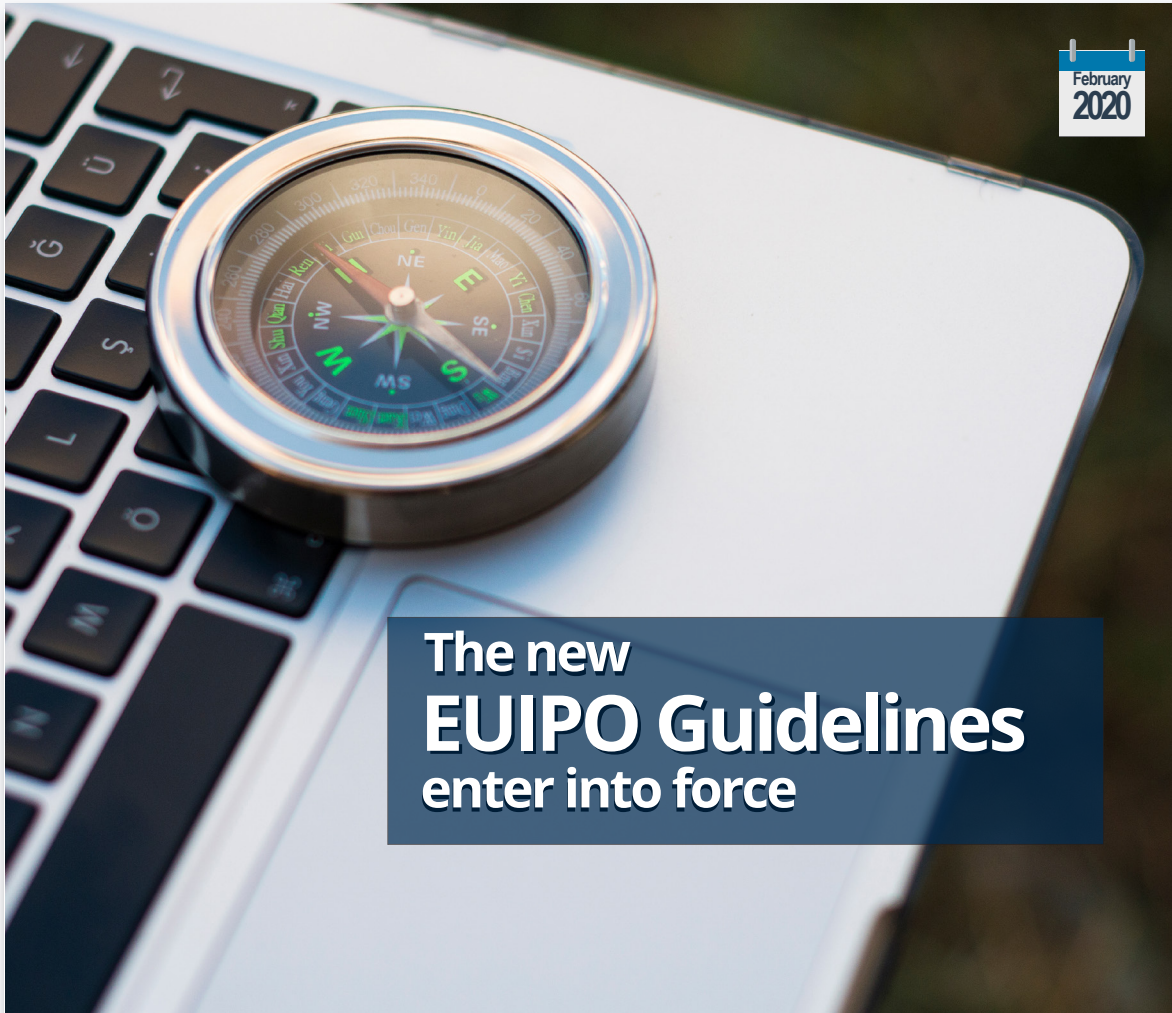


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New EUIPO Examination Guidelines enter into force

The EUIPO has revised its Examination Guidelines for European Union Trade Marks (EUTM) and Registered Community Designs (RCD). The new edition enters into force on 1 March 2021, following the approval of the Executive Director by means of [Decision EX-21-1](#).

The Guidelines are available in both electronic and PDF format on the [EUIPO website](#). This latest edition was timed to coincide with the entry into force of the most recent Decisions of the EUIPO's Executive Director on communication by electronic means and on technical specifications for annexes submitted on data carriers.

The new edition is currently available in five languages: English, French, German, Italian and Spanish. Nevertheless, the Guidelines will be made available in the other 18 official languages of the EU during the course of 2021.

Thanks to the new features introduced in the Guidelines in 2019, all the changes in the new edition can be compared with the previous edition by switching on the 'Show modifications' option at the top part of the electronic version of the Guidelines. For more information on the new edition, a dedicated [webinar](#) has been made available.

In addition, the EUIPO's Knowledge Circles have prepared the following summary of the main items under revision in the new edition of the Guidelines.

Part A: General Rules, Section 1: Means of Communication, Time Limits

3.1. Means of Communication

The new decision of the Executive Director EX-20-9 on 'Communication by electronic means' was signed on 3 November 2020 with a later date of entry into force (1 March 2021). This new decision brings in important changes regarding communication. In summary:

- it abolishes fax as a means of communication, both for the parties and for the Office, and this concerns all procedures (including all EUTM and all RCD related procedures);
- eComm becomes compulsory for all UserArea account holders, as holders may no longer opt out of this means of communication while the account remains active. This applies equally to new and existing account holders, including those that previously may have opted out under the former rules;
- two alternative back-up solutions are made available, one in the UserArea and the second in the form of a file-sharing solution.

3.1.3. Annex to communications

Paragraph 5.3.2.1. has been removed from Part C, section 1, Procedural matters (Opposition) which

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contained the list on “structured presentation” and inserted here, in Part A, as it is a matter of general application. It has been fully revised. Also, a clear explanation as to when annexes need to be submitted in duplicate has been inserted.

A reference to data carriers as a means of submitting annexes to communications has been inserted, and this includes a reference to the decision of the Executive Director, EX-20-10 on ‘Technical specifications for annexes submitted on data carriers’ which was signed on 22 December 2020 with a later date of entry into force (1 March 2021). This decision brings in important changes regarding the use of data carriers. In summary:

- it removes DVDs and CDs as acceptable types of carriers: only USB flash drives, pen drives or similar memory units are accepted;
- it reduces the acceptable size of individual annexes (files) to 20MB;
- it explains that the content of a data carrier will become part of the electronic file of the IP right, and as such, the original data carrier may be disposed of five years after its receipt. It also explains how the name and the structure of the content of the data carrier will be incorporated into the electronic file.

Part A: General Rules, Section 5: Professional Representation

Annex I and II

The tables have been restructured and offer a new presentation, including separate columns for professional representative requirements (Article 120(2)(c) EUTMR, and Article 78(4)(c) CDR) to clearly identify which Member States are subject to the different options available for entitlement in the ‘professional representative’ scenarios, namely the requirement to be in possession of a special professional qualification or the ‘five years’ experience’ requirement. Most of the entries have been revised and updated by the National Offices.

Part B: Examination, Section 2: Formalities

5.2 Specific filing date deficiency and e-filing applications

Practice will change for those e-filings in which the list of goods and services is filed as an attachment or filed separately. In accordance with Article 5 of Decision No EX-20-9 of the Executive Director of the Office of 03/11/2020 on communication by electronic means, these applications are not to be considered as filed electronically and they can not benefit from the specific reduced fee. If the fee (normal fee) has not been properly paid, a filing date objection will be raised (and not a formality objection). If the fee for paper filing is paid within one month, the filing date will be maintained, otherwise the filing date will be that of the date of payment.

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8.2. Collective marks and 8.3. Certification marks

These sections now tackle all formality issues regarding both, collective and certification marks as well as some parts which have been moved from other parts of the guidelines (namely Part B Examination, Section 4 Absolute grounds for refusal, Chapter 15 European Union collective marks and Chapter 16 European Union certification marks). Further explanations have also been added on how to include a reference to authorised users; a recommendation has also been introduced in the sense that any mention to “licensees” (or similar references) should be avoided.

8.3. Certification marks

This paragraph has been further elaborated, now clarifying the requirement regarding the characteristic to be certified in the regulations of use, reinforcing the existence of a link between the applied g/s and the characteristics applicants wish to certify (missing in 95% of the cases) and reinforcing the fact that characteristics cannot relate to service providers.

Part B: Examination, Section 3: Classification

5.3 Amendment and restriction of a list of goods and services

Clarification has been added to better explain a distinction has been made between amendment and restriction, and examples for both have been added. Criteria according to which restrictions and

amendments may be accepted or rejected have been added, such as subjectivity, targeted public, intended use or purpose, subject matter and theme.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 1: General principles

6 Scope of Objections to the Goods and Services

Clarification has been added regarding the goods and services which should be objected to if these are auxiliary goods or services. Some services have to be considered as stand-alone services and should always be assessed on their own and not as being auxiliary; this is the case for example of advertisement services.

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

2.9. Names of colours

Following the Case T 423/18, vita of 07/05/2019, explanations and examples have been updated and the Office will object to signs consisting of the name of a colour only when it constitutes an objective characteristic, inherent to the nature of that product and intrinsic and permanent with regard to that product or service.

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Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 6: Shapes or other characteristics that result from the nature of the goods, are necessary to obtain a technical result or give substantial value to the goods (Article 7(1)(e) EUTMR)

3. Shape or Other Characteristics of Goods Necessary to Obtain a Technical Result

The two steps assessment of sign consisting of shape or other characteristics of goods necessary to obtain a technical result has been further explained as well as the elements that can be taken into account under each step. In particular, it is clarified that information other than that relating to the graphic representation alone, such as the perception of the relevant public, can be taken into account to identify the essential characteristics of the sign at issue. However, for the assessment of the technical result, information which is not apparent from the graphic representation must originate from objective and reliable sources and may not include the perception of the relevant public (C 237/19, Gömböc Kutató):

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

3. Accepted Principles of Morality

The concept of accepted principles of morality has been clarified in view of the Judgement of

27/02/2020, C 240/18 P, Fack Ju Göhte, showing that this refers to the fundamental moral values and standards to which a society adheres at a given time, and that highlighting some elements of context can be relevant in the assessment of principles of morality.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 10: Trade marks in conflict with designations of origin and geographical indications (Article (1)(j) EUTMR)

The Office will no longer object ex officio to trade marks in conflict with GIs when applied for transport services. Transportation services are provided by specialist transport companies whose business is not the manufacture and sale of the goods covered by the GI. This constitutes a change of practice.

Another change of practice is that trade marks in conflict with GI applications will be objected to; if the applicant does not submit observations or does not overcome the objection, the proceedings will be suspended until the GI registration procedure is concluded.

References to Commission databases and registries have been updated in view of the creation of eAmbrosia database, which contains information regarding GIs protected at EU level in the wine, aromatised wines, spirit drinks and agricultural products and foodstuffs sectors.

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6.2.3 GIs protected under the Lisbon System (Geneva act)

Council Decision (EU) 2019/1754 of 7 October 2019 on the accession of the European Union to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications approved the accession of the EU to the Geneva Act which entered into force on 26 February 2020. Consequently, this new paragraph 6.2.3 has been added to this Chapter, under GIs not protected under EU Regulations, where it is explained that GIs from non-EU countries protected at EU level via the Geneva Act can form basis for objections pursuant to Article 7(1)(j) EUTMR.

Part B: Examination, Section 4: Absolute grounds for refusal, Chapter 12: Trade marks in conflict with traditional specialities guaranteed (Article (1)(l) EUTMR)

This Chapter was reviewed with the aim to remove the existing reference to the DOOR database and hence, replace it for the eAmbrosia database which also contains the relevant information about TSGs.

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

4. Consumers

Under Article 7(3) EUTMR, the evidence to be provided to the Office must show that the use

in question relates to the essential function of the specific kind of marks (individual, collective or certification). The guidelines now contain a definition of the essential function of collective and certification marks.

Part B: Examination, Section 4: Absolute Grounds for Refusal, Chapter 15: European Union Collective marks

3.1 Misleading as to the character or meaning of the mark

Collective marks consisting of a PDO/PGI or of a logo contained in the product specification will be objected to as being misleading according to Article 76(2) EUTMR.

3.2 Regulations governing use

The use of the template guiding applicants throughout the drafting process for the regulations governing use is recommended (internet link introduced in the text).

4.1 Article 74(2) EUTMR: 'geographical derogation'

The Office will assess on a case-by-case basis whether the signs containing geographically descriptive terms, including GIs, contain elements that are sufficient to render the mark distinctive as a collective mark.

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Part B: Examination, Section 4: Absolute Grounds for Refusal, Chapter 16: European Union Certification marks

3.4 Regulations governing use

The use of the template guiding applicants throughout the drafting process for the regulations governing use is recommended (internet link introduced in the text).

Part C: Opposition, Section 1: Opposition Proceedings

2.4.2.6 Multiple opponents

Multiple opponents are admissible only if all of them have entitlement to all the earlier rights. The examples of acceptable and non-acceptable combinations of opponents have been updated. Users are reminded that where the earlier right is owned by several proprietors, it is sufficient to designate only one of them as opponent, being the best way to avoid deficiencies concerning multiple opponents.

4.2.4.3 Proof of national law by reference to an online source

A reference to an online database will be accepted to the extent it provides official legal text originating from the government or official body of the Member State concerned, is publicly accessible, free of charge and its search environment is in the language of the proceedings. The translation of the legal text

into the language of the proceedings must also be available at the indicated source or submitted separately within the substantiation period. The WIPO Lex database is a useful source.

5.1.2 and Annex – Calculation of the grace period for non-use

The method of calculation of the 5-year grace period for non-use has been clarified.

Concerning earlier national marks, the Office and the national offices of Member States have updated the table summarising the relevant national provisions regulating the start date for calculating the 5-year grace period for non-use. The new table also indicates where in each national database extract the relevant date can be found.

Concerning earlier international registrations designating Member States, the Office will calculate the commencement of the 5-year grace period for non-use from the 'date of publication of the statement of grant of protection in the WIPO Gazette' (INID 450), and not from the date of 'tacit acceptance for protection'. The interested party can still prove a later or earlier relevant date, as applicable.

7.3.4.1 Monitoring suspended files by reference to online evidence

The Office will monitor the status of the earlier mark if the opposition has been suspended pending conclusion of national proceedings directed against

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that mark. If an inspection of online evidence after 6 months of suspension shows that those proceedings have concluded, the Office will resume the proceedings without awaiting information from the parties.

Part C: Opposition, Section 2: Double Identity and Likelihood of Confusion, Chapter 2: Comparison of Goods and Services

1.5.2.2 Unclear and imprecise terms

Clarification has been made regarding the practice on interpretation and comparison of unclear and imprecise terms. Unclear or imprecise terms in the earlier mark may not be excluded from the outset and must be compared with the contested goods and services taking into account the Canon criteria. Where the contested mark contains an unclear or imprecise term, the Office will reopen examination of the classification of the mark. The scope of unclear and imprecise terms can be clarified through a restriction or a partial surrender. In earlier marks, which are subject to proof of use, the scope can also be clarified by the submitted evidence, when proof of use is requested.

3.2.4 Complementarity

The definition and factors which need to be taken into account for establishing of complementarity between goods and services have been clarified. Respective examples and references to recent case law have been added.

Part C: Opposition, Section 2: Identity and Likelihood of Confusion, Chapter 4: Comparison of Signs

3.2.3.4 Effect of a disclaimer in the earlier mark

A disclaimer cannot have the effect of excluding, or attributing limited importance to, an element of a mark in the comparison of signs and the global assessment of the likelihood of confusion. The disclaimed element of the earlier mark cannot be disregarded in the comparison of signs.

Part C: Opposition, Section 2: Double Identity and likelihood of confusion, Chapter 5: Distinctiveness of the earlier mark

Development of practice by introducing the findings from C-766/18 relating to the distinctiveness of geographically descriptive collective marks registered pursuant to Article 74(2) EUTMR. In particular, the finding that such marks must not be assessed differently from other kinds of marks. So, the geographically descriptive elements in such collective marks will be considered to be devoid of distinctive character because the distinctiveness of such marks must stem from the addition of other elements enabling the consumer to distinguish the goods or services of the members of the proprietor association from those of other undertakings (refers to § 72 and 73 C-766/18). It has also been clarified that if the earlier mark consists only of a geographically descriptive element, its distinctiveness should be considered low (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 44).

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Part C: Opposition, Section 4: Rights under Article 8(4) and 8(6) EUTMR

In view of the accession of the European Union to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, paragraph 5.2.3.1 International agreements entered into by the EU and paragraph 5.3.2 Scope of protection of GIs protected under national law or international agreements now include specific wording on the implications of such accession. GIs originating in non-EU countries protected under the Geneva Act of the Lisbon agreement can be relied on in oppositions under Article 8(6) EUTMR provided that they were granted protection in the EU. Information on the relevant date for establishing priority and on the scope of protection conferred to those GIs has also been included.

Part C: Opposition, Section 6: Proof of Use

2.2 Genuine use: standard of proof

The lack of genuine use is not equivalent to use with the sole intention to maintain rights ('token use'). It is rather the absence of a sufficient extent of commercial exploitation of the mark in the relevant market.

2.3 Nature of use

Clarifications regarding nature of use of collective marks have been introduced. Genuine use of collective marks must be assessed in view of their

essential function, which is not to identify the identity of the origin but rather to identify that the goods or services come from the members of a collective. However, like individual marks, a collective mark must be used by the members to create or preserve an outlet for the registered goods or services. The same collective mark can be used by competitors to indicate their affiliation with the association, together with an individual mark which indicates the identity of origin of the goods or services as coming from a particular member of the association.

2.7.3 Use in a form different from the registered

The Office's practice regarding use of a trade mark in a form differing from the one registered has to be read in line with [Common Practice CP8](#) adopted by the European Union Intellectual Property Network, published on 15/10/2020.

2.8.6 Sale of the manufacturer's own goods

The use of the manufacturer's trade mark in relation to activities that form an integral part of the offer for the sale of its own goods, does not constitute use for retail services of such goods in class 35.

Part D: Cancellation, Section 2: Substantive provisions (AG)

3.3.2.1. Factors likely to indicate the existence of bad faith

An example of the dishonest intention of the applicant has been added: a trade mark application

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made without any intention to use the trade mark in relation to all or some of the goods and services covered by the registration might constitute bad faith under certain circumstances, if the applicant for registration of that mark had the intention either of undermining the interests of third parties, or of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark.

3.3.5. Extent of invalidity

The extent of a declaration of invalidity based on a finding of bad faith will not necessarily affect all the registration. It will depend on the evidence and arguments provided by the invalidity applicant.

Part E: Register Operations, Section 2: Conversion

4.1 Revocation on the grounds of non-use

Included a scenario of potentially allowing conversion to a specific Member State following revocation on the grounds of non-use when the conversion applicant provides a judgment from a national court where national law was used to assess genuine use. The requirements include that the national mark for which genuine use is found must be identical to the EUTM, covers the same goods and/or services, and there is an overlapping period of use.

Part E: Register Operations, Section 4: Renewals

7.2 Content of the request for renewal

The paragraph has been reformulated to clarify that where payment alone is relied on (Article 53(4) EUTMR last sentence) the amount paid must be of the basic renewal fee (1000€), not the reduced 850€ e-renewal fee. The reduced fee only applies to the cases where an e-request is submitted.

Part E: Register Operations, Section 5: Inspection of files

5.1. Excluded documents

A clarification has been inserted to clarify that where a 3rd party requests access to the evidence of a professional representative's entitlement to act before the Office, these are always refused as this data is never disclosed and consequently, they are excluded from inspection of files.

Also, an explanation has been inserted regarding potential 'ex-officio' marking of confidentiality by the Office for certain documents in the files such as passports or other ID documents which can be submitted in annexes to transfer requests, evidence of 'health data' which can be submitted in support of restitutio in integrum or extension requests, and even bank account extracts.

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Design Guidelines

In general, in line with decision of the Executive Director EX-20-9 on 'Communication by electronic means', all references to fax have been removed.

Examination of Design Applications

2.3 Content of the application and 2.7 Registration or examination report

The section explains how the Office, as Office of First Filing, now allows applicants to use WIPO DAS to exchange the priority documents for their RCD application and that this is only possible when filing electronically. In addition, in order to give more visibility to WIPO DAS, subheadings have been created.

3.3 Representation of the design and 5 Additional Requirements Regarding the Representation of the Design

Following the case C-217/17 P the guidelines have been adapted to implement this judgment in Office practice. Accordingly, no filing date will be accorded to cases of bad quality and non-neutral background (understood to extend to elements external to the design). All other inconsistencies are "formality" deficiencies requiring remedy but retaining the original filing date. The guidelines are structured to clarify the difference between Filing Date deficiencies and their consequence, and Formality deficiencies relating to views and their consequence.

6.1.4.4 Ex officio change of indication

In order to reduce deficiencies and enable a speedy processing of applications, deficiencies relating to product indications containing an obvious mismatch will be replaced ex officio by the examiner. This constitutes a change of practice.

6.2.1. Priority

In line with Decision No EX-20-7 of the Executive Director of the EUIPO, the section explains how the Office has implemented WIPO DAS as Office of Second Filing by allowing the submission of priority document by way of a reference to a WIPO DAS access code at the time of filing by e-filing.

12 International Registrations

The whole section has been updated. The section has been improved in terms of structure and content.

Examination of Design Invalidation Application

3.10.1 Statement of grounds and 3.10.2 Facts, evidence and arguments

The guidelines have been amended to clarify that the application form indicating the grounds on which the invalidity action is based is considered a 'statement of grounds' according to Art. 28(1)(v) (i) CDIR but it is to be complemented with facts, evidence and arguments according to Article 28(1) (b)(vi) CDIR for admissibility purposes. When the application form is not accompanied by such facts,

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evidence and arguments, a deficiency letter is sent to the invalidity applicant giving a deadline to remedy. If the invalidity applicant does not remedy within the prescribed deadline, the application will be considered inadmissible.

Section 3.10.2 Facts, evidence and arguments has been amended in order to make clear the above and to point out that only those mentioned under Article 28(1)(b)(vi) CDIR are requirements for admissibility (the others being requirements for substantiation). The Guidelines clarify that an assessment on the substance of the facts, evidence and arguments is carried out at a later stage when a decision is taken.

Furthermore, it has been clarified that the submission of extracts from Designview/TMview is under the responsibility of the invalidity applicant, and that where the invalidity applicant does not submit a (complete) certificate of registration of the earlier design/right, a deficiency letter is sent giving a deadline to remedy.

3.10.3 Admissibility in respect of one of the grounds or the earlier rights relied on

The guidelines have been updated to reflect the current practice to examine the admissibility of the invalidity action just with regard to one earlier right/ground invoked among several. In addition, the guidelines clarify that if during the proceedings it becomes clear that the decision cannot be taken on the basis of the earlier right/ground for

which the admissibility examination was originally carried out and other earlier rights/grounds have to be taken into account, the Invalidity Division will check the admissibility with regard to such earlier rights/grounds and, where applicable, it will send a deficiency letter giving to the invalidity applicant a deadline to remedy. Only once the inadmissibility is remedied or such deadline is expired without any remedy, the Invalidity Division can take a decision.

5.7.1 Disclosure of earlier design

The whole section has been reviewed in order to reflect the two-step analysis supported by case-law, and to reflect, in a separate subheading (5.7.1.5) the specificities of design disclosures on the internet, as contained in CP10.

5.7.2.2 Individual character

The guidelines have been updated with respect to the 4-step test of assessment of individual character established by case law. The implementation does not mean a per-point technique but rather a general principle, a coherent test taking into account all the relevant factors such as sector and type of products(s) concerned, informed user, freedom of the designer and comparison of designs with a conclusion on their overall impression.

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IP Mediation Conference: Online event, 22-23 March

The EUIPO Boards of Appeal, together with the EUIPO Academy and the International Cooperation and Legal Affairs Department of the EUIPO, are organising the **third IP Mediation Conference**, which will be held **online on 22-23 March 2021**.

Leading experts from national and international institutions, academia and from the EUIPO itself will gather to address a wide range of topics in the field of intellectual property mediation.

According to José Checa, General Counsel Brand, Marketing Properties & Licensing at Nestlé, and speaker at the 2019 IP Mediation Conference:

"I think mediation is a very flexible tool that can be tailored to the needs of the parties, in a particular dispute, and that's probably what makes this dispute resolution mechanism very attractive to companies. Mediation doesn't always need to be the only solution and there are other ways of resolving disputes through negotiation or arbitration or court resolution, but definitely mediation offers that flexibility that in certain moments of time it is really appreciated."

Take a look at the [programme](#) and register via the [conference page](#).

European Cooperation: new e-services in Lithuania

The State Patent Bureau of the Republic of Lithuania (SPB), with the support of the EUIPO's European cooperation project ECP1, has improved the e-filing and e-services tools available for its users.

The front office platform, available via the [SPB website](#), allows Lithuanian users filing applications and requests electronically, to automatically retrieve addresses and company data from the official Register of Legal Entities and the Register of Addresses. With this new feature, users will be **reducing potential misprints and human errors when filing applications** in the front office, avoiding this way incorrect applicant data to be imported to the SPB back office system.

This release at the Lithuanian office is an example of successful implementation of an improvement to a front office tool in an intellectual property office of the EU, within the framework of the European Cooperation Projects.

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WIPO-EUIPO Joint Work Programme

The Executive Director of the EUIPO, Christian Archambeau, held a virtual meeting with Daren Tang, Director General of the World Intellectual Property Organization (WIPO), to endorse the new EUIPO-WIPO Work Programme for 2021 and to discuss recent developments of both organisations.

They shared some new initiatives such as the small and medium-sized enterprises (SMEs) programme, the new EasyFiling tool and the establishment of a new sector on IP and Innovation Ecosystems at WIPO.

During the meeting, they both reaffirmed their commitment to **enhance cooperation by signing the Joint Work Programme for 2021**, covering a total of 26 activities. They also discussed about a number of initiatives to be implemented under the framework of the new Work Programme, including new technologies, Artificial Intelligence and the role of IP offices to improve the image of intellectual property towards new stakeholders.

The new Work Programme reflects a common vision on the fundamental role of IP and underlines that, by working together, the two organisations can contribute to make the IP system more effective and more relevant for the benefit of users around the world.

AfriPI: Integration of IP tools

AfriPI, the international cooperation project funded and directed by the EU and implemented by the EUIPO in Africa, has launched an initiative to create **awareness on the available IP tools and prepare the countries involved to integrate relevant tools** of the EU Intellectual Property Network (EUIPN) into their software.

This integration process also includes the sharing of knowledge and experiences as well as technical hands-on sessions. The African Intellectual Property Organization (OAPI) integrated DesignClass and the Harmonised Database tools in September 2020, which was a major step forward following the integration of TMview in January 2019.

Now AfriPI, in collaboration with the EUIPO Digital Transformation Department and other EU projects, has launched the process of establishing a TMview regional interface. It is planned to launch the interface in several pilot countries before gradually extending it.

Another development in terms of IP tool integrations is the licence agreement between the EUIPO and the Uganda Registration Services Bureau (URSB) to offer more services.

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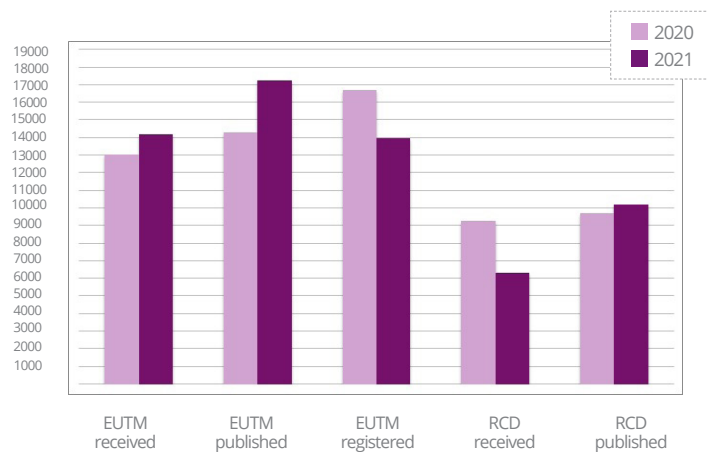
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Statistical Highlights

Monthly statistical highlights January*	2020	2021
European Union Trade Mark applications received	13 066	14 153
European Union Trade Mark applications published	14 263	17 253
European Union Trade Marks registered (certificates issued)	16 681	13 965
Registered Community Designs received	9 248	6 335
Registered Community Designs published	9 681	10 217



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EUIPO short film released: The IP Link

Every picture tells a story and the EUIPO's is one of accessible IP registration services for EU businesses, whether large or small. This is the starting point of [The IP Link](#), a 7-minute short film which was made with the help of over 80 EUIPO staff members.

The film stars a freelance designer and his baby daughter and shows the life of a trade mark from its conception through the application process. We see **intellectual property rights in motion**, how they are used and registered by companies and professionals. We also get a glimpse of the EUIPO staff, their collaborative ways of working and their workplace in Alicante.

The IP Link is part of the Office's move to **make IP information more user-friendly and relevant for companies, linking it to real business needs**. In fact, it is one of the promotional tools used for the array of initiatives for small and medium-sized businesses (SMEs) that the EUIPO has launched in the past months.

The film can be seen on the [About EUIPO page](#) and the [Ideas Powered for Business](#) section of the EUIPO website, which provides a one-stop shop for EU businesses looking to gain a competitive edge with IP.

From information on trade marks and designs to personalised free intellectual property support and e-learning courses, the section also gives access to the [SME Fund](#). This EUR 20 million grant scheme has been created in cooperation with the European Commission to help SMEs access their intellectual property rights.

All in all, supporting SMEs has received a passionate response from the EUIPO's staff. The IP Link film tries to **pay tribute to this public service commitment and to all the companies and professionals who entrust their trade marks and designs to the EUIPO**. Shot entirely in Alicante, the film was produced internally, demonstrating a real cross-departmental effort with staff working as actors, production experts, casting assistants and scriptwriters. [Don't miss it](#).

Goodbye old technology, hello new

Improved technology heralds a new era in EUIPO communications. From 1 March 2021, a number of important changes will affect the way the EUIPO communicates with customers. The changes are reflected in two key decisions recently adopted by the Executive Director of the EUIPO:

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100% eComm

- No more fax: as fax communications prove less and less reliable, the EUIPO has discontinued its fax service as a means of communication in the EUIPO procedures.

- Fully eComm: the EUIPO's secure e-communications platform will be the accepted means of communication for account holders in all matters relating to EU trade marks and designs via the User Area. Users, who have not chosen eComm as their preferred means of communication, will be automatically switched to eComm.

- File-sharing from the User Area: the 'Fax alternative' button, found in the User Area under the 'Communications' tab, will be renamed 'Correspondence alternative'. While the usual terms and conditions will still apply, this will serve as a back-up in the event of malfunction of specific e-operations.

- File-sharing from outside the User Area: a new option will be available for users who are unable to access their account. The file-sharing platform will be independent from the EUIPO's website and will be available during the EUIPO's business hours after contacting us.

- For more on communication by electronic means, see [Decision No EX-20-09](#).

No more CDs and DVDs

- USBs and pen drives: users must submit documents or other items of evidence for use in proceedings using small portable storage drives,

such as USB flash drives, and not external hard drives, such as CD-ROMs or optical discs.

For more on the technical specifications for annexes submitted on data carriers, see [Decision No EX-20-10](#).

China: EUTM and RCD Focus

The remarkable growth in filings for EU trade marks and designs by Chinese applicants may have come to prominence during 2020 – especially following the onset of the COVID 19 pandemic – but this story starts much earlier.

The latest China Focus Report was initially developed to study the exponential growth in interest from Chinese applicants over the decade from **2010** to **2019**. This trend was clearly identified in the previously published EUIPO [Trade Mark Focus](#) and [Design Focus](#) reports and this new report provides more detailed information regarding top Chinese applicant/owner and class filing/registration volumes and rates, as well as data concerning straight-through applications and objection/deficiency rates.

However, the global COVID 19 pandemic is currently impacting and disrupting human societies, provoking health and economic crises in major economies and developing countries. Several of the 'Top 10'

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countries, in terms of EUTM and RCD filings, are amongst the hardest hit. Therefore, the EUIPO feels that the picture would not be complete without an update on the impact this unprecedented upheaval is having on the filings for EU IP rights.

This analysis focuses specifically on the preponderant influence of demand from China on overall application volumes for both EUTMs and Direct RCDs since the pandemic began to spread globally, that is, during the first few months of **2020**. This general expansion can clearly be seen in the notable increase in the Chinese share of overall EUTM filings (from **9.5 %** in **2019** to **16.2 %** in **2020**) and Direct RCD filings (from **14.3 %** in **2019** to **19.1 %** in **2020**).

The predominance of technology-based enterprises, such as **Huawei**, in the Top 10 ranking of EUTM applicants from China is echoed in the distribution of the Top 10 Chinese EUTM classes filed for, with **Class 9** (electrical apparatus; computers) accounting for **20 %** of all Chinese EUTM class filings from **2010** to **2019**.

The most relevant fluctuation in Chinese EUTM class filings for **2020** concerns **Class 10** (medical apparatus & instruments). Indeed, more than **25 %** of overall **Class 10** filings in 2020 originated from Chinese applicants. This fact demonstrates a strong correlation between the increased global demand for personal protective equipment (PPE) and

Chinese efforts to meet this demand by significantly increasing their production and supply of goods such as medical-grade gloves and masks. More detailed information on how increasing Chinese demand for EU IP rights is impacting overall filing dynamics is available on the new [China: EUTM and RCD Focus – 2010 to 2019 Evolution & 2020 COVID 19 Impact Analysis](#)

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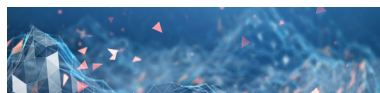
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Payment of fees with credit card: authentication required

Recently, some users of our services have been unable to complete their fee payments with credit/debit cards due to non-compliance with the Strong Customer Authentication (SCA) requirements. To avoid this situation, we recommend that users contact their bank to ensure that their credit/debit cards meet the requirements to complete secure payments.

The SCA is a requirement of the [second Payment Services Directive \(PSD2\)](#) within the European Economic Area. It is an authentication process that validates the identity of the user of a payment service or payment transaction. The SCA requirement makes it easier and safer for consumers to pay for goods and services online and helps fight fraud.

This requirement adds extra layers of security to electronic payments and ensures that they are verified with multi-factor authentication. To make any electronic payment, a combination of two of the following elements is needed:

- Knowledge: something only the user knows, e.g. a password or a PIN code
- Possession: something only the user possesses, e.g. a mobile phone, and
- Inherence: something the user is, e.g. the use of a fingerprint or facial recognition

More information can be found in the [FAQ section](#) of the European Commission.

ACADEMY webinars

Latest webinars

New kinds of evidence deriving from the internet - how should right holders present evidence to ensure success?

Traditional sources of evidence are rapidly being overtaken by evidence from online sources. Tune in to Tuesday's webinar to find out some of the pitfalls of evidence sourced online as well as how to assess its probative value.

After this webinar you will know:

- how to file online sourced material to support a claim;
- how to present material sourced online to support a claim.

Watch the webinar [here](#).

The multifaceted notion of bad faith

The concept of bad faith is not defined, delimited, or even described, in any way in EU trade mark legislation. Join the webinar with us as we review the specific case-law in order to identify general patterns of bad faith, and issues of identity.

Watch the webinar [here](#).

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AI & IP at the crossroad (Webinar organised in collaboration with CEIPI)

A new generation of artificial intelligence (AI) tools are at the heart of an increasing number of applications. AI is now capable of delivering answers to problems that until only a few years ago were considered beyond our reach. From automating the control of vehicles to recognising speech and classifying images at levels comparable to — or even higher than—human capabilities, these processes are now spearheading an unprecedented wave of technical developments. How to secure legal protection for such objects is therefore of the utmost strategic and economic importance for applicants worldwide. Intellectual property is one of the principal tools innovators can use to protect their technical contribution and, as such, IP constitutes an essential means to promote and incentivise technical progress. After introducing the essential characteristics of the latest generations of AI inventions, we will turn our focus to the protection of AI in general, and the products that are made possible by it. This will in turn raise questions as to how to they are protected ('how to protect AI using various IP rights?'), questions of ownership ('who is the inventor when AI participates in the creation of a product?'), questions of enforcement ('can AI be used to detect infringement?'). More broadly, the relationship with other fields of law (from fundamental rights to competition law) will also be discussed.

Watch the webinar [here](#).

New Edition of EUIPO Guidelines

In this webinar, some of the main changes to the latest edition of the EUIPO Guidelines will be explained in a panel discussion with experts from those areas affected. The new edition of the EUIPO Guidelines will enter into force on 1 March 2021.

Watch the webinar [here](#).

Upcoming webinars

Webinar: **Basics of surveys for legal evidence** [Tuesday, 2 March](#), 10.00 a.m. – 11.00 a.m.

Webinar: **EUR 20 m SME Fund for Intellectual Property. Get your refund! Questions & Answers** [Tuesday, 9 March](#), 10.00 a.m. – 11.00 a.m.

Webinar: **AG examination of trade marks that refer to the content of the goods and services. Talking about what things are about** [Tuesday, 16 March](#), 10.00 a.m. – 11.00 a.m.

Webinar: **Need an IP strategy? Pre-diagnostic service (IP Scan). 75% off with SME fund.** [Tuesday, 23 March](#), 10.00 a.m. – 11.00 a.m.

Webinar: **Track on case-law: decision of the trimester of the GC and CJEU. Decisions of the trimester of the EUIPO BoA** [Tuesday, 30 March](#), 10.00 a.m. – 12.00 a.m.

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On recent case-law

In the case C-720/18, The Court of Justice of the European Union clarified the notion of genuine use of a trade mark (Testarossa) and, more specifically, in this case it deals with a situation where a trade mark is only used for some of the goods for which it has been registered.

In addition, the Court ruled on the burden of proof of genuine use in revocation proceedings. Consequently, this decision claims the pre-eminence of European law over national law (German law in this case).

For a closer look at this and other cases, we invite you to watch the following webinar [Decisions of the Trimester GC and the CJEU](#).

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

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



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

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

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



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

Luxembourg trade mark and design news

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

17/12/2020, C 490/19, Morbier, EU:C:2020:1043

KEYWORDS: Geographical origin

NORMS: Article 13(1)(d) Regulation 1151/2012/EU; Article 13(1)(d) Regulation 510/2006/EC

KEY POINTS: EU law prohibits, in certain circumstances, the reproduction of the shape or appearance of a product protected by a protected designation of origin (PDO). It is necessary to determine whether that reproduction may mislead consumers considering all the relevant factors, including the way in which the product is presented and marketed to the public and the factual context (§ 39, 41).

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FACTS AND QUESTION REFERRED TO THE COURT OF JUSTICE

'Morbier' is a cheese produced in the Jura mountains (France) which has enjoyed a PDO since 22 December 2000. It is characterised by the presence of a black line which divides the cheese in two horizontally. That black line, originally made from a layer of cinder and now made from vegetable carbon, is expressly referred to in the product description in the specification for the PDO.

Société fromagère du Livradois SAS, which has produced Morbier cheese since 1979, is not situated within the geographical area reserved for the name 'Morbier'. Ever since the expiry of a transitional period, it has therefore used the name 'Montboissié du Haut Livradois' for its cheese.

In 2013, the Syndicat interprofessionnel de défense du fromage Morbier ('the Syndicat') brought proceedings against Société fromagère du Livradois before the Tribunal de Grande Instance de Paris (Regional Court, Paris, France). The Syndicat accuses Société fromagère du Livradois of infringing the PDO and committing acts of unfair and parasitic competition by producing and marketing a cheese that reproduces the visual appearance of 'Morbier', the product covered by the PDO, in particular the black line. Its action was dismissed.

By a 2017 judgment, the Cour d'Appel de Paris (Court of Appeal, Paris, France) upheld that decision. That court held that the PDO is intended to protect, not the appearance or features of a product, but its name, so that the production of a product using the same techniques is not prohibited. The Syndicat therefore appealed to the referring court on a point of law.

In those circumstances, the Cour de Cassation (Court of Cassation, France) seeks a ruling by the Court of Justice on the interpretation of Article 13(1) of Regulation 510/2006/EC and Article 13(1) of Regulation 1151/2012/EU, which concern the protection of registered names. In particular, the question arises as to whether the reproduction of the physical characteristics of a product covered by a PDO, without the use of the registered name, may constitute a practice that is liable to mislead the consumer as to the true origin of the product, which is prohibited by Article 13(1)(d) of those two regulations. The Court therefore finds it necessary, for the first time, to interpret Article 13(1)(d) of both of those regulations.

CONSIDERATIONS AND ANSWER OF THE COURT OF JUSTICE

The Court finds, in the first place, that Article 13(1) of Regulation 510/2006/CE and Article 13(1) of Regulation 1151/2012/EU do not prohibit solely the use by a third party of the registered name

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(§ 23-31). In the second place, the Court states that Article 13(1)(d) of both regulations prohibits the reproduction of the shape or appearance characterising a product covered by a registered name, where that reproduction may lead the consumer to believe that the product in question is covered by that registered name. In that regard, it is necessary to assess whether that reproduction may mislead the European consumer, who is reasonably well informed and reasonably observant and circumspect, considering all the relevant factors in the case, including the way in which the products in question are presented and marketed to the public, and the factual context (§ 39, 41).

In reaching those findings, the Court notes, first of all, that Article 13(1) of Regulation 510/2006/EC and Article 13(1) of Regulation 1151/2012/EU contain a graduated list of prohibited conduct and do not merely prohibit the use of the registered name itself. Thus, although they do not specify the prohibited conduct, Articles 13(1)(d) of both regulations broadly cover any conduct, other than that prohibited by Articles 13(1) (a) to (c), which may result in the consumer being misled as to the true origin of the product in question (§ 29, 30, 33).

Regarding whether the reproduction of the shape or appearance of a product covered by a registered name may constitute conduct liable to mislead the consumer, the Court observes that, indeed, the protection provided for by Regulations No 510/2006

and No 1151/2012 concerns the registered name and not the product covered by that name. It follows that the purpose of that protection is not to prohibit the use of manufacturing techniques or the reproduction of one or more characteristics indicated in the specification of a product covered by a registered name, on the ground that they appear in that specification (§ 36).

Nevertheless, PDOs are protected as they designate a product that has certain qualities or characteristics. Thus, the PDO and the product covered by it are closely linked (§ 37). Therefore, the possibility remains that the reproduction of the shape or appearance of a product covered by a registered name may fall within the scope of Article 13(1)(d) of both regulations without that name appearing either on the product in question or on its packaging. This will be the case where that reproduction is liable to mislead the consumer as to the true origin of the product in question (§ 38).

In order to determine whether that is the case, it is necessary, in particular, to assess whether an element of the appearance of the product covered by the registered name constitutes a baseline characteristic which is particularly distinctive of that product such that its reproduction may, in conjunction with all the relevant factors in the case in point, lead the consumer to believe that the product containing that reproduction is covered by that registered name (§ 40).

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THE COURT'S ANSWER:

'Article 13(1) of Regulation 510/2006/EC on the protection of geographical indications and designations of origin for agricultural products and foodstuffs and Article 13(1) of Regulation 1151/2012/EU on quality schemes for agricultural products and foodstuffs must be interpreted as meaning that they do not prohibit solely the use by a third party of a registered name.

Article 13(1)(d) of Regulation 510/2006/CE and Article 13(1)(d) of Regulation 1151/2012/EU must be interpreted as prohibiting the reproduction of the shape or appearance characterising a product covered by a registered name where that reproduction is liable to lead the consumer to believe that the product in question is covered by that registered name. It is necessary to assess whether such reproduction may mislead the European consumer, who is normally informed and reasonably observant and circumspect, taking into account all relevant factors in the case'.

17/12/2020, C 607/19, Husqvarna, EU:C:2021:61

KEYWORDS: Counterclaim, Preliminary ruling, Proof of use, Revocation grounds

NORMS: Article 51(1)(a) CTMR [now Article 58(1)(a) EUTMR], Article 55(1) CTMR [now Article 62(1) EUTMR]

KEY POINTS: Article 51(1)(a) CTMR must be interpreted as meaning that, in the case of a counterclaim for the revocation of rights in an EU trade mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended is the date on which that counterclaim was filed (§ 51).

FACTS AND QUESTIONS REFERRED TO THE COURT OF JUSTICE:

This request for a preliminary ruling concerns the interpretation of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR. The request has been made in proceedings between Husqvarna AB and Lidl Digital International GmbH & Co. KG ('Lidl'), concerning an action for infringement of an EU trade mark brought by Husqvarna against Lidl.

Husqvarna manufactures appliances and tools for gardening and landscaping. It is the proprietor of a three-dimensional EU trade mark, registered on 26 January 2000, for the goods 'sprinklers for irrigation'. From July 2014 until January 2015, Lidl offered for sale a spiral hose set consisting of a spiral hose, a sprinkler nozzle and a coupling sleeve. Taking the view that the product marketed by Lidl constituted an infringement of its trade mark, Husqvarna brought an action for infringement against Lidl before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), for the purposes of, inter alia, bringing the infringement to an end and obtaining

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damages. Lidl, by way of counterclaim, requested the revocation of Husqvarna's rights in the mark alleging non-use of that mark.

The referring court, the Bundesgerichtshof (Federal Court of Justice, Germany) takes the view that the outcome of the dispute depends, first, on the question of whether the determination of the relevant date for the purposes of calculating the five-year period referred to in Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR is governed by those regulations and, second, should that be the case, on how that date is to be determined. The Bundesgerichtshof is of the view that that question is a procedural matter and that, in the absence of any clarification in the CTMR and EUTMR (trade mark regulation), it falls within the scope of national law [in the main proceedings paragraph 25(2) MarkenG (German trade mark law)].

Therefore, the Bundesgerichtshof decided to stay the proceedings and asks the Court of Justice (CJ) in essence, whether, in the case of a counterclaim for revocation, as provided for in Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR, the relevant date for the purposes of determining whether the continuous period of five years referred to in those provisions has ended is laid down by those regulations and, if so, what that date is.

CONSIDERATIONS AND ANSWERS OF THE COURT OF JUSTICE:

Article 101 CTMR, entitled 'Applicable law', provides, first of all, in paragraph 1, that the EU trade mark courts are to apply the provisions of that regulation. Next, paragraph 2 of that article states that, on all matters not covered by that regulation, an EU trade mark court is to apply its national law, including its private international law. Finally, paragraph 3 of the same article specifies that, unless otherwise provided in that regulation, an EU trade mark court is to apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located (§ 34).

Article 51(1)(a) CTMR provides that the rights of the proprietor of the EU trade mark are revoked, inter alia, on the basis of a counterclaim in infringement proceedings if, within a continuous period of five years, the trade mark has not been put to genuine use in the EU in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use (§ 35). The trade mark regulation does not expressly indicate the relevant date for the purposes of calculating that continuous period of five years (§ 36).

Nevertheless, it follows from the provisions of the trade mark regulation laying down the framework of the applicable regime, that the date that determines

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the end of the continuous five-year period is the date on which the application or counterclaim in question was filed (§ 37).

Pursuant to the first sentence of Article 55(1) CTMR, the EU trade mark is to be deemed not to have had, as from the date of the application for revocation or the counterclaim, the effects specified in the trade mark regulation, to the extent that the rights of the proprietor have been revoked; the second sentence of that provision states that an earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties (§ 38).

It is apparent from the consequences of the revocation, as provided for in Article 55(1) CTMR, that it is the date of the counterclaim that must be considered when determining the end of the continuous five-year period of non-use of the mark, which is one of the circumstances enabling revocation to be established, as referred to in Article 51(1) CTMR. The counterclaim can succeed only if that circumstance has been established as at that date (§ 39, 44).

The unitary character of the EU trade mark, ensured in recital 3 and Article 1 CTMR, could be called into question if the scope of the protection of the mark that its proprietor enjoys under EU law could vary, in the context of counterclaims for revocation, according to the procedural rules of the Member

States where those counterclaims are filed (§ 46-47).

Consequently, the CJ states that Article 51(1)(a) CTMR must be interpreted as meaning that, in the case of a counterclaim for the revocation of rights in an EU trade mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended, is the date on which that counterclaim was filed (§ 51).

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

09/12/2020, T 622/19, JC JEAN CALL Champagne PRESTIGE Bottle (3D)-Bottle et al (3D), EU:T:2020:594

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Conceptual dissimilarity, Phonetic dissimilarity, Three dimensional mark, Visual dissimilarity

NORMS: Article°8(1)(b) CTMR [now Article°8(1)(b) EUTMR], Article°8(5) CTMR [now Article°8(5) EUTMR], Article 72(3) EUTMR.

KEY POINTS: In light of the fact that the marks under comparison are at least visually similar, the Board of Appeal (BoA) should have carried out a global assessment of the likelihood of confusion (LOC), taking into consideration all of the relevant factors (04/03/2020, C 328/18 P, BLACK

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LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 75-76). The BoA should have also taken the degree of visual similarity between the signs into consideration (§ 64).

FACTS: The applicant sought to register the three-dimensional sign 'JC JEAN CALL Champagne PRESTIGE', claiming the colours gold, black and, after intervention by Office, white for wine of French origin, namely Champagne; in accordance with the specifications of the protected geographical indication 'Champagne' in Class 33.

Pursuant to Article 8(1)(b) and Article(5) CTMR an opposition was filed based on the three-dimensional EUTM No 6538987 (claiming the colours gold and black), registered for wines with registered designation of origin Champagne in Class 33 ('earlier trade mark No 1'), the three-dimensional EUTM No 12019683, claiming the colours gold and black ('earlier trade mark No 2'), and the position EUTM No 12013801, claiming the colour gold ('earlier trade mark No 3'). Earlier trade marks Nos 2 and 3 are registered for, inter alia, alcoholic beverages (except beers), in particular wines, sparkling wines and champagnes in Class 33. The Opposition Division rejected the opposition.

The applicant filed an appeal. The BoA dismissed the appeal. Firstly, it found that earlier marks Nos 1 to 3 and the mark applied for were not similar, and that therefore there was no LOC. Secondly, it took the view that the reputation of those earlier marks had not been established, so Article 8(5) EUTMR was not applicable either.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(1)(b) CTMR and (ii) infringement of Article 8(5) CTMR. The GC upheld the action and annulled the contested decision.

EUTM application



Earlier trade mark



(No 1)



(No 2)



(No 3)

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

The relevant public is the general public in the EU, which is interested in champagne and will display an average level of attention (§ 24).

The goods are identical (not disputed) (§ 25).

The BoA's assessments of the signs are not disputed insofar as they relate to earlier trade mark No 3, which is not a three-dimensional mark (§ 33). Earlier marks Nos 1 and 2 must each be considered as a whole and it is not possible, as the BoA correctly found (§ 35-43), to regard some elements as dominant or categorise some elements as negligible (§ 49). The same is true of the mark applied for, since the BoA found that the shape of the bottle, the colour of the bottle and the black foil did not constitute distinctive elements, without, however, categorising them as negligible. Those elements cannot be excluded from the comparison of the signs or given no weight in that comparison (§ 45, 46 and 48), since the combination of a bottle covered with an opaque, shiny, coloured foil, in particular a golden-coloured one, and a black foil is not in any way usual (§ 48 and 49).

As regards the visual comparison of the marks, the BoA took into account only the differences between them, failing to consider the marks as a whole when carrying out the global assessment of the similarity

between them. Its finding is therefore vitiated by an error of assessment, because it is based on the incorrect premise that the supposedly non-distinctive common elements between the marks do not, regardless of their number and degree of similarity, and even though they are not categorised as negligible, have any influence on the overall impression created by the marks. Even assuming that those elements are non-distinctive, the BoA was not entitled to disregard the points of similarity and conclude that the marks were visually dissimilar overall. It should have found that the signs were visually similar overall. The same conclusion would have had to be reached even if the BoA had found, as it suggested, that those elements had very little impact on the overall impression created by the marks. It could nevertheless have differentiated the degree of overall visual similarity between the marks, by considering the number of common elements as a proportion of the total number of elements of the marks under comparison, and by considering whether the combination of those elements was more or less unusual (§ 57). Therefore, the BoA erred in finding that earlier marks Nos 1 and 2 and the mark applied for created different overall visual impressions (§ 58).

The signs under comparison are phonetically dissimilar (not disputed) (§ 59).

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The signs are conceptually dissimilar since the distinctive elements of earlier marks Nos 1 to 2 and those of the mark applied for evoke different concepts, while the common elements are descriptive or non-distinctive and therefore unable to confer a conceptual similarity (not disputed) (§ 60).

The BoA erred in finding that the signs were dissimilar overall, since it erred in finding that earlier marks Nos 1 to 2 and the mark applied for were visually dissimilar and, consequently, visually, phonetically and conceptually dissimilar. In light of the fact that those marks are at least visually similar, the BoA should have carried out a global assessment of the LOC, considering all the relevant factors (04/03/2020, C 328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 75-76). It should also have considered the degree of visual similarity between the signs (§ 64).

(ii) INFRINGEMENT OF ARTICLE 8(5) CTMR

The BoA correctly found that it had not been established that the earlier marks have a reputation in the EU. The degree of recognition of the earlier marks is too low (1 %) and the submitted evidence does not even show that this recognition is attached to the name 'Armand de Brignac' or the marks as registered (§ 72-78 and 86).

CONCLUSIONS ON THE OUTCOME OF THE ACTION

The GC annuls the contested decision (§ 87). The conditions for the exercise of the GC's power to alter decisions are not satisfied, since the BoA erroneously found that the signs were not similar and did not carry out the global assessment of the LOC. The Court does not have the power to carry out such an assessment and rule on whether or not there is a LOC (§ 88-89).

16/12/2020, T 438/18, BIKOR EGYPTIAN EARTH, EU:T:2020:630

RESULT: Action dismissed

KEYWORDS: Bad faith

NORMS: Article 52(1)(b) CTMR [now Article 59(1)(b) EUTMR]

KEY POINTS: The potentially descriptive nature of a verbal element comprising a mark does not prevent the conclusion that the proprietor of that mark acted in bad faith when filing the application for the mark (13/11/2019, C 528/18 P, Outsource 2 India (fig.), EU:C:2019:961, § 69) (§ 28).

The EUTM proprietors were not linked to the applicant and bad faith on the part of the EUTM

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proprietors cannot be presumed based merely on their business relationship with an intermediary who knew of the existence of the mark EGYPTIAN EARTH (§ 35-36).

The fact that the EUTM proprietors are also proprietors of other marks using the same term in different language versions suggests that the registration of that mark is not artificial in nature or devoid of logic in commercial terms and had a legitimate aim (§ 39-41).

The addition of the distinctive term 'bikor' also suggests a lack of bad faith on the part of the EUTM proprietors when filing the application for the mark (§ 42-43).

FACTS: Ms Elżbieta Korbut Bikor and Bikor Professional Color Cosmetics Małgorzata Wedekind ('the EUTM proprietors'), registered the word mark BIKOR EGYPTIAN EARTH on 22/08/2012 as an EUTM for goods and services in Classes 3 and 41.

An invalidity application was filed on 23/12/2013 by Pareto Trading Co., Inc. ('the applicant'), based on Article 52(1)(b) and Article 7(1)(b) and (e)(ii) CTMR on the ground that the EUTM proprietors had applied for the mark in bad faith since the applicant had registered the mark 'EGYPTIAN EARTH' in the United States and Canada and used it as a non-registered mark in Europe. The Cancellation Division upheld the invalidity application, considering that the EUTM

proprietors had acted in bad faith when they filed the mark.

The EUTM proprietors filed an appeal before the Board of Appeal (BoA). The BoA upheld the appeal and dismissed the invalidity action. The BoA found that the applicant had not proved that the EUTM proprietors were acting in bad faith when they filed the contested mark.

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 52(1)(b) CTMR. The GC dismissed the action.

SUBSTANCE: INFRINGEMENT OF ARTICLE 52(1)(b) CTMR

The potentially descriptive nature of a verbal element comprising a mark does not prevent the conclusion that the proprietor of that mark acted in bad faith when filing the application for the mark (13/11/2019, C 528/18 P, *Outsource 2 India* (fig.), EU:C:2019:961, § 69) (§ 28).

The applicant had entrusted the distribution of its products in Europe to an intermediary and had authorised that intermediary to use the mark 'EGYPTIAN EARTH' under certain conditions. That intermediary also had a business relationship with the EUTM proprietors, as they were clients of the intermediary (§ 32).

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However, the EUTM proprietors were not linked to the applicant and bad faith on the part of the EUTM proprietors cannot be presumed based merely on their business relationship with an intermediary who knew of the existence of the mark 'EGYPTIAN EARTH' (§ 35-36). There is no evidence that the EUTM proprietors knew or should have known that the applicant was using the mark 'EGYPTIAN EARTH' for the marketing of goods similar to those covered by the contested mark when they filed the EUTM (§ 38).

The applicant also fails to demonstrate that the EUTM proprietors had the sole intention of preventing the applicant from using its mark and that they did not intend to use the contested mark. The fact that the EUTM proprietors are also proprietors of other marks using the same term in different language versions suggests that the registration of that mark is not artificial in nature or devoid of logic in commercial terms and had a legitimate aim (§ 39-41).

The addition of the distinctive term 'bikor' also suggests a lack of bad faith on the part of the EUTM proprietors when filing the application for the mark (§ 42-43).

16/12/2019, T 535/19, JCE HOTTINGER-HOTTINGER, EU:T:2020:614

RESULT: Action dismissed

KEYWORDS: Admissibility, Passing off

NORMS: Article 8(4) CTMR [now Article 8(4) EUTMR], Article 53(1)(c) CTMR [now Article 60(1)(c) EUTMR], Article 27(4)(a) and (b) EUTMDR, Article 177(1)(d) RPGC

KEY POINTS: Undated documents may, in certain cases, be used to establish use of a mark to the extent to which they serve to confirm facts inferred from other items of evidence (19/12/2019, T 383/18, businessNavi (fig.), EU:T:2019:877, § 72) (§ 46).

Annual financial statements are highly reliable and have a high evidential value because they have been audited by an independent audit firm (§ 61).

Article 8(4) CTMR does not require that the use must be proved in the territory of the Member State of which the law is invoked (09/07/2010, T 430/08, Grain Millers, EU:T:2010:304, § 41) (§ 112).

Goodwill is normally proved by evidence of, inter alia, trading activities, advertising, and customers' accounts. Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill (18/07/2017,

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T 45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 49 and the case-law cited) (§ 94). The mere fact that the business of the claimant seeking to maintain an action for passing-off is very small does not of itself prevent it having goodwill since a very slight trading activity has been held to be sufficient to create goodwill (§ 95).

According to section 5(4) of the UK Trade Marks Act, as interpreted by the national courts (decision of the House of Lords *Reckitt & Colman Products Ltd v Borden Inc.* [1990] R.P.C. 341, 406 HL ('Reckitt decision')), the opponent must establish, in accordance with the legal rules governing actions for passing-off, as laid down by the law of the United Kingdom, that three conditions are satisfied: namely, first, the goodwill acquired by the non-registered trade mark or the sign, second, misrepresentation by the proprietor of the subsequent mark and, third, damage caused to that goodwill (18/07/2017, T 45/16, *Byron (fig.) / BYRON*, EU:T:2017:518, § 43 and the case-law cited) (§ 81).

According to the national case-law (*Reckitt decision*) misrepresentation must be proved by taking into account the customer base which is interested in the services provided both by the claimant in an action for passing-off and those of the defendant (11/06/2009, T 114/07 & T 115/07, *Last Minute Tour*, EU:T:2009:196, § 60, 92) (§ 122-124).

FACTS: The EUTM proprietor registered the word mark JCE HOTTINGUER for services in Classes 35 and 36. Pursuant to Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR, an application for declaration of invalidity was filed based on the non-registered earlier national word mark HOTTINGER, used in the course of trade of more than mere local significance in the United Kingdom (UK) for financial and advisory services. The invalidity applicant invoked the law of passing-off. The Cancellation Division (CD) rejected the invalidity application. It found that the invalidity applicant had not proved that the non-registered earlier national trade mark had been used in the course of trade before and on the filing date of the application for a declaration of invalidity.

The invalidity applicant filed an appeal before the Board of Appeal (BoA) and also attached additional evidence to its appeal. The BoA partially annulled the CD's decision and declared the trade mark invalid for all the contested services, with the exception of advertising; publication of publicity texts; updating of advertising material in Class 35. So far as concerns the evidence adduced for the first time before the BoA, the latter decided to consider it admissible since it met the requirements of Article 27(4)(a) and (b) EUTMDR. The BoA found that the evidence clearly showed, first, that the invalidity applicant had carried out genuine trading activities under the non-registered earlier national trade mark before and on the date of application for registration of the contested mark, next, there was misrepresentation

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in relation to the services considered to be identical or similar and, finally, it could be assumed that the invalidity applicant would suffer harm given the similarity of the signs and the identity or similarity of the services.

The EUTM proprietor filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of essential procedural requirements of the application for a declaration of invalidity and (ii) infringement of Articles 53(1)(c) CTMR, read in conjunction with Article 8(4) CTMR. The GC dismissed the action.

SUBSTANCE: (i) ADMISSIBILITY OF PLEAS IN LAW

The first plea is inadmissible (§ 27). The application must be sufficiently clear and precise to enable the defendant to prepare its defense and the Court to rule on the action, if necessary, without any further information (Article 21 Statute of the Court of Justice of the EU and Article 177(1)(d) RPGC) (§ 23-24). The applicant merely reiterates the same arguments it put forward before the BoA and does not rely on any error of law or procedure made by the BoA as referred to in Article 72(2) EUTMR (§ 26).

The parts of the second plea in law, however, correspond to these requirements of precision (§ 30-35).

(ii) INFRINGEMENT OF ARTICLE 53(1)(c) CTMR AND ARTICLE 8(4) CTMR

a) On an error of assessment of the use of the non-registered earlier national trade mark in the course of trade of more than mere local significance.

The evidence filed by the invalidity applicant before the CD as supplemented by new evidence adduced before the BoA was not undated, as claimed by the proprietor (§ 44-45) and the single undated document could be used to establish use of a mark since it confirms facts inferred from other items of evidence (19/12/2019, T 383/18, businessNavi (fig.), EU:T:2019:877, § 72) (§ 46). Each of the annual financial statements for the period 2006 to 2016 contains a statement that the invalidity applicant's principal activities were 'portfolio management advisory and discretionary services'. The statements also indicate the turnover's value and its geographical distribution. Since they have been audited by an independent audit firm, those financial statements are highly reliable and, therefore, have a high evidential value (§ 61). The business activities carried out under the non-registered earlier national trade mark were also confirmed by the press articles and exhibits concerning transactions carried out by the invalidity applicant's managing director on its behalf (§ 63). Finally, the evidence shows as well that the relevant public had knowledge of the non-registered earlier national trade mark (§ 69-75).

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Thus, the BoA did not err in finding that the evidence was capable of demonstrating that the non-registered earlier national trade mark had been used in the course of trade and its significance was of more than mere local significance.

b) On an error of assessment of the existence of a right to prohibit the use of the contested mark under the law of the United Kingdom

It follows from section 5(4) of the UK Trade Marks Act, as interpreted by the national courts ('Reckitt decision'), that the opponent must establish, in accordance with the legal rules governing actions for passing-off, as laid down by the law of the United Kingdom, that three conditions are satisfied: namely, first, the goodwill acquired by the non-registered trade mark or the sign, second, misrepresentation by the proprietor of the subsequent mark and, third, damage caused to that goodwill (18/07/2017, T 45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 43 and the case-law cited) (§ 81).

The BoA, giving particular importance to the two witness statements of the invalidity applicant's managing director (§ 101, 102) and to exhibits which substantiated them (§ 103-108), was right to find that the evidence showed that the invalidity applicant had acquired goodwill in the services referred to in the application for a declaration of invalidity (§ 109).

Article 8(4) CTMR does not require that the use must be proved in the territory of the Member State of which the law is invoked (09/07/2010, T 430/08, Grain Millers, EU:T:2010:304, § 41) (§ 112).

Goodwill is normally proved by evidence of, inter alia, trading activities, advertising, and customers' accounts. Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill ((18/07/2017, T 45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 49 and the case-law cited) (§ 94). The mere fact that the business of the claimant seeking to maintain an action for passing-off is very small does not of itself prevent it having goodwill since a very slight trading activity has been held to be sufficient to create goodwill (§ 95).

According to the national case-law (Reckitt decision), misrepresentation must be proved by taking into account the customer base which is interested in the services provided both by the claimant in an action for passing-off and those of the defendant (11/06/2009, T 114/07 & T-115/07, Last Minute Tour, EU:T:2009:196, § 60, 92) (§ 122-124). Given that in the present case there would be misrepresentation in any event, irrespective of the customer segment taken into consideration, the fact that the BoA considered that the misrepresentation had to be assessed with regard to the customers of the proprietor of the contested mark has no effect on the lawfulness of the contested decision (§ 126).

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For an action for passing-off to be well founded, the misrepresentation must lead to a likelihood of confusion (§ 127). The BoA was correct in holding that there was a likelihood of confusion between the signs for the contested services which were found to be identical or similar to different degrees to the services covered by the non-registered earlier national trade mark (§ 124-130, 136).

The BoA rightly found that, given that the signs were highly similar and the services partly identical or similar to different degrees (not disputed), there was no need for the invalidity applicant to adduce specific evidence of instances of confusion that would be likely to cause damage to the invalidity applicant (§ 141-143).

16/12/2020, T 665/19, €\$(fig.), EU:T:2020:631

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Non-distinctive, Well known facts need no evidence

NORMS: Article°94(1) EUTMR, Article°95(1) EUTMR, Article°7(1)(b) EUTMR.

FACTS: The applicant sought to register the figurative sign '€\$' for goods and services in Classes 9 (such as 'computer software, electronic publications downloadable from the Internet'), 36

(such as 'foreign exchange operations, financial services') and 41 (such as 'publishing of texts other than advertising texts, organisation and conduct of workshops and training courses'). Pursuant to Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR, the examiner refused the application for goods and services in Classes 9, 36 and 41.

The Board of Appeal (BoA) dismissed the appeal.

The applicant filed an action before the General Court (GC). The GC upheld the action. It found that there was a lack of reasoning as the decision did not contain any statement of reasons in relation to the goods and services covered by the mark that are not related to foreign exchange operations. The BoA failed to explain why it considered that the sign was descriptive for each of those goods and services. Accordingly, the GC could not exercise its review of legality of the substance of the decision.

The case was remitted back to the BoA.

In the new decision, the BoA found that the sign was devoid of any distinctive character for all the goods and services applied for. The symbols of the euro and of the dollar, two well-known currencies within the EU, will be easily perceived by the relevant public in the mark applied for. Nothing distinguishes these symbols from the way in which they are generally used in commerce, the graphic elements of the signs are merely decorative. Secondly, the sign

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applied for was also objected under Article 7(1) (i) concerning trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest.

The applicant filed another action before the GC, relying on five pleas in law: (i) infringement of Article 94(1) EUTMR in combination with Article 41(2)(c) of the Charter of Fundamental Rights of the EU, (ii) infringement of Article 95(1) EUTMR, (iii) infringement of Article 72(6) EUTMR, (iv) infringement of Article 7(1)(b) EUTMR and (v) infringement of Article 7(1)(i) EUTMR. The GC dismissed the action.

EUTM Application



SUBSTANCE: i) and iii) INFRINGEMENT OF ARTICLE 94(1) EUTMR in combination with Article 41(2)(c) of the Charter of Fundamental Rights of the EU and of ARTICLE 72(6) EUTMR.

Although the BoA did not assess the distinctive character of the mark for each of the goods and services covered by the application, it divided them into five different groups and gave separate and

adequate reasons for each of those groups. The BoA explained why it considered that the sign at issue is, for each of those groups, devoid of distinctive character. Accordingly, the BoA complied with its duty to state reasons (§ 36-43).

The BoA decision also complied with the first judgment of the GC and did not repeat the mistakes found in it (§ 57.)

ii) INFRINGEMENT OF ARTICLE 95(1) EUTMR

EUIPO decision-making bodies can base their decisions on well known facts, which have not been invoked before them, without having to establish their accuracy (10/09/2019, T 744/18, Silueta en forma de elipse discontinua (fig.) / Silueta en forma de elipse (fig.), EU:T:2019:568, § 57-58) (§ 63). In order to challenge a well-known fact, and thus oblige EUIPO to provide evidence in response to that challenge, the appellant must do so in a detailed manner (10/09/2019, T 744/18, Silueta en forma de elipse discontinua (fig.) / Silueta en forma de elipse (fig.), EU:T:2019:568, § 63). This has not been done in the present case so the head of claim must be dismissed (§ 65-67).

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

The goods and services of the sign applied for are aimed both at professionals and average consumers (not contested) (§ 84).

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The BoA considered the overall impression produced by the mark, examining in detail also the graphical representation of the same and holding in that regard that it is a common one, not distinguishable from those commonly used in trade (§ 88-90).

A mark must allow the relevant public to distinguish the products covered by that mark from those of other undertakings without paying particular attention, so that the distinctiveness threshold, necessary for registration of a mark, cannot depend on the public's level of attention (14/02/2019, T 123/18, DARSTELLUNG EINES HERZENS (fig.), EU:T:2019:95, § 17, 11/09/2019, T 34/19, PRODUCED WITHOUT BOILING SCANDINAVIAN DELIGHTS ESTABLISHED 1834 FRUIT SPREAD (fig.), EU:T:2019:576, § 29). Accordingly, the level of attention of the relevant public is not to be considered when assessing distinctive character of the mark in question (§ 93).

The mark applied for is devoid of any distinctive character in relation to goods in Classes 9 and services in Classes 36 and 41 (§ 98-111).

Since one of the absolute grounds for refusal is applicable, there is no need to review the applicant's arguments in relation to Article 7(1)(i) EUTMR (§ 112).

16/12/2020, T 859/19, Alkemie / Alkmene, EU:T:2020:615

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Conceptual Dissimilarity, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

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

FACTS: The applicant sought to register the word mark Alkemie for goods and services in Class 3, such as Cosmetics and cosmetic preparations for skin care, Class 5, such as Cosmetics with medical properties: medicated lotions and dietary aids and Class 35 such as Retailing, wholesaling, sale via the internet and mail order sale of the following goods: cosmetics, cosmetic preparations for skin care [...].

Pursuant to Article 8(1)(b) EUTMR an opposition was filed based on the earlier EU word mark Alkmene registered for goods in Class 3, such as Body care and beauty products, particularly make-up removing preparations, essential oils and essences . The Opposition Division upheld the opposition for part of the goods and services.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that there was a likelihood of confusion (LOC) between the signs.

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

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

The relevant public consists of the general consumer and professionals (only for the wholesale services) in the EU displaying a level of attention that varies from average to high while being higher for the health-related goods in Class 5. (not disputed) (§ 20-21).

The goods and services under comparison are identical or similar to varying degrees (not disputed) (§ 22-23).

The comparison concerns two word marks which are both composed of seven letters, without any space or other separation. Both marks have to be assessed as a whole, since the public's attention will not be drawn to any particular sequence of letters, such as the letter sequences 'emie' and 'mene' (§ 28-31).

The marks are visually similar to an average degree due to the identity of four letters out of seven and the presence of the same two letters in reverse order (§ 35-37).

The signs are phonetically similar to an average degree since both marks consist of three syllables and the pronunciation of the two words differs only in the different sound of the letters 'i' and 'n', which is not capable of reducing the similarity resulting from the pronunciation of the other letters (§ 41-42).

The marks are not similar from a conceptual point of view, since for the relevant public, the mark applied for may evoke ideas associated with the concept of alchemy, while the earlier mark has no meaning (§ 51).

Given the normal inherent distinctiveness of the earlier mark and the average degree of visual and phonetic similarity between the signs, that cannot be neutralised by the conceptual differences (which are not so clear and specific) and the principle of imperfect recollection, there is a LOC between the signs even for the relevant public with a high level of attention for the identical or similar goods (§ 58-61).

However, while noting that the food accessories in Class 5 covered by the mark applied for were not similar to the goods covered by the earlier mark, the BoA confirmed the existence of a LOC regarding those goods, which appear in the list of goods and services in respect of which the opposition was upheld by the OD. The contested decision is thus annulled in so far as it dismissed the appeal as regards food accessories in Class 5 (§ 63-66).

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16/12/2020, T 860/19, ALKEMIE (fig.) / Alkmene, EU:T:2020:616

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Conceptual Dissimilarity, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

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

FACTS: The applicant sought to register the figurative mark 'ALKEMIE' for goods and services in Class 3, such as Cosmetics and cosmetic preparations for skin care, Class 5, such as Cosmetics with medical properties: medicated lotions and dietary aids and Class 35 such as Retailing, wholesaling, sale via the internet and mail order sale of the following goods: cosmetics, cosmetic preparations for skin care [...].

Pursuant to Article 8(1)(b) EUTMR an opposition was filed based on the earlier EU word mark Alkmene registered for goods in Class 3, such as Body care and beauty products, particularly make-up removing preparations, essential oils and essences. The Opposition Division upheld the opposition for part of the goods and services.



The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that there was a likelihood of confusion (LOC) between the signs.

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

Trade mark application



Earlier rights

Alkeme

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

The relevant public consists of the general consumer and professionals (only for the wholesale services) in the EU displaying a level of attention that varies from average to high while being higher for the health-related goods in Class 5 (not disputed) (§ 20-21).

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The goods and services under comparison are identical or similar to varying degrees (not disputed) (§ 22-23).

The earlier mark is composed of seven letters, without any space or other separation. The word elements are juxtaposed in such a way as to form a single word. Thus, there is nothing in the wording to suggest that the relevant public would separate the letter sequence 'Alk' from the other letters making up that word (§ 28). The mark applied for consists of a word element and a figurative element (§ 29). Despite the slight stylisation of certain letters making up the word element, it appears to constitute a single word, since it is written in a uniform manner in the same colour and font in terms of size, horizontal alignment and distance between the letters; furthermore, it evokes a word which exists in various languages of the EU (§ 31). Neither the word element nor the figurative element exclusively dominates the image of the mark applied for, since they are both of a similar and clearly visible size; therefore, no part of the mark applied for can be regarded as negligible (§ 36). Both marks have to be assessed as a whole, since the public's attention will not be drawn to any particular sequence of letters, such as the letter sequences 'emie' and 'mene' or the figurative element in the mark applied for (§ 37).

In view of the presence of a non-negligible figurative element in the mark applied for, which does not appear in the earlier mark, the visual similarity of the

signs is below average, despite their similar word elements with four identical letters out of seven and the same two letters in reverse order (§ 46).

The signs are phonetically similar to an average degree since both marks consist of three syllables and the pronunciation of the two words differs only in the different sound of the letters 'l' and 'n', which is not capable of reducing the similarity resulting from the pronunciation of the other letters (§ 51-52).

The marks are not similar from a conceptual point of view, since for the relevant public, the mark applied for may evoke ideas associated with the concept of alchemy or associated with the image of a dragonfly, and the earlier mark has no meaning (§ 62).

Given the normal inherent distinctiveness of the earlier mark and the degree of visual similarity below average and the average phonetic similarity between the signs, that cannot be neutralised by the conceptual differences (which are not so clear and specific) and the principle of imperfect recollection, there is a LOC between the signs even for the relevant public with a high level of attention for the identical or similar goods (§ 67-74).

However, while noting that the food accessories in Class 5 covered by the mark applied for were not similar to the goods covered by the earlier mark, the BoA confirmed the existence of a LOC as regards those goods, which appear in the list of goods and

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services in respect of which the opposition was upheld by the OD. The contested decision is thus annulled in so far as it dismissed the appeal as regards food accessories in Class 5 (§ 75-78).

16/12/2020, T 863/19, PCG CALLIGRAM CHRISTIAN GALLIMARD / GALLIMARD et al., EU:T:2020:632

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Enhanced distinctiveness, Identity of the goods and services, Likelihood of confusion, Personal name mark, Phonetic similarity, Similarity of the goods and services, Similarity of the signs, Survey, Visual similarity

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

KEY POINTS: games; toys in Class 28 are similar to interactive television and/or audiovisual games in Class 9 (§ 64). In the past, the Court has already found similarity between games in Class 28 and games in Class 9 (19/04/2016, T 326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 59) (§ 61).

Where marks are composed of an identical element understood as a surname, the mere addition in one of the marks of a first name, in this case 'Christian', cannot create a conceptual difference between

those marks. On the contrary, those marks will be understood by the relevant public as designating the names of people and, more particularly, of people having the same surname (08/11/2017, T 271/16, Thomas Marshall Garments of legends (fig.) / MARSHALL et al., EU:T:2017:787, § 78) (§ 109).

FACTS: The applicant sought to register the word mark PCG CALLIGRAM CHRISTIAN GALLIMARD as an EUTM for goods and services in Classes 9, 16, 28 and 41.

An opposition was filed based on the earlier EUTM No 1 845 031 GALLIMARD registered for goods and services in Classes 9, 16 and 41 ('earlier trade mark No 1'), earlier EUTM No 9 995 226 GALLIMARD registered for goods and services in Classes 9, 38 and 41 ('earlier trade mark No 2') and earlier mark GALLIMARD well known in France ('earlier trade mark No 3'). The grounds are Article 8(1)(b) and Article 8 (2) CTMR.

The Opposition Division upheld the opposition for all the contested goods and services, except for some goods in Class 16 such as paper and cardboard; bookbinding material.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that there is a likelihood of confusion (LOC) between the contested mark and earlier trade marks Nos 1 and 2, both of which also enjoy enhanced distinctive

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character for part of the goods and services for which they are registered. The opposition based on earlier trade mark No 3 did not need to be examined.

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

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

Comparison of goods and services

The contested journals; pamphlets; prospectuses; activity books; exercise books; writing books; children's activity books; manuals [handbooks]; instructional manuals for teaching purposes; calendars; atlases; posters; agendas; newspapers; magazines [periodicals]; educational publications in Class 16 are all included in the printed publications, books of the same Class for which earlier mark No 1 has been used (§ 41). Therefore, the products under comparison are identical (§ 42).

The contested production of video and/or sound recordings; production of sound and image recordings on sound and image carriers; production of educational sound and video recordings in Class 41 are all included in the broader category production covered by earlier mark No 2 (§ 52). Therefore, the services under comparison are identical (§ 53).

The contested animated cartoons cinematographic films, multi-media recordings in Class 9 are identical to pre-recorded video discs and pre-recorded discs in the same class covered by earlier mark No 2 (§ 56).

The contested games; toys in Class 28 are similar to interactive television and/or audiovisual games in Class 9 covered by earlier mark No 2 (§ 64). In the past, the Court has already found similarity between games in Class 28 and games in Class 9 (19/04/2016, T 326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 59) (§ 61).

Comparison of the marks

The element 'Gallimard' is the most distinctive and dominant element within the mark applied for, because it is an uncommon surname. The element 'PCG' is secondary because it is an acronym and it is short. The same applies to the terms 'calligram' (which is weak for most of the contested goods and services in connection with publishing, literature and publications) and the first name Christian (which is very common) (§ 85).

The term 'Gallimard' in the earlier marks, which will not be dissected by the relevant public, is clearly distinctive for the goods and services covered (§ 86).

The signs are visually and aurally similar to an average degree (§ 93 and 98).

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Conceptually, the signs share the common element “Gallimard” which will be perceived as a rare and uncommon surname, evoking a famous editor in the mind of the French public. The fact that the signs have such surname in common may give rise to a high conceptual similarity (19/09/2019, T 678/18, GIUSTI WINE / DG DeGIUSTI (fig.) et al., EU:T:2019:616, § 52-53) (§ 108), which, in this case, is partially attenuated by the additional elements in the contested mark (§ 111). Therefore, the signs are conceptually similar to an average degree (§ 112).

Where marks are composed of an identical element understood as a surname, the mere addition in one of the marks of a first name, in this case ‘Christian’, cannot create a conceptual difference between those marks. On the contrary, those marks will be understood by the relevant public as designating the names of people and, more particularly, of people having the same surname (08/11/2017, T 271/16, Thomas Marshall Garments of legends (fig.) / MARSHALL et al., EU:T:2017:787, § 78) (§ 109).

The BoA also rightly held that the earlier marks enjoy a high degree of recognition among the French public for electronic publications in Class 9, printed publications, books in Class 16 and for services in Class 41 such as publication services (§ 116-123).

Global assessment of likelihood of confusion

Taking into account the identity or similarity of the goods and services, the average visual, aural and conceptual similarity of the marks, the enhanced degree of distinctive character of the earlier marks for some goods and services and the normal distinctiveness for others, and considering the autonomous distinctive position retained by the element ‘GALLIMARD’—which makes it clearly perceptible in the mark applied for—there is a LOC for the French-speaking public in relation to all of the contested goods and services (§ 149).

16/12/2020, T 3/20, Canoleum / Marmoleum, EU:T:2020:606

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Declaration, Restitutio in integrum

NORMS: Article°104 EUTMR, Article 97(1)(f) EUTMR

KEY POINTS: Where a sworn declaration, submitted as evidence according to Article 97(1)(f) EUTMR, is made in the interest of the declarant, it has only limited probative value and should be supported by additional evidence (16/06/2015, T 585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 28-31). The assessment of the probative value to be attributed to such a statement, however, must consider the circumstances of the concrete case (§ 51-52).

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As regards a declaration made by a lawyer, the fact that the lawyer is a member of a legal profession who is required to carry out his duties in accordance with the rules of professional conduct and moral requirements, and who would be exposed to penal sanctions in case of a false statement that would be, moreover, prejudicial to his reputation, must be considered (§ 55). A written sworn declaration by a lawyer (and by his wife) constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive and there is no doubt about its authenticity (§ 56, 58).

Where additional evidence capable of supporting the content of a sworn declaration, such as a medical certificate, could not reasonably be required or was not available, (namely in case of a specific and sudden illness), the situation is different from those where such statements are submitted in order to establish purely objective facts, such as genuine use of a mark, and where according to established case-law, the declarations must be supported by additional evidence for their probative value (§ 57 59).

FACTS: On 17 May 2017, the applicant sought to register the word mark Canoleum for goods in Classes 19 and 27.

On 27 September 2017, pursuant to Article 8(1) (b) CTMR, an opposition was filed based on the earlier international registration of the word

mark Marmoleum designating the EU and several Member States for goods in Classes 19 and 27. The Opposition Division rejected the opposition since it found that there was no likelihood of confusion.

On 9 April 2019, the opponent filed an appeal before the Board of Appeal (BoA). However, the opponent did not submit the statements of grounds within the prescribed time limit of Article 68 EUTMR (12 June 2019). The opponent attached to the statement of grounds an application for restitutio in integrum according to Article 104 EUTMR, claiming that the lawyer dealing with the case was unable to submit the statement of grounds within the prescribed time limit because of an unforeseeable serious illness. In support of that argument, the opponent produced two sworn declarations, one from the lawyer and the other from his wife. By decision of 9 October 2019, the BoA dismissed the appeal as inadmissible. It took the view that the lawyer had not adduced sufficient proof that he had taken all due care required by the circumstances. The BoA criticised him for, inter alia, not having produced a medical certificate, considering that the sworn declarations had limited probative value.

The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 104 EUTMR in conjunction with Article 97(1)(f) EUTMR. The GC upheld the action and annulled the decision of the BoA.

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SUBSTANCE: INFRINGEMENT OF ARTICLE 104 EUTMR IN CONJUNCTION WITH ARTICLE 97(1)(f) EUTMR

A sworn statement constitutes admissible evidence according to Article 97(1)(f) EUTMR (§ 51). Where a sworn declaration is made in the interest of the declarant, it has only limited probative value and must be supported by additional evidence (16/06/2015, T 585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 28-31). This does not, however, allow the Office to consider, in principle, that such a statement is, in itself, not credible. The probative value to be attributed to such a statement depends on the circumstances of the case (§ 52).

In the present case, as regards the declaration made by the lawyer, the BoA failed to consider the fact that the lawyer is a member of a legal profession who is required to carry out his duties in accordance with the rules of professional conduct and moral requirements and who would be exposed to penal sanctions in case of a false statement, which would be, moreover, prejudicial to his reputation (§ 55).

A written sworn declaration by a lawyer constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive, and there is no doubt about its authenticity (§ 56).

Furthermore, the BoA did not consider the fact that the illness alleged by the lawyer as the cause of the

failure to comply with the time-limit was private and that he was best placed to provide information on that incident and, in particular, on his symptoms and disorders (§ 57).

As regards the declaration made by the lawyer's wife, the BoA should also have considered the fact that the persons who witness an incident, are mostly in the immediate vicinity of the person concerned and that, like the lawyer himself, his wife would also be exposed to penal sanctions in case of a false sworn declaration (§ 58).

Moreover, the BoA did not consider the fact that additional evidence capable of supporting the content of both sworn declarations, such as a medical certificate, could not reasonably be required or was not available. The present case relates to a specific and unforeseeable event in a person's life. That situation is therefore different from those where such statements are submitted in order to establish purely objective facts, such as genuine use of a mark and in which according to established case-law the declarations must be supported by additional evidence for their probative value (§ 57-59). Consequently, the GC annulled the decision of the BoA.

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09/12/2020, [R2642/2017-1](#), KEYNOTE

Revocation grounds – Article 58(1)(a) EUTMR – Legal certainty – Abuse of rights and process – Revocation rejected

The request for a declaration of revocation of the EUTM registration was filed on the grounds of non-use in respect of all the goods covered by registration, namely those in Classes 9, 38 and 42. The Cancellation Division rejected the request for a declaration of revocation on the basis that the cancellation applicant was seeking to rely on Article 58(1)(a) EUTMR for abusive ends unrelated to the public interest underlying this provision. The Cancellation Division stated that the principle that the motives and earlier conduct of an applicant for revocation are irrelevant to the scope of the examination under Article 58(1)(a) EUTMR, which is not absolute where there is evidence that a party is engaged in abusive practices.

The Board observes, first, that the many of the facts and principal legal issues in this case duplicate those addressed by the Grand Board of Appeal in case [11/02/2020, R 2445/2017-G, Sandra Pabst](#). Pursuant to Article 166(8) EUTMR decisions taken by the Grand Board on appeals are binding on individual Boards of Appeal. Thus, the Board is compelled to

closely follow the reasoning and findings set out in the case above. The Board finds, taking into account the merits of the present case that, whilst it is legitimate (and requires no clarification, explanation or justification) to attack an individual trade mark, it is clearly abusive in itself to attack a long list of trade marks belonging to another party which have nothing in common other than their ownership. What the cancellation applicant is seeking to obtain is not the cancellation of a particular trade mark in the public interest, but the loss of a large part of the trade mark portfolio of a given company. Moreover, the background of the case is that the cancellation applicant threatens to deprive the EUTM proprietor of a very significant number of these rights as a retaliatory measure following the failure to obtain the 'SHERLOCK' trade marks from the EUTM proprietor by consent or contract. The cancellation applicant's attempt to obtain the 'SHERLOCK' trade marks, coupled with a massive revocation attack over a short period of time against 120 trade marks belonging to the EUTM proprietor is no more than a scheme to obtain a particular trade mark, that is, to force the EUTM proprietor into an agreement. The Board also addresses the aspects of appropriation of the EUTM proprietor's trade marks throughout the EU by the cancellation applicant and related companies, the quantity of revocation cases overall, the absence of underlying business activities or a rational explanation for the cancellation applicant's actions. As to the former, the Board notes that the public interest underlying Article 58 EUTMR is not

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absolute. It is in the public interest to cancel a non-used trade mark but it is not in the public interest to flood other parties or even Offices with vexatious requests. The Board cannot see any rational aim or objective in this huge mass of activities, taking also into account the expense involved for Office fees or costs of company registrations. To the contrary the absence of any rational explanation rather supports the finding of abuse, based on the consideration that there are no legitimate business interests behind all this. The Board, taking into account all the circumstances of the case, confirms the findings of the contested decision that there was an abuse of rights and of process on the part of the cancellation applicant.

15/01/2021, R 67/2020-1, Urban Exploration / Urban Explorer (fig.)

Earlier trade mark



Contested EUTM

Urban Exploration



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

The applicant sought to register the word mark 'Urban Exploration' for a range of services in Class 35, specifically for on-line retail store services, retail store services, mail order, catalogue and distributorship services, all featuring different categories of goods, but expressly excluding such services relating to vehicles, parts and fittings for vehicles. An opposition was filed on the grounds of Article 8(1)(b) EUTMR based on an earlier EUTM registration for the figurative mark above in respect of retail and wholesale services in relation to vehicles, their parts and fittings in Class 35. The Opposition Division upheld the opposition and refused the contested EUTM entirely on the grounds of a likelihood of confusion for a part of the relevant public. As regards the services at issue, the Opposition Division found that retail services relating to specific goods were considered to be similar to retail services relating to other specific goods independently of whether or not there was a similarity between the goods in question. It held that the services under comparison shared the same nature as both were retail services, had the same purpose of allowing consumers to conveniently satisfy different shopping needs and had the same method of use.

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The Board annuls the contested decision and rejects the opposition on the grounds that there is no likelihood of confusion as the services at issue are dissimilar. The Board has analysed the nature of retail services emphasising that a retail service is, inter alia, an advisory activity, namely an aid to assist the purchaser in selecting from an assortment. It requires the retailer to have expertise with regard to the properties, functions, uses and qualities of the goods. The retailer's skills, expertise and knowledge required for retail services differ significantly depending on the sector of the goods. In view of this the Board finds that in the case at hand the skills associated with that of purveying vehicles, their parts and accessories are very different from those associated with the sale of clothing, footwear, headgear, camping and outdoor equipment. It is clear that the nature of the goods at issue is different, as is their purpose and method of use. There is no proximity between the goods which form the subject-matter of the retail services under comparison. This is particularly the case if the specification of the contested services mentions that none of the retail services relate to vehicles, or parts and fittings for vehicles. The services themselves are neither in competition with, or complementary to, each other. They also have completely different distribution channels.



12/01/2021, R 2684/2019-5, Pinkman / Pinkman

Earlier trade mark

Pinkman

Contested sign

Pinkman

Earlier non-registered trade mark – Article 8(4) EUTMR – Lack of valid basis –Opposition rejected

The applicant sought to register the word mark 'Pinkman' for, inter alia, goods in Class 34. An opposition was filed on the grounds of Article 8(4) EUTMR based on an earlier non-registered UK trade mark used in the course of trade in respect of electronic cigarettes, flavour essences, liquids and liquid nicotine solutions for electronic cigarettes. The Opposition Division partly upheld the opposition and rejected the contested EUTM on the grounds of Article 8(4) EUTMR in conjunction with the law governing the earlier non-registered UK trade mark, i.e. the common law tort of passing off.

The Board annuls the contested decision and rejects the opposition in its entirety on the grounds that the requirements of Article 8(4) EUTMR have

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not been fulfilled. The decision deals with the consequences of the withdrawal of the UK from the EU ('Brexit'). It is recalled that as of 1 January 2021 the EUTMR is no longer applicable to United Kingdom rights. Accordingly, as of 1 January 2021 earlier rights protected under the law of 'passing off' in the United Kingdom are not governed 'under the law of a Member State' as stipulated by Article 8(4) EUTMR. The Board emphasises that earlier rights invoked in an opposition or cancellation have to be a) valid at the time when the contested mark was filed and b) continue to be valid during the opposition, cancellation or appeal proceedings when the decision is taken. It is not sufficient that the earlier right was valid when the application for the younger mark was lodged. If the earlier mark is withdrawn, not renewed, cancelled, revoked or loses its validity for any other reason in the course of the proceedings, the opposition or cancellation is automatically dismissed. A different view would lead to the absurd result that any EUTM filed before 1 January 2021 might still be attacked by an 'earlier' UK right (filed before the attacked EUTM) even many years from now although the UK right would have lost its validity in the territory of the European Union long ago. The Board also holds that the opposition fails not only due to the lack of a valid basis, but also because the opponent did not show use in the course of trade of the invoked earlier right under Article 8(4) EUTMR.



08/12/2020, R 1439/2019-5, apo-discounter.de (fig.)

apo-discounter.de

Revocation grounds – Article 58(1)(a) EUTMR – Extent of use – Use for the services at issue – Appeal partially allowed

A request for a declaration of revocation of the EUTM registration was filed on the grounds of non-use pursuant to Article 58(1)(a) EUTMR in respect of all the services covered by the registration in Class 35 that concerned wholesale and retail services in relation to different categories of goods, including chemicals, pharmacy products, cosmetics, household goods and goods for the health sector. The Cancellation Division upheld the request for revocation on the grounds that there was insufficient evidence as regards the extent of use made in respect of the services under the trade mark within the European Union.

The Board, first, deals with the issue of belated evidence adduced by the EUTM proprietor accepting it as additional evidence under its discretionary power conferred under Article 95(2) EUTMR and Article 27(4) EUTMDR. The Board then addresses the applicable standard for the proof of use of wholesale and retail services. It stresses that the question of whether the evidence of use is sufficient to show genuine use of a trade mark for retail (or

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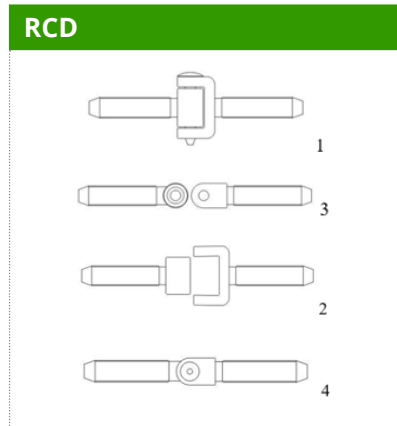
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wholesale) in relation to specific goods should be answered by applying the same principles and rules which also govern the proof of use of any other good or service. If the mark is registered for retail services relating to the products A and B and evidence was shown only for retailing products A, the mark has to be revoked for retail in relation to products B. Likewise, if the mark is registered for retail relating to the general category of goods A, which can be divided into two independent sub-categories A1 and A2, and proof of the use was only shown for retailing relating to the sub-category A1, the list of services subject to the revocation request needs to be limited to 'retail for A1'. In the present case, also in view of the supplementary evidence furnished by the EUTM proprietor in the appeal proceedings, the Board finds that there is genuine use demonstrated in the European Union in respect of some of the services covered by the registration, namely 'retail services in relation to pharmaceutical preparations and cosmetics'. Although the evidence adduced only shows the use in respect of online retail, the Board, applying the principles established in the 'Aladin' judgment (14/07/2005, T 126/03, Aladin, EU:T:2005:288, § 45), acknowledges the use in respect of the entire category of 'retail services'. It underlines that online retail services have the same purpose as traditional retail. Moreover, both variants overlap to a large extent. Thus, most traditional retailers also offer their goods on internet platforms nowadays. At the same time, some online retailers have also started to sell their products in physical shops. For those reasons, 'online retail' is not an independent sub-category of retail in general.

Analysing further the evidence on file, the Board finds that genuine use of the EUTM is demonstrated only in respect of 'retail in relation to cosmetics and pharmaceutical preparations', the latter being an independent sub-category of the general categories 'chemicals', 'pharmacy products', 'goods for health sector' covered by the EUTM registration. The Board concludes that the evidence is insufficient to prove use of the mark for retail services in relation to the general categories 'chemicals', 'pharmacy products' and 'goods for health sector'.

21/01/2021, R 2486/2019-3, Fittings for windows



Invalidation - Scope of proceedings - Article 63(1) CDR - Lack of novelty - Article 5 CDR

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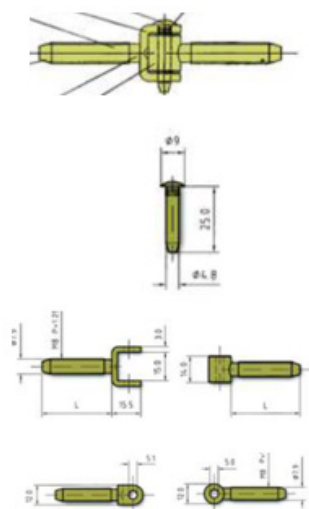
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An application for a declaration of invalidity of the RCD above was filed on the grounds of its lack of novelty pursuant to Article 5 CDR. Specifically, the invalidity applicant claimed in essence that the contested RCD was not new since a number of identical designs had been made available to the public before its filing date, inter alia, the following designs:



invalidity under Article 6 CDR which was not invoked by the invalidity applicant. By doing so, the Invalidity Division went beyond the facts, evidence and arguments provided by the parties and the relief sought within the meaning of the second sentence of Article 63(1) CDR. The contested decision is therefore vitiated by an error and should in principle be annulled. Nevertheless, pursuant to the second sentence of Article 60(1) CDR, the Board may either remit the case to the department responsible for the decision appealed for further prosecution or exercise any power within the competence of that department. Having all the facts and evidence of the case needed for the reassessment of the substantial part of the case based on Article 5 CDR, the Board will examine the merits of the case. The Board finds that the designs at issue are identical since they coincide in all their features of appearance, namely the elongated shape of a bolt hinge which comprises a bush portion, a forked portion and a rotation pin. Slight differences in the proportions, if any, are considered immaterial details. Consequently, the appeal is dismissed and the contested RCD declared invalid.

The Invalidity Division declared the contested RCD invalid because of its lack of individual character. The Board finds that the Invalidity Division exceeded the limits of its powers by examining the individual character of the contested RCD, a ground of

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29/01/2021, R 1100/2020-5, GAUDÍ ORIGINAL INSPIRATED (fig.) / Antoni Gaudí et al.

Earlier rights

Antoni Gaudí

Contested EUTM



Invalidity – Right to a name – Article 60(2)(a) EUTMR – Decision confirmed – EUTM cancelled

A request for a declaration of invalidity of the EUTM registration was filed, inter alia, on the grounds of Article 53(2)(a) CTMR (now Article 60(2)(a) EUTMR) invoking a right to the name Antoni Gaudí. The Cancellation Division upheld the request for a declaration of invalidity and declared the contested EUTM invalid in its entirety. The EUTM proprietor filed an appeal claiming that the Cancellation Division had not correctly interpreted Spanish law as regards the right to a name.

The Board finds that the cancellation applicant's claim based on the provisions of Spanish law relating to the protection of a name is well founded. The contested EUTM violates the cancellation applicant's right to the name Antoni Gaudí, the famous Catalan architect. Firstly, the Board confirms that cancellation applicant is entitled, as the architect's heir, to bring the relevant action against the EUTM registration. Secondly, according to Spanish law, trade marks consisting of the name, surname, pseudonym or any other sign which, for the general public, identifies a person other than the applicant cannot be registered without consent. In the present case, the contested EUTM comprises the word element 'Gaudí' together with an imitation of one of the few existing photographs of Antoni Gaudí evoking also his unique technique called 'trencadis'. The cancellation applicant is entitled to represent the rights of Antoni Gaudí and to prohibit the use of a trade mark containing the name Antoni Gaudí under Spanish law. It has not been demonstrated that the EUTM proprietor has obtained consent to use these elements in the trade mark. Consequently, the Board dismisses the appeal.

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03/02/2021, R 836/2020-2, SENSATION (fig.) / Sensation et al.

Earlier trade marks

Sensation

SENSATION
J. Morant - Valencia

Contested EUTM

SENSATION

Invalidity – Article 60(1)(a) EUTMR – Proof of use – Belated evidence – Time of use – Cancellation rejected

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Article 60(1) (a) EUTMR in conjunction with Article 8(1)(a) and (b) EUTMR in respect of part of the goods and services in Classes 31 and 35 covered by the registration. The request for a declaration of invalidity was based on the earlier Spanish trade mark ‘SENSATION’ and the earlier international registration for the figurative mark above, designating the Benelux, France, Germany and Italy, both registered in respect of goods in Class 31. The EUTM proprietor requested proof of use of the earlier trade marks.

The Cancellation Division rejected the request for a declaration of invalidity in its entirety on the grounds that genuine use of both earlier marks within the second relevant five-year period had not been demonstrated by the cancellation applicant.

The Board observes that the cancellation applicant does not in fact dispute that the request for a declaration of invalidity was correctly rejected due to the lack of genuine use in the second relevant time period. On the contrary, it seems to accept this, by simply presenting an annex with invoices from this period. The Board finds that the purpose of the new evidence filed by the cancellation applicant before the Board is not to challenge the finding of the contested decision, but rather to remedy it. Therefore, the Board takes the view that exercising its discretionary power conferred to it under Article 95(2) EUTMR in favour of the cancellation applicant at this stage would mean exercising it against the EUTM proprietor, contrary to the legal principles of the EUTMR and the relevant case-law, since it would be tantamount to allowing the cancellation applicant another opportunity to prove its point. Moreover, it is noted that in its appeal the cancellation applicant did not provide any reasons, valid or otherwise, as to why it failed to produce any evidence or arguments in support of genuine use of its earlier marks in the second relevant five-year period. Consequently, the Board rejects, in accordance with Article 27(4) EUTDMR, the evidence submitted by the cancellation applicant at the appeal stage and dismisses the appeal.

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09/02/2021, R 237/2020-4, Sol de Mallorca / Mallorca

Earlier PGI

Mallorca

Contested sign

Sol de Mallorca

Article 8(6) EUTMR – Protected Geographical Indication – Opposition allowed

The applicant sought to register the word mark ‘Sol de Mallorca’ for goods in Classes 32 and 33. The EUTM applied for was rejected under Article 7(1)(j) EUTMR with respect to ‘alcoholic beverages (except beer); wine’ in Class 33. It was allowed to proceed for the remaining goods, namely ‘soft drinks; alcohol-free wine’ in Class 32. An opposition was filed on the grounds of Article 8(6) EUTMR. The opposition was based on the protected geographical indication ‘Mallorca’ registered for ‘wine with protected geographical indication (PGI)’. The Opposition Division rejected the opposition on the grounds that the goods applied for, being soft drinks and alcohol-free wine, were not comparable goods to wine for which the PGI ‘Mallorca’ was protected. The Opposition Division therefore considered the claim based on Article 103(2)(a)(i) of Regulation No 1308/2013 in conjunction with Article 8(6) EUTMR as unfounded.

The Board annuls the contested decision and rejects the EUTM entirely. The Board notes that the sign applied for contains the only element of the PGI, and only adds the terms ‘Sol de’ which in English mean ‘Sun of’. The element ‘Mallorca’ plays an independent role in the sign applied for, is immediately perceivable, and the further elements do not alter its meaning. The Board confirms that there is direct commercial use of the PGI ‘Mallorca’ in the contested sign. As regards the goods concerned, the Board states that, although it is true that ‘wine’ is regulated by a specific law, i.e. Regulation No 1308/2013, while ‘alcohol-free wine’ is not regulated at all at European Union level, it is essential that the producers of alcohol-free wine need wine to produce their product. This leads to the conclusion that producers of alcohol-free wine need to have at least the same knowledge and know-how as wine producers. Moreover, the taste of both products is similar and differs only with respect to the taste of alcohol. The texture and bouquet of alcohol-free wine and wine are quite similar, if not even identical. The place of origin has, as with respect to wine, also an important role with alcohol-free wine, since the basic product, the grapes, are the same. Therefore, the Board considers that ‘alcohol-free wine’ is a comparable product to ‘wine’, in accordance with Article 103(2)(a)(i) of Regulation No 1308/2013. The same applies to the contested ‘soft drinks’, since this general term covers ‘alcohol-free wine’. The general term follows the same fate as the specific term, since the Board cannot split the general term into subcategories; it is therefore irrelevant that the general term comprises various goods which

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are different from 'alcohol-free wine'. Since the sign applied for contains a protected geographical indication, the conditions of Article 8(6) EUTMR are fulfilled and the opposition is allowed entirely.

11/02/2021, R 1926/2020-4, Khan krum / Khan krum



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

The applicant sought to register the word mark 'Khan Krum' for goods in Class 33. An opposition was filed on the grounds of Article 8(1)(a) and (b) EUTMR based on an earlier EUTM registration for the identical word mark in respect of 'wines, spirits and liqueurs; wine-based alcoholic beverages; grape alcohol-based alcoholic beverages' in Class 33. The Opposition Division found that the earlier EUTM was used only with respect to 'wine' in Class

33. It refused the EUTM applied for, except for the goods 'preparations for making alcoholic beverages' finding that these goods were dissimilar to 'wine' for which the use of the earlier mark was demonstrated.

The Board annuls the contested decision to the extent it rejected the opposition for the goods above. As to the nature of the contested goods at issue in the appeal proceedings, the Board indicates that 'preparations for making alcoholic beverages' are not only products such as essences or extracts which are obtained by distillation or otherwise from a plant, which are addressed only to a specialised public. This term also includes preparations for mulled wine and punch, which are similar to wine. As such, the nature, purpose and method of use of the contested goods are the same as for 'wine'. They differ in that 'preparations for making alcoholic beverages' are normally not consumed directly contrary to wines. However, 'preparations for making alcoholic beverages' are sold in supermarkets, next to wine and other alcoholic beverages or in very close proximity; consequently, they also share the same distribution channels. They address the same public, i.e. the general consumer, and may be produced by the same undertakings as those producing wine. Consequently, these goods are similar to at least an average degree. Since the signs are identical, the Board concludes that a likelihood of confusion exists.

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