerned, in which many of the signs used by national postal operators throughout the EU or by their successor companies use a post horn logo on a yellow background. Therefore, the relevant public will not associate this device or the colour yellow with the opponent or its services but more generally with the services of several national postal operators (§ 54).

In view of that tradition in the sector concerned, which explains why signs which have similarities have coexisted for a long time, and of the low distinctiveness of the earlier mark, the BoA rightly found that there was no LOC between the signs, despite the fact that they have an average degree of similarity and despite the identity or similarity of the goods and services concerned (§ 55).



**17/11/2020, T 495/20, sb hotels (fig.) / Sbe, EU:T:2020:556**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility

**NORMS:** Article 19 (3) and (4) Statute of the Court of Justice of the European Union, Article 51(1) RPGC

**KEY POINTS:** From the use of the word 'represented' in Article 19, third paragraph of the Statute of the Court of Justice of the European Union (Statute) follows that, for the purposes of bringing an action before the GC, a 'party' within the meaning of that article, in whatever capacity, is not permitted to act itself but must use the services of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is a party to the EEA Agreement (04/02/2020, Uniwersytet Wrocławski and Republic of Poland / REA, C-515/17 P et C-561/17 P, EU:C:2020:73, § 58 and case law cited) (§ 7).

A legal person cannot be properly represented before the EU Courts by a lawyer who occupies a directing position within the body which he represents (04/12/2014, C-259/14 P, ADR Center/ Commission, EU:C:2014:2417, § 23, 27 and 06/04/2017, C-464/16 P, PITEE/Commission, EU:C:2017:291, § 25). In the present case the lawyer who represents the applicant occupies the position

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of one of three members of the boards of directors and cannot be considered to satisfy the condition of being a third party in relation to the applicant (§ 9-10).

**FACTS:** The applicant SB Hotel Spain, SL, filed an action before the General Court (GC), challenging the BoA's decision R 2649/209-5. The application was signed by one of the three members of the board of directors. The GC rejected the action as manifestly inadmissible.

**SUBSTANCE:** Under Article 19, third and fourth paragraphs of the Statute of the Court of Justice of the European Union (Statute), applicable to the procedure before the General Court (GC) pursuant to Article 51 (1) RPGC, parties, other than the Member States and institutions of the EU, the Surveillance Authority of the European Free Trade Association (EFTA), or the States which are parties to the Agreement on the European Economic Area (EEA), must be represented by a lawyer who is authorised to practise before a court of a Member State or of another State which is party to the EEA Agreement (§ 6).

It is apparent from these provisions, and in particular, from the use of the word 'represented' in Article 19, third paragraph of the Statute that, for the purposes of bringing an action before the GC, a 'party' within the meaning of that article, in whatever capacity, is not permitted to act itself but must use the services

of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is a party to the EEA Agreement (04/02/2020, Uniwersytet Wrocławski and Republic of Poland / REA, C-515/17 P et C-561/17 P, EU:C:2020:73, § 58 and case law cited) (§ 7).

The requirement to have recourse to a third party is based on a conception of the lawyer's role as collaborating in the administration of justice and as being required to provide, in full independence and in the overriding interests of justice, such legal assistance as his client needs. Such a conception reflects legal traditions common to the Member States and is also to be found in the EU legal order as is demonstrated by, precisely, Article 19 of the Statute of the Court (18/05/1982, 155/79, AM & S Europe v Commission, EU:C:1982:157, § 24 (§ 8).

A legal person cannot be properly represented before the EU Courts by a lawyer who occupies a directing position within the body which he represents and cannot therefore be regarded as a 'third party' in relation to it (04/12/2014, C-259/14 P, ADR Center/Commission, EU:C:2014:2417, § 23, 27 and 06/04/2017, C-464/16 P, PITEE/Commission, EU:C:2017:291, § 25) (§ 9).

As in the present case, the lawyer who signed the application is one of the three members of the board of directors of the applicant, the application initiating proceedings has not been brought in

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accordance with the third and fourth paragraphs of Article 19 of the Statute and Article 51(1) RPGC (§ 10-11).

**18/11/2020, T 377/19, Tc carl / carl touc (fig.) et al., EU:T:2020:546**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Conceptual similarity, Distinctive element, Likelihood of confusion, Phonetic similarity, Visual similarity

**NORMS:** Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR]

**KEY POINTS:** The case-law according to which the first name is less distinctive than the family name (20/02/2013, T 631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T 647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) concerns only signs formed by the first name and surname of a person and is not applicable where the marks under comparison merely comprise a first name (§ 39).

The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although

that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient in that regard for the common component not to be negligible (27/09/2018, T 449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T 67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60)

**FACTS:** The applicant sought to register the word mark Tc Carl as an EUTM for goods and services in Class 2, 37 and 42.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on the earlier French figurative mark 'carl touc' registered for goods and services in Classes 9, 41 and 42 to prevent the registration of the mark for the services in Classes 37 and 42. The Opposition Division (OD) upheld the opposition for all the contested services.

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The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that, in view of the normal degree of distinctiveness of the earlier mark and the visual, aural and conceptual similarity between the marks, there was a likelihood of confusion (LOC) for the general public and professionals with a level of attention that varies from normal to high for similar or identical services.

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

### EUTM application

**Tc carl**

### Earlier trade mark



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

ON THE DISTINCTIVE AND DOMINANT ELEMENTS OF THE TRADE MARKS



The applicant, who bears the burden of proof, has not proved that the word element 'carl' has any particular significance in relation to the services, nor that it is used in the relevant sector (§ 38-42). The case-law alleged by the applicant to demonstrate that the first name is less distinctive than a family name (20/02/2013, T 631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T 647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) is applicable only for signs formed by the first name and surname of a person, whereas the marks under comparison merely comprise a first name (§ 39). The BoA did not err in its conclusion that the distinctive character of the word element 'Carl' is normal (§ 43).

The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient, in that regard, for the common component not to be negligible (27/09/2018, T 449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

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## Case law

As regards the earlier mark, the word element 'Carl', which has normal inherent distinctive character and is located before and above the element 'touch', is the element that will most attract the relevant public's attention. However, despite its relatively low distinctive character, the element 'touch' must not be ignored in the overall impression created by the earlier trade mark (§ 50). The two word elements of which the trade mark applied for is composed occupy an independent distinctive role in the mark applied for, and the relevant public will perceive these elements without attributing more importance to one element than the other (§ 52).

### ON THE SIMILARITY OF THE MARKS

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T-67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60).

The signs are visually (§ 61-67) and phonetically (§ 68-70) similar to a medium degree, and show some conceptual similarity (§ 71-72), as rightly held by the BoA. Therefore, the BoA did not err in finding the overall similarity between the marks (§ 73).

### ON THE DISTINCTIVE CHARACTER OF THE EARLIER MARK



The BoA did not err in stating that the distinctive character of the earlier trade mark was normal (§ 79).

### ON THE LIKELIHOOD OF CONFUSION

Even a low similarity of several services can be offset by the degree of similarity between the trade marks. Therefore, the BoA correctly found that there was a LOC between the signs for the relevant public (§ 89).

**18/11/2020, T 378/19, Tc Carl / carl touc (fig.) et al, EU:T:2020:544**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Conceptual similarity, Distinctive element, Likelihood of confusion, Phonetic similarity, Visual similarity

**NORMS:** Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR]

**KEY POINTS:** The case-law according to which the first name is less distinctive than the family name (20/02/2013, T 631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T 647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) concerns only signs formed by the first name and surname of a person and is not applicable where the marks under comparison merely comprise a first name (§ 39).

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The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible, that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient, in that regard, for the common component not to be negligible (27/09/2018, T 449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark, is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T 67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60)

**FACTS:** The applicant sought to register the word mark Tc Carl as an EUTM for goods in Class 9.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on the earlier French figurative mark 'carl touc' registered for goods and services in Classes 9,



41 and 42. The Opposition Division (OD) upheld the opposition for part of the goods.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that in view of the normal degree of distinctiveness of the earlier mark and the visual, aural and conceptual similarity between the marks, there was a likelihood of confusion (LOC) for the general public and professionals with a level of attention that varies from normal to high for similar or identical products.

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

### EUTM application

Tc carl

### Earlier trade mark



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

ON THE DISTINCTIVE AND DOMINANT ELEMENTS OF THE TRADE MARKS

The applicant, who bears the burden of proof, has not proved that the word element 'carl' has any particular significance in relation to the goods, nor that it is used in the relevant sector (§ 38-42). The case-law alleged by the applicant to demonstrate that the first name is less distinctive than a family name (20/02/2013, T 631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T 647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) is applicable only for signs formed by the first name and surname of a person, whereas the marks under comparison merely comprise a first name (§ 39). The BoA did not err in its conclusion that the distinctive character of the word element 'Carl' is normal (§ 43).

The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of

the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient, in that regard, for the common component not to be negligible (27/09/2018, T 449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

As regards the earlier mark, the word element 'Carl', which has normal inherent distinctive character and is located before and above the element 'touch', is the element that will most attract the relevant public's attention. However, despite its relatively low distinctive character, the element 'touch' must not be ignored in the overall impression created by the earlier trade mark (§ 50). The two word elements of which the trade mark applied for is composed occupy an independent distinctive role in the mark applied for, and the relevant public will perceive these elements without attributing more importance to one element than the other (§ 52).

ON THE SIMILARITY OF THE MARKS

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T 67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60).

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The signs are visually (§ 61-67) and phonetically (§ 68-70) similar to a medium degree, and show some conceptual similarity (§ 71-72), as rightly held by the BoA. Therefore, the BoA did not err in finding the overall similarity between the marks (§ 73).

### ON THE DISTINCTIVE CHARACTER OF THE EARLIER MARK

The BoA did not err in stating that the distinctive character of the earlier trade mark was normal (§ 79).

### ON THE LIKELIHOOD OF CONFUSION

Even a low similarity of several goods can be offset by the degree of similarity between the trade marks. Therefore, the BoA correctly found that there was a LOC between the signs for the relevant public (§ 89).

**18/11/2020, T 21/20, K7 / K7, EU:T:2020:550**

**RESULT:** Action dismissed

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

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

**KEY POINTS:** The level of attention of the average consumer from the general public in relation to

computers, including various software goods and computer hardware goods, and smart phones; mobile phones; wearable smart phones in Class 9, is higher than in relation to everyday consumer goods, without, however, being particularly high (§ 35-36, 38).

Computers and smart phones; mobile phones; wearable smart phones in Class 9 have at least an average degree of similarity (§ 50-53, 55).

**FACTS:** The applicant sought to register the word sign K7 as an EUTM for goods in Class 9, namely Smart phones; mobile phones; wearable smart phones.

An opposition based on the earlier EU word mark k7 registered for, inter alia, computers in Class 9 and services in Classes 41 and 42, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition, finding that there was a likelihood of confusion (LOC).

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the signs were identical and that a LOC could not be excluded for the goods that were similar, even if only to some extent with regards to the general public which displays a level of attention that is higher than average.

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

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

THE RELEVANT PUBLIC AND ITS LEVEL OF ATTENTION

Computer hardware (computers, tablets, smartphones, and so on) and computer products (software and so on) correspond, for the most part, to standardised goods that are easy to use, are not highly technical, and are widely distributed in all types of stores at affordable prices. To that extent, they are everyday consumer goods intended for the general public (17/02/2017, T 351/14, GATEWIT / Wit software (fig.), EU:T:2017:101, § 52). Accordingly, the relevant public consists of the average consumer from the general public in the EU, who is reasonably well informed and reasonably observant and circumspect (§ 23-24, 29-31, 33-34). Although the purchase price of some of the goods in Class 9 may be relatively high, and those goods may be subject to a period of use spanning several years, the majority of those goods are electronics aimed at the general public, which, nowadays, are relatively inexpensive, have a relatively short lifespan and do not require any particular technical knowledge (05/12/2017, T 893/16, MI PAD / IPAD et al., EU:T:2017:868, § 25) (§ 36). The level of attention of the average



consumer from the general public is thus higher in relation to the goods in Class 9 than in relation to everyday consumer goods, without, however, being particularly high (§ 35-36, 38).

COMPARISON OF THE SIGNS

As the marks are word marks, it is immaterial whether the letter 'k' is written in upper or lower case (§ 40-41). Consequently, the signs are identical (§ 42).

COMPARISON OF THE GOODS

Considering the characteristics of computers, on the one hand, and of smart phones and wearable smart phones, on the other, those goods have similarities as regards their nature and their intended purpose. The differences between those goods have become increasingly less pronounced. On the one hand, computers, smart phones and wearable smart phones are all electronic devices which function using an operating system, run applications, and are accessible via a display and a keyboard. Accordingly, those goods function and are built in a similar manner. On the other hand, computers, smart phones and wearable smart phones can all be used to access online services, communicate, whether or not via an internet connection, access multimedia content or use applications. Consequently, those goods have similar, if not identical, features (§ 50).

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The goods are also in competition, since there is an element of interchangeability between them. Consumers may buy smart phones or wearable smart phones as a substitute for computers, inasmuch as a vast majority of their functions overlap (§ 51). They may also have the same producers, users and distribution channels (§ 52).

On account of the state of technological development, these assessments also apply to mobile phones (§ 53). Therefore, the goods have at least an average degree of similarity (§ 55).

### GLOBAL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

As the signs are identical and the goods have at least an average degree of similarity, the BoA was justified, in light of the principle of interdependence, in finding that there was a LOC. This remains true despite the higher than normal level of attention displayed by the relevant public (§ 59).

The applicant's argument that the United States Patent and Trademark Office waived its refusal to register the applicant's US trade mark after the restriction of the list of goods in the context of the administrative procedure cannot invalidate that conclusion. The EU trade mark system is an autonomous system (12/12/2013, C 445/12 P, Baskaya, EU:C:2013:826, § 48). Neither the Office nor the Courts of the EU are bound by decisions

adopted in any Member State, or in a third country, finding that that sign is capable of being registered as a national trade mark (25/03/2014, T 539/11, Leistung aus Leidenschaft, EU:T:2014:154, § 53).

**25/11/2020, T 882/19, ΑΠΛΑ! (fig.), EU:T:2020:558**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Claim for alteration of EUIPO decision, Laudatory mark, Non-distinctive, Principle of legality

**NORMS:** Article 7(1)(b) EUTMR

**KEY POINTS:** None

**FACTS:** The applicant sought to register the figurative sign 'ΑΠΛΑ!' as an EUTM for goods and services in Classes 1-6, 8, 9, 14, 16, 21-36, 39 and 43. The examiner refused the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. The BoA found that the Greek-speaking public will perceive the sign, composed of the Greek word 'ΑΠΛΑ' (corresponding to the English adverb 'simply', or to the neuter plural form of the English adjective 'simple', 'uncomplicated', 'unadorned') accompanied by an exclamation mark, as a laudatory advertising

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message destined to promote the claimed goods and services by highlighting the fact that they are simple as regards, for example, their composition or their ingredients or also that are easy to use. The BoA stated that the banal figurative elements do not suffice to distract the attention from the non-distinctive message conveyed. It refused the application based on Article 7(1)(b) EUTMR and held that there was no need to rule on Article 7(1)(c) EUTMR.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) and (c) EUTMR and (ii) infringement of equal treatment.

### EUTM Application



#### SUBSTANCE: ADMISSIBILITY

The applicant's head of claim, seeking registration of the mark applied for, is inadmissible. Although the claim could be interpreted as seeking an alteration of the BoA's decision, the BoA has no competence



to deal with a request to register an EUTM. Thus, it is not for the GC to take a decision on an application requiring the alteration of the BoA decision in this respect (§ 23-26).

#### (i) INFRINGEMENT OF ARTICLE 7(1)(b) AND (c) EUTMR

The relevant public is composed of Greek-speaking average consumers and professionals depending on the specific goods and services (not disputed) (§ 39-40).

The sign consists of the word 'ΑΠΛΑ' in white capital letters, associated with an exclamation mark, within a black rectangular frame with a white outline (§ 41).

The verbal element in capital letters 'ΑΠΛΑ' of the sign, means 'easily', when used as an adverb, and 'something that is not complex, that is concise', when it is used as the neutral plural of the adjective 'απλόζ' (simple) (not disputed) (§ 42). The word in upper case letters 'ΑΠΛΑ', without an accent, may be read as 'άπλα' in the sense of 'space', a term that is not widely used, but is a rare term (not disputed) (§ 42).

The BoA correctly found that the sign is understood as meaning 'easily' in so far as it is the most common meaning of the verbal element (§ 43-44). Moreover, the relevant public will focus its attention on the message conveyed by the verbal element of the mark, also in view of the exclamation mark (§ 45).

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The sign has a laudatory and promotional meaning. It essentially suggests to the relevant public the idea of 'simplicity' for the goods and services applied for. The relevant public will not perceive the sign as going beyond the promotional information that the goods and services are easy or can be used with simplicity, and therefore not as an indication of the commercial origin of the goods or services (§ 47). The BoA was right in applying a global reasoning for the goods and services by explaining that 'simplicity' was a general quality of the goods and services, which may have a positive influence on the consumer's preference, irrespective of the characteristic on which the quality in question focuses and in providing examples for each class of goods or services (§ 51-53). The sign is therefore devoid of distinctive character pursuant to Article 7(1)(b) EUTMR (§ 54)

Since one absolute ground for refusal is sufficient for refusal of registration of a sign, there is no need to examine the arguments related to Article 7(1)(c) EUTMR (§ 56-57).

### (ii) INFRINGEMENT OF THE PRINCIPLE OF EQUAL TREATMENT

Concerning the alleged infringement of the principle of equal treatment, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the



application of those principles must be reconciled with respect for the principle of legality. The legality of the decisions must be assessed solely on the basis of the EUTMR (§ 63-70).

**25/11/2020, T 874/19, Flaming forties / 40 FLAMING FRUITS (fig.), EU:T:2020:563**

**RESULT:** Action dismissed

**KEYWORDS:** Complementary goods and services, Conceptual dissimilarity, Distinctive element, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Visual similarity

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

**KEY POINTS:** Sporting activities in Class 41 are similar to a low degree to gambling and gaming services in the same class, since the services under comparison are complementary and coincide in their purpose and their marketing channels (§ 36 38, 40). Cultural activities in Class 41 are also similar to a low degree to the services of editing or recording of sounds and images, sound recording services, and video entertainment and gaming services in the same class (§ 42).

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017,

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T 441/16, SeboCalm / Sebotherm, EU:T:2017:747, § 67; 07/02/2018, T 793/16, Boxes [packaging], EU:T:2018:72, § 53 56) (§ 53).

FACTS: The applicant sought to register the word sign Flaming Forties for goods and services in Classes 9, 28 and 41. Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on an earlier Bulgarian figurative mark 40 FLAMING FRUITS for goods and services in Classes 9, 28 and 41. The Opposition Division upheld the opposition.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It took the view that the goods and services were identical or similar. It found that the signs were visually similar to an average degree and phonetically similar to a low degree. A conceptual comparison between them was not possible. It took the view that the inherent distinctiveness of the earlier mark was average. It concluded that there was a likelihood of confusion (LOC) between the signs.

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



### EUTM application

#### Flaming Forties

### Earlier trade marks



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

The relevant public is the Bulgarian public consisting, in part, of the general public and, in part, of a public of specialists, in particular in the gaming and gambling industry. Its level of attention varies from normal to enhanced, depending on the goods and services concerned (§ 24, 29-31).

The goods in Classes 9 and 28 covered by the marks are identical and, with the exception of sporting and cultural activities, the services in Class 41 covered by the mark applied for are identical to the services in the same class covered by the earlier mark (not disputed) (§ 33). Sporting activities in Class 41 covered by the mark applied for are similar to a low degree for a non-negligible part of the relevant public to some of the services in that class covered by the earlier mark, namely gambling and gaming.

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This is because those services are complementary and coincide in their purpose and their marketing channels (§ 36-38, 40). The cultural activities in Class 41 covered by the mark applied for are also similar to a low degree to the services of editing or recording of sounds and images, sound recording services, video entertainment services and the gaming services for entertainment purposes in that class covered by the earlier mark (§ 41, 42, 44).

### THE COMPARISON OF THE SIGNS

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017, T 441/16, SeboCalm / Sebotherm, EU:T:2017:747, § 67, 07/02/2018, T 793/16, Boxes [packaging], EU:T:2018:72, § 53 to 56) (§ 53).

Analysis of the LOC here focuses on that part of the relevant public that reads Latin characters but does not understand the meaning of the English terms 'flaming' and 'forties' (§ 55). Those words have an average degree of inherent distinctiveness. By contrast, that public will be capable of perceiving the meaning of the English word 'fruits' — which forms part of basic English vocabulary — since it is a generic word and is very common in everyday life (§ 54). Even if it could be held that the distinctiveness of that element is limited with regard to some of the goods or services in the gambling sector, that will not be the case with regard to all of the goods or services covered by the earlier mark (§ 55). However,

that element is only one of the various elements that make up the earlier mark. The element '40' is distinctive to a low degree for some goods in Class 28 and has an average degree of distinctiveness for other goods in Classes 9 and 28 and services in Class 41. This is because it is not established that it may be perceived as a reference to paylines or to the model number of a machine. The element '40' is not dominant (§ 56 57). Furthermore, the red banner, as a figurative element, is less distinctive than the words 'flaming' and 'fruits' (§ 58). Therefore, for the purposes of the visual, phonetic and conceptual comparison, the signs must be considered as a whole since certain elements may be more distinctive than others, but none of the elements is dominant (§ 59).

The signs are visually similar to a low degree (and not to an average degree as the BoA found) because of the differences between the words 'fruits' and 'forties' as well as those resulting from the presence, in the earlier sign, of the number '40', the banner and the elements symbolising sparkles (§ 63 65).

The signs are phonetically similar to an average degree (and not to a low degree as the BoA found) because of the identical pronunciation of the term 'flaming', which will also be longer than that of the words 'fruits' and 'forties', and in light of the fact that it is followed by two words beginning with the same sound connected by the pronunciation of the letter 'r' (§ 68-70).

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While a large part of the relevant public will be able to perceive both the concept of the number '40' and that of 'fruits' in the earlier sign, it will not be able to associate them with any concepts which it might perceive in the sign applied for. Furthermore, that large part of the relevant public will not be able to associate the sign applied for with a particular concept. Consequently, the signs are not conceptually similar (the BoA erred in finding that no conceptual comparison between the signs was possible) (§ 74).

### THE GLOBAL ASSESSMENT OF THE LOC

The signs have the distinctive element 'flaming' in common. This constitutes the first of the two words in the sign applied for and the first of the two words in the earlier sign. Considering the fact that a substantial part of the relevant Bulgarian public can read Latin characters but does not understand the meaning of the English terms 'flaming' and 'forties' — but which is capable of perceiving that of the word 'fruits' — the signs are visually similar to a low degree, phonetically similar to an average degree and are conceptually different. Considering the average degree of inherent distinctiveness of the earlier mark, taken as a whole, and the imperfect recollection of trade marks, the BoA was right in finding that there was a LOC on the part of the relevant public displaying a level of attention that varies from average to high in respect of the goods which are identical or similar to a low degree (§ 81 82).



25/11/2020, [T 875/19](#), **Flaming Forties (fig.) / 40 FLAMING FRUITS (fig.)**, EU:T:2020:564

**RESULT:** Action dismissed

**KEYWORDS:** Complementary goods and services, Conceptual similarity, Distinctive element, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Visual similarity

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

**KEY POINTS:** Sporting activities in Class 41 are similar to a low degree to gambling and gaming services in the same class since the services under comparison are complementary and coincide in their purpose and their marketing channels (§ 36 38, 40). Cultural activities in Class 41 are also similar to a low degree to the services of editing or recording of sounds and images, sound recording services, and video entertainment and gaming services in the same class (§ 42).

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017, T 441/16, SeboCalm / Sebotherm, EU:T:2017:747, § 67; 07/02/2018, T 793/16, Boxes [packaging], EU:T:2018:72, § 53 56) (§ 53).

**FACTS:** The applicant sought to register the figurative sign Flaming Forties for goods and services in Classes 9, 28 and 41. Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on an earlier Bulgarian figurative mark 40 FLAMING

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FRUITS for goods and services in Classes 9, 28 and 41. The Opposition Division upheld the opposition.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It took the view that the goods and services were identical or similar. It found that the signs were visually similar to an average degree and phonetically similar to a low degree. A conceptual comparison between them was not possible. It took the view that the inherent distinctiveness of the earlier mark was average. It concluded that there was a likelihood of confusion (LOC) between the signs.

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

### EUTM application



### Earlier trade mark



### SUBSTANCE:

#### INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

The relevant public is the Bulgarian public consisting, in part, of the general public and, in part, of a public of specialists, in particular in the gaming and gambling industry. Its level of attention varies from normal to enhanced, depending on the goods and services concerned (§ 24, 29-31).

The goods in Classes 9 and 28 covered by the marks are identical and, with the exception of sporting and cultural activities, the services in Class 41 covered by the mark applied for are identical to the services in the same class covered by the earlier mark (not disputed) (§ 33). Sporting activities in Class 41 covered by the mark applied for are similar to a low degree for a non-negligible part of the relevant public to some of the services in that class covered by the earlier mark, namely gambling and gaming. This is because those services are complementary and coincide in their purpose and their marketing channels (§ 36-38, 40). The cultural activities in Class 41 covered by the mark applied for are also similar to a low degree to the services of editing or recording of sounds and images, sound recording services, video entertainment services and the gaming services for entertainment purposes in that class covered by the earlier mark (§ 41, 42-44).

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### THE COMPARISON OF THE SIGNS

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017, T 441/16, SeboCalm / Sebotherm, EU:T:2017:747, § 67, 07/02/2018, T 793/16, Boxes [packaging], EU:T:2018:72, § 53 to 56) (§ 53).

Analysis of the LOC here focuses on that part of the relevant public that reads Latin characters but does not understand the meaning of the English terms 'flaming' and 'forties' (§ 55). Those words have an average degree of inherent distinctiveness. By contrast, that public will be capable of perceiving the meaning of the English word 'fruits' — which forms part of basic English vocabulary — since it is a generic word and is very common in everyday life (§ 54). Even if it could be held that the distinctiveness of that element is limited with regard to some of the goods or services in the gambling sector, that will not be the case with regard to all of the goods or services covered by the earlier mark (§ 55). However, that element is only one of the various elements that make up the earlier mark. The element '40' is distinctive to a low degree for some goods in Class 28 and has an average degree of distinctiveness for other goods in Classes 9 and 28 and services in Class 41. This is because it is not established that it may be perceived as a reference to paylines or to the model number of a machine. The element '40' is not dominant (§ 56 57). Furthermore, the red banner, as a figurative element, is less distinctive than the

words 'flaming' and 'fruits' (§ 58). The other figurative elements as the grey square, the red stripes and the fruits in the sign applied for are secondary (not disputed) (§ 59). Therefore, for the purposes of the visual, phonetic and conceptual comparison, the signs must be considered as a whole since certain elements may be more distinctive than others, but none of the elements is dominant (§ 60).

The signs are visually similar to a low degree (and not to an average degree as the BoA found) because of the differences between the words 'fruits' and 'forties' as well as those resulting from the presence, in the earlier sign, of the number '40', the banner and the elements symbolising sparkles (§ 63 66).

The signs are phonetically similar to an average degree (and not to a low degree as the BoA found) because of the identical pronunciation of the term 'flaming', which will also be longer than that of the words 'fruits' and 'forties', and in light of the fact that it is followed by two words beginning with the same sound connected by the pronunciation of the letter 'r' (§ 69-71).

While a large part of the relevant public will be able to perceive the concept of the number '40' in the earlier sign, it will not be able to associate it with any concepts which it might perceive in the sign applied for. Furthermore, that large part of the relevant public will be able to perceive the concept of fruits

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in each of the signs at issue. Consequently, the signs are conceptually similar, albeit to a very low degree (the BoA erred in finding that no conceptual comparison between the signs was possible) (§ 75).

### THE GLOBAL ASSESSMENT OF THE LOC

The signs have the distinctive element ‘flaming’ in common. This constitutes the first of the two words in the sign applied for and the first of the two words in the earlier sign. Considering the fact that a substantial part of the relevant Bulgarian public can read Latin characters but does not understand the meaning of the English terms ‘flaming’ and ‘forties’ — but which is capable of perceiving that of the word ‘fruits’ — the signs are visually similar to a low degree, phonetically similar to an average degree and there is a very low degree of conceptual similarity. Considering the average degree of inherent distinctiveness of the earlier mark, taken as a whole, and the imperfect recollection of trade marks, the BoA was right in finding that there was a LOC on the part of the relevant public displaying a level of attention that varies from average to high in respect of the goods which are identical or similar to a low degree (§ 82-83).



**25/11/2020, T 57/20, GROUP Company TOURISM & TRAVEL (fig.)-GROUP Company TOURISM & TRAVEL (fig.), EU:T:2020:559**

**RESULT:** Action dismissed

**KEYWORDS:** Right of defence, Right to be heard

**NORMS:** Article 8(4) EUTMR, Article 94 EUTMR

**KEY POINTS:** The obligation of the Office to obtain information ex officio about the national law invoked under Article 8(4) EUTMR by all means available to it in relation to its power of verification should have been better reconciled with the obligation under Article 94(1), second sentence, EUTMR (the right to be heard). By failing to invite the opponent to take a position on an important provision of the Bulgarian Law on Marks and Geographical Indications, which had a decisive weight on the outcome of the dispute, the BoA infringed the opponent’s right to be heard (§ 51-52).

**FACTS:** The applicant sought to register the figurative mark GROUP Company TOURISM & TRAVEL for services in Classes 35, 39 and 43.

An opposition based on a unregistered figurative mark used in Bulgaria, the Czech Republic, Hungary, Poland and Slovakia for services in Class 39 was filed pursuant to Article 8(4) EUTMR. The Opposition Division dismissed the opposition insofar as the opponent had not specified or provided any

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evidence about the applicable national law on which it relied and under which the use of the mark applied for might have been prohibited in the Member States concerned.

In case R 1587/2013 4, the Fourth Board of Appeal dismissed the appeal of the opponent. It found that in the opposition proceedings the opponent had failed to provide evidence of the applicable national law in all jurisdictions. The reference to particular provisions of the Bulgarian law, made on appeal, was out of time. No original-language version of Article 12(6) of the Bulgarian Law on Marks and Geographical Indications ('the Bulgarian Law') was adduced and Article 76(2) CTMR (now Article 95(2) EUTMR) did not apply.

The opponent brought an action before the General Court (GC) claiming (i) (ii) infringement of Article 76(1) and (2) CTMR (now Article 95(1)-(2) EUTMR and (iii) infringement of Article 8(4) EUTMR.

The GC annulled the decision of the Fourth Board of Appeal (29/06/2016, T 567/14, GROUP Company TOURISM & TRAVEL (fig.) / GROUP Company TOURISM & TRAVEL (fig.), EU:T:2016:371). It held that the particulars of the national legislation supplemented the initial evidence which concerned the use in the course of trade of a unregistered Bulgarian mark. The production of the content of the national law was not subject to compliance with any specific formality. The mere citation of

the national law in the notice of opposition and in the language of the proceedings satisfied the formal requirements set out under Rule 19(2)(d) CTMIR. The Office must — of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where it is necessary for the purposes of assessing the applicability of the ground for refusal, the accuracy of the facts or the evidential value of the documents submitted. The Board of Appeal was required to carry out further research into the wording and scope of the provisions of national law relied on, either on its own motion or by inviting the opponent to corroborate the information it had provided on Bulgarian law.

The Office filed an action before the Court of Justice (CJ) relying on two pleas in law: (i) infringement of Article 76(2) CTMR (now Article 95(2) EUTMR) in conjunction with Rule 50(1) CTMIR and (ii) infringement of Article 8(4) EUTMR in conjunction with Rule 19(2)(d) CTMIR.

The CJ confirmed the judgment of the GC (19/04/2018, C 478/16 P, GROUP Company TOURISM & TRAVEL (fig.) / GROUP Company TOURISM & TRAVEL (fig.), EU:C:2018:268).

After resuming the case under reference R 2059/2018 5, the Fifth Board of Appeal invited the parties to provide further information on the

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wording and scope of the provisions relied on. The opponent argued that the national law relied on consisted of Articles 12(1) and (6) of the Bulgarian Law. The applicant raised, inter alia, the issue on the application of Article 38b in the context of Articles 12(1) and (6) of the Bulgarian Law on Marks and Geographical Indications and argued that the national law required an explicit and detailed indication of the opponent's valid trade mark application for the unregistered mark on which the opposition was based.

The Fifth Board of Appeal dismissed the appeal of the opponent. It found that the opposition based on earlier unregistered rights in the Czech Republic, Hungary, Poland and Slovakia was not substantiated. As regards the earlier unregistered mark in Bulgaria, the opponent referred to Article 12(6) of the Bulgarian Law, which had to be interpreted in conjunction with Article 12(1) expressly referring to Article 38b of the Bulgarian Law. This appeared to specify the conditions that needed to be satisfied for the opponent to be able to avail themselves of the right to oppose based on a unregistered mark but the opponent failed to provide the content of that provision. The Board verified, on its own motion, the content of Article 38b(1), which required the filing of an application for registration of the unregistered mark before the filing date of the opposition. Such an application was not submitted by the opponent. It concluded that the reference to the national law provided by the opponent was incomplete as the



content of Article 38b was missing, as was the proof of filing of the application for registration of the unregistered mark required by Bulgarian law.

The opponent filed an action before the GC, relying on three pleas in law, namely, (i) an incorrect application of the Bulgarian Law, (ii) infringement of the right to be heard and (iii) infringement of the principle of good and sound administration. The GC annulled the decision of the Board of Appeal (BoA). It found that the BoA infringed the right of defence of the opponent, who was not given the opportunity to comment on the application of Article 38b of the Bulgarian Law as part of the applicable national law invoked under Article 8(4) EUTMR.

### EUTM application



### Earlier trade mark



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### **SUBSTANCE:** ii) INFRINGEMENT OF THE RIGHT TO BE HEARD

The opponent invoked Article 12(6) in conjunction with Article 12(1) of the Bulgarian Law. The fact that Article 12(1) expressly refers to Article 38b of the same Bulgarian Law did not permit the conclusion that the opponent recognised, even implicitly, that the latter provision constituted, or could have constituted, a relevant element of the national law, nor that it was aware of the scope of this provision. Following the BoA's invitation to file observations on the applicable national law, the opponent was in no way required to invoke Article 38b nor to argue against its application (§ 42-45).

The content of the national law, which was established by the BoA following the exercise of its power of verification, had a broader scope than the national law invoked by the opponent. Therefore, the BoA's reference to Article 38b(1) of the Bulgarian Law resulted in new matters of fact and law which had not been the subject of a debate between the parties (§ 46).

The fact that the application of Article 38b(1) and its consequences in this case weighed heavily on the outcome of the dispute implies that the BoA was required to allow the parties to adopt a position and therefore to submit their observations on the content, scope and relevance of Article 38b(1) (§ 47-49).

The obligation of the Office to obtain information ex officio about the national law invoked under Article 8(4) EUTMR by all means available to it in relation to its power of verification, should have been better reconciled with the obligation under Article 94(1), second sentence, EUTMR. By failing to invite the opponent to take a position on Article 38b of the Bulgarian Law, the BoA infringed Article 94(1), second sentence, EUTMR (§ 51-52).

If the opponent had been invited to comment on the scope of Article 38b(1) and on the possible consequences of this provision in the present case, it would have had the opportunity to defend itself and to submit the arguments raised before the GC (§ 53-54).

The opponent may have been able to submit evidence of a filing of an application for registration of the unregistered mark relied on if it had been requested to do so (§ 55).

Since the second plea is upheld, the contested BoA decision is annulled. Therefore, it is not necessary to examine the first and third pleas (§ 57).

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### Cases referred to the Grand Board

02/07/2020, [R 2248/2019-G](#), [GEORGE ORWELL](#)

**Outcome:** No decision on application

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

**Keywords:** Personal name mark, Descriptive element, Distinctive character, Word mark

#### Summary:

On 2 July 2020, the Fifth Board of Appeal decided to refer case R 2248/2019-5, [GEORGE ORWELL](#) to the Grand Board.

This case concerns the assessment of whether the name of a famous person will be merely perceived as indicating the content or subject matter of books, films, or entertainment, cultural or educational services in Classes 9, 16 or 41, being thus descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the contrary that it may still serve as an indicator of the origin of those goods and services. The Boards of Appeal have issued diverging decisions on this issue.

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 Fifth Board in the EUIPO OJ on 4 January 2021 (language of the proceedings: English).

29/06/2020, [R 1719/2019-G](#), [ANIMAL FARM](#)

**Outcome:** No decision on application

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

**Keywords:** Descriptive element, Distinctive character, Word mark

#### Summary:

On 29 June 2020, the Fifth Board of Appeal decided to refer case R 1719/2019-5, [ANIMAL FARM](#) to the Grand Board.

This case concerns the assessment of whether the title of a famous and well-known book – as such – will merely be perceived as indicating the content or subject matter of books, films, games or entertainment services in Classes 9, 16, or 41, being thus descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the

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contrary that additional factors must be present in order to reach the aforesaid conclusion. The Boards of Appeal have issued diverging decisions on this issue.

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 Fifth Board in the EUIPO OJ on 4 January 2021 (language of the proceedings: English).

**02/07/2020, R 1922/2019-G, 1984**

**Outcome:** No decision on application

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

**Keywords:** Descriptive element, Distinctive character, Word mark

### Summary:

On 2 July 2020, the Fifth Board of Appeal decided to refer case R 1922/2019-5, 1984 to the Grand Board. This case concerns the assessment of whether the title of a famous and well-known book – as such – will merely be perceived as indicating the content or subject matter of books, films, games or entertainment services in Classes 9, 16, or 41, being thus descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the contrary that additional factors must be present in order to reach the aforesaid conclusion. The Boards of Appeal have issued diverging decisions on this issue.

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 Fifth Board in the EUIPO OJ on 4 January 2021 (language of the proceedings: English).

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23/11/2020, R 634/2020-5, kradle care planning assistant (fig.) / Gradle

#### Earlier trade mark

Gradle

#### Contested sign



#### Proof of use – Article 33(5) EUTMR – Decision confirmed

The applicant sought to register the figurative mark above for goods in Class 9. An opposition was filed on the grounds of Article 8(1)(b) EUTMR. The opposition was based on an EUTM, filed on 5 May 2009 and registered on 7 October 2009, for the word mark 'Gradle' insofar as it was registered for goods in Class 9 comprising the entire class heading in Class 9 of the edition of the Nice Classification in force at the time of filing. The applicant requested proof of use of the earlier mark for all the goods in Class 9. The Opposition Division rejected the opposition finding an absence of the earlier mark's



use for the goods on which opposition was based. It found, essentially, that the evidence adduced by the opponent showed use of the earlier mark in respect of software which did not fall within any of the categories for which the earlier mark was registered.

The Board confirms the contested decision and dismisses the appeal. The Board indicates that in accordance with Article 33(5) EUTMR the goods covered by the earlier EUTM in Class 9 can only be interpreted as including goods covered by the literal meaning of the indications in the heading of the relevant class and cannot be interpreted as comprising a claim to goods that cannot be so understood. The opponent did not exercise its right conferred by Article 33(8) EUTMR to declare, up until 24 September 2016, that its intention on the filing date of the EUTM had been to seek protection in respect of goods beyond those covered by the literal meaning of the heading of the class concerned. The Board finds that the evidence produced by the opponent relates exclusively to a specific type of software, instructional material and support services related to that software. The literal meaning of the goods in Class 9 does not cover software. Thus, there is clearly no evidence of use of the earlier mark in respect of the goods in Class 9 for which it is registered and on which the opposition is based.

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27/10/2020, R 1036/2019-1, SAGER ELECTRONICS / Hager services et al.

### Earlier trade mark

Hager services

### Contested sign

SAGER ELECTRONICS

**Likelihood of confusion – Similarity of the goods and services – Similarity of the signs – Enhanced distinctiveness – Phonetic dissimilarity – Decision annulled**

The applicant designated the European Union in its international registration ('IR') for the word mark 'SAGER ELECTRONICS' in respect of goods and services in Classes 9, 35 and 42. The opponent filed an opposition. The grounds of the opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division refused the IR in respect of all the goods and services on the basis of a likelihood of confusion with the earlier EUTM for the word mark 'Hager services', as the signs at stake were found similar visually and aurally, and the goods and services concerned were found in part identical and in part similar to a different degree.

The Board finds that the average consumer in this case is reasonably attentive and the level of



attention with respect to the goods and services is higher than normal. As regards the signs at stake, the Board confirms, as already established in its earlier decision (15/06/2020, R 867/2019-1, Sager / Hager services et al.), that neither the word element 'Sager' nor 'Hager' have their own meaning that will be perceived by consumers. It is to be expected that the word element 'Hager' in combination with the word element 'services' in the earlier mark will be perceived as a surname. Likewise, the word element 'Sager' in the contested mark will be seen as a surname. The Board indicates that the fact that both marks refer to surnames does not make them conceptually similar. Visually and aurally, the letters 'H' and 'S' are quite far apart with additional different word elements 'services' or 'electronics', even if they possess a low degree of distinctive character. According to well-established case-law the first letter is particularly important in the case of normally structured surnames or in the case of trade marks which resemble such surnames. Therefore, having regard to the fact that the goods and services concerned are targeted at specialists with an increased level of attention, the differences between the signs are sufficient to conclude that there is no likelihood of confusion. Consequently, the opposition is rejected on the basis of Article 8(1)(b) EUTMR and the case is remitted back to the Opposition Division to examine the grounds of Article 8(5) EUTMR invoked by the opponent.

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26/10/2020, R 1890/2019-1, Auratone

EUTM

**AURATONE**

**Proof of use – Revocation grounds – Article 58(1) EUTMR – Proper reasons for non use – Decision confirmed**

A request for the revocation of the EUTM registration was filed on the grounds of non-use pursuant to Article 58(1) EUTMR in respect of all the goods covered by the registration. The EUTM proprietor, in its defence, relied in particular on justified reasons for non-use, namely the existence of ongoing administrative and civil proceedings regarding the ownership of the trade mark 'AURATONE' in the United States of America. The Cancellation Division upheld the application for a declaration of revocation and declared the EUTM revoked in its entirety. It considered the arguments and evidence submitted by the EUTM proprietor insufficient to constitute proper reasons for non-use of the contested EUTM. The EUTM proprietor filed an appeal reasserting the claim that the proceedings in the United States stifled its ability to use the mark in the EU. Thus, it requested that the decision be set aside or, in the alternative, for the Board to use its discretion, pursuant to Article 71(1)(b) EUTMDR, to suspend the appeal proceedings until the civil lawsuit before the



court in the United States was decided upon. The Board dismisses the appeal in its entirety. First, as regards the request to suspend the appeal proceedings, the Board finds that granting a suspension in the present case would only be warranted and logical if the pending lawsuit in the United States were to have influence on the EUTM proprietor's capacity to use the contested EUTM in the EU or would lead to the finding that the EUTM proprietor was not allowed to use the EUTM. It is clear from Article 132 EUTMR that the civil courts of the United States do not have jurisdiction over the validity of an EU trade mark. Second, regarding the proper reasons for non-use relied on by the EUTM proprietor, the Board confirms that those obstacles do not have a direct relationship with the mark concerned, as they have not proven to have imposed restrictions upon the EUTM proprietor to use the mark in the EU. The evidence adduced by the EUTM proprietor does not enable the Board to establish that the circumstances which take place in the United States will also have a direct effect in the EU. The Board also indicates that the EUTM proprietor's statements of having been barred from using the mark seem to be contradictory in light of the evidence adduced by the cancellation applicant showing that just one day after the application for a declaration of revocation was filed the EUTM proprietor filed another EUTM application for the word 'AURATONE'.

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18/11/2020, R 2988/2019-2, DecJet / DECOjet

### Earlier trade mark

DECOJet

### Contested sign

DecJet

**Likelihood of confusion – Article 8(1)(b) EUTMR – Dissimilarity of the goods and services – Decision partially annulled**

The IR holder sought to register the figurative mark above for goods and services in Classes 7 and 42. The opponent filed an opposition on the grounds of Article 8(1)(b) EUTMR in respect of all the goods and services covered by the contested mark, basing the opposition on an earlier EUTM registration for the word mark 'DECOjet' in respect of goods in Classes 9 and 11. The Opposition Division partially upheld the opposition, namely for all the contested goods in Class 7 and refused it as regards the services in Class 42. The IR holder filed an appeal against the contested decision requesting that the decision be partially set aside.



The Board finds that all of the conflicting goods are directed at highly specialised consumers in the pharmaceutical and food production industries, such as scientists, engineers, researchers and laboratory technicians whose level of attention will be significantly higher than average. The opponent's mark covers devices, such as apparatus and installations for so-called 'clean rooms' used in production plants. The 'clean rooms', produced and installed by the opponent, are closed spaces designed to allow control over environmental contaminants which may compromise the work being carried out in the clean room. These are often required in the manufacture of electronic hardware, biology, medicine and food, or in any context where the environment may need to be free from bacteria, viruses, fungal spores or other potential pathogens. The contested goods, on the other hand, are various types of powder processing machines and insulators for use in the production processes of the chemical and pharmaceutical industries. The purpose of clean room devices is to maintain a sterile environment, thus allowing it to function as a clean room. The purpose of the powder processing machines is to process powder. In the Board's opinion, the nature and intended purpose of the respective goods is clearly not the same. The goods are also not produced by the same companies, nor are they complementary. The opponent's clean room devices

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are not, as such, necessary or of relevance for the functioning of the contested powder processing machines. The Board concludes that there is no similarity between the goods concerned and thus there can be no likelihood of confusion, regardless of the degree of similarity between the conflicting signs. Consequently, the opposition is rejected in its entirety.

18/11/2020, R 1284/2020-5, microCBD

### EUTM application

**microCBD**

**Word mark – Descriptive element – Non-Distinctive – Article 7(1)(b) and (c) EUTMR – Article 7(2) EUTMR – Appeal dismissed**

The applicant sought to register the word mark 'microCBD' for goods in Classes 5 and 32, mainly dealing with vitamin supplements, vitamin beverages, non-alcoholic beverages and non-alcoholic preparations for making beverages. The examiner refused the application on the grounds of Article 7(1)(b) and (c) EUTMR.

The Board confirms the decision and dismisses the appeal. The sign applied for is a mere combination of the word 'micro', which is commonly used to form compound words with the meaning 'very, extremely small', and the word component 'CBD', which is the customary abbreviation for 'cannabidiol', an active ingredient that can be used in beverages and vitamin preparations. Thus, the term 'microCBD' makes it immediately clear to consumers that the goods concerned contain a very small amount of cannabidiol. There is therefore a clear connection between the meaning of the sign and the designated goods. The Board dismisses the applicant's argument that the sign applied for is a fanciful word. It recalls that the mere fact that the term is not included in dictionaries does not mean that the consumer would not understand it. Consequently, the sign 'microCBD' is a descriptive indication within the meaning of Article 7(1)(c) EUTMR, in conjunction with Article 7(2) EUTMR. The Board also confirms that in respect of the goods applied for the sign is devoid of distinctive character within the context of Article 7(1)(b) EUTMR. Referring to established case-law the Board dismisses as unfounded the applicant's argument, in support of the registrability of the sign at hand, that it had succeeded in registering other EUTMs with the word element 'micro'.

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27/11/2020, R 1682/2020-1, RiCCotta

### EUTM application



**Figurative mark – Descriptive element –  
Figurative element – Non-distinctive – Misspelled  
word mark – Article 7(1)(b) and (c) EUTMR –  
Decision confirmed – Application rejected**

The applicant sought to register a figurative mark depicting the word element 'RiCCotta' for goods in Class 29, namely 'ricotta'. The examiner refused the mark applied for pursuant to Article 7(1)(b) and (c) EUTMR for all the goods applied for. According to the examiner, despite the presence of the sequence of letters 'CC' written in stylised capital letters, the sign would be understood as meaning 'Ricotta', an Italian cheese, by the Italian-speaking part of the public of the European Union. Furthermore, it was found that the stylisation of the sign was not sufficient to allow the relevant public to perceive the mark as an indication of commercial origin for the goods applied for. Thus, it was concluded that the sign was descriptive and lacked distinctive character.



The Board confirms the contested decision and rejects the sign applied for on the grounds of Article 7(1)(b) and (c) EUTMR. Firstly, the Board notes that the word element of the sign at hand is clearly and immediately recognisable by the relevant public as a simple and obvious misspelling of the word 'Ricotta', the Italian cheese. The double 'CC' in capital letters does not allow the word element to be perceived as a neologism, given that the mere spelling error does not in any way change the concept conveyed by the sign, which remains clearly understandable and obvious. The Board confirms the examiner's assessment that the Italian-speaking part of the public of the European Union will not perceive the expression contained in the sign 'RiCCotta' as unexpected or distinctive in itself. Secondly, the Board finds that the graphic representation of the contested sign will not be capable of significantly altering the purely descriptive impact of the word element so as to render the sign distinctive for the relevant consumer. Consequently, the decision is confirmed and the application rejected.

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19/11/2020, R 2281/2019-5, M MODERNO (fig.) / VEKA (fig.) et al.

### Earlier trade mark



### Contested sign



**Likelihood of Confusion – Article 8(1)(b) EUTMR – Visual dissimilarity – Phonetic dissimilarity – Decision Confirmed**

The applicant sought to register the figurative mark above for goods in Classes 6 and 19. An opposition was filed on the grounds of Article 8(1)(b), Article 8(4) and 8(5) EUTMR based on several earlier rights, inter alia, EUTM registration for the figurative mark above in respect of goods and services in Classes 1, 17, 19 and 37. The Opposition Division rejected the opposition on the grounds that none of the earlier marks and rights were similar to the contested sign.



The Board dismisses the appeal. As a preliminary point, the Board rejects the opponent's argument that the verbal elements of the contested sign are non-distinctive and descriptive. The Board indicates in this regard that in the context of opposition proceedings, Article 7(1)(b) and (c) EUTMR cannot be applied. As regards the grounds under Article 8(1)(b) EUTMR the Board refers to settled case-law according to which, where a trade mark is composed of verbal and figurative elements, the former are, in principle, more distinctive than the latter, since the average consumer will readily refer to the goods in question by quoting the name of the trade mark rather than describing its figurative element. In the present case, the word 'VEKA' is the distinctive and dominant element in the earlier mark, whereas in the contested sign, although the verbal element 'MODERNO' has a weak distinctive character, this element together with the figurative element and the letter 'M' are co-dominant. The Board finds that, as the verbal elements of the conflicting marks are clearly different, the mere appearance of a basic graphic element such as a rhombus, which is moreover stylised differently in each case, cannot lead to a visual similarity. Nor there is any phonetic similarity between the signs or semantic meaning in common. The public will not recall or remember the few negligible commonalities of the figurative elements (rhombuses) which are moreover fully counteracted by the different verbal elements. Consequently, the Board concludes that, since the signs are dissimilar overall, one of the conditions

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for the application of Article 8(1)(b) EUTMR is not satisfied, without need to compare the goods or to examine the enhanced distinctiveness or reputation of the earlier marks as claimed by the opponent. For the same reasons regarding the overall dissimilarity between the conflicting marks, the grounds of Article 8(5) and Article 8(4) EUTMR are also inapplicable.

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