

# Alicante News

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Up to date information on IP and EUIPO-related matters



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### A lawyer in the kitchen: food and IP law

By Eleonora Rosati

English author Virginia Woolf famously stated: ‘One cannot think well, love well, sleep well, if one has not dined well.’

When we buy the ingredients needed to prepare our meals, we want to make food that we like and which our dinner guests will also enjoy. Certain places, regions, and countries conjure up an intrinsic relation to the tastes and recipes they are famous for: [Parmigiano Reggiano](#) ‘screams’ Italy in the same way as we associate [Armagnac](#) with France and [Dalmatinski pršut](#) with Croatia. When we reminisce, we all have foods that, over the years, have forged a deep link to our loved ones, including parents and grandparents.

In short: food takes up a substantial part of our time and plays a significant role in shaping our life and, with that, also our identity. But how does intellectual property (IP) law protect it?

#### IP and food: a *tour d’horizon*

Food and drinks can be protected through IP law in different ways.

Starting with trade secrets, the best-known example of a secret recipe probably remains that of Coca-Cola. First developed in 1886, more than 135 years later, the 7-ingredient recipe of the famous beverage is still – officially – a mystery. Despite that, over time, [attempts](#) have been made to unveil such a recipe. It is believed that solely two Coca-Cola top executives know exactly how the various ingredients are to be combined.

Patents and copyright are also available. The method for manufacturing Dutch Heksenkaas (‘witch’s cheese’) was patented in 2012. This cheese spread was also at the centre of [litigation](#) before the Court of Justice of the European Union (CJEU), which famously had to decide whether the taste of a food product (so not the recipe, which may be safeguarded in the same way as a book or poem) could be protected by copyright in itself. The CJEU ruled that, in principle, ‘sensory’ objects like taste and smell are not excluded from copyright. What is needed, however, is a system that allows to identify a taste or smell in a precise and objective manner. Such a system does not seem to be available just yet, but it might well be developed in the future!

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Issues similar to those of copyright have been also faced by those trying to register smells and tastes as trade marks: over time, the EUIPO has famously rejected applications to register ‘[the taste of artificial strawberry flavour](#)’ and ‘[the smell of vanilla](#)’. The CJEU has also confirmed that a smell simply described as ‘[balsamically fruity with a slight hint of cinnamon](#)’ could not be registered as a trade mark.

### **Geographical indications (more and more) on the rise**

In all this, [geographical indications](#) (GIs) are deserving of a special mention. By indicating that a product – e.g., a certain food or wine – has a specific geographical origin, a GI essentially protects the reputation or qualities of that product as stemming from its place of origin.

For example, when you buy some [Danablu](#) cheese at your local grocery store, you know that you are acquiring a product with certain features as this is a protected GI. This means that the use of that name is reserved for cheese makers that produce their cheese in Denmark, from Danish milk, and in accordance with set specifications.

The same goes for several other food products and wines that are produced across the EU territory: besides [Parmigiano Reggiano](#), [Armagnac](#) and [Dalmatinski pršut](#) and just to mention but a few,

[Δαφνές](#) (‘Dafnes’ wine from Greece), [Budapesti téliszalámi](#) (salami from Hungary), [Clare Island Salmon](#) from Ireland, and [Драгоєво](#) (‘Dragoevo’ wine from Bulgaria) are all registered GIs.

Over time, the importance of GIs has increased, also because this particular IP right is [considered instrumental](#) to the realisation of objectives that include the preservation of the agrifood system and related social networks, as well as economic, sociocultural and environmental sustainability and the protection of cultural heritage. It is also for these reasons that, recently, the European Commission [proposed legislation](#) that would establish an EU system to protect, as GIs, not just agricultural products, but also craft and industrial products.

### **A buffet of IP rights**

There are several ways to protect foods and wines through IP law and, with that, safeguard the expertise, skills, and talent that are embodied in them. GIs also offer a way to acknowledge the special link between a place and the qualities and reputation of agricultural products originating from there.

Going back to Woolf’s quote: it is true that ‘One cannot think well, love well, sleep well, if one has not dined well’. Sometimes, however, this is not enough.

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To dine well, it may be also necessary to think about the IP rights that protect what one is about to eat and drink. In sum: dinner parties can, on occasion (or even always?!), become more enjoyable when you have an IP lawyer sitting at your table!

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

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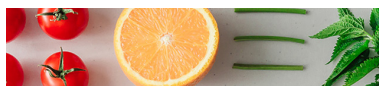
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### Alicante News: New year, new format

Our monthly newsletter, **Alicante news**, will soon have a new style and format.

Following the [survey launched earlier this year](#), the feedback received was analysed and a proposal was put forward to improve the quality and format of Alicante News, currently a downloadable PDF document.

From the team behind Alicante News, we would like to thank you – our readers – for your responses and participation in the survey. Alicante News would not be possible without you!

As of February 2022, Alicante News will have a refreshed style and all content will be available at a glance in the email newsletter, so you can click on the information that you are interested in. Stay tuned for more details in the next edition.

#### The survey results

The survey ran from 1 March to 15 April 2022 and the feedback received was used to better understand your interests and preferences while, at the same time, develop a proposal to enhance the newsletter.

Among the main findings, we learned that...

- 85 % of respondents read Alicante News on a computer, 20 % in print and 20 % on a mobile device (answers were not mutually exclusive).
- 80 % of respondents prefer to keep it monthly.
- The most-liked content is: case-law, EUIPO news and webinars.
- 85 % are satisfied or very satisfied with the content.

#### About Alicante News

[Alicante News](#) is the EUIPO's flagship monthly newsletter containing case-law summaries, as well as information on intellectual property law and practice and other related news. First launched as a printed publication called 'OHIM news' in 1996, it evolved into an electronic format in 2006 and currently has close to 6 500 subscribers from all over the world.

For any questions, you may contact us at [informacion@euipo.europa.eu](mailto:informacion@euipo.europa.eu).

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## Revision of Regulation and Directive on industrial designs

The [Designs Directive](#) and [Community Design Regulation](#), originally created twenty years ago, are currently being revised.

The revision aims to ensure that design protection is fit for purpose in the digital age and it is more accessible and efficient for individual designers, SMEs and design intensive industries in terms of lower costs and complexity, increased speed, greater predictability and legal certainty.

The European Commission adopted two (package) proposals for a revised [Regulation](#) and [Directive](#) on 28 November 2022 which, inter alia, aspire to:

- Modernise existing provisions to clarify rights in terms of scope and limitations
- Simplify and streamline the process of registering designs in the EU
- Adjust and optimise the level and structure of payable fees
- Harmonise procedures and ensure they complement national design systems
- Allow the reproduction of original designs for repair purposes of complex products (such as cars) with an EU-wide “repair clause”

### Background

The proposals follow the [Intellectual Property Action Plan](#), adopted in November 2020, which aims to revise the EU legislation on design protection. It reflects calls from stakeholders, the Council and the European Parliament requesting the modernisation of the legislation, while aiming to build on results of a comprehensive evaluation of the EU trade mark legislation reform.

### Next steps

The two proposals will now be passed to the European Parliament and the Council for adoption under the ordinary legislative procedure.

When the new proposals are adopted, the new rules of the Directive will be transposed into the national law within two years.

Regarding the Community Design Regulation, part of the changes will become applicable within 3 months after its entry into force, and the rest will when the delegated and implementing acts are enacted (18 months after entry into force).

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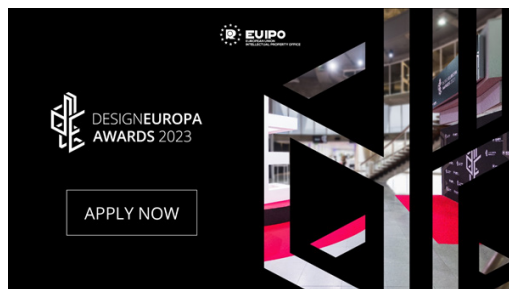
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## DesignEuropa Awards 2023 – the Berlin edition!



The 2023 edition of the [DesignEuropa Awards](#) will take place in Berlin, Germany.

[Berlin](#) was appointed a City of Design by UNESCO in 2006. Additionally, Germany is the second leading country protecting designs at EU level, having filed more than 14 000 registered Community designs (RCD) so far in 2022. This fourth edition of the DesignEuropa Awards will build on the success of previous editions which have taken place in Milan (Italy), Warsaw (Poland) and Eindhoven (the Netherlands).

Moreover, the DesignEuropa Awards 2023 **application period is now open**. If you are a designer or you represent a client that has registered an innovative design, you can submit your application or nomination via the [DesignEuropa Awards](#) website. The application period runs until 10 March 2023.



Organised every two years by the EUIPO, the DesignEuropa Awards give recognition to outstanding designs and industry pioneers who have registered their ideas and products as registered Community designs.

The [Awards categories](#) are:

- **The Industry Award:** For designs from large and medium-sized businesses.
- **The Small and Emerging Companies Award:** Aimed at designs from small companies as well as from recently established companies, regardless of their size.
- **The Lifetime Achievement Award:** Reserved for designers with a significant body of work, developed over the course of a career, who have had a considerable impact on the field of design.

The criteria to apply or nominate a design are:

- all designs submitted must be valid RCDs that are marketed and sold (in any country);
- all designs entered must be marketed by the owner of the RCD or a licensee;
- candidates may submit a maximum of five different entries (one RCD per entry), provided that each RCD has been designed by a different designer.

[Apply or nominate for a design now](#)

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## Practice tip: Acquired Distinctiveness

As distinctiveness acquired through use is not automatically considered by the EUIPO in trade mark applications, applicants must file a specific claim under Article 7(3) EUTMR if they seek to rely on it. The EUIPO is not bound to examine any evidence of distinctiveness acquired through use if it is not raised by the applicant, so it is important to be clear and precise in making this claim.

It is also essential to indicate the type of claim being made with regard to acquired distinctiveness (i.e. whether it is a principal or subsidiary claim). In a principal claim, the EUIPO takes a single decision on the distinctiveness of the mark. In this decision, it determines whether the mark has inherent distinctiveness, and then, if it does not, the EUIPO decides on whether the mark has acquired distinctiveness through use. In subsidiary claims, the EUIPO takes one decision on the inherent distinctiveness of the mark, and then, when that decision becomes final, it takes a subsequent separate decision on whether the mark has acquired distinctiveness through use.

The claim can be made, at the latest, in reply to the objection letter raised by the EUIPO. If the type of claim is not indicated, the EUIPO will send a deficiency letter requesting that the applicant provide this information. This prolongs the process.

To prevent delays, it is recommended you indicate the type of claim when requesting it. This will allow the EUIPO to proceed immediately to the decision stage.

For swiftness of proceedings in a principal claim under Article 7(3) EUTMR, the applicant should submit their reasoning and evidence together with the claim. However, in subsidiary claims, applicants can submit these after the decision on inherent distinctiveness has been taken.

For more information on claims for distinctiveness acquired through use under Article 7(3) EUTMR, please see the [Guidelines](#).

## Third-Party Observations in 2021

Thanks to Article 45 EUTMR, anybody can submit the so-called 'third-party observations' (TPOs), to inform the EUIPO why they consider that an EU trade mark (EUTM) application should not be registered on the basis of one of the absolute grounds in Article 7 EUTMR.

The EUIPO considers any TPOs it receives carefully. Those received before publication of the EUTM application are dealt with during the examination of absolute grounds for refusal. If they are received after publication of the EUTM, the EUIPO may decide that the examination of the corresponding EUTM application should be reopened.

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The following is a summary of the TPOs Annual Report 2021 compared with previous years.

## 1. TPOs filed

Only 0.16 % of all EUTM applications filed in 2021 received TPOs (see Table 1 below), representing 315 TPOs out of the 197 909 applications received by the EUIPO. This is the highest amount of TPOs received in the last 10 years. However, the percentage of applications for which a TPO was filed only increased slightly over 2020 (0.13 % to 0.16 %) and is still below average compared to 2012-2020.

Table 1. Comparison EUTMA/TPO filed

	Total EUTMAs	TPOs filed	%
2012	107 962	201	0.19 %
2013	114 413	232	0.20 %
2014	117 456	230	0.20 %
2015	130 407	191	0.15 %
2016	135 259	227	0.17 %
2017	146 409	216	0.15 %
2018	152 495	297	0.19 %
2019	160 408	289	0.18 %
2020	176 992	233	0.13 %
2021	197 909	315	0.16 %

Source: EUIPO, TPO database

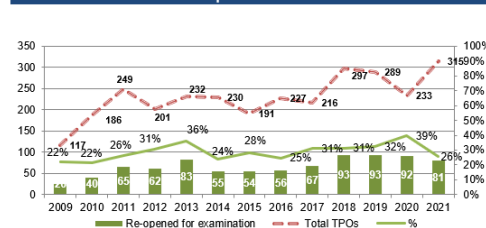
Regarding trade mark type, the majority of TPOs were for word marks (51 %) or figurative marks (46.3 %). This reflects the general trend in the type of mark selected by the applicants in their applications; with, in the same year, 56.7 % of applications for word marks and 42.88 % for figurative marks.

## 2. Reopened examinations based on TPOs

In 26 % of the TPOs filed (81 cases), the Office decided to reopen the examination of the application. This is a significant decline on 2020 figures (39 %). It is also below the average proportion of cases reopened over the last 10 years (30.3 %).

Chart 1 shows, in absolute numbers and relative terms, how many TPOs were filed per year, from 2009 to 2021 and how many led to the re-examination of the EUTM application.

Chart 1. TPOs that re-opened the examination 2009 - 2021



## 3. Geographic TPOs

Geographic TPOs concern protected geographical indication (PGI), protected geographical designation of origin (PDO) and 'simple' geographic terms.

These terms are mostly likely to be objected to on the basis of Article 7(1)(c) (descriptiveness) or 7(1)(j) (protection of geographical indications) EUTMR.

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Table 2. Geographic and Non-Geographic TPOs 2021

	Total TPOs	Geographic term	Geographic TPOs filed	Non-Geographic TPOs filed
2012	201	100	50 %	50 %
2013	232	102	44 %	56 %
2014	230	95	41 %	59 %
2015	191	128	67 %	33 %
2016	227	99	44 %	56 %
2017	216	95	44 %	56 %
2018	297	111	37 %	63 %
2019	289	109	38 %	62 %
2020	233	66	28 %	72 %
2021	315	61	19 %	81 %
Average			41.2%	58.8%

Source: EUIPO, TPO database

Table 2 shows that 61 TPOs referred to the use of a geographical term in 2021, representing 19 % of all TPOs filed. This is the lowest percentage ever recorded since 2009 and represents a steep decline from the average percentage of 41.2 % recorded in the last 10 years.

The downward trend in TPOs relating to use of geographical terms continues to improve every year. This reflects the EUIPO's efforts to make its practice clear on trade marks containing geographical terms, particularly protected geographical indications.

#### 4. TPOs filed based on Absolute Grounds

Data recorded in 2021 confirmed the trend of raising more than one ground in TPOs. 81 % of TPOs were based on at least two grounds, representing an 8 % growth rate on the previous year.

In 2021, in line with previous years, the three most invoked grounds from the EUTMR were:

- Article 7(1)(b) — 162 instances;
- Article 7(1)(c) — 158 instances;
- Article 7(1)(g) — 132 instances.

The chart below must be interpreted keeping in mind the changes implemented by the legislative reform in 2016. The following amendments to the existing EUTMR were made:

- the texts in Article 7(j) and (k) were merged into Article 7(j) to cover conflicts with protected geographical designations of origin (PDOs) and protected geographical indications (PGIs) irrespective of the agricultural sector;
- new grounds for refusal were introduced in the EUTM system: Article 7(1)(k) (protection of traditional terms for wine), (l) (protection of traditional specialities guaranteed) and (m) (protection of plant variety rights).

In relation to these new absolute grounds for refusal, 1 out of 5 TPOs were filed based on Article 7(1)(j). The Office received only 7 TPOs referencing Article 7(1)(k), and none based on Article 7(1)(l) or (m) EUTMR.

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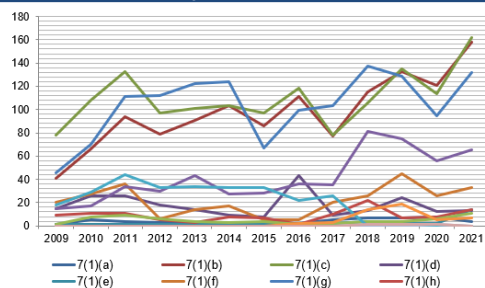
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Chart 2. TPOs per Absolute Ground 2009-2021



Source: EUIPO, TPO database

In conclusion, the number of TPOs received for examination by the EUIPO in 2021 increased significantly over the preceding year, but remains low in proportion to the overall number of applications filed. However, the number of examinations reopened based on TPOs filed (26 %) decreased significantly compared to the previous year and remains lower than the average reopening rate of 29 % over the period 2009-2021.

The trend of filing TPOs invoking multiple absolute grounds continues. In 2021, Article 7(1)(b), (c) and (g) EUTMR of the absolute grounds were most frequently invoked.

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## Poland and Italy join the IP Register in Blockchain

The addition of the Patent Office of the Republic of Poland and the Italian Patent and Trademark Office to the [IP Register in Blockchain](#) brings the total number of participating offices to six. By joining the EUIPO's blockchain initiative, the two intellectual property offices open the doors to new and innovative services to their users.

Blockchain technology improves speed while maintaining high quality data transfers. Data integrity and security are taken to another level opening the door to new services that improve connectivity between users and their IP rights and speed up the connection between IP offices.

Since 2021, the IP Register in Blockchain platform has created a fast and secure 'Data Transfer Service' between IP offices and the EUIPO's [TMview](#) and [DESIGNview](#), the two largest databases of trade marks and designs in the world.

The latest addition of Poland and Italy during the month of November will vastly increase the number of IP registrations in the register. Poland transferred more than 34 000 records to DESIGNview whilst Italy brought more than 1 101 000 trade marks to TMview.

This brings the IP register to [3.5 million records for trade marks](#) and [1.6 million records for designs](#). These records increased the IP register to a rough total of 5 100 000 records altogether.

The commitment and dedication of all participating offices is shaping and enabling the future of blockchain-powered intellectual property services.

## Artificial intelligence at the EUIPO

Artificial intelligence (AI) has great potential to drive innovation and transform lives for the better. It is already revolutionising industry and intellectual property, but it is also changing how we work, communicate and cooperate.

For these reasons, the EUIPO has put great efforts into laying the groundwork to reap the benefits of AI for itself and its customers by emphasising knowledge building and exchange in this area for staff, customers and partners.

AI is already used to great effect in some of the services offered by the EUIPO, such as [eSearch Plus](#) and [TMview](#), to the benefit of our customers.

Want to learn more about the fascinating world of AI? Here's a [roundup of the EUIPO's AI offering](#).

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## ACADEMY webinars

### Latest webinars

#### Blockchain in the EU and the IP sector

As we move beyond the blockchain hype, this webinar draws upon the EUIPO's experiences in several blockchain projects in the IP sector.

In this session you will learn where blockchain supports tangible use cases that have either been implemented or are being explored at the EUIPO.

If you are interested in understanding how blockchain might shape and deliver added value for the EU, and in particular for future IP services, this is the webinar for you.

#### The Metaverse - is it relevant for your (IP) strategy?

Many legal and technical issues have arisen (or will arise) in connection with the metaverse. Intellectual property issues are among the important ones. The metaverse is called to be the evolution of the Internet and will probably become one of the next communication channels in the form of a virtual reality space for users to interact and spend time

and where brands and companies will be present. Consequently, the metaverse will probably become part of your company's strategy.

During this webinar you will receive an insight into what the metaverse is, some of its more technical aspects, current existing platforms and its connection to emerging technologies such as blockchain or NFTs.

This webinar is for you if you are a user or future user of the European Union trade mark (EUTM) and registered Community design (RCD) systems with basic level knowledge in the field.

#### Track Case-law: Boards of Appeal decisions and GC/CJ judgments (2022 Q3 and Q4)

This webinar provides an overview of the most relevant judgments of the General Court and the Court of Justice of the EU as well as decisions of the EUIPO's Boards of Appeals.

The webinar, which is part of a series of webinars that take place every quarter, will keep you updated on all the latest EU trade mark- and design-related case-law developments.

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## Upcoming webinars

Our Tuesday Webinars will be back on 17 January 2023.

Thank you for your participation throughout the year!

## On recent case-law

In [R-0726/2021-3](#), the Boards of Appeal confirmed the invalidity of the registered design filed by PUMA in 2016, a viral Instagram post from Rihanna wearing those same shoes in 2014 was solid proof that the design had been disclosed before the priority date.

Power-up your knowledge on the requirements related to the disclosure of an invoked earlier design, by following our webinar on [Disclosure of earlier designs in RCD invalidity proceedings \(Article 7 CDR\)](#). Plenty of practical examples are discussed.

*For more on this or other developments in intellectual property law, take advantage of our extensive online learning offering in the [EUIPO Academy Learning Portal](#).*

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### Case-law comment: Breaking borders

**By Christoph Bartos, Member of the First Board of Appeal of the EUIPO**

This article reflects the views and opinions of the author, and not the position of the EUIPO.

**13/07/2022, T-768/20, The Standard, EU:T:2022:458**

Can use outside the EU constitute genuine use within the European Union? The General Court decides on this matter for the first time.

#### Background

In 2011, the Office registered an EUTM for various goods and services in Classes 18, 25, 38, 39, 41, 43 and 44, including hotel, restaurant, bar, cafe, cocktail lounge services; providing banquet and social function facilities for special occasions; catering services; personal valet services; providing meeting/convention room facilities for other type conventions.

In 2018, an application for revocation of the EUTM for all the goods and services was filed, on the grounds there was no genuine use in the European Union.

The Cancellation Division revoked the contested EUTM in its entirety with effect from 10 October 2018. The proprietor lodged an appeal that was dismissed.

The Board of Appeal reasoned that the evidence concerned hotel services and ancillary services provided by the proprietor in the United States. The Board of Appeal noted the following evidence:

- documents referring to advertisements;
- promotional campaigns targeting customers in the European Union;
- reservations made directly by customers and through travel agencies in the European Union;
- invoices addressed to customers residing in the European Union;
- a booking portal accessible to European Union customers;
- figures concerning traffic on the proprietor's website.

The Board of Appeal considered the evidence insufficient to prove that the contested EUTM had been put to use in the European Union because the hotel and ancillary services were outside European Union territory. It held that the nationality or geographical origin of the customers and the fact that the advertisements or the offers of service were intended for consumers in the European Union were irrelevant.

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### The analysis

'Genuine use' of a trade mark means that the trade mark is used in accordance with its essential function. This is to guarantee the identity of the origin of the goods or services for which it is registered to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the trade mark.

The evidence must refer to the place, time, extent and nature of use. However, the territorial scope of the use of the EUTM is not a separate condition for genuine use, but one of the factors determining that use, which must be included in the overall analysis and examined at the same time as the other factors.

While it is clear that use of an EUTM outside the EU cannot be taken into consideration, there is a distinction between the place where the services are rendered and the place of use of the mark.

The Board of Appeal held that since the services were rendered outside of the European Union, there was no use of the trade mark within the European Union. Therefore, the Board of Appeal did not assess the evidence in substance. It wrongly applied Article 59(1) EUTMR in conjunction with Article 18 EUTMR. The decision was therefore annulled.

As the Court cannot, in exercising its review of legality, assume the role of the Board of Appeal to undertake a factual assessment of the case, which the Board of Appeal did not do, the case is once again before the Boards of Appeal.

### Practical significance

For the first time, the General Court answered the question, 'Can the provision of services outside the European Union constitute genuine use in the European Union?'

Affixing a trade mark to goods in the European Union which are for export only, and will not be put on the internal market, may constitute genuine use, if the other factors are fulfilled. Equally, a trade mark that is affixed to goods which are imported into the European Union and put on the internal market may be considered genuinely used.

However, services can be neither exported nor imported. Services are provided at the place where the consumer 'enjoys' the service. This place is, however, not the only place where a trade mark is used. Services are used also in advertisements or other places to create or preserve an outlet for those services, as long as the advertising is done or the other actions take place within the European Union.

It is important to clearly establish that the goods and services were provided to consumers residing in the European Union, that the consumers in the European Union were exposed to the trade mark by publicity and that consumers in the European Union could order these goods and services.

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### Luxembourg trade mark and design news

19/10/2022, T-323/21, Kasite (fig.), EU:T:2022:650

#### Contested mark as registered

卡斯特

#### Sign as used



**No genuine use – Use not as registered – Trade mark representing Chinese characters used with verbal elements and figurative elements – Decision confirmed – EUTM revoked**

The contested mark representing three Chinese characters, registered for still wines in Class 33, was revoked by the Board of Appeal (BoA) on the grounds that it was used in a way that altered its distinctive character [Article 18(1)(a) EUTMR]. The General Court (GC) confirms the [BoA's decision](#).

Regarding the definition of the relevant public, the GC states that it consists of the general public, who would be unable to verbalise or memorise the Chinese characters forming the contested mark (§ 34). There is nothing in the wording of the trade mark application to suggest that the still wines are intended exclusively for customers of Chinese and Chinese-speaking origin. The mere fact that these Chinese characters may be identified by the Chinese-speaking public is not in itself sufficient to establish and define a particular category of consumers (§ 29).

The GC adds that, although the EUTM proprietor's commercial strategy consists of selling its goods mainly to Chinese restaurants in France, they are also sold through other commercial channels (§ 30). Moreover, the goods also target non-Chinese-speaking consumers who frequent Chinese restaurants (§ 31).

In relation to the nature of use, the GC finds that, since the relevant public will not be able to verbalise or memorise the Chinese characters represented in the contested mark, these characters will be

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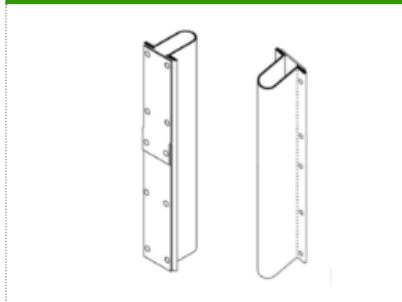
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perceived as meaningless, abstract signs or as decorative elements referring to China or to Asia (§ 47). Moreover, the contested mark appears on the product packaging and in advertisements in a very small print accompanied by the verbal elements 'DRAGON DE CHINE' and by the representation of a dragon. These added elements dominate the overall impression (§ 51). Therefore, the Chinese characters will be perceived as a decorative element rather than as an indication of origin (§ 52). As a result, the added elements alter the distinctive character of the contested mark as registered (§ 55).

19/10/2022, T-231/21, Posts, EU:T:2022:649

### Contested design



**Features not solely dictated by the technical function – Decision annulled – Application for invalidity rejected**



The contested design was declared invalid by the Board of Appeal (BoA) on the grounds that all the features of appearance of the product concerned had been dictated by its technical function [Article 8(1) CDR]. When assessing the considerations that had been taken into account when the contested design was created, the BoA relied on a patent application. The General Court (GC) annuls the [BoA decision](#).

The GC underlines that, in order to identify the product to which an RCD is intended to be applied, the indication that relates to that product in the design's application for registration should be taken into account, but also, where necessary, the design itself, insofar as it makes the nature of the product, its intended purpose, or its function, clear.

Moreover, EUIPO may rely, given the degree of difficulty of the design at issue, on other relevant material, and, inter alia, on data relating to intellectual property rights conferred previously in respect of the product concerned, such as patents (§ 28-30). However, because of its purely technical purpose, a patent application cannot automatically serve to rule out the possibility that considerations other than technical ones, for example visual considerations, might also have been taken into account in the creation of a design which is, moreover, represented in that document (§ 32).

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In this case, the GC notes that all the expert opinions provided confirm the important, or even preponderant, role that technical considerations played in the design process. However, they also refer to visual considerations having been taken into account in the creation of at least two of the three features of the contested design (§ 40).

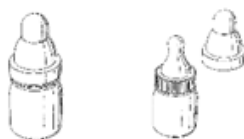
The GC recalls that, if at least one of the features of appearance of the product related to an RCD is not solely dictated by the technical function of that product, the design at issue cannot be declared invalid under Article 8(1) CDR (§ 43). Moreover, the existence of alternative designs, though they do not constitute evidence on their own, and in all cases, to prove that considerations other than technical considerations were taken into account in the creation of the design at issue, do constitute a relevant factor that may be taken into account. The existence of alternative designs may substantiate other items of evidence that have been provided, such as expert opinions (§ 45).

Furthermore, the fact that the product concerned is visible to the public is one of the objective circumstances that make it possible to prove that the product's appearance has not been solely dictated by its technical function, although, as with the existence of alternative designs, that circumstance cannot, on its own, suffice to prove that (§ 49, 53).

The GC concludes that due to the objective circumstances of this case and, in particular, the expert opinions, the existence of alternative designs and the fact that the product concerned is visible to the public and is very large, some features of the product concerned – a security fence post – were not solely dictated by the technical function of that product (§ 54).

**26/10/2022, T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK), EU:T:2022:675**

### Contested mark as registered



### Sign as used



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### **Genuine use – Use as registered – Joint use of a shape mark with a word mark – Distinctive character of a shape mark – Decision annulled**

The contested mark, registered for confectionery and candy in Class 30, was revoked by the [Cancellation Division](#) on the grounds that the sign had not been used as registered [Articles 18(1)(a) and 58(1)(a) EUTMR]. The Board of Appeal (BoA) confirmed the revocation. It found that the distinctive character of the contested mark was weak and that the additional figurative and word elements covering the sign as used altered the distinctive character of the mark as registered. The General Court (GC) annuls the [BoA's decision](#).

The GC notes that, first of all, it is necessary to examine whether the three-dimensional 'shape' of the contested mark differs from the form in which it was registered (§ 39). In the present case, the shape of the mark as used is identical to the shape as it was registered (§ 44).

The next step is to determine whether the addition of word and figurative elements may have led to use in a 'form' that differs from the contested mark as registered, albeit in elements that do not alter the distinctive character of the mark (§ 39).

Regarding the distinctive character of the contested mark, the GC states that the BoA erred in attributing it a weak distinctive character on the sole ground

that it consisted of a commonly shaped baby's bottle. The goods protected by that mark, such as candy and sugar confectionery, are entirely unrelated to babies' bottles. Furthermore, it is apparent from the evidence submitted that the mark is sometimes described as candy in the shape of a baby's bottle, and it is unusual in the relevant sector to designate candy by its shape. Therefore, the contested mark has an average degree of distinctive character (§ 61).

The GC recalls that a trade mark that is only used as part of a composite mark, or in conjunction with another mark, must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 18(1)(a) EUTMR (§ 75). The GC finds that the addition of 'BIG BABY POP!' and the few other figurative and word elements to the surface of the contested mark as used does not alter the form of that mark as the consumer can still distinguish the form of the three-dimensional mark, which remains identical in the eyes of that consumer (§ 80). Moreover, it is inconceivable from a commercial and regulatory point of view to sell the goods at issue in the way the contested mark is registered, without any label on its surface (§ 83). Therefore, the GC concludes that the additional figurative and word elements do not alter the distinctive character of the mark as registered (§ 88).

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09/11/2022, T 596/21, **Figurative mark / Wolf Jardin (fig.) et al.**, EU:T:2022:697

### Contested mark



### Earlier trade marks



**Comparison of signs - Perception of the figurative trade mark - Distinctiveness of the earlier marks - Decision confirmed - Opposition rejected**

The Board of Appeal (BoA) confirmed the Opposition Division's decision to refuse the opposition against the registration of the international trade mark designating the EU in relation to goods and services in Classes 4, 7, 8, 12 and 35, as it found no likelihood of confusion between that mark and the earlier trade marks pursuant to Article 8(1)(b) EUTMR. The General Court (GC) confirms the [BoA decision](#).

The GC agrees with the BoA's findings that each of the signs at issue represents a black drawing on a white background and that, while the earlier marks consist of the representation of the head of a canine, the shape exhibited by the contested sign is rather abstract, as a result of its clean curved lines, its sharp edges and the lack of figurative details. Therefore, the GC finds it unlikely that the average consumer, who normally perceives a mark as a whole and does not carry out an analysis of its details at the time of purchase, will be capable of spontaneously associating the contested sign with the head of an animal, or even with the head of a canine, without engaging in an analysis which goes beyond that expected at the time of purchase. In accordance with the BoA, the GC concludes that the overall impression created by the contested sign makes the identification of the head of an animal, let alone of a particular animal, highly arbitrary (§ 38, 39). Considering that the earlier signs evoke the concept of a canine's head, whereas the sign applied for is abstract, the signs do not, for the relevant public, convey the same idea (§ 46).

As regards the opponent's arguments that the earlier marks have a high degree of inherent distinctiveness because they do not convey any meaning in relation to the goods and services covered by them, the GC replies that the absence

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of any conceptual link between the mark and the goods or services covered by that mark does not automatically confer a high degree of inherent distinctiveness on the mark capable of providing broader protection (§ 58).

In reference to the opponent's argument that the GC had already held that 'the earlier mark has a highly distinctive character, both inherently and acquired through use', the GC notes that the BoA is not bound by a judgment of the Court that was delivered in the context of different proceedings, and which concerned different marks and goods and services that were, in part, different. If the opponent could simply rely on a previous decision of the GC relating to the same sign to demonstrate that that sign has inherent distinctiveness, this would firstly infringe the other party's rights of defence, to the extent that it could not examine, assess and challenge the facts on which the GC and the BoA had previously relied. Secondly, it would erroneously extend a judgment's principle of *res judicata* concerning parties other than the parties to the present proceedings, thereby impeding the review of the legality of an administrative decision by a judicial authority, which would clearly be contrary to the principle of legality (§ 66).



09/11/2022, T-610/21, K K WATER (fig.) / K (fig.),  
EU:T:2022:700

### Contested mark



### Earlier trade mark



### Visual and conceptual comparison of single letters – Distinctiveness of a single letter – The principle of interdependence

Contrary to the findings of the Opposition Division, the Board of Appeal (BoA) decided that a likelihood of confusion could not be ruled out for the relevant public given the identity of the goods (hair preparations, shampoos in Class 3). The General Court (GC), annuls the [BoA decision](#).

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The GC points out that in the case of very short elements consisting of single letters, it is more likely that the relevant public will perceive the graphic and stylistic differences. In this case, the stylisation and the arabesques of the letter 'k' of the earlier mark give it an air of movement or dynamism which is not present in the mark applied for (§ 36-37).

As regards the concept of single letters, the GC notes that no concept could be associated with the letter 'K' in relation to the goods at issue (§ 49). As regards the applicant's argument that a single letter only has a weak (or very weak) degree of distinctive character, and therefore, in the present case, it is only the very specific stylisation of the letter 'k' of the earlier mark that confers a 'minimum' degree of distinctive character on that mark, the GC replies that where a sign consists of a highly stylised letter or is accompanied by other relatively elaborate figurative elements, that sign may be recognised as having a normal degree of distinctive character. Given that the single letter 'k' lacks meaning in relation to the goods and it is highly stylised, the earlier mark is distinctive to a normal degree (§ 55, 57).

As the marks at issue have a low degree of visual and phonetic similarity and are conceptually different, and the relevant public has an average degree of attention, they will more easily perceive

the differences between the marks at issue (§ 62, 64). The GC therefore concludes that there would be no likelihood of confusion despite the identical goods.

It points out that a mechanical application of the principle of interdependence does not ensure a correct global assessment of the likelihood of confusion. A finding that amounts to recognising a likelihood of confusion between two signs, one consisting primarily of a highly stylised, single capital letter and the other consisting of the same capital letter but written with very different stylisation and combined with other word elements, would de facto amount to granting a monopoly over one capital letter of the alphabet for a specific range of goods. The Court has already had occasion to assess that risk, pointing out that the purpose of an opposition that has been brought on the basis of a sign consisting of a single letter is to prevent the registration of a trade mark that is likely to give rise to a likelihood of confusion with an earlier mark, 'in particular on account of its stylistic similarity'. In contrast, according to the Court, the purpose of the opposition is not to prevent the registration of a trade mark because it represents the same capital letter; nor is it to prevent the registration of all other trade marks consisting of this letter (§ 67, 68).

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19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.)

### Contested sign



**No distinctive character acquired through use - Figurative mark representing a pattern - Territorial aspects - Internet evidence in assessing distinctive character acquired through use - Awareness of luxury brands - Decision confirmed - EUTM cancelled**

The Board of Appeal (BoA) confirmed the Cancellation Division's decision that the contested mark was inherently devoid of distinctive character [Article 7(1)(b)EUTMR] for the goods in Class 18 and that the applicant had not demonstrated that the contested trade mark had acquired distinctive character through use [Article 7(3)(b)EUTMR]. The applicant appealed. The General Court (GC) annulled that [BoA decision](#). After rejecting the applicant's arguments seeking to challenge the lack of inherent distinctive character of the contested mark, the GC found that the BoA had infringed Article 59(2)

EUTMR since it had failed to examine all the relevant evidence submitted by the applicant to demonstrate the distinctive character acquired through use of the contested mark and to carry out an overall assessment of that evidence (10/06/2020, T 105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258). The case was remitted to the BoA which, after examining all the evidence submitted by the applicant, held that it had not demonstrated distinctive character acquired through use of the contested mark and dismissed the action. The applicant appealed again alleging infringement of Article 7(3) EUTMR and of Article 59(2) EUTMR. The GC confirms the second [BoA decision](#) in this case.

The GC notes that a mark that is, ab initio, devoid of distinctive character in all Member States, can only be registered pursuant to Article 7(3) EUTMR if it has been proved to have acquired distinctive character through use throughout the territory of the European Union (§ 24).

However, the GC also points out that for certain goods or services, economic operators tend to group several Member States together in the same distribution network, treating those Member States, especially for marketing strategy purposes, as if they were one and the same national market. When this happens, the evidence for use of a sign within such a cross-border market is likely to be relevant for all the Member States concerned. The same is true when, due to a geographic, cultural or linguistic proximity

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between two Member States, the relevant public of one state has a sufficient knowledge of the products and services that are present on the national market of the other (§ 27). For example, advertising campaigns may target several Member States or be broadcasted simultaneously in the media zone of those Member States (§ 65). Yet, the GC clarifies that the mere possibility that the relevant public in the Member States concerned may have been exposed to those advertising campaigns or exposed to the magazines published elsewhere, for example during travel to Member States where they had been distributed, cannot be considered relevant evidence for assessing the relevant public's perception in the Member States concerned (§ 70).

Regarding internet evidence, the GC states that with the growing importance of the internet in the course of trade, the relevant public's perception may, nowadays, be largely influenced by the presence and promotion of a brand in the virtual realm. This evidence, for example, the internet pages on which a mark concerned is displayed, promoted or marketed, may thus be likely to play an increasingly important role in assessing distinctive character acquired through use of a trade mark. However, to be relevant for that purpose, this type of evidence must demonstrate that it targets or is consulted by a significant part of the relevant public in the Member States in which the mark is, ab initio, devoid of inherent distinctiveness (§ 80). To that end, account should be taken, in particular, of the top-level

domains of the websites in question, their language and their content (§ 81), and traffic analysis reports (§ 82). The mere fact that a website on which the mark at issue was promoted is accessible in certain Member States is not sufficient to demonstrate that a significant part of the relevant public in those Member States has been exposed to it (§ 84).

Additionally, the GC clarifies that when it comes to luxury brands, the relevant public's awareness of them is not necessarily proportionate to the volume of sales of the goods bearing the marks. Even consumers in the general public who are unable to purchase luxury-branded goods are exposed to them and familiar with them. The fact that a trade mark is among the most well-known luxury brands may therefore, in principle, be relevant for the purposes of assessing the general public's perception of that mark (§ 47, 60, 126).

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26/09/2022, R 1241/2020 4, [Nightwatch](#)

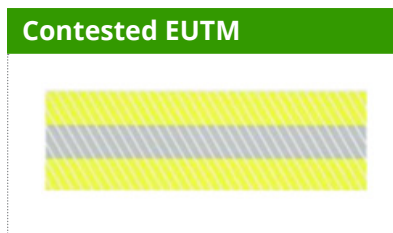
**Withdrawal during the appeal period – Conversion to national trade mark in a State where the grounds of refusal apply – Decision annulled – Request for conversion allowed**

The examiner refused the EUTM application for the word 'NIGHTWATCH' considering it to be descriptive and devoid of distinctive character for the English-speaking public. The applicant withdrew the application during the appeal period, without filing an appeal, subsequently requesting conversion of its EUTM application into a national trade mark application for, inter alia, the United Kingdom. The Register of the Office's Operations Department rejected the conversion request as regards the United Kingdom.

The Board of Appeal (BoA) annuls that decision. It concludes that, where an EUTM application is withdrawn during the appeal period, there is no final decision on refusal of the EUTM application. Therefore, the Office cannot apply Article 139(2)(b) EUTMR for conversion requests (according to which the applicant for, or proprietor of, an EUTM may request the conversion of their application or trade mark into a national trade mark application to the extent that the EU trade mark ceases to have effect).

Instead, they should apply Article 139(1)(a) EUTMR (which permits conversion of an EUTM application or an EUTM into a national trade mark application in the event that it has been refused, withdrawn, or deemed to be withdrawn). The BoA notes that there is no reason why an applicant should be required to file an appeal against the refusal decision to be able to file a conversion request. This would simply lead to a complication that is legally unnecessary. It would be detrimental to the economy of proceedings if a party to those proceedings were required to file an appeal simply to be able to request a conversion after withdrawing an application.

11/10/2022, R 1151/2018 1, [Device of two luminous yellow bands with a silver grey band between \(fig.\)](#)



**Characteristics necessary to obtain a technical result – Article 7(1)(e)(ii) EUTMR – Figurative trade mark – Decision confirmed – EUTM application rejected**

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The examiner refused the registration of the figurative trade mark depicted above pursuant to Article 7(1)(b) EUTMR for goods in Classes 9, 17 and 24. According to the examiner, the parallel luminous yellow / silver-grey bands do not significantly depart from the basic pattern used as a safety element on security items and are not of a nature as to render the mark distinctive. The applicant's argument that this sign has been widely used by firefighters since 1995 was considered irrelevant given that Article 7(3) EUTMR was not invoked.

The Board of Appeal (BoA) rejects the EUTM application pursuant to Article 7(1)(e)(ii) EUTMR (signs which consist of the shape, or another characteristic, of goods which is necessary to obtain a technical) and does not examine Article 7(1)(b) EUTMR. It concludes that all the mark's features have the global purpose of enhancing the visibility of the applicant's reflective markings. Each of the essential visual elements of the mark applied for are functional features that are necessary to obtain a technical result for the goods at issue: visual identification indicators in Class 9, *synthetic rubber, semi-finished rubber in the form of strips, mouldings, cuttings and profiles, unprocessed or semi-processed gutta-percha, semi-worked rubber; plastics in extruded form* in Class 17, *textiles and textile goods* in Class 24, all of those goods for use by manufacturers of

protective clothing for firefighters to be incorporated by the manufacturers into said clothing. Regarding the assessment of a mark applied for within the framework of Article 7(1)(b) EUTMR and under Article 7(1)(e)(ii) EUTMR, the BoA points out that they do not coincide in object and purpose. Article 7(1)(e)(ii) EUTMR is based on an objective examination and, thus, the presumed perception of the sign by the average consumer is not a decisive aspect. Besides, for the purpose of applying Article 7(1)(e)(ii) EUTMR, apart from the graphic representation of the sign, any material relevant to appropriately identifying the technical function of the sign's features in the context of the goods at issue must be considered. To this end, the distinctive character of the elements of a sign is not relevant, or at least not critical for the application of this provision. The BoA also emphasises that the grounds for refusal listed in Article 7(1)(e) EUTMR are excluded from the scope of the exception under Article 7(3) EUTMR. Therefore, even if the features of the goods that are necessary to obtain a technical result have become distinctive as a consequence of the use that has been made of them, they are prohibited from being registered as a trade mark.

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25/10/2022, R 1246/2021 5, DEVICE OF A BANKSY'S MONKEY (fig.)

### Contested EUTM



**No bad faith – Trade mark not descriptive – Distinctive – Decision annulled – Application for invalidity rejected**

The EUTM was filed on 7 November 2018 by Pest Control Office Limited, a company which was set up to represent Banksy's interests while preserving his anonymity. The EUTM was registered on 8 June 2019 in respect of various goods and services in Classes 9, 16, 25, 28 and 41. A request for a declaration of invalidity of the EUTM for all the goods and services was filed on 28 November 2019, on the grounds of Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR (lack of distinctive character), Article 7(1)(c) EUTMR (descriptive character) and Article

59(1)(b) EUTMR (bad faith). The Cancellation Division (CD) declared the invalidity of the contested EUTM, finding that it had been applied for in bad faith since the EUTM proprietor never had any intention of using it.

The Board of Appeal (BoA) annuls the CD's decision and rejects the request for a declaration of invalidity in its entirety. Firstly, it finds that the EUTM is distinctive and not descriptive. The BoA clarifies that the same artwork or sign may be protected as an original creative work by copyright and as an indicator of commercial origin by trade mark law. Therefore, the fact that the contested sign is a piece of artwork is not an obstacle to it also being a mark indicating the origin of the goods and services in question. The BoA notes that the cancellation applicant did not submit any convincing evidence or arguments to prove that the subject matter of the goods and services would be the artwork. It also failed to indicate which features or characteristics of the goods and services would be indicated by the contested sign. Therefore, the contested sign has not been registered in breach of Article 7(1)(b) or (c) EUTMR.

As regards the alleged bad faith, the BoA observes that making the artwork contained in the contested sign publicly available and not taking any steps to protect the copyright on that sign, does not necessarily mean that there was never an intention to use the sign as a trade mark. Furthermore, the

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cancellation applicant's assumption that the need to stay anonymous was the reason for not seeking copyright protection and choosing trade mark protection instead, even if true, cannot justify a finding that there was no intention to use the contested trade mark. With respect to Banksy's statement that 'Copyright is for losers', the BoA underlines that it is irrelevant. Freedom of opinion and expression is a fundamental right. In any case, this statement does not demonstrate that the EUTM proprietor has a negative view of intellectual property rights, and thereby filed a trade mark that he had no intention of using. Finally, the BoA points out that the cancellation action was brought only half a year into the five-year grace period. Within that period, a trade mark owner is free to choose when to start using its trade marks. Therefore, considering the circumstances of the case, it cannot be assumed that the EUTM proprietor had no intention of using the contested mark. The BoA concludes that the presumption of good faith is still valid and the cancellation applicant failed to prove the contrary.

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### New cancellation decisions

In this section you will find a new summary of an interesting decision in the area of cancellation at the EUIPO.

13/07/2022, C 23 285, West Lake (fig.)

#### Contested IR designating the European Union



#### Revocation grounds – Article 58(1)(a) – Evidence of use – Proof of use – Revocation upheld

The contested IR was registered for inner tubes and tyre covers for various kinds of vehicles; inner tubes and tyre covers for bicycles in Class 12. An application for a declaration of revocation was filed on the grounds of Article 58(1)(a) EUTMR, claiming that the mark had not been put to genuine use for any of the registered goods.

The IR holder submitted evidence showing use exclusively for tyres for cars or other types of motor vehicles and claimed that the documents sufficiently demonstrate genuine use for all of the registered goods.

Regarding the inner tubes, the IR holder argued that they registered the IR in 2002, when tyres were still used with inner tubes, whereas nowadays the

market situation is fundamentally different and most tyres are tubeless. The holder asked the Office to extend the effects of the proof of use adduced for tyres to also cover inner tubes, since the goods are directly connected.

As to the tyre covers, the IR holder argued that (i) the term refers to the outer part of the tyre, (ii) the word used in the French version of the IR's specification denotes the external part of a tyre or the tyre itself, (iii) the conjunction 'and' in inner tubes and tyre covers means the term refers to the inner and outer part of a tyre, together a tyre and (iv) the Chinese basic registration of the IR refers to 'inner and outer tires'.

Concerning the inner tubes, the Cancellation Division found that it is not appropriate to accept proof of use for different but somehow linked goods as automatically covering registered goods. As to the tyre covers, this term is sufficiently clear and precise and can only refer to something that is put over a tyre to protect or hide it. Furthermore, to accept the holder's reasoning would undermine legal certainty. It is for the trade mark applicant to choose the accurate wording or to remedy any inconsistencies between the list of the basic registration and that of the IR.

In the absence of any evidence of use for the registered goods or proper reasons for non-use advanced and proven by the IR holder, the IR was entirely revoked.

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