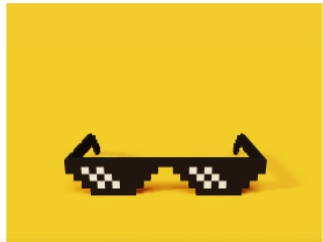
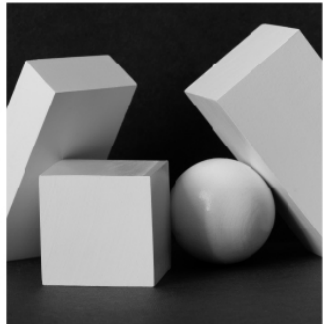


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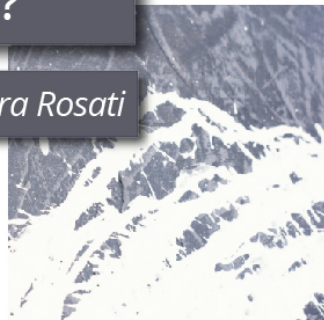
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Up to date information on IP and EUIPO-related matters



How unconventional is 'unconventional' IP?

First Page article by Eleonora Rosati



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How unconventional is 'unconventional' IP?

When we think of the different intellectual property (IP) rights and what each of them protects, we usually refer to – for example – words and logos for trade marks, books and art for copyright, a piece of furniture or a fashion creation for design rights, a pharmaceutical drug or a machine for patents.

Yet, IP can also protect 'things' or 'objects' that may be perceived as being less conventional than those above.

When we speak about the IP protection available, for example, for sounds, or colours and patterns, shapes, tattoos, memes and GIFs, or tastes and smells, we refer to 'non-traditional' or 'unconventional' IP. But how easy is it to protect these 'objects', in particular as trade marks?

Sounds

Starting with sounds, those that can be represented through musical notation, like a jingle, can be protected in principle under trade mark and copyright law. But how about those sounds that cannot be represented through musical notation, take for example "the acoustic rendition of the belling of a stag" or "the yell of the fictional character

TARZAN"? While copyright seems unavailable to them, trade mark protection requires determining whether such sounds act as indicators of commercial origin, that is – in technical terms – whether they display the required distinctiveness.

For quite some time, especially in the aftermath of a [seminal ruling](#) of the Court of Justice of the European Union (CJEU), those seeking trade mark registration of such sounds faced difficulties complying with the requirement of graphical representation of marks. Following the [latest reform](#) of the EU trade mark system and a change in the representation requirements, the European Union Intellectual Property Office (EUIPO) [can receive](#) trade marks applications for signs represented by the accepted formats. For sound marks, the EUIPO [only accepts](#) applications that are an audio file reproducing the sound.

Colours, patterns and shapes

Colours and patterns, for instance the [colours](#) of a well-known football club or the [pattern](#) used by an iconic fashion house, can be also protected – among other things – as trade marks. Today, the representation requirements of colour and pattern marks have been clarified by the case law and by the [EU trade mark reform](#).

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Like shapes (for example the [shape of the bottle](#) of a soft drink or the shape of the packaging of a chocolate bar), consumers do not always perceive colours and patterns as being indicators of commercial origin in themselves. The key requirement of distinctiveness may thus not always be fulfilled at the very outset. Like for other marks, distinctiveness may be however acquired through the use made of the sign and the resulting effect on consumer perception.

In addition to the above, another aspect to take into account is that [the law prohibits the registration of certain shapes and other characteristics of goods](#), for example shapes that are exclusively technical like that of a [well-known company's toy bricks](#) or the [shape of the Rubik's Cube](#), irrespective of whether such signs are perceived by consumers as indicators of commercial origin.

Tattoos, memes and GIFs

Turning to tattoos, these are often artistic works (that is, drawings) that have one key characteristic: that of being attached to the human body. While tattoos are in principle protectable under copyright law (and potentially also trade mark and design law!) by the same conditions as any other kind of work, the peculiarity of the medium on which they are impressed may give rise to conflicts between the rights of the tattoo artist in relation to their

tattoo and the rights of the person carrying such a tattoo. For example: can a tattoo artist object to the reproduction of their tattoo even if the person carrying it has already consented to the use of their own likeness?

While this question has not yet received an exhaustive answer across Europe, in the USA a court recently [ruled](#) that the rights of the person carrying the tattoo prevail over the copyright of the tattoo artist. In this particular case, a videogame developer had already received permission from some high-profile basketball players, including LeBron James, to reproduce their likeness – including their tattoos – in avatars featured in the videogame. The ruling determined that permission was not also needed to clear the tattoo artists' copyright in relation to tattoos visible on the athletes' bodies.

Similarly to tattoos, building blocks of internet culture such as memes (examples include "[Condescending Willy Wonka](#)" and "[Distracted boyfriend](#)") and GIFs also raise questions under copyright law. From the perspective of trade mark law, it is worth recalling that it is possible to register motion marks like, for example, the [moving logo](#) of a well-known telecommunications company or the [signature move](#) of a chef.

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Tastes and smells

Unlike 'objects' that are perceived through one's own mechanical senses (sight, hearing, touch), tastes and smells are perceived through chemical senses and are, as a result, highly subjective: the way something smells or tastes to a person may be different to how it smells or tastes to another person. Because of this peculiarity, can tastes and smells be protected by IP?

Insofar as trade marks and copyright are concerned, the answer is very similar: it is not possible to receive protection under either of them if the taste or smell at issue cannot be identified with sufficient precision and objectivity. The CJEU [recently confirmed](#) this in a case concerning copyright protection of the taste of a cheese spread.

The road ahead

When we think about IP rights, the focus cannot be limited to 'traditional' or 'conventional' subject matter: what we may regard as 'non-traditional' or 'unconventional' IP is an increasingly diverse and relevant group of 'objects'.

The availability of different IP rights represents an opportunity for those seeking to protect 'objects' like those discussed in this article. Nevertheless, since IP



rights grant their owners a monopoly, IP offices and courts are and should continue being mindful of the need to balance IP protection with the interests and rights of third parties and the public at large. All this requires, among other things, a thorough and careful examination of the requirements for protection under IP law.

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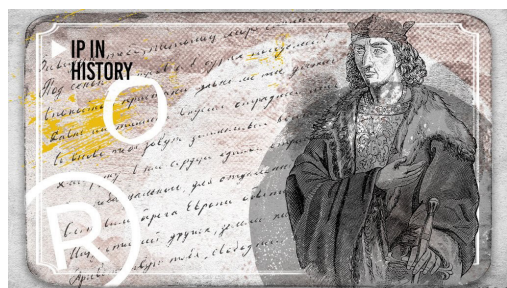
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IP from the Ancient to the Modern Age



Creativity is in our DNA. From early cave paintings, to the Works of Da Vinci, Michelangelo, Mozart and Bach, humans have always found ways to express creativity.

Over the next Alicante News issues we will delve into the history of IP, from ancient times to the middle ages and up to the modern day. We will trace how as a society, we have strived to protect that which we create.

This series of articles, each focused on a specific period of time, will take a close look at the lengths taken to protect what we now call, Intellectual Property.

Creativity and ingenuity are distinctive traits of human beings. They're what mark us apart from the rest of the animal kingdom. Is it therefore surprising that the history of that area of the law concerned precisely with protecting the results of human creativity and inventiveness dates back thousands of years? Probably not!



In fact, the journey of what we today call intellectual property (IP) emerged during the ancient, medieval, and Renaissance cultures and if we look back in time, it is clear the people of those periods valued and recognised the uniqueness of an individual's ideas. Not only that, they found early ways to protect them.

IP in Ancient Greece and Rome

Travelling back in time by over 2 500 years, we would for example discover that – in the important city of Sybaris in Magna Graecia (today, southern Italy) – chefs enjoyed a 1-year monopoly of their original and elaborate culinary recipes. Staying in ancient Greece, in 330 BCE, one of Plato's former students, Lycurgus of Athens, passed a law that required authentic copies of the works of Aeschylus, Euripides and Sophocles to be preserved in the city's archives, the practical objective being to protect the dramatists' creativity and prevent deviations from the originals of their works.

The Romans were also concerned with safeguarding the creations of one's mind, one's intellectual property if you like and in the 1st century BCE we can find two interesting examples. In both his correspondence and work, Cicero often referred to what today we would call 'plagiarism'. Whilst when judging a literary contest, Vitruvius exposed some 'false poets' who had copied from others. Because of their actions, these authors were tried, convicted, and ultimately disgraced.

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Although no specific IP statute was issued during the Roman age, did you know that Roman jurists developed some concepts, including the distinction between a work (*corpus mysticum*) and its tangible support (*corpus mechanicum*) that are still relied upon today in copyright law? The Court of Justice of the European Union itself referred to this distinction in a recent case concerning ... the making and selling of posters of artworks!

IP in the Middle Ages and the Renaissance

If we fast forward six hundred years to the 6th century CE, Ireland was the theatre of a dispute over copying that eventually led to a series of historically important events and proved to be quite the early IP drama. Christian missionary Columba copied a psalter from Finian without his permission. A dispute ensued between them and eventually, King Diarmait mac Cerbhiail decided in favour of Finian and pronounced the famous phrase: **“To every cow belongs its calf; to every book its copy”**. But the story does not end there: a series of other events led in fact to the Battle of Cúl Dreimhne, the death of 3 000 people, and – ultimately – to Columba’s exile.

Continuing our journey in time, things continued developing during the Renaissance. In Florence, for example, architect and engineer **Filippo Brunelleschi** was granted the first ever recorded ‘patent’ for *“some machine or kind of ship”, which could “bring in any merchandise and load on the river Arno and on any other river or water, for less money than usual, and with several other benefits to merchants and others”*. Meanwhile in England, Henry

VI granted John Utynam the first industrial privilege, consisting of a 20-year monopoly to make stained glass. And just a few decades later in 1474, the first comprehensive statute regulating industrial brevets was issued in the Venetian Republic.

IP in the Modern Age

It was throughout the Modern Age that the contemporary understanding of IP began taking shape: during this time, in fact, the system shifted from being one of ‘privileges’ granted by a monarch or ruler to one of legal ‘rights’ and for the first time, **IP ‘rights’ were thus born**.

In 1624, the **Statute of Monopolies** was adopted in England, whereby the monarch could exceptionally grant “letter patents” for novel inventions for a period of 14 years. Then came a landmark piece of legislation on copyright and the first of the Modern Age. The **Statute of Anne**, was passed in 1710 with the stated goal of being *“An act for the encouragement of learning”* and it granted an initial 14-year right over “copies of printed books”.

Towards the end of the 18th century, IP rights also received express recognition in the US Constitution, where the Intellectual Property Clause allows US Congress, *“To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”* US Congress enacted the first federal patent statute in 1790; in the same year, the first federal copyright legislation was also adopted.

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The value and legacy of the early history of IP

So, what does this early history tell us about today's IP system? Three things at least, for sure. First, that different societies throughout the ancient world, Middle Ages and Renaissance shared a growing appreciation of intellectual work and, with that, the need to protect it. We've also seen how the 'objects' that are now covered by IP rights – from culinary recipes to books and machines – have been considered deserving of protection, through different mechanisms, for a very long time. Finally, that what we call IP today substantially reflects the legacy of this early history, notably that of the Modern Age. For example, the idea that IP rights are functional to guaranteeing **“the progress of science and useful arts”** remains a cornerstone of several IP regimes around the world as of today.

One year of Glview

[Glview](#), the search database for all geographical indications (GIs) protected at European Union level, celebrated its first anniversary.

The platform stem from a collaboration between the European Commission ([Directorate-General for Agriculture and Rural Development](#) DG AGRI) and the EUIPO.

Glview currently contains more than 5 200 GIs protected in the EU and more than 40 000 entries showing the protection of EU GIs worldwide.

A year after its launch, Glview provides the most complete and reliable GI data in the world. The EUIPO, in cooperation with DG AGRI, provides training and continuous support to the Member States' competent authorities, allowing them to take full advantage of the tool's capabilities.

The EUIPO has been heavily involved in the legal aspect of GIs since 2018. As part of the cooperation with DG AGRI, the Office has undertaken important initiatives in four GI-related areas:

- **GI capacity building** / Assisting the Commission in the examination of GI files. The dedicated team of EUIPO GI expert examiners has examined over 1 100 GI applications so far.
- **GI knowledge expansion** / Awareness-raising and training activities. Organisation of more than 40 webinars, seminars and workshops dedicated to GIs, including two major conferences in Alicante and Brussels.
- **GI promotion and dissemination** / International cooperation in promoting GI schemes. The EUIPO plays an important role in promoting the GI system internationally in territories like China, India, Latin America and, more recently, Africa. Overall, more than 90 initiatives of this kind have been implemented in recent years.
- **GI IT tools and databases** / Development of IT tools and databases to increase legal certainty and transparency.

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Finally, the EUIPO is also involved in the extensive EU GIs legal reform, providing technical assistance to the European Commission in the ongoing legislative reviews in the areas of both agricultural, and craft and industrial GIs. This will reshape the landscape of GI protection in the EU.

TM5 and ID5 Annual Meetings

The [TM5 Annual Meeting](#) took place virtually from 3 to 5 November 2021 and was organised by the China National Intellectual Property Administration (CNIPA).

Also hosted by the CNIPA, the [ID5 partners](#) held their 7th Annual Meeting virtually on 1 and 2 November 2021.

The Executive Director of the EUIPO, Christian Archambeau, thanked Dr Shen Changyu, Commissioner of the CNIPA, for the hard work in organising the meetings. He emphasised the importance of continued cooperation and communication, including the partners' support of the TM5 TMview project, which is concluding this year following the integration of all TM5 offices into the [TMview search tool](#). He also praised the TM5 and ID5 achievements during the Chinese office's term and welcomed the forthcoming handover to the EUIPO in 2022. The 2022 TM5 and ID5 Annual Meetings will be held in Brussels in October 2022.

Discussions at the meetings focused on ongoing projects and their status as well as new project

proposals. The TM5 partners approved a new project on 'Trade Mark Protection in Opposition and Appeal (review) Procedure', which will be co-led by the CNIPA and the EUIPO and aims to take stock of opposition and review procedures of the TM5 offices.

The ID5 partners highlighted the forum's main achievements, such as the conclusion of the CNIPA/EUIPO co-led 'Quality Management' project, which resulted on the publication of a [catalogue of quality services](#) involving users. The ID5 partners also approved a new project for the creation of an informative user guide on the view and drawing requirements for designs, jointly led by the CNIPA and the EUIPO. The objective of the user guide is to present the differences and similarities concerning view submissions in the five offices.

This year's user sessions focused on pandemic-related issues and their effects on the industry, the measures taken by the offices, user expectations, and the increased use of virtual tools, among other topics.

TM5 is the name given to the multilateral cooperation forum of the five largest trade mark offices in the world: CNIPA, EUIPO, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the United States Patent and Trademark Office (USPTO). These offices are also the members of the Industrial Design 5 forum (ID5), created in 2015 to bring together the five largest design offices in the world to seek synergies and common strategies for the benefit of users in the field of design registration.

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Update on the EUIPO MBBC

For the first time since the start of the pandemic, all delegations were able to attend the [Management Board and Budget Committee](#) (MBBC) at the EUIPO premises on 16-18 November 2021.

The MBBC is made up of representatives from the EU Member States, the European Commission and the European Parliament. The Benelux Office for Intellectual Property, the European Patent Office, the World Intellectual Property Office, the Community Plant Variety Office and user associations also attend as observers.

The meetings are held in separate sessions, one for the management board, another for the budget committee and a joint session.

In the joint session, members approved the framework for establishing a multiannual contribution agreement with the European Commission under the Single Market Programme for a period of 3 years (2022-2024).

During the Management Board meeting, members agreed on an update to the project definition of **European Cooperation Project 6**, which targets small and medium-sized businesses (SMEs) to improve their competitiveness through awareness-

raising on the importance and value of IP rights and support on registration. The project now includes IP pre-diagnostic audit services as well as the European IP Information Centre and [Alternative Dispute Resolution](#) initiatives.

The Management Board also approved the EUIPO's [2022 Work Programme](#) and adopted a proposal for distributing the offsetting amount corresponding to the 2020 budget year. Furthermore, the Draft Action Plan of the [Boards of Appeal](#) 2021-2026 was presented to the Delegates for discussion.

During the Budget Committee meeting, Members elected Ms Maria João Lampreia as Deputy Chairperson of the Budget Committee. Her 4-year term of office will start on 8 June 2022 and may be renewed once.

Due to significant growth in the volume of applications and the corresponding workload, the Budget Committee adopted the Amending Budget No 2/2021 and also approved the Office's [2022 Budget](#).

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Latest cooperation updates

Follow the latest milestones on the EUIPO's European and international cooperation projects:

- [Public Consultation](#) on the update of CP1 acceptability of classification terms, CP1 general indications of the nice class headings and CP2 implementation of 'IP translator' following the transposition of directive 2015/2436. Deadline: 23 December 2021.
- [Malaysia joined DESIGNview](#).
- The Patent Office of the Republic of Latvia (LRPV) implemented the [Back Office Admin Tool Application Tracker](#).
- The Romanian Office for Inventions and Trademarks (OSIM) completed the implementation of a new type of dossier (litigation dossier) as part of the [Back Office improvements project](#).
- The EU-Georgia Intellectual Property Project (EUGIPP) published [examination guidelines](#) for national and international designs.
- New [Practice Fiche](#) concerning the Graphic Representation of Designs in participating IP Offices of CARIFORUM.
- [Antigua and Barbuda joined TMclass](#).

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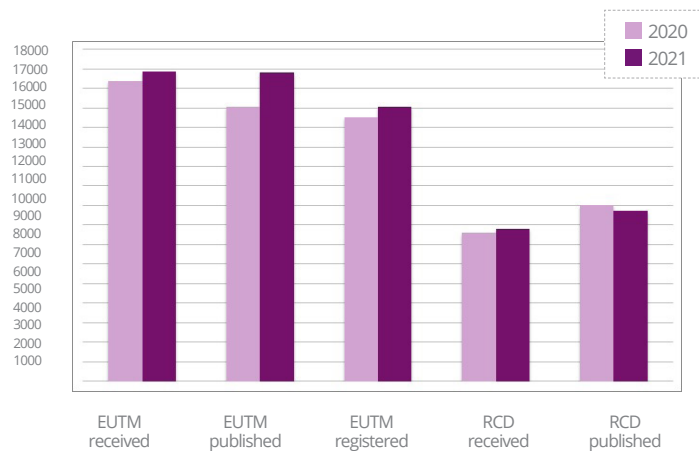
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Statistical Highlights

Monthly statistical highlights October*	2020	2021
European Union Trade Mark applications received	15 386	15 852
European Union Trade Mark applications published	14 043	15 818
European Union Trade Marks registered (certificates issued)	13 521	14 058
Registered Community Designs received	7 594	7 799
Registered Community Designs published	9 041	8 715



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EUIPO Guidelines – now in 23 EU languages

The [EUIPO Guidelines](#) for examination of EU trade marks and registered Community designs are now available in the **23 official languages of the European Union**.

The Guidelines were adopted by the Executive Director of the EUIPO on 8 February 2021 in [Decision No EX-21-1](#), and have been in force since 1 March 2021.

The Guidelines were previously available only in English, French, German, Italian and Spanish, the five working languages of the EUIPO. The following languages have now been added: Bulgarian, Croatian, Czech, Danish, Dutch, Estonian, Finnish, Greek, Hungarian, Latvian, Lithuanian, Maltese, Polish, Portuguese, Romanian, Slovak, Slovene and Swedish.

The EUIPO's current trade mark and design practice is reflected in the Guidelines, which are intended to help both users and the EUIPO staff in charge of the various procedures.

[Access the EUIPO Guidelines](#)

New pilot roadmap for links to attachments

In its continued efforts to make communication with customers more agile and eco-friendly, the EUIPO launched a 6-month pilot on 15 May 2021 to **replace attachments with links in official outgoing communications**.

During the pilot, postal communications included both printed attachments and a page containing a list of links to these attachments. Once a [User Area account](#) is created, the customer can download their attachments from the links listed in the User Area.

The links page looks something like this:



You can download the attachments from your EUIPO User Area by using the links below.

C400A - Communication to the applicant - 23/11/2015	https://euiipo.europa.eu/copla/document/3333a6
Decision - 28/05/2020	https://euiipo.europa.eu/copla/document/3333a7
Certificate - 21/09/2015	https://euiipo.europa.eu/copla/document/3333a9

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The pilot did not fully meet expectations. In particular, it was noted that customers receiving communications by post were unaware of the benefits of e-communication and the User Area. Accordingly, the EUIPO has decided to extend the pilot in one area only – cancellation proceedings – and apply it to all letters in this area.

From 15 November 2021, all attachments in cancellation proceedings letters will be sent in the form of a page containing a list of links, both in e-communication and by post.

In cancellation proceedings: in the event that a customer receives the page containing the list of links by post but does not create his or her User Area account within 15 days of receipt of the links, the EUIPO Information Centre will get in touch. Assistance will be offered to create a User Area account and/or the user can request that the printed attachment(s) are renotified by post.

In all other proceedings: communications sent via e-Comm will include only the page containing the list of links, while communications sent by post will include both the page of links and the printed attachments.

If the new pilot roadmap for cancellation proceedings is successful, the EUIPO will consider expanding it to other areas.

The main goal of this initiative is to get more customers to register in the User Area and benefit from the advantages of electronic communications.

In the future, it is envisaged that the **User Area will be the customer's single point of contact** with the EUIPO. This is critical for those customers involved in proceedings who need to be able to communicate swiftly and effectively as and when required. In general, one point of contact will simplify the complex and time-consuming task of keeping abreast of day-to-day communications. [This video](#) shows the benefits of using e-communications with the EUIPO.

Latest SQAP audit

On 10, 24 and 25 November 2021, the EUIPO held the sixth Stakeholder Quality Assurance Panel (SQAP) on the quality of **absolute grounds decisions**.

[Eighteen users](#) representing ten user associations met virtually to check a sample of absolute grounds decisions against the EUIPO quality criteria.

The SQAP initiative was launched by the EUIPO in 2017 aiming to integrate the user's perspective into the quality management system of the Office. In SQAP, users contribute directly to improving the quality of the EUIPO decisions.

More information on the audits and how to become a SQAP auditor is available on the [SQAP section](#).

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Practice tip: No encrypted files please!

Last year the EUIPO published a practice tip on the [accepted file formats for annexes](#) in all proceedings. But what about encrypted files? Or encrypted data carriers? Does the EUIPO accept them? The answer is NO.

Encrypted files are not accepted because they do not comply with the file formats as specified in [Decision No EX-20-10](#) on technical specifications for annexes submitted on data carriers.

Encrypted files often have:

- an .exe format, or
- some other format

neither of which comply with the specifications as set out in Article 2 of the above Decision.

As a result, if a file is not in an accepted format and does not comply with the technical specifications:

- it will be deemed not to have been filed, and
- the EUIPO will not invite you to resubmit a file in a correct format.

Files submitted in an executable file format are not acceptable, nor are those in any encrypted format, even if the resulting executed or decrypted file is in one of the accepted file formats.

Accordingly, such files:

- will not be decrypted, and
- will not be a part of the case file.

For further information on the accepted file formats, as well as on file sizes, file structure, file names and the consequences of non-compliance with these technical specifications, see the referred [Decision of the Executive Director](#) of the EUIPO.

Ideas Powered SME Fund helps 13 000 European SMEs

Since its launch in January 2021, the [EUIPO's initiative](#) that grants financial aid for intellectual property matters has provided support to 12 989 Small and Medium-sized enterprises (SME) across all 27 EU countries.

The largest number of applications have been from companies based in **Germany** (1 401), followed by **Spain** (1 365), **Poland** (1 348) and **Italy** (1 295).

The grants cover trade mark, design basic application fees and IP pre-diagnostic services (IP Scan). More than 21 000 trade mark and 5 000 design grants were requested at national, regional and EU level. Requests for IP Scan amounted to 841, with the vast majority of applications received coming from first time users.

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The Ideas Powered for Business SME Fund is a joint effort between the EUIPO, the European Commission and EU IP offices. The fund aims to help European small and medium-sized enterprises access their intellectual property rights. It can also be requested by IP representatives who can act of behalf of an SME

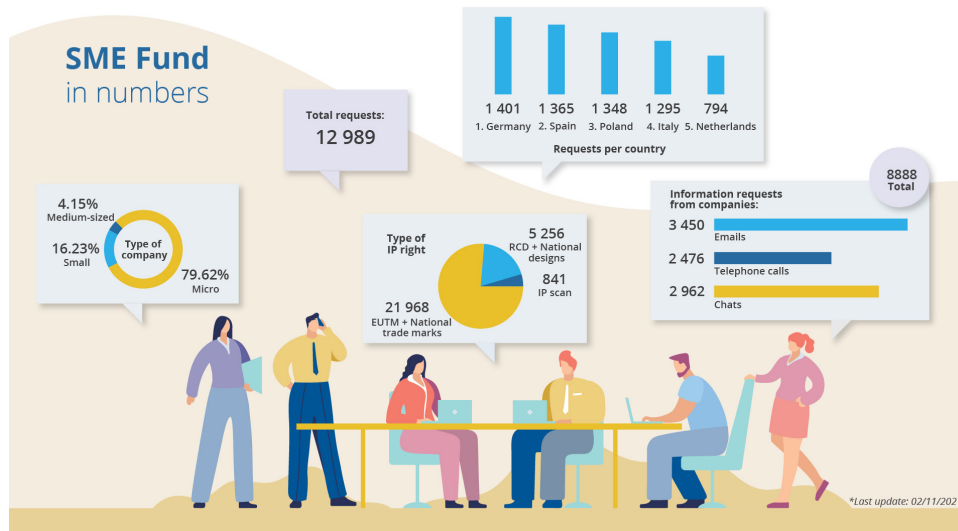
The application period for the SME Fund is now closed, but the support for SMEs will continue in 2022. The EUIPO is working on an **expanded multi-annual programme** that will continue to offer

support, into the future. In the meantime, small businesses can access:

- free training courses;
- a platform to access a modern dispute resolution service that helps settle IP disputes between companies; and
- tailor-made advice from IP professionals.

Follow Ideas Powered for Business on [Twitter](#) and [LinkedIn](#) to receive the latest news.

[More on Ideas Powered for Business](#)



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Anti-counterfeiting blockchain infrastructure

Public sector organisations, including the EUIPO, leverage blockchain technology to move away from siloed and ineffective centralised systems. Current systems are inherently insecure and costly, with duplicated and inefficient workflows. **Blockchain networks** offer more secure, agile and cost-effective structures. This is particularly true when it comes to **supply chain and authenticity management**.

Currently, there are many tools, procedures and instruments being used to combat counterfeiting. However, systems are scattered and often work separately, which criminal networks use to their advantage.

The EUIPO has recently organised a contest to design a **scalable, decentralised blockchain authentication platform**. The application phase of the contest ended on 30 September and the submissions are currently being evaluated. The winner is expected to be announced in the first quarter of 2022.

The objective of the contest is to select the best proposal for a high-level design for a blockchain-based compliance infrastructure that will authenticate products and exchange data between

all parties in the supply chain. The compliance infrastructure aims to contribute towards synchronisation between all parties involved in this process: the EU intellectual property offices, governments, customs authorities, manufacturers, retailers, logistics operators and, above all, customers. Everyone has a stake in the anti-counterfeit challenge.

The authentication platform will interconnect products' 'track and trace' solutions with the risk analysis systems of enforcement authorities and the existing EUIPO tools ([TMview](#), [DesignView](#), [IPEP](#) and [IP Register in Blockchain](#)). The Office will continue developing this platform over the next two years, and welcomes all customs authorities, rights holders, retailers, logistics operators and the entire blockchain community to take part in this journey.

APIs are coming!

Over the last few months, the EUIPO has been working on the application programming interfaces (API) initiative, which will **allow customers to integrate their IT systems with the EUIPO**.

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The first beta version of the **EU trade marks filing API** is expected to be published during the first quarter of 2022. Customers will then be able to get familiar with the interface and start exploring its options.

Seven IP companies registered their interest to participate in the project's pilot phase following a call for interest last July. Several successful workshops followed, in which companies were guided through the journey of developing and testing APIs with the objective of obtaining beta API interactions with Office systems. The most recent workshop, held on 13 October, focused on how to improve future APIs.

Stay tuned for more information on the API initiative.

Collaboration on research IP management

The European Commission's Directorate General Research and Innovation, the [European Innovation Council and SMEs Executive Agency](#) (EISMEA) and the EUIPO signed a letter of intent for cooperation on intellectual property management.

The commitment aims to develop a process of cooperation towards closer collaboration between the parties in actions related to IP management.

This will support directly the European Research Area objective to translate results into the economy, ensuring [market uptake of research output](#) and Europe's competitive leadership in technology.

The letter of intent builds on the Memorandum of Understanding signed between the European Commission and the EUIPO on 16 April 2019.

The signatories will coordinate their efforts in terms of awareness raising activities on IP, support measures for innovative SMEs to boost their innovation potential, and improve the understanding of the benefits that IP can provide. In addition, they will share IP related data and will cooperate in IP management policy development and in knowledge-transfer activities, such as the development of a Code of Practice for smart use of IP (expected by the end of 2022).

The [European Research Area](#) aims to create a single, borderless market for research, innovation and technology across the EU. It helps countries be more effective together by strongly aligning their research policies and programmes. The European Innovation Council (EIC), implemented by EISMEA, provides Business Accelerator Services, including on IP management, to EIC projects.



Better IP management in the wider research and innovation community is fundamental for achieving breakthrough market-driven innovations and contributes to a more competitive European industry.

This webinar is for small and medium-sized businesses that wish to develop an intellectual property strategy and protect their intellectual property rights at EU level or worldwide. The EUIPO and WIPO give an overview on the use of IP rights as a decisive asset for businesses. They will also explain in detail available initiatives that support small businesses in setting up their IP strategy.

ACADEMY webinars

Latest webinars

Recent case-law in the field of designs

This webinar provides an overview of the most relevant judgments of the GC/CJEU and decisions of the EUIPO Boards of Appeal in 2021 on Community Designs.

[Watch the webinar](#)

EUIPO and WIPO intellectual property support initiatives for your business. A webinar organised in collaboration with WIPO

The World Intellectual Property Organization (WIPO) and the European Union Intellectual Property Office (EUIPO) explain various initiatives that are available to support your business.

During this webinar you will:

- discover the EUIPO's Ideas Powered for business initiatives to support businesses in setting up their IP strategy;
- learn about WIPO's tools and services to help businesses build IP strategies;
- learn from a real SME on how they use IP in their business strategy.

[Watch the webinar](#)

Packaging as a product: an IPR perspective A webinar organised in collaboration with the EPO

Packaging combines visual appeal and functional aspects, and is often part of a product's identity.

Packaging can be protected under trade mark and design law, with patents protecting any technical aspects.

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Interesting questions arise when these IP rights are combined: what makes an invention in packaging patentable; why are relatively few packaging shapes granted trade mark protection; where does the packaging end and the product begin?

Our experts look at examples as well as the latest case-law.

[Watch the webinar](#)

Find a backer for your business – how intellectual property can boost access to financing from private equity investors

Access to finance is a key constraint to the growth of small and medium-sized enterprises (SMEs); it is one of the most cited obstacles facing SMEs when growing their businesses. At the same time, intellectual property and its value are often not adequately taken into account by small businesses and start-ups. In the increasingly knowledge-driven economy, IP is a key consideration in day-to-day business decisions and can give a business a competitive advantage.

This webinar is open to anyone, in particular SMEs who want to find out about Invest Europe's and the EUIPO's tailored services that facilitate SME business journeys. At the webinar you will:



- learn from Invest Europe about available sources of funding for SMEs;
- understand how IP is assessed by the investors when deciding on financing a business;
- acquire knowledge about how to benefit from the EUIPO SME Fund;
- discover the EUIPO Ideas Powered for business initiatives to support businesses in setting up their IP strategy.

[Watch the webinar](#)

Upcoming webinars

Webinar: **IP Enforcement and Data protection**, [Tuesday 7 December](#), 10.00–11.00 (CET)

Webinar: **Track on case-law: Decisions of the trimester of the EUIPO Boards of Appeal – Decisions of the trimester of the General Court (GC) and Court of Justice of the European Union (CJEU) (Q4)**, [Tuesday 14 December](#), 10.00–12.00 (CET)

On recent case-law

The concept of bad faith is not defined, delimited or even described in any way in the EU trade mark legislation. In the recent case AGATE, the GC confirmed that a registration for AGATE was invalid because the application had been made in bad faith (29/09/2021, [T 592/20](#), Agate / Agate EU:T:2021:633).

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It is up to the mark proprietor to provide plausible explanations on the objectives and commercial logic of the application for registration of that mark.

Watch the webinar on the [multifaceted notion of bad faith](#). Join to review the specific case-law to identify general patterns of bad faith and identity circumstances.

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

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28/10/2021, [C-123/20](#), Ferrari, EU:C:2021:889

Preliminary ruling — Community designs — Articles 4, 6 and 11 CDR — Infringement proceedings — Unregistered Community design — Appearance of a part of a product — Conditions for protection — Individual character



On 2 December 2014, Ferrari S.p.A. presented to the public for the first time the top-of-the-range FXX K car model, in a press release containing two photographs showing a side view and a front view of that vehicle, respectively.

Since 2016, Mansory Design & Holding GmbH ('Mansory Design'), established in Germany, had produced and marketed sets of personalisation accessories, known as 'tuning kits', designed to alter the appearance of another road-going Ferrari model, produced in a series, in such a way as to make it resemble the appearance of the Ferrari FXX K.

Ferrari brought an action for infringement and related claims against Mansory Design, on account of the alleged infringement of the rights conferred by three unregistered Community designs in respect of parts of the FXX K model, namely components of its bodywork. Those Community designs arose at the time of the publication of the press release dated 2 December 2014.

The Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) dismissed those claims in their entirety.

Following an appeal brought before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), that court dismissed Ferrari's appeal, holding that the first and second designs claimed never existed, since Ferrari had

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not shown that the minimum requirement of a certain autonomy and consistency of form had been satisfied, whereas the third design claimed did indeed exist, but had not been infringed by Mansory Design.

It was in that context that the Bundesgerichtshof (Federal Court of Justice, Germany), before which Ferrari brought an appeal, asked the Court of Justice ('CJEU') to clarify whether making available to the public images of a product, such as the publication of photographs of a car, could lead to the making available to the public of a design of a part, or a component part, of that product and, if so, to what extent the appearance of that part or component part had to be independent of the product as a whole in order for it to be possible to examine whether that appearance had individual character.

In its preliminary ruling, the CJEU holds, inter alia, that EU law must be interpreted as meaning that the making available to the public images of a product, such as the publication of photographs of a car, results in the making available to the public of a design of a part of that product or of a component part of that product, as a complex product, provided that the appearance of that part or component part is clearly identifiable at the time that the design is made available (Article 3(a) and (c), Article 4(2) and Article 11(2) CDR) (§ 52).

The material conditions required for the protection of a Community design to arise, whether registered or not, namely novelty and individual character, are the same for both products and parts of a product (Articles 4 to 6 CDR) (§ 33-34). Provided that those material conditions are satisfied, the formal condition for giving rise to an unregistered Community design is that of making it available to the public, within the meaning of Article 11(2) CDR. In accordance with that article, 'a design shall be deemed to have been made available to the public within the European Union if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the [European Union]'. In order for the making available to the public of the design of a product taken as a whole to entail the making available of the design of a part of that product, it is essential that the appearance of that part is clearly identifiable when the design is made available. However, that does not imply an obligation for designers to make available separately each of the parts of their products in respect of which they seek to benefit from unregistered Community design protection (§ 30-43).

The concept of 'individual character', within the meaning of Article 6 CDR, governs not the relationship between the design of a product and the designs of its component parts, but rather the relationship

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between those designs and other earlier designs. In order for it to be possible to examine whether the appearance of a part of a product or a component part of a complex product satisfies the condition of individual character, it is necessary for that part or component part to constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture. That presupposes that the appearance of that part or component part is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole (§ 44-51).

25/10/2021, T 329/20, Pendentì, EU:T:2021:732

Community design — Invalidation proceedings — Article 25(6) CDR — Action brought by the applicant for a declaration of invalidity against the decision to maintain the Community design in an amended form — No interest in bringing proceedings — Action rejected as inadmissible

'A' held a Community design consisting of a trailer in the shape of a heart engraved by the word 'Pianegonda'. 4B Company S.r.l. filed a design invalidity application regarding the design on the ground that it used an earlier distinctive sign pursuant to Article 25(1)(e) CDR. It based its application on the use of its EU word mark 'PIANEGONDA', which was also registered for jewellery.

In the invalidity proceedings, 'A' requested, pursuant to Article 25(6) CDR, that the contested design be retained in a modified form without engraving the word corresponding to the word mark 'PIANEGONDA'. 4B Company objected to the retention of the design in an amended form, on the ground that the removal of the engraving would not allow the identity of the design to be preserved. The design was subsequently transferred to Deenz Holding Ltd.

The Invalidation Division ('ID') dismissed the application to have the contested design maintained in an amended form and granted the design invalidity application, declaring the contested design invalid in its entirety, on the basis of Article 25(1)(e) CDR. Deenz Holding Ltd. filed an appeal before the Boards of Appeal ('BoA'). The BoA annulled the decision of the ID, declared the contested design invalid insofar as it used the word mark 'PIANEGONDA' and granted the application for maintenance of the contested design in an amended form.

The General Court ('GC') dismissed the action brought by 4B Company as being inadmissible on the ground that it had no interest in bringing proceedings.

The system of registration of Community designs is based on the principle that all applications complying with formal requirements are entered in the Register of Community Designs. The corollary

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of that principle is that it is only following a design invalidity application concerning a Community design, which has been registered, that that design may be declared invalid, if use is made of an earlier distinctive sign, on application by the holder of the right to that sign (§ 27 35).

Article 25(6) CDR allows the registration of a Community design to be maintained where the inadmissible element is removed. That possibility, as an alternative solution to the invalidity of the design in its entirety, constitutes an adjustment of the sanction provided for in order to ensure proportionality. Article 25(6) CDR, insofar as it advocates the maintenance of a design which has been the subject of a design invalidity application under Article 25(1)(e) CDR, is intended to protect the interests of the holder of the right to that design. Similarly, to the extent to which such maintenance is conditional on a partial disclaimer, following the annulment of the design in question, pursuant to Article 25(1)(e) CDR, Article 25(6) CDR is also intended to protect the interests of the holder of the right to the sign the use of which has led to the design being annulled in its original form (§ 39).

The ID ruled on two applications, namely the design invalidity application brought by 4B Company, which was upheld, and the application of the holder of the contested design, which had in the meantime become the successor to A's rights, which was dismissed (§ 46). That part of the decision of the

ID rejecting the entry of the contested design in an amended form cannot therefore be regarded as a decision granting an application made by 4B Company (§ 52).

In those circumstances, the decision of the ID could be the subject of an appeal only by the party whose claims had not been upheld, namely Deenz Holding (§ 53). The BoA also upheld 4B Company's appeal (§ 56). Therefore, the action brought before the GC by 4B Company cannot confer an advantage (§ 58).

Moreover, 4B Company cannot seek the annulment of the contested decision insofar as that decision upheld the application for the contested design to be maintained in an amended form (§ 59). To allow such a possibility would amount to allowing 4B Company to interfere in the part of the proceedings concerning the application of the holder of the right to the contested design, going beyond the proceedings which 4B Company had initiated, which concerned a design invalidity application based on Article 25(1)(e) CDR (§ 60). In its action, 4B Company claims the infringement of Article 25(6) CDR, whereas its design invalidity application had been based on Article 25(1)(e) CDR. Thus, by the present action, 4B Company seeks to alter the subject matter of its design invalidity application and the grounds relied on in support of that application (§ 61).

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Finally, the fact that 4B Company would like to have the design declared invalid in its entirety, cannot constitute a vested and present interest in having that decision annulled (§ 66).

Consequently 4B Company has no interest in having the contested decision annulled. The action is dismissed as being inadmissible (§ 67).

13/10/2021, T-712/20, DEVICE OF ARROW WITH WING (fig.) / DEVICE OF ARROW WITH WING (fig.), EU:T:2021:700

Scope of the appeal — Substantial procedural violation — Legitimate expectations — Action dismissed

The applicant sought to register the EU figurative mark representing an arrow with wing. An opposition was filed in respect of all the goods and services.

The Opposition Division ('OD') rejected that opposition as inadmissible. The opponent brought an appeal against that decision and requested, in the statement setting out the grounds of appeal, that it be annulled in part insofar as it concerned only certain goods and services.

The BoA inferred from this that the applicant had withdrawn its appeal in respect of the other goods

and services covered by the mark applied for. The effect of that partial withdrawal was that the goods and services not mentioned in that statement no longer formed part of the opposition proceedings and that, as regards those goods and services, the rejection of the opposition had become final. Consequently, the BoA partially annulled the OD's decision in respect of the contested goods and services and referred the case back to it for a further examination of those goods and services.

In its judgment, the GC dismisses the opponent's action and provides clarification as to the scope of the examination carried out by the BoA in opposition proceedings. In that context, the case-law established in proceedings before the EU Courts concerning the relationship between pleas raised of the Board's own motion and the form of order sought in an action apply (14/11/2017, C-122/16 P, British Airways v Commission) § 89-90).

The BoA, in the context of an appeal relating to a relative ground for refusal of registration of a mark, which is brought against a decision of the OD, cannot adjudicate beyond the subject matter of the appeal brought before it (Article 47(5), Article 71(1), first sentence, and Article 95(1) EUTMR). The BoA, in accordance with the jurisdiction of the EU Courts under the system for governing judicial review proceedings, can only annul the decision of the OD within the limits of the submissions which an appellant set out in its appeal (§ 21).

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The BoA must examine of its own motion the pleas relating to the issues of law which have not been raised by the parties, but which concern essential procedural requirements, such as the rules on admissibility of an opposition (Article 27(2) EUTMR) (§ 22-24). Nonetheless, that power does not mean that the BoA has the power to modify of its own motion the form of order sought by an appellant in the appeal brought before it, since such an approach would disregard the distinction between the pleas in law and the form of order sought, the latter of which defines the limits of an appeal (§ 25). Thus, by examining of its own motion a plea relating to essential procedural requirements, the BoA does not go beyond the scope of the dispute before it or in any way infringes the rules of procedure relating to the presentation of the subject matter of the dispute (§ 26). However, it would be different if, following the examination of the decision forming the subject matter of the appeal, the BoA, on the basis of such an examination of its own motion, were to declare an annulment going beyond what was sought in the duly submitted form of order before it, on the ground that such an annulment was necessary in order to correct the unlawfulness found of its own motion in carrying out that analysis (§ 26).

The GC concludes that, in the present case, the applicant is not justified in claiming that the BoA should have annulled the OD's decision in its entirety, since the effect of that decision would

have been to rule outside the subject matter of the dispute as defined by the applicant itself (§ 29).

06/10/2021, [T 32/21](#), Muresko, EU:T:2021:643

Seniority — Articles 39 and 40 EUTMR — Conditions for the admissibility of the seniority claim — Action dismissed

The applicant is the proprietor of the EU word mark 'Muresko', which was registered on 12 September 2016 by the Office.

On 3 February 2020, with regard to that trade mark, the applicant brought before the Office a seniority claim in respect of identical Polish and German marks, in accordance with Article 40 EUTMR. Article 40(1) EUTMR provides that the proprietor of an EU trade mark who is the proprietor of an earlier identical trade mark registered in a Member State [...] for goods or services which are identical to those for which the earlier trade mark has been registered, or contained within them, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it was registered. The applicant did not dispute the fact that the registration of those national trade marks had expired, but relied on the fact that a seniority claim in respect of those marks had been accepted for another EU trade mark.

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The Office rejected the contested claim on the ground that the registration of the national marks had expired at the time that claim was filed.

The GC dismisses the action for annulment of the contested decision. It finds, for the first time, that an earlier national mark must be registered and in force on the date on which the seniority of that mark is claimed for an identical EU trade mark.

The GC adopts a literal interpretation of Article 40 EUTMR. Taking into account the various language versions, the wording of that article clearly states that the identical earlier national mark, the seniority of which is claimed for the EU trade mark, must be registered at the time the seniority claim is filed (§ 22-25).

That interpretation is confirmed by the context of Article 40 EUTMR, read in conjunction with Article 39(3) EUTMR. Once the seniority claim based on the identical earlier national mark has been accepted for the EUTM, the proprietor may let the first mark expire, while continuing to enjoy the same rights under the second mark as those which he or she would have had if the first trade mark had continued to be registered. Thus, the system of claiming seniority of a national trade mark following registration of an EUTM is based on the principle that the proprietor of the earlier national mark will not surrender that mark or allow it to lapse before the seniority claim which he or she has filed has been



accepted for the EU trade mark. This is based on the premiss that, at the date on which that claim is filed, the registration of the identical earlier national mark has not already expired (§ 27-29).

That interpretation is also consistent with the aim of the system of claiming seniority, which is to enable the proprietors of national trade marks and identical EU trade marks to streamline their trade mark portfolios while maintaining their earlier rights. The presumption that the rights attached to an identical earlier national mark will be maintained, which must be interpreted narrowly, is not to be applied generally, but only in favour of an identical EUTM and in respect of identical goods or services for which the seniority claim has been accepted and in the event of non-renewal of the registration of the identical earlier national mark. A seniority claim which has been accepted does not therefore have the effect of ensuring the survival of the earlier national mark concerned or even of merely maintaining certain rights attached to it separately from the EU trade mark for the benefit of which that claim was accepted (§ 30-31).

Therefore, although the applicant may rely on the presumption that the rights attached to the earlier Polish and German trade marks would be maintained after their expiry, for the benefit of another EUTM for which the seniority claim had been accepted before their expiry, it cannot, nevertheless, rely on that same presumption in support of the contested seniority claim for the EU trade mark at issue (§ 39).

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06/10/2021, T 342/20, **Abresham Super Basmati Sela Grade One World's Best Rice (fig.) / BASMATI, EU:T:2021:651**

Withdrawal Agreement of the UK from the EU — Transition period — Subject matter of the action — Interest in bringing proceedings — Admissibility — Action upheld (BoA decision annulled)

The applicant sought to register the EU figurative mark 'Abresham Super Basmati Sela Grade One World's Best Rice' for rice flour and other food products made of rice. An opposition based on the non-registered word mark in the United Kingdom, 'BASMATI', used to refer to rice, which, under the applicable law in the United Kingdom, would allow it to prohibit the use of the mark applied for was filed pursuant to Article 8(4) EUTMR.

By decision of 2 April 2020, the Board of Appeal ('BoA') rejected the opposition on the ground that the opponent had failed to prove that the name 'basmati' allowed it to prohibit the use of the mark applied for in the United Kingdom.

The GC annulled the decision of the BoA and adjudicated on the effects of the withdrawal of the United Kingdom from the European Union on pending cases relating to EU trade marks.



The withdrawal of the United Kingdom from the European Union has not rendered the dispute devoid of purpose (§ 16 23).

The withdrawal agreement, which sets out the arrangements for the withdrawal of the United Kingdom from the European Union, entered into force on 1 February 2020 and provides for a transition period from 1 February to 31 December 2020, during which EU law continues to be applicable in the United Kingdom (§ 16).

The decision of the BoA was taken on 2 April 2020, that is to say, during the transition period. Until the end of that period, the earlier mark continued to receive the same protection as it would have received had the United Kingdom not withdrawn from the European Union (§ 17 18).

Since the purpose of the action before the GC is to review the legality of decisions of the BoA, the GC must take into account the date of the contested decision when assessing that legality (§ 19). For the GC to find that the litigation becomes devoid of purpose following the withdrawal of the United Kingdom from the European Union would amount, for the GC, to taking into account matters arising after the adoption of the contested decision, which do not affect its merits (§ 20, 23).

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The opponent retains an interest in bringing proceedings. The interest in bringing proceedings must continue until the final decision, which presupposes that the action must be able to procure an advantage to the party bringing it (§ 25). The GC rejects the Office's argument that the trade mark applicant had no interest in bringing proceedings because, if the opposition were upheld, the applicant would be able to convert his mark into national trade mark applications in all EU Member States. Those considerations apply, in principle, to any opposition proceedings (§ 24-26). The GC finds that if it were to annul the decision of the BoA and refer the case back, the BoA would not be obliged to dismiss the action in the absence of an earlier trade mark protected by the law of a Member State. Following the annulment of a decision of the BoA, the BoA must take a new decision on that same action by reference to the situation at the time that the action was brought, since the action is again pending at the same stage as it was before the contested decision (§ 27).

The GC annuls the contested decision on the ground that the BoA misapplied the legal tests for the extended form of passing off under the law applicable in the United Kingdom, in that it ruled out the risk of misrepresentation and damage to the goodwill enjoyed by the term 'basmati' (§ 32-72).

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Cases referred to the Grand Board

20/08/2021, R 0798/2021-G, CRIADORES (fig.)

Revision – Article 69 EUTMR – No decision on application

On 20 August 2021, the Fifth Board of Appeal decided to refer case R 0798/2021-5, CRIADORES (fig.) to the Grand Board.

The case concerns the validity of a second decision refusing a trade mark application when, following the filing of an appeal against the first decision, the examiner granted revision pursuant to Article 69 EUTMR.

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

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the Fifth Board in the EUIPO OJ on 2 November 2021 (language of the proceedings: Spanish).

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29/09/2021, [R 1650/2018-G](#), DARSTELLUNG EINER BAUMWOLLKAPSEL (fig.)

EUTM application



Certification mark – Withdrawal – Article 7(1)(b) EUTMR – Article 85 EUTMR – Article 66 EUTMR – Article 71(3) EUTMR – Without deciding on the merits

The appellant sought to register a figurative sign depicting a cotton boll as an EU certification mark for goods in Classes 17, 18, 22, 23, 24, 25 and 27. The examiner refused the application pursuant to Article 7(1)(b) EUTMR in respect of all the goods for which protection was sought. The appellant filed an appeal requesting that the examiner's decision be annulled. The case was referred to the Grand Board. Following the withdrawal of the appeal, the Grand Board took note of the withdrawal and declared the appeal proceedings closed.

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27/10/2021, R 1410/2019-5, MANUKA HONEY

Word mark – Certification mark – Article 85(1) EUTMR – Non-distinctive – Article 7(1)(b) EUTMR – Descriptive – Article 7(1)(c) EUTMR – Decision confirmed – Application rejected

The applicant sought to register the word mark 'MANUKA HONEY' as an EU certification mark for 'honey', in Class 30. The examiner refused the application on the grounds of Article 85(1) EUTMR and Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR. It was found that 'Manuka honey', being a dark honey made from the nectar of manuka tree flowers (manuka - a myrtaceous tree growing in New Zealand and also the southern part of Australia) described the kind of honey in question. Consequently, the sign was found descriptive, and lacked distinctive character in respect of 'honey' and was not capable of performing the essential function of a certification mark, which was to distinguish certified goods or services from goods and services that were not certified. The applicant appealed.

The Board first analyses the applicability of Article 7(1)(b) EUTMR regarding certification marks filed in accordance with Article 83 EUTMR. The Board indicates that the wording of Article 85(1) EUTMR ('... in addition to the grounds for refusal of an EU trade

mark application provided for in Articles 41 and 42 EUTMR...') already literally implies that the absolute ground for refusal under Article 7(1)(b) EUTMR is applicable to certification marks. A systematic interpretation arrives at the same conclusion. Article 83(1) EUTMR defines an EU certification mark as an EU trade mark with certain characteristics. Thus, the definition of EU trade marks and the requirements for obtaining an EU trade mark also apply to EU certification marks. Moreover, EUTMR provisions on EU certification marks do not contain any *lex specialis* concerning Article 7 EUTMR. In particular, whereas Article 74(2) EUTMR includes an explicit derogation from Article 7(1) EUTMR for EU collective marks, such a derogation does not exist for EU certification marks. Finally, the provisions of Article 4(a) EUTMR, Article 7(1)(b) EUTMR, Article 74(1) EUTMR and Article 83(1) EUTMR all refer to the distinguishing function as the key element for defining EU trade marks, be it ordinary trade marks, collective marks or certification marks. The Board thus concludes that Article 7(1)(b) EUTMR is applicable to EU certification marks. At the same time, with regard to the assessment of inherent distinctiveness of an EU certification mark, the Board acknowledges that exactly the specific function of an EU certification mark to distinguish goods or services which are certified by its proprietor in respect of specific characteristics from goods and services which are not so certified, may also have an impact on the perception of that type of trade mark on part of the relevant public.

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Certification marks are normally used side by side with ordinary marks on the product, its packaging or in advertisements. The public is used to the fact that certification marks often (but not necessarily) have the form of a logo or seal, allude to the certified characteristics or include words such as 'certified', 'tested', 'controlled', 'verified', 'accepted', 'approved' etc. Sometimes, the association responsible for the certification programme (Article 83(2) EUTMR) is also mentioned in the logo or seal. Therefore, the different functions of ordinary marks on the one hand and certification marks on the other hand and the different perception of those two types of marks by consumers may lead to a different assessment of the minimum degree of inherent distinctiveness. Thus, one and the same sign might be devoid of any distinctiveness under Article 7(1)(b) EUTMR when filed as an ordinary trade mark and, at the same time, meet the threshold of sufficient inherent distinctiveness under Article 85(1) EUTMR in combination with Article 7(1)(b) EUTMR when filed as a certification mark.

As to the capability of the sign at issue to perform the function of a certification mark, the Board agrees with the examiner that at the time of filing the application, in October 2017, at least a significant part of the English-speaking public understood the term 'Manuka honey' as referring to a honey made from the nectar of manuka tree flowers. Thus, the term 'Manuka honey' simply refers to a type of honey, just as 'Pinetree honey' or 'Acacia honey'.

As a purely generic indication, it does not fulfil the primary function of a certification mark, namely to distinguish certified honey from honey which is not so certified. Thus, the protection for the mark was rightly refused pursuant to Article 85(1) EUTMR in conjunction with Article 7(l)(b) EUTMR and Article 7(2) EUTMR. The Board emphasises that, even if one took the view that the public in the UK should not be considered anymore following its departure from the EU on 1 January 2021, the perception of the sign on part of the UK public in October 2017 when the application was filed is still relevant for the examination of this sign. The Board considers in this regard that, if the consumers in the UK perceived the sign in a certain manner it is highly likely that the public in Ireland had the same perception because of the strong economic, cultural and geographic bonds between those two countries. As regards the applicant's claim that 'Manuka honey' has very specific certifiable characteristics and that certification marks by their very nature often refer to the certified characteristics, the Board indicates that it is not denied that a specific type of food product like honey made from the nectar of a certain plant may be, in principle, certifiable. However, it is important to distinguish between marks which allude to certain characteristics and those which plainly describe them. The word sequence 'Manuka honey' belongs to the latter group: it is exclusively descriptive of the kind of honey and therefore does not function as a certification mark. In particular, there is no link between the meaning of the sign

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and any certification. The mere indication of certain characteristics must be kept for all competitors even if there might be alternative expressions to refer to those characteristics. Consequently, the Board dismisses the appeal and remits the case to the examiner for further examination of the subsidiary claim based upon Article 7(3) EUTMR and Article 2(2) EUTMIR.

27/09/2021, R 1867/2018-5, Zsolnay / ZSOLNAY 1853 (fig.) et al.

Bad faith – Article 59(1)(b) – EUTMR Belated evidence – Article 95(2) EUTMR – Decision confirmed – EUTM cancelled

An application for a declaration of invalidity of the EUTM was filed for all the goods and services in Classes 19 (building materials), 41 (organisation and conduction of events, congresses and conferences) and 43 (services in relation to hotels, restaurants and the rental of meeting rooms and furniture) on the grounds of Article 59(1)(b) EUTMR (bad faith) and Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR (likelihood of confusion). The Cancellation Division declared the EUTM invalid in its entirety on the grounds of Article 59(1)(b) EUTMR. It held that the EUTM proprietors applied for the registration of the contested mark in bad faith. It was established that, at the time of the filing the application, the sign 'ZSOLNAY' had a reputation with regards to

porcelain and ceramics, based on it being part of the *Hungarikum* (a collective term for excellent achievements of the 'Hungarians' that stands for distinguishable, high-quality values). It was held that despite the EUTM proprietors being part of the Zsolnay family, they had not pursued legal purposes by registering the contested EUTM.

The Board confirms the contested decision. First, it holds that, against the submissions of the EUTM proprietors, the belated evidence proving that the EUTM proprietors were minority shareholders of the cancellation applicant's entity in 2014 can be accepted in accordance with Articles 95(2) EUTMR and 27(4) EUTMDR, since this evidence is prima facie relevant for the proceedings and it was impossible for the cancellation applicant to submit it earlier since the EUTM proprietors, for their part, only contested this fact at the appeal stage. Second, the Board holds that the EUTM proprietors acted in bad faith when filing the contested EUTM. The Board emphasises that account must be taken of all the relevant factors specific to the particular case which obtained at the time of filing the application for registration of a sign as an EU trade mark (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361). This includes factors such as the commercial logic underlying the filing of the application for registration of that sign as an EU trade mark and the chronology of events leading up to that filing. In the case at hand the commercial logic in the sense that the EUTM proprietors planned to genuinely use the mark for

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the registered goods and services is held to have been missing. Furthermore, based on their position as minority shareholders of a small corporation at the time of filing, the EUTM proprietors had special fiduciary duties with regard to the cancellation applicant. Since the EUTM proprietors also took part in general assemblies and had access to privileged information about the cancellation applicant's company and its plans, the EUTM proprietors knew that by registering the trade mark they would significantly harm the interests of the cancellation applicant. It is established that the contested EUTM is identical to the traditional and well-known brand 'ZSOLNAY' in Hungary. The Board concludes that the EUTM proprietors applied for the registration of the contested EUTM 'ZSOLNAY' in order to unduly block future activities of the cancellation applicant under the mark 'ZSOLNAY' for related goods and services. Thus, they filed the contested EUTM in bad faith, not acting in compliance with the customary practices in trade and commerce.

25/10/2021, R 555/2021-5, Nextcar / CarNext (fig.) et al.

Likelihood of confusion – Article 8(1)(b) EUTMR – Similarity of the goods and services – Common element – Visual similarity – Phonetic similarity – Conceptual identity – Figurative element – Decision confirmed – Opposition partially rejected



Earlier marks



Contested sign

NEXTCAR

The applicant sought to register the word mark 'NEXTCAR' as an EUTM for franchising services, vehicle rental services and for related services in Classes 35, 36, 39 and 42. An opposition was filed on the grounds of Article 8(1)(b) EUTMR. It was based on several earlier rights for the figurative mark, as depicted above, all registered for services in Classes 35, 37 and 39, mainly for retail, maintenance and rental of vehicles. The Opposition Division partially upheld the opposition on the grounds that there was a likelihood of confusion for all the contested services in Classes 35 and 39. Both the opponent and the applicant appealed.

The Board confirms the contested decision. It finds, first, that the services concerned are directed at the public at large and at business customers with an

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average to high degree of attention. The services in Class 35 are partly identical or partly similar, and in Class 39 they are identical, whereas in Classes 36 and 42 they are dissimilar. In this respect, the Board notes that the comparison of the goods or services does not relate to a question of law, but to a question of fact (15/10/2020, T-788/19, Sakattack, EU:T:2020:484, § 124) with the result that the party concerned must provide facts, arguments and evidence supporting its position that the comparison of the [goods or] services carried out by the Opposition Division is wrong. In the present case, the opponent did not provide sufficient facts, arguments and evidence to support its relevant arguments regarding the similarity between the contested services in Classes 36 and 42 with the ones covered by the earlier mark in Class 35. Next, as regards the signs at hand, the Board confirms that the combination of the comprehensible individual elements 'next' and 'car' merely creates a combination that is suggestive. It is not promoting a clearly and immediately positive aspect of the services. The sign 'NEXTCAR' plays on the meaning of 'Next' as an allusion to the 'future', in the sense that it can be used as an adjective to mean 'immediately following'. However, the combination of 'next' and 'car' does not convey this message in a clear and unambiguous way. Therefore, the word combination is distinctive. This applies even more so to the differently ordered word combination in the earlier trade mark 'CarNext'. The Board confirms that the conflicting signs are visually and aurally



similar to an average degree and conceptually identical. Since the conflicting services are partly identical or partly similar and the signs consist of two identical elements, 'next' and 'car', reversing the order of the elements and figurative elements of the earlier mark are not sufficient to exclude a likelihood of confusion.

05/11/2021, R1993/2019-5 X (fig.) / X (fig.)

Earlier mark



Contested sign



Figurative mark - Dissimilarity of signs - Likelihood of confusion - Article 8(1)(b) EUTMR - Decision confirmed - Opposition rejected

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The applicant sought to register the figurative mark depicted above for, inter alia, services in Class 35 related to advertising, business management, business administration, office functions, retail sale and wholesale and the services of a retail store in all online media (internet), mobile, wireless or remote (correspondence, teleshopping) in relation to apparel (clothes), supplemental clothing, shoes, accessories for footwear, headgear, sunglasses and accessories, gear and equipment, sports bags, all-purpose sports products and accessories for sports and fitness. An opposition was filed on the grounds of Article 8(1)(b) EUTMR based on an EUTM for the figurative mark, as depicted above, registered in respect of a wide range of services in Class 35. The Opposition Division rejected the opposition in its entirety, finding that the differences between the conflicting signs were sufficient to exclude any likelihood of confusion, even assuming that the services were identical.

The Board confirms the contested decision. As regards the relevant public, the Board considers that only the contested retail services or services typically rendered in the context of the retail sale of goods target both the public at large and professionals, whereas all the remaining services are aimed at the professional public whose level of attention will be high. As regards the comparison of the services concerned, the Board takes the same approach as the Opposition Division, assuming that the respective services are identical which is the best case scenario for the opponent. As to the conflicting

signs, the Board confirms that a non-negligible part of the relevant public will perceive the earlier mark and the contested sign the contested sign as a stylised letter 'X'. The Board finds that visually the signs are similar to a low degree and aurally they are identical, although this identity is not decisive in respect of the services in Class 35. As to the conceptual perception, the Board, referring to the Grand Board decision of 26/03/2021, R 551/2018-G, Device (fig.) / Device (fig.), finds that in the present case, since the services at issue do not concern mathematics and information technology where the letter 'X' has a specific meaning, it can be considered that no concept will be associated with the letter 'X' per se (apart from the fact that both signs represent the same letter of the alphabet). Consequently, for the relevant public perceiving the signs as the stylised representation of the letter 'X', which may serve to describe the semantic content of the signs at issue, this is not sufficient to establish their conceptual similarity (26/03/2021, R 551/2018-G, Device (fig.) / Device (fig.), § 89). The Board emphasises that the fact that the signs are short, which allows the relevant public to perceive the differences between them more easily, is an important factor which must be taken into account (25/01/2017, T-187/16, Litu / Pitu, EU:T:2017:30, § 32). The aural identity is not decisive, since the services concerned are generally not ordered orally. The Board also takes account of the fact that the level of attention of the relevant public will be high for many of the services concerned. In those circumstances it is concluded that a likelihood of confusion between the signs can be excluded, even if the services may be identical.

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26/10/2021, R 1952/2020-1, Syrena

Proof of use – Nature of use – Time of use – Burden of proof – Decision partially annulled – Revocation partially rejected

An application for a declaration of revocation of the EUTM was filed based on non-use pursuant to Article 51(1)(a) of Regulation No 207/2009 in respect of the goods in Classes 9 (computer and video game programs and software), in Class 12 (motor vehicles for locomotion by land and parts thereof) and in Class 28 (games and playthings, model vehicles; scale model vehicles made of all materials). The Cancellation Division revoked the EUTM for all the goods except for 'cars' in Class 12. Both the EUTM proprietor and the cancellation applicant appealed. The Board dismissed both appeals. The decision was appealed before the General Court by the cancellation applicant, who sought the General Court to annul the Board's decision insofar as it declared that the contested mark should be maintained in respect of 'cars' in Class 12. By its judgment of 23/09/2020, T-677/19, Syrena, EU:T:2020:424, the General Court annulled the Board's decision to the extent that it maintained the registration of the contested mark in respect of 'cars' in Class 12 other than 'racing cars'. In particular, the General Court observed that the Board had considered that genuine use of the mark had been established with respect to 'racing cars', 'sports cars' and 'electric cars', and proceeded to examine the merits of the Board's findings in respect of each of those categories, taken separately. The General Court found that the Board was correct in finding genuine use in respect



of 'racing cars', however the Board's decision was vitiated by inadequate reasoning insofar as it took the view that genuine use had been established in respect of 'sports cars'. Moreover, the General Court held that the Board was wrong finding genuine use for 'electric cars'.

The Board qualifies the scope of appeal as consisting in the examination of the revocation action against the contested mark with respect to 'sports cars', for which the General Court found that the Board's findings in its preceding decision had been vitiated by inadequate reasoning. Having regard to all the materials submitted by the EUTM proprietor, the Board takes the view that the evidence does not show that a sports car, that is to say, a low, fast car for use both in motor sports, as well as on public roads, was about to be marketed within the relevant period. As established by the General Court, the criteria relating to racing cars, without appropriate arguments, do not necessarily apply to sports cars. They are not intended for a market as specific as racing cars, which are high-end bespoke collectable goods that may require many hours of work well after the sale has been concluded. It is not therefore possible to determine the genuine use of the contested EUTM during the relevant period for the subcategory of 'sports cars', or to regard the mark as used in order to create or preserve an outlet for 'SYRENA' sports cars. The Board recalls that genuine use cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned. Such evidence has not been

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adduced in the present case. Inasmuch as the EUTM proprietor argues, as proper reasons for non-use, that having regard to the lengthy approval process, the requirement of use within the time-limits set out by the EUTM Regulations can only be fulfilled by major car manufacturers, the Board refers to EU legislation which envisages specific exceptions for small-volume manufacturers such as the EUTM proprietor (Directive 2007/46/EC of the European Parliament and of the Council of 5 September 2007 establishing a framework for the approval of motor vehicles and their trailers, and of systems, components and separate technical units intended for such vehicles, OJ L 263, 9.10.2007). Moreover, the length of any administrative proceedings and testing may, at least to a certain degree, depend on whether or not the party involved cooperates swiftly with the authorities, meets all the obligations prescribed by the procedural and substantive law (including technical norms and protocols), files complete submissions and avoids deficiencies. The Board takes the view that the obstacles described fell within the responsibility of the proprietor of the contested mark and could not therefore be regarded as obstacles independent of that proprietor's will. There is nothing to support the inference that the launch of the approval process was imminent. Consequently, as confirmed by the General Court, the Board concludes that the contested EUTM has been used for 'racing cars' only. Genuine use of the contested EUTM in respect of 'sports cars' has not been established. Furthermore, proper reasons for non-use in respect of the relevant subcategories of 'cars' in Class 12 have not been demonstrated to a requisite legal standard. Consequently, the cancellation applicant's appeal is upheld in part.



26/10/2021, R 811/2021-3, **Applicators for subcutaneous implants**

Prior design



Contested design



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Disclosure within the EU – Individual character – Article 6 CDR and Article 7(1) CDR – Decision annulled – RCD invalidated

The design holders registered a Community design for 'Applicators for subcutaneous implants'. The invalidity applicant claimed that the design lacked novelty and individual character and that consequently it should be annulled pursuant to Articles 5 and 6 CDR. In support of its claims, it notably provided extracts of posts from social media accounts.

The Invalidity Division rejected the design invalidity application considering that the invalidity applicant had failed to submit sound evidence of the disclosure of its design. Since disclosure was not demonstrated, the Invalidity Division did not assess the contested design's alleged lack of novelty or individual character.

The Board annuls the contested decision and declares the contested design invalid. The Board recalls that disclosure must be demonstrated by means of solid and objective evidence which must be considered in its entirety. The Board further indicates that in order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information which that document contains. In this regard, as a matter of principle, the appearance of a picture of a prior design on the internet can serve as disclosure



unless this event cannot reasonably be known in the course of trade by specialists in the sector concerned operating in the European Union. Information disclosed on the internet is considered to be publicly available as of the date the information was posted. In the present case, extracts of the posts from the Instagram accounts contain the images of the prior design. All extracts contain their source of origin (the URL address), the dates of the posts, and the number of 'likes' or 'views'. It can be inferred from this that the product was made available to the public before the filing date of the contested design. It further appears from the content that the Instagram accounts are commercial ones that aim to inform potential customers about new products and events, which confirms that the prior design was publicly disclosed by means of, inter alia, Instagram posts. Consequently, the Board considers that disclosure of the prior design was demonstrated. The Board has examined the designs under comparison and notes that they coincide in their overall structure of an elongated pen-like shape, with the same blue/white colours. They only differ in an additional blue rectangular button in the lower section of the contested design. This difference is not sufficient to produce a different overall impression on the informed user. Therefore, the contested design lacks individual character and is declared invalid.

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We continue with the series of summaries of interesting decisions in the area of cancellation.

13/08/2021, **C 41 642 (INVALIDITY), BOSS HOSS CYCLES (fig) / Boss Hoss Cycles (fig)**

Earlier US trade marks

BOSS HOSS;
BOSS HOSS COUNTRY (word marks)



(figurative marks)

Contested IR designating EU



(Figurative mark)



Invalidity – Article 59(1)(b) EUTMR – Bad faith, Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR - Unauthorized filling by agents of the TM proprietor, Assignment Article 21(a) and (2)(a) EUTMR – Cancelled

The Applicant is a manufacturer of motorcycles, trikes, accessories and clothes and owner of several trade mark registrations in the USA. The Registrant of the contested trade mark is the owner of a German entity. The parties had concluded in an 'Agreement' that the Registrant was allowed to act as an importer. However, the Applicant discovered that the importer registered, in its own name, a very similar international trade mark registration designating the EU. Therefore, the applicant filed a request of declaration of invalidity on the grounds of Article 59(1)(b) and Article 60(1)(b) in conjunction with Article 8(3) EUTMR and requested the assignment of the EUTM in accordance with Article 21(1) and (2)(a) EUTMR.

The Cancellation Division recognized the commercial relationship between the parties, on the basis of the Agreement and other evidence submitted, and concluded that the importer was indeed, an 'agent' of the proprietor. Therefore, the Cancellation Division had to verify if the other criteria of Article 8(3) were fulfilled. Although the wording of this Article is

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broad enough to include tacit or implied consent, the Cancellation Division concluded that, if the Agreement enabled the importer to use the trade marks, the importer did not have a clear, specific and unconditional permission for filing the trade mark. The contested trade mark was thus filed, without the consent of the proprietor, by an agent who failed to justify his acts. Since most of the goods at hand were found similar, if not identical and one of the earlier rights invoked was identical to the contested registration, the criteria of Article 8(3) EUTMR were fully met. The Cancellation Division applied in this case, the rarely invoked Article 21 EUTMR and the IR was partially assigned to the applicant, in relation to part of the goods of the contested mark which are closely related or equivalent in commercial terms.

Furthermore, all the above mentioned factors were also sufficient to prove the dishonest intention of the importer, and that he acted against honest business practices. The Cancellation Division concluded there was bad faith and, declared the IR invalid for the remaining contested goods on the grounds of Article 59(1)(b) EUTMR, as far as the goods not covered by the assignment are concerned and which were considered dissimilar.

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