

Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links 

Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

January
2020

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

First Page

Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

In accordance with the [Withdrawal Agreement](#) concluded between the EU and the UK (read the latest news [here](#)), the UK left the EU on 1 February 2020.

However, the Withdrawal Agreement stipulates that during a transition period that will last until 31 December 2020, EU law remains applicable to and in the UK. **This extends to the EUTM and RCD Regulations and their implementing instruments.**

This continued application of the EUTM Regulations and the RCD Regulations during the transition period includes, in particular, all substantive and procedural provisions as well as the rules concerning representation in proceedings before the EUIPO.

In consequence, all proceedings before the Office that involve grounds of refusal pertaining to the territory of the UK, earlier rights originating from the UK, or parties/representatives domiciled in the UK will run as they did previously, until the end of the transition period.

With the entry into force of the withdrawal agreement, the information previously published by



the EUIPO on this site – which exclusively referred to the scenario of the UK's withdrawal without an agreement – has become obsolete and has been removed.

In particular, Communication 2/19 is not relevant anymore, as it has become devoid of purpose. Further information as regards the situation as from 1 January 2021 will follow in due course.

This information supersedes all previous information on the impact of the UK's withdrawal from the EU as regards EUTMs and RCDs published on the [EUIPO website](#).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

EUIPN Updates



Malta joins DesignClass

The Commerce Department and Intellectual Property Office of Malta (CD-IPRD) is now part of the Common Harmonised Database on Product Indications (HDBPI) in DesignClass.

The integration was carried out with the support of the EUIPO's European Cooperation Projects and in close collaboration with the CD-IPRD. As a result, the complete set of Maltese translations is now available to all users through the DesignClass tool using the Locarno Classification, which consists of 32 classes (headings) and 219 subclasses (subheadings).

DesignClass allows users to easily navigate the harmonised database of product indications to search for a specific translated term and find the class they are in before applying for design protection. Terms can be searched in 27 languages, including 23 EU languages.

The HDBPI is constantly updated so it evolves with the market and user needs. The integration of the Maltese Intellectual Property Office into the "Harmonisation community" is another step forward for this cooperation project.

The EUIPO and its stakeholders are currently collaborating on five major European Cooperation Projects. The projects aim to benefit users across the EU by providing modern, state-of-the-art tools and services for intellectual property offices.

Improved e-filing for designs in Romania

The State Office for Inventions and Trademarks (OSIM) in Romania has now fully implemented the upgrade of its front office IT system, improving the e-filing for designs.

The OSIM's digital platform, developed in cooperation with the EUIPO's European Cooperation programme, helps filing design applications in a simple and efficient way.

The new e-filing service for designs allows users to submit design views in a digital format rather than on paper, which significantly simplifies the administrative processes and increases efficiency within OSIM.

The new service is able to process standardised, multiple and divisional design applications. It also provides user guidance through the sections, previous design applications as a template to import data, and improved fees details.

The EUIPO and its stakeholders are currently collaborating on five major European Cooperation Projects. The projects aim to benefit users across the EU by providing modern, state-of-the-art tools and services for intellectual property offices.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



More News



Quality: knowledge-sharing and training at EUIPO

January 2020 marked three years of the implementation of the Interactive Collaborative Examination (ICE) process at EUIPO.

Initially launched as an first central examination on absolute grounds, the ICE model has since been rolled out across the decision-taking framework in the Office, bringing efficiencies for EUIPO staff and users.

The first ICE team brought experienced examiners together to jointly assess compliance with the absolute grounds for refusal of EUTM applications. This led to time saving, in that potential issues were flagged up and dealt with quickly. The system also allowed for direct knowledge sharing between team members.

From that original grouping, a whole range of ICE processes were set up, including classification, search, designs and recordals, as well as IP.ICE, created in January 2018.

The IP.ICE format houses decision takers in relative grounds, and was implemented to be a knowledge-sharing hub.

It takes in the Internal Quality Check (IQC), thus not only ensuring that decisions checked are in line

with the Office's quality standards but also that the issues detected allow for a more agile management of training needs.

IP-ICE caters for these needs via specific training sessions, as well as through knowledge sharing and strategy sessions that are regularly run for the teams dealing with relative grounds in EUIPO. This allows decision takers to keep up to date on practice, case-law and quality issues, including feedback from participants in the Stakeholder Quality Assurance Panels (SQAP).

The cross-activity nature of the IP-ICE hub allows collaboration and harmonisation across EUIPO, which in turn feeds into the quality of the Office's decisions, and has a positive effect on key indicators like timeliness and quality.

Enhancing TM protection on e-commerce marketplaces: workshop

Representatives from e-commerce marketplaces and the EUIPO will meet in Alicante on 25 February for a first exploratory workshop.

The workshop will focus on EU trade mark (EUTM) rights, and will be structured around three main issues — information resources on trade mark rights, access to the IP protection programmes

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



More News

of e-commerce marketplaces and exchange of information, all with the aim of enhancing trade mark protection on e-commerce marketplaces.

This first gathering will pave the way for a broader event and discussions with IP owners, and will centre on the discussion of opportunities and concrete actions to jointly develop the EUIPO's initiatives envisioned in its Strategic Plan 2025 to adapt its services to the growth of e-commerce.

The workshop will also offer an opportunity for the EUIPO and e-commerce marketplaces to present information resources and initiatives, and explore how they could develop cooperation to promote and facilitate access to trade mark rights with e-commerce focused SMEs.

Representatives from e-commerce marketplaces interested in participating are invited to contact observatory@euipo.europa.eu

Report on the protection and enforcement of IPR in third countries

The European Commission has published its biannual Report on the protection and enforcement of intellectual property rights in third countries (Third Country Report).



The Third Country Report identifies countries outside of the European Union in which the state of intellectual property protection and enforcement gives rise to the greatest concern and provides an update of the existing Commission's list of priority countries.

It aims to improve intellectual property rights protection and enforcement worldwide, as well as inform rights holders, including SMEs, of the potential risks when conducting business in certain countries.

For the first time, the Third Country Report contains a dedicated section on the protection of plant variety rights.

The EUIPO, through the Observatory, has supported the creation of the Third Country Report with a number of its studies, as well as provided technical support.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

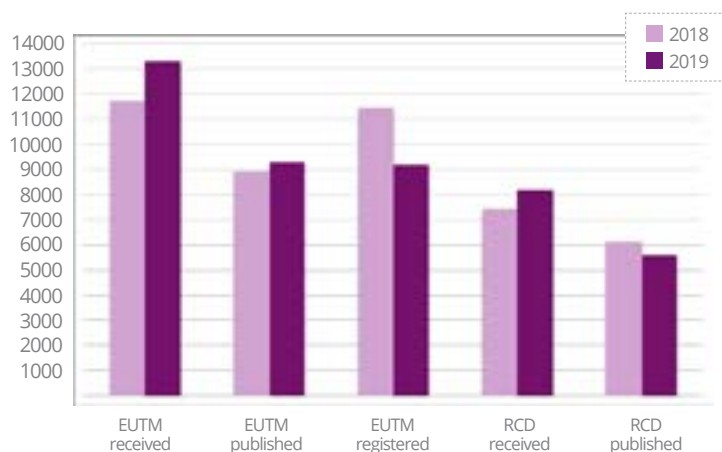


Statistical Highlights



Monthly statistical highlights December*	2018	2019
European Union Trade Mark applications received	11 718	13 292
European Union Trade Mark applications published	8 930	9 283
European Union Trade Marks registered (certificates issued)	11 450	9 219
Registered Community Designs received	7 418	8 203
Registered Community Designs published	6 094	5 574

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



First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Luxembourg trade mark and design news

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

C 143/19 P; Ein Kreis mit zwei Pfeilen (fig.); Der Grüne Punkt - Duales System Deutschland v EUIPO; Judgment of 12 December 2019; EU:C:2019:1076; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Collective mark, Nature of use

FACTS: The proprietor registered the figurative sign 'Ein Kreis mit zwei Pfeilen' as an EU collective mark for goods and services in Classes 35, 39, 40 and 42.

An application for partial revocation was filed pursuant to Article 51(1)(a) CTMR. The Cancellation Division (CD) partially upheld the application and revoked the proprietor's rights for all the goods, with the exception of goods consisting of packaging.

The proprietor filed an appeal, which was dismissed by the Board of Appeal (BoA). The BoA held that the proprietor had not provided proof that the mark was used in accordance with its essential function, namely to guarantee the identity of the origin of the goods for which it was registered. The average EU consumer would not perceive the mark as as

an indication of the origin of those goods, instead associating the mark with an environmentally sound conduct of the undertakings participating in the proprietor's recycling system.

The proprietor filed an action before the General Court (GC), which was also dismissed (12/09/2018, T 253/17, EIN KREIS MIT ZWEI PFEILEN (fig.), EU:T:2018:909).

The proprietor appealed to the Court of Justice of the European Union (CJ), claiming that the GC misinterpreted the concept of 'genuine use' within the meaning of Article 15(1) CTMR and failed to take proper account of the characteristics of collective marks set out in Article 66 CTMR. The CJ set aside the GC's judgment and annulled the BoA's decision.

EU collective mark



SUBSTANCE: The essential function of a collective mark is to distinguish the goods or services of the members of the association which is the proprietor of that mark from those of other undertakings (para. 52). Thus, unlike an individual mark, a collective mark does not have the function of indicating to the consumer 'the identity of

First Page

■ Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

■ December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



Case law



origin' of the goods or services in respect of which it is registered (para. 53). Article 66 CTMR by no means requires that manufacturers, producers, suppliers or traders who are affiliated with the association which is the proprietor of a collective mark, form part of the same group of companies which manufacture or supply the goods or services under unitary control (para. 54). Collective marks are, like individual marks, part of the course of trade (para. 56). Their use must therefore, in order to be classified as 'genuine' within the meaning of Article 15(1) CTMR, be part of the objective of the undertakings concerned to create or preserve an outlet for their goods or services (para. 56).

A collective mark is used in accordance with its essential function from the moment it enables the consumer to understand that the goods or services covered originate from undertakings which are affiliated with the association, the proprietor of the mark, and to thereby distinguish those goods or services from those originating from undertakings which are not affiliated (para. 58). In the present case, it is clear from the findings made by the GC that the collective mark was used in accordance with its essential function, since the producer or distributor of the goods at issue was part of the proprietor's licensing system (para. 59).

The assessment of genuine use of the mark should be carried out by evaluating, particularly, whether such use is viewed as warranted in

the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (para. 62). In this respect, the GC has failed to apply those criteria to the present case (para. 63). It was for the GC to examine whether the use properly established in this case (namely the affixing of the mark to the packaging of the goods of undertakings affiliated with a local collection system and of environmentally sound disposal) was viewed, in the economic sector concerned, as warranted to maintain or create a share in the market for the goods (para. 67).

It cannot be ruled out that the indication on the packaging of everyday consumer goods by a manufacturer or a distributor, of the affiliation with such an environmentally sound system may influence consumers' purchasing decisions and, thus, contribute to the maintenance or creation of a share in the market relating to those goods (para. 70).

Thus, the GC had erred in law in its application of the concept of 'genuine use' (para. 78).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



C 783/18 P; Form einer Flasche; EUIPO v Wajos; Judgment of 12 December 2019; EU:C:2019:1073; Language of the case: DE

RESULT: Appeal dismissed

KEYWORDS: Lack of reasoning, Minimum degree of distinctiveness, Shape of the product, Three dimensional mark

FACTS: The applicant sought to register the 3D mark 'FORM EINER FLASCHE' as an EUTM for goods in Classes 29, 30, 32 and 33. The examiner refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal finding that the mark was devoid of distinctive character.

The General Court (GC) upheld the applicant's action against the decision of the BoA 03/10/2018, T 313/17, FORM EINER FLASCHE (3D), EU:T:2018:638. The GC found that the average consumer was perfectly capable of perceiving the shape of the packaging of such goods as an indication of their commercial origin (para. 26 of the judgment under appeal). It stated that the form of a transparent amphora-like container departs significantly from classical amphoras as the upper part is separated from the lower, narrower part by a slight ridge, which not only constitutes a technical and functional feature, but also adds aesthetic value to the contested mark;

the combination of elements comprising the sign was unique and not trivial and so easily memorised by the relevant public (paras 34-35 of the judgment under appeal). It held that, therefore, the container acquires a particular appearance which, taking the overall aesthetic result into account, is capable of holding the attention of the public concerned and enabling that public, aware of the shape of the packaging of the goods, to distinguish the goods covered from those with a different commercial origin (para. 36 of the judgment under appeal). It concluded that, taken as a whole, the sign presents the required minimum distinctiveness for registrability (para. 39 of the judgment under appeal).

The Office appealed to the Court of Justice of the European Union (CJ). In support of its appeal, the Office relied on two pleas in law (i) infringement of Article 7(1)(b) EUTMR in that the GC had examined if the sign has 'sufficient characteristics' to attract the attention of the average consumer and did not apply the 'significant departure from the norm' test; and (ii) infringement of the duty to state reasons. The CJ dismissed the appeal.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

SUBSTANCE:

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

The CJ confirmed that a three-dimensional mark depicting the form of the good applied for can only be considered to be distinctive where that mark departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin (12/01/2006, C 173/04

EUTM application



P, Standbeutel, EU:C:2006:20, §§ 29 and 31; 07/05/2015, C 445/13 P, Bottle, EU:C:2015:303, §§ 90-91) (para. 24). The CJ found that the GC had, in substance, correctly applied the case-law referring to testing whether there was a 'significant departure from the norm or customs of the sector' (paras 26 and 30).

There is no need to explicitly define the norms and



customs of the sector of the goods concerned. The GC implicitly carried out an analysis of the distinctive character of the components of the three-dimensional sign in the light of the norms of the relevant sector (C 445/13 P, Bottle, EU:C:2015:303, §§ 82-87) (para. 31).

Various factors, such as the aesthetic result and the aesthetic value, can be considered to justify the finding of a significant departure from the norms of the sector, as long as these factors relate to the finding of an 'objectively unusual visual effect of the design' of the shape (para. 32). However, the concrete marketing conditions do not appear to be a relevant factor in that respect (para. 33).

(ii) INFRINGEMENT OF THE DUTY TO STATE REASONS.

The judgment under appeal satisfied the requirements of providing a statement of reasons by which the GC is bound, since the GC explained in detail that the trade mark applied for has an exceptional character in view of the customs of the sector. The reasoning enables persons concerned to understand the grounds of the GC's judgment and provides the CJ with sufficient information to exercise its powers of review (para. 40).

First Page

■ Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

■ December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



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

T 255/19; BIOTON; Baustoffwerke Gebhart & Söhne v EUIPO; Judgment of 12 December 2019; EU:T:2019:853; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS:

The applicant sought to register the word mark BIOTON for goods in Class 19.

The examiner partially refused the application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, namely for building and construction materials (not of metal); surfacing elements; façade elements; bricks.

The applicant filed an appeal, which the Board of Appeal (BOA) dismissed. It held that the mark was descriptive and devoid of distinctive character.

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

SUBSTANCE:

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

The relevant public consists of German-speaking professionals in the construction sector (not disputed) (para. 17).

The sign is composed of the two word elements 'bio' and 'ton'. The term 'ton' in German refers to argil, the base material out of which the goods may be formed (para. 19). The term 'bio' is used not only for agricultural products and food but also in a broader sense. It refers to the ideas of respecting the environment, using natural material or being manufactured in an ecological way (paras 20-23). The sum of the elements 'bio' and 'ton' does not produce anything other than the word 'Bioton' and is thus descriptive for the goods (para. 25).

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

The GC does not need to examine the plea since one absolute ground for refusal is sufficient (paras 31-32).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



T 624/18; GRES ARAGÓN (fig.); Gres de Aragón v EUIPO; Judgment of 19 December 2019; EU:T:2019:868; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Lack of reasoning, Principle of legality

FACTS: The applicant sought to register the figurative mark 'GRES ARAGÓN' for goods and services in Classes 19 and 35. The examiner refused the application pursuant to Article 7(1)(b), Article 7(1)(c) and Article 7(2) EUTMR.

The BoA dismissed the appeal. It found that the relevant public, consisting of the general public and professionals who purchase ceramic and building materials, would understand the terms 'gres' and 'aragón' combined with the goods and services in question as designating a ceramic material (sandstone) produced or originating from the autonomous community of Aragon (Spain) and would not perceive the sign as having distinctive character.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) and (c) EUTMR and infringement of the duty to state reasons and (ii) infringement of Article 7(3) EUTMR. The GC upheld the action and annulled the contested decision.

EUTM Application



SUBSTANCE:

INFRINGEMENT OF ARTICLE 7(1)(b) and (c) EUTMR AND INFRINGEMENT OF THE DUTY TO STATE REASONS.

The applicant claims essentially that various trade marks with the same composition as the trade mark applied for — that is to say, a general descriptive element, in this case the element 'gres', an indication of alleged origin, and a graphic element — had been registered with the Office, including the GRES DE BREDA trade mark (para. 18).

The statement of reasons required by Article 296 TFEU must disclose in a clear and unequivocal manner the reasoning followed by the institution that adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable courts to exercise their power of review. It is not necessary for the reasoning to go into all the relevant facts and points of law, since the question whether the statement of reasons meets the requirements of

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Article 296 TFEU must be assessed with regard not only to its wording but also to its context and to all the legal rules governing the matter in question (para. 26).

The Office is obliged to exercise its powers in accordance with the general principles of EU law, such as those of equal treatment and sound administration (para. 28). In the light of those two principles, the Office must, when examining an application for registration of a trade mark, take into account any decisions already taken in respect of similar applications and consider in particular whether it should decide in the same way or not (10/03/2011, C 51/10 P, 1000, EU:C:2011:139, § 73-75 and 77) (para. 29).

The Office's reasoning that the trade mark GRES DE BREDA has been found to have distinctive character mainly because of its preponderant figurative elements (para. 37) does not feature at all in the contested decision but was submitted for the first time by the Office during the written reply stage (paras 38-39). The BoA failed to respond to the arguments put forward by the appellant in relation to the registrations of earlier trade marks that it had evoked in support of its appeal (para. 40).

Moreover, the applicant claims that the BoA has failed to demonstrate a link between the goods in question and the territory of the Autonomous Community of Aragon, and that the contested

decision is therefore not in accordance with the case-law, the Office's decision-making practice or the obligation to state reasons (para. 41).

The Office is obliged to demonstrate that the geographical name is known to the relevant public as the designation of a place and that the name in question currently suggests to that public a link with the goods or services in question, or that it is reasonable to assume that such a name may, for that public, designate the geographical origin of the goods or services mentioned (15/01/2015, T 197/13, MONACO, EU:T:2015:16, § 51 and EUIPO Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR), paragraph 2.6, Geographical terms) (para. 42).

Even though the Office's guidelines are not binding for the purpose of interpreting provisions of EU law, and the legality of BoA decisions must be assessed solely on the basis of the EUTMR as interpreted by the EU judiciary and not on the basis of a decision-making practice previous to the Office's guidelines (para. 44), the Office must, in the light of the principles of equal treatment and sound administration, take into account any decisions already taken in respect of similar applications and consider in particular whether it should decide in the same way or not (para. 45).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The BoA merely took the view that the term ‘aragón’ described the origin of the goods and services without examining whether there was a link between the geographical name Aragon and the goods and services covered by the trade mark applied for. It did not state why such an examination had not taken place in the present case (paras 47-48 and 52).

Therefore, the contested decision is vitiated by an error in law in that the BoA did not examine the link between the geographical term ‘aragón’, which appears in the trade mark applied for, and the goods and services covered by that trade mark (para. 54).

T 28/19; VERITEA / VERI / AGUA PURA DEL PIRINEO et al.; Karlovarské minerální vody v EUIPO; Judgment of 19 December 2019; EU:T:2019:870; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Identity of the goods and services, Lack of reasoning, Similarity of the signs

FACTS:The applicant sought to register the word sign VERITEA as an EUTM for goods in Classes 30 and 32. An opposition based on the earlier EU word mark VERI — AGUA PURA DEL PIRINEO, and the earlier Spanish word mark VERI, both registered for goods in Class 32, was filed pursuant to Article 8(1) (b) EUTMR.

The Opposition Division (OD) upheld the opposition based on the earlier EU word mark VERI — AGUA PURA DEL PIRINEO.

The applicant filed an appeal before the Board of Appeal (BoA) that was dismissed. The BoA found, that, given the identity and similarity between the goods and the visual and phonetic similarity between the mark applied for and the earlier EU word mark VERI — AGUA PURA DEL PIRINEO, there existed a likelihood of confusion (LOC).

The applicant filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of the obligation to state reasons and (ii) infringement of Articles 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE:

(i) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS.

In stating the reasons for the decisions, it is sufficient to set out the facts and legal considerations that have decisive importance in the context of the decision (para. 24). The BoA did not breach the obligation to state reasons (para. 27).

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

The relevant public is the general public in the EU with an average level of attention. The assessment

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



of LOC can be limited to the Spanish-speaking part of the relevant public (para. 33).

The goods covered by the marks were identical or similar (not disputed) (para. 33).

Distinctive elements of the marks. The expression 'agua pura del pirineo' in the earlier mark is descriptive for non-alcoholic beverages, because it could be understood by the Spanish-speaking part of the relevant public as referring to 'pure water from the Pyrenees'. Therefore, it has a weak or even no distinctive character (paras 38 and 49). The element 'veri' of the earlier mark has no meaning for the Spanish-speaking part of the relevant public and is the most distinctive element of that mark because of its fanciful character (paras 38 and 56). The mark applied for, as a whole, has no meaning for the Spanish-speaking public and is therefore distinctive (not disputed) (paras 39 and 57).

Comparison of the signs. As the signs coincide in the sequence of the letters 'v', 'e', 'r' and 'i' which make up the initial part of the marks and constitute the most distinctive element of the earlier mark, the marks are visually and phonetically similar to an average degree regardless of the presence of differentiating elements (paras 40 and 66). The signs are conceptually dissimilar, since the mark applied for, as a whole, has no meaning for the Spanish-speaking public and, in the earlier mark, the element 'veri' is meaningless, unlike the expression

'agua pura del pirineo' (paras 41 and 72-73).

Global assessment of LOC. In view of the visual and phonetic similarity and of the identity and similarity of the goods, the differences between the marks were insufficient to rule out the existence of a LOC on the part of the relevant Spanish-speaking public (paras 74 and 84).

T 40/19; THE ONLY ONE by alphspirit wild and perfect (fig.) / ONE; Amigüitos pets & life v EUIPO; Judgment of 19 December 2019; EU:T:2019:890; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Conceptual dissimilarity, Dissimilarity of signs, Dominant element, Figurative element, Phonetic similarity, Reputation, Visual dissimilarity

FACTS: The applicant sought to register the figurative mark for goods in Classes 5 and 31. An opposition based on the earlier EU word mark ONE, registered for foodstuffs for animals in Class 31 was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR.

The Opposition Division (OD) partially upheld the opposition on the basis of Article 8(5) EUTMR. It found that the mark applied for was likely to take unfair advantage of, or be detrimental to, the

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



distinctive character or the repute of the mark ONE for most goods in Classes 5 and 31. The OD rejected the opposition on the basis of Article 8(1)(b) EUTMR and Article 8(5) EUTMR for trace elements (preparations of -) for human and animal use in Class 5 and flowers in Class 31.

The applicant filed an appeal before the Board of Appeal (BoA) that was dismissed. The BoA upheld the opposition, first, on the grounds set out in Article 8(1)(b) EUTMR for identical or similar goods and, secondly, on the grounds set out in Article 8(5) EUTMR, for goods with a low degree of similarity and for dissimilar goods.

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

EUTM application



Earlier trade mark

ONE

SUBSTANCE: PRELIMINARY ADMISSIBILITY ISSUES.

The opponent disputes the formal admissibility of the action, relying on infringement of Articles 177(5) and 51(3) RPGC since it is not apparent from the documents submitted before the Court that the power of attorney was signed by the applicant's legal representative. However, the RPGC no longer requires proof that the authority granted to the lawyer was conferred on him or her by someone authorised for the purpose, Article 51(3) RPGC (28/09/2016, T 476/15, FITNESS, EU:T:2016:568, § 19) (paras 13-14).

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

The relevant public is the general public and the professional public in the veterinary sector within the EU. The goods in Class 5 are aimed at the general public and the professional public in the veterinary sector. The level of attention of the relevant public is above average for food additives and supplements and high for veterinary preparations. The identical goods in Class 31 are aimed at the general public whose level of attention is no more than average since animal food is purchased on a regular basis (paras 25-30 and 31).

The goods are in part identical, in part similar and, in part dissimilar (not disputed) (para. 34).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Dominant elements. The BoA erred in its assessment that the word 'one' formed an independent and distinctive part within the dominant elements of the sign applied for (para. 52). The fact that the component 'the only one' occupies an important part of the black square must be put into perspective. The comparison of that component with the other components demonstrates that its position and size do not give it a dominant character while removing all significance, in the overall impression, from the other elements (para. 47). The words 'by α' and the words 'the only one' are large enough to attract the attention of the relevant public. The same applies to the words 'alpha spirit', which on account of their position below the letter 'α' and the fact that the word 'alpha' is in red, give the impression of forming a whole with the words 'by α' and will be perceived by the relevant public (para. 48). Only the words 'wild and perfect' are negligible because of their size and the font used (para. 49).

Accordingly, the signs are visually different; and not, as stated by BoA, similar to a low degree. Whereas the visual impression of the earlier mark is determined by the word 'one' as the only component, the visual impression of the mark applied for is determined by seven words, 'the only one by α alpha spirit' (with the last three words 'wild and perfect' being negligible) as well as the figurative elements (para. 59-60).

The degree of phonetic similarity between the marks is low, and not as the BoA considered, below

average. Despite the presence of the word 'one' in both marks, the fact that there are at least six other words that could be pronounced in the mark applied for serves to differentiate it from the earlier mark (paras 68-69).

The signs are conceptually different. The words 'one', 'only', 'by' and 'alpha' are easily understood even by the non-English-speaking public (para. 78), and therefore the presence in the signs of the common word 'one' is not sufficient to conclude that there is a strong conceptual similarity between the two signs, as held by the BoA (paras 78-81).

It is not necessary to rule on the inherent distinctiveness of the earlier mark. The very low degree of similarity between the signs does not support the conclusion that there is a likelihood of confusion (LOC), notwithstanding the similarity, if not the identity, of the goods, and even having regard to the public, which has a level of attention that is no higher than average (para. 91).

Moreover, the goods in Classes 5 and 31 are generally sold in self-service stores and are physically displayed to consumers who will, generally, perceive the visual aspect of the marks before purchase. In relation to such goods, visual similarity plays a very important part in the global assessment of LOC. The visual difference between the earlier mark ONE and the mark applied for 'THE ONLY ONE by α alpha spirit wild and perfect' will clearly be noticed by the

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

average consumer (para. 93). Consequently, the visual and conceptual difference and the low degree of phonetic similarity will preclude consumers from believing that the goods come from the same undertaking or from economically linked undertakings (para. 94).

The BoA was wrong to consider that proof of the reputation of the earlier mark had been furnished since it relied, essentially, on evidence concerning the mark PURINA ONE and did not raise the question of whether or not that reputation could be established on the basis of a mark presented in a different form (paras 98-103 and 104). Consequently, this cannot call into question the conclusion that there is no LOC between the marks (para. 111).

(ii) INFRINGEMENT OF ARTICLE 8(5) EUTMR.

The condition of Article 8(5) EUTMR requiring that the mark has a reputation, is not satisfied, since the BoA was wrong to consider that proof of the reputation of the earlier mark had been furnished (paras 115-118).

T 589/18; MIM NATURA (fig.) / MM et al.; Japan Tobacco v EUIPO; Judgment of 19 December 2019; EU:T:2019:887; Language of the case: EN

RESULT: Action dismissed



KEYWORDS: Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS:

The applicant sought to register the figurative mark 'MIM NATURA' for goods in Class 33, namely Alcoholic beverages (except beer). An opposition based on international registration of the word mark MM and figurative mark 'MM', designating the European Union for the goods Alcoholic beverages (except beer) in Class 33 and the German word mark MUMM registered for goods in Class 33, namely Alcoholic beverages, except beers and champagne, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division upheld the opposition.

The applicant filed an appeal, which was dismissed by the Board of Appeal (BoA). The BoA found that the figurative element of the mark applied for was quite common in connection with the goods applied for and that in view of the similarity of the word element 'mim' in the central position and the earlier international registration of the word mark MM, and the identity of the goods, there was likelihood of confusion (LOC). It found LOC as well with the earlier German word mark MUMM for the identical goods because of the visual and phonetic similarity of the signs.

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

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



EUTM application



Earlier trade marks



SUBSTANCE:

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

For reasons of procedural economy, the GC first examines whether the contested decision is lawful as to the examination of the LOC between the mark applied for and the earlier German word mark MUMM (para. 24).

The relevant public consists of the general public with an average level of attention (not disputed). The goods covered by the marks are identical (not disputed) (paras 25-26).

The BoA did not err in its assessment of the figurative elements in the mark applied for, when it found, in essence, that the word elements in that mark were more distinctive than the figurative elements, in particular the representation of a crown, and that the term 'mim', since it was in a central position in the mark applied for, was the element that was most likely to attract the attention of consumers (para. 35).

The earlier sign MUMM and the dominant word element in the sign applied for, namely the element in capital letters 'MIM', begin and end with the capital letter 'M'. They differ only in the presence of the capital letter 'I' in the middle of the element 'MIM' and in the presence of the capital letter 'U' and the additional final capital letter 'M' in the earlier sign MUMM. Thus, there is visual similarity between the signs (paras 40-41).

There is phonetic similarity between the signs since the element 'natura' can, at the very most, be taken into consideration only as a secondary element. The dominant word element of the sign applied for, namely 'mim', and the earlier sign MUMM, coincide in the pronunciation of the letter 'm' at the beginning and the end of each of them. The only difference in the pronunciation of the element 'mim' and the earlier mark MUMM lies ultimately in the pronunciation of the vowel 'i' in the former and the vowel 'u' in the latter, which is secondary (paras 45-46 and 49).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

The signs are not conceptually similar since only the sign MUMM, which means inter alia 'courage' or 'guts' in German, conveys a concept (paras 55-57).

There is LOC between the mark applied for and the German word mark, in view of the identity of the goods covered, the average level of attention of the relevant public and the fact that there are visual and phonetic similarities. The phonetic similarity is particularly important with regard to the goods because these goods are often consumed after being ordered orally (paras 68-69).

There is no need to examine whether there is also LOC between the mark applied for and the international registration of the word mark MM, designating the European Union (para. 75).

T 690/18; Vita; Sony Interactive Entertainment Europe v EUIPO; Judgment of 19 December 2019; EU:T:2019:894; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Res judicata

FACTS: The proprietor registered the word sign Vita as an EUTM for goods in Class 9. An application for revocation was filed pursuant to Article 51(1) (a) CTMR. The Cancellation Division (CD) revoked the contested mark. The proprietor filed an appeal,



which was dismissed by the Board of Appeal (BoA) on 12 November 2015 (earlier decision).

The proprietor filed an action before the General Court (GC) against the earlier decision, registered as case T 35/16, relying on a single plea in law, infringement of Article 51(1)(a) CTMR. The GC upheld the action and annulled the earlier decision in its entirety on the basis of a public policy issue raised ex officio, namely the inadequate statement of reasons (12/12/2017, T 35/16, Vita, EU:T:2017:886). The GC held in particular that the earlier decision did not make it possible to determine with sufficient clarity the reasons why the BoA had taken the view that the proprietor had not proved genuine use of the contested mark for the various types of goods in question.

Further to this judgment, the BoA dismissed the appeal. It examined and reassessed whether the evidence provided by the proprietor made it possible to establish genuine use of the contested mark. However, it observed that, in the judgment in case T 35/16, the GC had upheld certain findings of the BoA as to the assessment of evidence for genuine use relating to certain goods and that these findings had become final as a consequence of the judgment in case T 35/16.

The proprietor filed an action before the General Court (GC) against that decision (contested decision), relying on two pleas in law: (i) infringement of

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

Article 65(6) CTMR in that the BoA failed to take the necessary measures to comply with the judgment in case T 35/16 and (ii) the duty to state reasons.

SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE 65(6) CTMR.

The proprietor claims that the BoA wrongly found that the GC had upheld certain findings of the BoA. In its view, in case T 35/16 the GC concluded only that the earlier decision was vitiated by a failure to state reasons and that it had, accordingly, to be annulled in its entirety, but it did not confirm the correctness of the reasoning relating to any of the arguments advanced by the parties. As a result, the proprietor claims that the BoA wrongly failed to examine the proprietor's arguments as to whether the evidence concerning certain goods was capable of demonstrating genuine use of the contested mark (paras 39, 40 and 41).

As no appeal has been brought against the judgment in case T 35/16, it has become final (para. 44). A judgment annulling the contested decision takes effect ex tunc and has the effect of retroactively eliminating the contested decision from the legal system (25/03/2009, T 402/07, ARCOL / CAPOL, EU:T:2009:85, § 21). In order to comply with the judgment and to implement it fully, the Office is required to have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis, insofar as they are



necessary for the purposes of determining the exact meaning of what is stated in the operative part. It is those grounds which, on the one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons which underlie the finding of illegality contained in the operative part and which it must take into account when replacing the annulled decision (25/03/2009, T 402/07, ARCOL / CAPOL, EU:T:2009:85, § 22; 13/04/2011, T 262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 41) (para. 45).

In case T 35/16, the GC annulled the earlier decision on the basis of a public policy issue raised ex officio, namely the inadequate statement of reasons (paras 46 and 47).

The obligation to state reasons constitutes an essential procedural requirement which must be distinguished from the question of the merits of those reasons, which concern the substantive legality of the contested measure. The reasoning of a decision consists of a formal statement of the grounds on which that decision is based. If those grounds are vitiated by errors, the latter will vitiate the substantive legality of the decision, but not the statement of reasons in it, which may be adequate even though it sets out reasons which are incorrect (22/09/2016, C 442/15 P, Pensa, EU:C:2016:720, § 35 (para. 48).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

The failure to state reasons found by the GC concerned three aspects of the earlier decision: (i) The BoA had not explained why the reproductions of memory cards bearing the sign PSVita produced by the applicant were not capable of establishing genuine use of the contested mark for data carriers containing programs. (ii) It had not stated in a sufficiently clear and unequivocal manner the reasons why it had found that genuine use of the contested mark had not been established for audio and/or image carriers (not of paper), in particular magnetic tape cassettes, audio tapes, audio compact discs, DAT (digital audio tape) cassettes, videodiscs, videotapes, exposed films, lithographs. (iii) It had not explained why it had not accepted the applicant's evidence establishing the presence of the sign PSVita on the video games to be played on the PlayStation Vita console (para. 49).

In its examination of that public policy issue, the GC also noted that the BoA had set out the reasons regarding some of the contested goods to the requisite legal standard (para. 50).

The GC found that the BoA had only stated the reasons forming the basis of the earlier decision to the requisite legal standard. However, it did not examine the arguments on the alleged infringement of Article 51(1)(a) CTMR. Consequently, the GC did not rule on the substantive legality of the earlier decision. It follows that the force of res judicata concerns only the statement of reasons as an



essential procedural requirement, and not its substantive legality (para. 51).

Moreover, the force of res judicata extends only to the grounds of a judgment which constitute the necessary support of its operative part and are, therefore, inseparable from it (25/07/2018, C 84/17 P, C 85/17 P & C 95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 52). Consequently, the aspects of the earlier decision, which the GC had observed were well reasoned, cannot be considered as having acquired the force of res judicata (by analogy 25/07/2018, C 84/17 P, C 85/17 P & C 95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 53). Thus, in the present case, the BoA could neither be bound by those aspects of the earlier decision nor uphold them in the contested decision (para. 52).

The BoA therefore wrongly held that the findings concerning the PlayStation Vita and the video game Aqua Vita had become final as a consequence of the judgment in case T 35/16, and that the GC had upheld the finding of the BoA that the PlayStation Vita console did not belong to the category of audio and/or image carriers (not of paper) because its principal function was not the storage of audio and image files (para. 53).

The BoA was required to hand down a fresh decision on all the relevant issues for the application of Article 51(1)(a) CTMR (para. 54). The first plea in

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



law is upheld and the contested decision annulled in its entirety.

(ii) INFRINGEMENT OF THE DUTY TO STATE REASONS.

There is no need to rule on the other plea in law.

T 729/18; LLOYD (fig.) / LLOYD'S (fig.); El Corte Inglés v EUIPO; Judgment of 19 December 2019; EU:T:2019:889; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dissimilarity of the goods and services, Retail services

FACTS: The applicant sought to register a figurative mark as an EUTM for goods and services in Classes 3, 14, 18, 25 (clothing, footwear, headgear) and 35 (wholesaling and retailing, including via the internet and through teleshopping, in the fields of [...] clothing, footwear, headgear).

An opposition based on an earlier EU figurative mark, registered for services in Classes 3, 14 and 18, was filed pursuant to Article 8(1)(b) EUTMR. The earlier mark does not cover goods in Class 25.

The Opposition Division (OD) partially upheld the opposition. It found that registration could not be

granted, first, in respect of the goods in Classes 3, 14, 18 and 25 and, secondly, in respect of the sales services in Class 35 insofar as those services related to, inter alia, the goods in Class 14; however, registration could be granted in respect of the sales services in Class 35 insofar as those services related to, inter alia, some of the goods in Class 18 and the goods in Class 25.

Both parties appealed. The Board of Appeal (BoA) partially dismissed the appeal brought by the opponent and therefore upheld the application for registration also in respect of the services in Class 35 insofar as those services related to the goods in Class 25. In that regard, the BoA stated that goods and retail services were similar only where the goods covered by the earlier mark were actually the subject of the retail services. In this case, however, it found that the goods covered by the earlier mark were not the subject of the retail services in respect of which registration had been sought. There was no similarity between those goods and services and therefore no likelihood of confusion (LOC).

The opponent filed an action with the General Court (GC), relying only on the infringement of Article 8(1) (b) EUTMR. According to the opponent, the BoA had been inconsistent when comparing the goods and services with regard to the complementarity between the goods in Classes 3, 14 and 18 and the goods in Class 25, and had therefore erred when examining the LOC. The GC dismissed the action.

First Page

■ Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

EUTM Application



Earlier trade marks



SUBSTANCE:

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

The relevant public consists of the French-, Italian- and Spanish-speaking general public as well as of professionals in the EU. The level of attention varies from average to high, depending on whether the general public or professionals are concerned (not disputed) (para. 28).

Comparison of the goods and services. The BoA correctly found that the mark applied for could be registered insofar as the sales services in Class 35 (wholesaling and retailing, including via the internet and through teleshopping in the fields of clothing, footwear, headgear) related to the goods in Class 25 (clothing, footwear, headgear) (paras 30 and 51).



Even if the sales services for clothing, footwear and headgear in Class 35 relate to goods in Class 25 (para. 37), as stated by the BoA, the earlier mark has not been registered in respect of goods in Class 25 but only in respect of goods in Classes 3, 14 and 18 (paras 38 and 47). Goods in Class 25 differ from goods in Classes 3, 14 and 18 in terms of their nature, purpose and method of use (paras 39-43).

A LOC is to be excluded, regardless of the degree of similarity or identity between the signs, if the goods or services that the signs cover are different (paras 52 and 54).

T 54/19; BIANCOFINO; Nosio v EUIPO; Judgment of 19 December 2019; EU:T:2019:893; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Lack of reasoning, Laudatory mark, Non-distinctive, Principle of legality, Word mark

FACTS: The applicant sought to register the word mark BIANCOFINO for goods in Class 33, namely wines; sparkling wines. The examiner refused the application pursuant to Article 7(1)(b), (c) and (k) CTMR.

The Board of Appeal (BoA) dismissed the appeal and confirmed the examiner's decision on the grounds

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



of Article 7(1)(b) EUTMR. It found that the sign is just a combination of two generic terms indicating the colour and the quality of the goods for the Italian consumer. The word 'bianco' designates a typology of wines (white wines). The word 'fino' would be understood in a laudatory sense (fine, refined, elegant). It holds that the two terms, even when joined together, are devoid of distinctive character.

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

SUBSTANCE:

(i) ALLEGED INFRINGEMENT OF THE DUTY TO STATE REASONS.

In accordance with the first sentence of Article 94(1) EUTMR, the Office provided, in a clear and unequivocal manner, the essential grounds for which it considered that the trade mark applied for was devoid of distinctive character (paras 18-20 and 22).

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

The relevant public consists of Italian-speaking reasonably attentive and circumspect wine consumers (not disputed) (para. 33).

The sign BIANCOFINO is easily dissected and results from the juxtaposition of two common terms in Italian 'bianco' and 'fino' (not disputed) (para. 38). The term 'bianco' is an adjective which designates, in oenology, a wine made through the fermentation of white grapes. It follows that, with regard to the goods in question, the term 'bianco' gives information, which from their very nature is, and must be considered to be, devoid of distinctive character (not disputed) (para. 39).

The word 'fino' is defined in the online version of the Treccani dictionary, as a variation of the word 'fine' and has a very high number of meanings including the overlapping indication, 'refined'. The sign applied for, by the presence of the word 'fino', will therefore be perceived by the relevant public, in at least one of its potential meanings, as a reference to superior quality or to the high-end nature of the goods in question and, therefore, as an indication of the quality of those goods (para. 42). The mere fact that the term 'fine' is more customary in the wine sector than 'fino' is not enough for the relevant public to attribute no meaning to it with the sign BIANCOFINO (para. 44). The combination 'biancofino' is not unusual in its structure and has nothing particularly special about it (para. 46). The sign is thus unable to fulfil the essential function of indicating the commercial origin of the goods (para. 47).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

In accordance with the principles of equal treatment and sound administration, the BoA provided an explicit statement of their reasoning for departing from previous decisions in respect of similar applications and, more particularly, regarding the trade mark NERO FINO (paras 49-52).

T 743/18; I.J. TOBACCO INDUSTRY (fig.) / JTi (fig.); Japan Tobacco v EUIPO; Judgment of 19 December 2019; EU:T:2019:872; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dissimilarity of signs

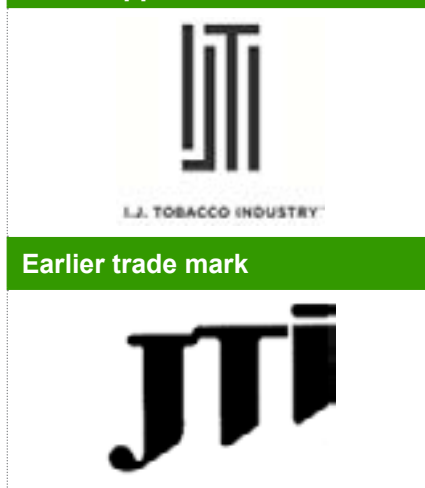
FACTS: The applicant sought to register the figurative mark 'I.J. TOBACCO INDUSTRY' for tobacco; smokers' articles; matches in Class 34. An opposition based on the earlier EU figurative mark 'JTi', registered for cigarettes, raw and manufactured tobacco, smokers' articles and matches in Class 34, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition.

The opponent filed an appeal before the Board of Appeal (BoA), which was dismissed. The BoA found that the figurative element of the mark applied for was the dominant element of that mark and that the word element 'i.j. tobacco industry' was not negligible. It concluded that there was no likelihood of confusion (LOC).



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

EUTM Application



Earlier trade mark



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

The relevant public is the general public in the EU. Consumers of tobacco products and smokers' articles have a high level of attention on account of their high degree of brand loyalty (para. 27).

The figurative element of the mark applied for is the dominant part since it is in a more visible position and is thus likely to occupy a position of greater

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



importance, even if imperfectly, in the mind of the consumers. This element will not be perceived by the relevant public as a group of upper-case letters 'IJTI' (para. 29). The word element 'i.j. tobacco industry' is not totally negligible but has a visually secondary position; it does not alter the assessment (para. 31).

The signs are visually not similar since the signs have only the letters 'j' and 'i' as common elements; the letters 'i.j.' are used in the mark applied for, whereas they form part of the letter group 'jTi' in the earlier mark (para. 34).

The signs are phonetically not similar since the figurative part of the mark applied for is illegible and will be pronounced by the public having a basic knowledge of English as the word elements 'i.j. tobacco industry', or, for those who prefer to shorten it, as 'i.j.'. Those pronunciations are clearly different from the pronunciation of the earlier mark, which contains the letters 'i' and 'j', but in a reversed order compared to the earlier mark, and, more importantly, with the letter 'T' appearing between them (para. 37).

The signs are not conceptually similar since the earlier mark does not convey any message, like the element 'i.j.' in the mark applied for (para. 41).

The overall impression created by the marks is different, as they do not display sufficient visual,

phonetic or conceptual similarities. There is no need to examine the applicant's arguments relating to the degree of similarity between the goods covered by the marks or to assess the LOC globally (para. 45).

T 69/19; Bad Reichenhaller Alpensaline (fig.); Südwestdeutsche Salzwerke v EUIPO; Judgment of 19 December 2019; EU:T:2019:895; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive, Figurative element

FACTS: The applicant sought to register the figurative mark 'Bad Reichenhaller Alpensaline' for goods in Classes 5, 21 and 30. The examiner refused the application pursuant to Article 7(1)(b) and Article 7(1)(c) in combination with Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal. The BoA found that the trade mark applied for was a descriptive indication for the goods within the meaning of Article 7(1)(c) EUTMR.

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 7(1)(b) EUTMR.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



EUTM application



SUBSTANCE:
INFRINGEMENT OF ARTICLE 7(1)(c) EUTMR.

The relevant public is the German-speaking public consisting of the general public and specialists (not disputed) (paras 18-20).

The visual impression is dominated by the word element 'Alpensaline' written inside the figurative element which resembles a mountain or a salt crystal. The word elements 'Bad Reichenhaller Alpsalpine', due to their grammatical and visual position, indicate 'Alpensaline, which is located in Bad Reichenhall, Germany'. This small town in the Alps has been associated with the salt trade for centuries (paras 24-28, 40 and 48). The figurative elements are not capable of diverting the attention of the relevant public from the meaning of the word element 'Bad Reichenhaller' (paras 41-42).

As the word sequence 'Bad Reichenhaller Alpsalpine' complies with the rules of German grammar and does not differ from the meaning of the sum of its components, the relevant public will understand the sign as meaning 'Alpensaline, which is located in Bad Reichenhall' (para. 53).

The sign is therefore descriptive for the goods in Classes 5 and 30 which consist of salt, including pharmaceuticals and similar goods that may consist of salt for medical purposes, as well as bakery products (paras 60-61). The sign is also descriptive for the goods in Class 21 that may serve to store or offer salt (para. 66).

T 175/19; eVoter; Vereinigung der Bayerischen Wirtschaft v EUIPO; Judgment of 19 December 2019; EU:T:2019:874; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive, Word mark

FACTS: The applicant sought to register the word mark eVoter for goods and services in Classes 9, 16, 35, 38, 41, 42 and 45. The examiner partially refused the application, namely for all goods and services in Classes 9, 35, 38, 41, 42 and 45 and graphic representations in Class 16 pursuant to Article 7(1) (b) and Article 7(1)(c) in combination with Article 7(2) EUTMR.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The Board of Appeal (BoA) dismissed the appeal and confirmed the decision of the examiner on the grounds of Article 7(c) and (b) EUTMR. It found that the sign must be refused for all the goods and services for which the sign could be used for creating and using an electronic voting system for any kind of selection or evaluation carried out in everyday life.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of the principle of good administration and (iii) infringement of Article 7(1)(b) EUTMR.

SUBSTANCE:

(i) AND (ii) INFRINGEMENT OF ARTICLE 7(1)(c) EUTMR AND INFRINGEMENT OF THE PRINCIPLE OF GOOD ADMINISTRATION.

The relevant public consists of English-speaking general and professional consumers of the European Union. They pay a normal to high level of attention (paras 7 and 23-26).

The concept of the person referred to by the 'evoter' sign covers a wide range of circumstances related to a voting system for any kind of selection or evaluation (para. 29).

The sign directly and without further reflection describes the nature, intended purpose or subject of the goods and services in Classes 9, 35, 38, 41,

42 and 45 and graphic representations in Class 16. With the help of software in Class 9 and the graphic representations in Class 16, the process and the result of the vote can be seen. The advertising and marketing services in Class 35 can be used to promote electronic voting by inviting the public to participate in it. The other services in Class 35, namely market research and analysis of data, are directly connected to an electronic vote insofar as they serve in the preparation and implementation of the vote and its evaluation, documentation and analysis. The telecommunications services in Class 38 are a necessary element of an electronic voting system. The services of publication and education in Class 41 can relate to an electronic voting system or be assessed by means of such a system. The IT services in Class 42 serve to adapt the electronic voting systems to the special needs of the parties involved. The online dating services in Class 45 consist of facilitating contacts between people by means of a procedure, which is based on an assessment from the participants using an electronic voting system. With regard to the legal services in the same class, the trade mark applied for can be understood as the designation of the subject of such services, which can concern the legality of various aspects of an electronic vote, or as a means to assess these services by using such a system (paras 9, 10 and 30-39).

As to the second plea, according to which the BoA had come to a different conclusion in a case relating

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

to another trade mark, it is sufficient to note that the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign falls within a ground for refusal (para. 40).

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

Since one of the absolute grounds for refusal listed in Article 7(1) EUTMR is sufficient for the refusal of an application, there is no need to consider the third plea (paras 44-45).

T 270/19; ring (fig.); Amazon Technologie v EUIPO; Judgment of 19 December 2019; EU:T:2019:871; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive, Lack of reasoning

FACTS: The international registration (IR) holder designated the European Union for the IR of the figurative mark 'ring' for goods and services in Classes 9, 35, 37, 42 and 45. The examiner partially refused the application pursuant to Article 7(1)(b), Article 7(1)(c) and Article 7(2) EUTMR for certain



goods in Class 9, such as Consumer electronic products, namely, doorbells, motion sensors and monitoring equipment, namely, video monitors and video cameras for monitoring the interior and exterior of homes, retail stores, or offices for security and surveillance; electronic wireless LAN enabled doorbells.

The Board of Appeal (BoA) dismissed the appeal. It held that the mark applied for, when associated with the goods, would be perceived by the relevant public as an indication that all the goods are likely to emit a clear resonant or vibrating sound. It also held that, since the mark applied for merely informed consumers of the functionality of the goods, it was purely descriptive. It also held that the graphic elements used were not such that they could divert the relevant public's attention away from the descriptive information provided by the word element 'ring'.

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

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

EUTM application



SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 94(1) EUTMR.

The BoA did give reasons why the goods in question formed a homogeneous group, which could be the subject of general reasoning (para. 31), notably that all the goods could emit sound and ring whenever their motion detectors were set off by someone breaching a private zone (para. 28). Moreover, it noted that the goods in question, whether doorbells, motion sensors, video monitors or video cameras, had a clearly specified purpose, namely that of monitoring the interior and exterior of homes, retail stores, or offices for security and surveillance (para. 29). The BoA stated that the relevant consumer will perceive the mark applied for, when linked with the goods in question, as an indication that those goods include an alarm system, producing, in particular, a clear resonant or vibrating sound (para. 32) and directly informs the relevant consumer of the very nature of those goods (paras 32-34). Thus, the BoA



did substantiate its refusal to register the mark applied for in respect of all the goods in question (para. 36).

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

The relevant public is composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect and a professional public with a high level of attention. Since the mark applied for consists of a readily identifiable English word, the relevant public consists not only of the public in the Member States in which English is an official language, that is, Ireland, Malta and the United Kingdom, but also the public in the Member States where English is largely understood, such as Denmark, the Netherlands, Finland and Sweden, especially as regards the professional public (not disputed) (para. 48).

The BoA correctly concluded that the mark applied for merely informed consumers of the functionality of the goods in question and was, accordingly, of a purely descriptive nature (paras 51-52). The verbal element 'ring', which means to 'make a clear resonant or vibrating sound' in particular, immediately informed the consumers, without their further thought, that the goods in question, doorbells, motion sensors, monitoring equipment,

First Page

■ Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

■ Malta joins DesignClass

■ Improved e-filing for designs in Romania

More News

■ Quality: knowledge-sharing and training at EUIPO

■ Enhancing TM protection on e-commerce marketplaces: workshop

■ Report on the protection and enforcement of IPR in third countries

Statistical Highlights

■ December 2019

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



namely video monitors and video cameras, include a system to enable them to produce a clear resonant or vibrating sound. The mark applied for is descriptive of the intended purpose of the goods whose function is to allow the monitoring of the interior and exterior of homes, retail stores, or offices for security and surveillance (paras 55, 56 and 61).

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

Since one of the absolute grounds for refusal listed in Article 7(1) EUTMR is sufficient for the refusal of an application, there is no need to examine this plea (paras 65-68).

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

New Decisions from the Boards of Appeal

EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). Decisions of the Presidium of the Boards of Appeal can be found [here](#) and the EUIPO Official Journal [here](#). For best results, please use either the Mozilla Firefox or Google Chrome browsers.

27/11/2019, R166/2019-1, 3D BLACKLIGHT MINIGOLF (fig.)

EUTM application



Outcome: Application rejected.

Norms: Article 7(1)(b) EUTMR.

Keywords: Figurative mark; Figurative element; Non-distinctive.

Summary: The applicant sought to register the figurative sign '3D BLACKLIGHT MINIGOLF', covering services in Class 41 (such as golf) and Class 43 (food and beverages). The examiner found that the relevant English-speaking consumer would immediately understand it as an indication of a



black-lit 3D miniature golf. The sign was accordingly rejected as descriptive in respect of all the services applied for.

The trade mark applied for contains the English word 'BLACKLIGHT' and the internationally recognised terms '3D' and 'MINIGOLF'. A black light is mainly used for show effects, as this effect is mainly used in darkened rooms, where its radiation causes neon colors and other fluorescent substances to glow. Neither a minimum degree of interpretation by the relevant public is necessary in order to understand it, nor does it trigger a thought process. The relevant public, who has the most basic knowledge of English, will therefore recognise the meaning of the sign applied for easily and without the need for further reflection.

The statement '3D BLACKLIGHT MINIGOLF' is devoid of distinctive character with regard to all the services applied for, since it provides information about the subject or thematic content of these services and the place where they are offered. The Board notes that the applicant's statement that there are no restaurants or bars for use at minigolf courses was not proved in any way. On the contrary, as the examiner rightly indicated, it is customary for these installations to offer refreshments or snacks and the courses (§ 20).

The graphic representation of the trade mark applied for is not capable of offsetting the mark's

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



lack of distinctive character. The figurative element of the purple golf ball merely emphasises the message of the word elements.

Consequently, the appeal is dismissed and the application is rejected.

19/12/2019, R2448/2018-1, Windsor-castle

Outcome: Decision confirmed.

Norms: Article 7(1)(b) EUTMR.

Keywords: Word mark; Non-distinctive

Summary: The applicant sought to register a word mark 'Windsor-castle' for goods in Classes 16 and 30. The examiner refused the application for the goods in Class 30 pursuant to Article 7(1)(b) EUTMR, as the sign would be associated by the relevant public with the United Kingdom and the British crown. Windsor Castle is a historical building, one of Europe's oldest castles and highly associated with the British royal family. For the goods specified in Class 30 such as tea and coffee, the sign would be understood as having a relationship with this historical building in England and not as an indication of origin from a specific undertaking.

The Board confirms that the sign is devoid of distinctive character as it serves as advertising information for Windsor Castle. The Board notes that the relevant consumer would perceive the

goods as they are sold within the tourist context of Windsor Castle, and not as an indication of their commercial origin. Moreover, the sign does not have any additional design elements that would confer distinctive character upon it. In relation to the applicant's claim that it was the proprietor of several national, international and EU trade mark registrations containing the word 'Windsor-castle', the Board notes that the registrability of a mark is based solely on the EUTMR and not on previous decisions.

Consequently, the appeal is dismissed and the application is rejected.

18/12/2019, R1675/2019-5, Sienna selection

Outcome: Application rejected.

Norms: Article 7(1)(b) EUTMR.

Keywords: Word mark; Descriptive; Non-distinctive.

Summary: The application for the word mark 'Sienna selection' intended for goods in Class 34 (such as traditional products associated with tobacco, smoker's articles vapes/electronic cigarettes and heated tobacco products) was rejected pursuant to Article 7(1)(b) EUTMR. The examiner indicated that 'Sienna' was a colour and the sign 'Sienna selection' would be seen as 'a range of products in a honey-yellow colour'. Moreover, colours had replaced other indications as a means to show flavour, intensity

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



and/or nicotine level, and the sign would be taken as reference to these characteristics – if not now – in the future. Finally, the word ‘Selection’ could refer to the fact that a consumer would not randomly select a product – in this case, their selection could be of a ‘Sienna’ product: the name merely represented the nature of their choice.

The appellant refers to the Office Guidelines (Guidelines of the Office, Part B, Section 4, Chapter 4, paragraph 2.9. Names of Colours), which point out that the key to a proper analysis of a sign consisting exclusively of the name of a colour (for the purposes under Article 7(1)(c) EUTMR) is whether the application claims goods and services for which the colour can reasonably be perceived by the public as a description of one of its characteristics.

The Board points out that the smoker’s articles may well be produced and marketed in different colours and a consumer faced with the mark ‘SIENNA SELECTION’ will reasonably expect such items to be of that colour, or, perhaps, to form part of the range of sienna smoking products. In particular, smokers will see these items as an extension of electronic or traditional smoking products – part of a collection. It is not necessary that colour be the main reason for their purchase, as long as it can reasonably affect consumer choice. In this context, the Board notes that an objection under Article 7(1)(c) EUTMR can apply regardless of whether or not the mark pertains to an element or characteristic of the goods which plays only a minor role.

It does not matter that colour schemes are proprietary – that is, they may be individually developed and marketed by particular businesses – the point is that that colour will be taken as designating a quality in the goods, and thus is something consumers will look for in these products, and something that affects their choice. This will be particularly so for consumers who – due to their personal experience and interest in health issues related to smoking – would more easily understand the descriptive connotations of the mark applied for. Returning to the test set out by the General Court in the ‘Blud (fig.) judgment (12/08/2018, T 375/17, , Blue (fig.), EU:T:2018:340§ 30-33, it is clear that the nature of ‘sienna’ as a colour will be understood by the relevant public and be perceived by them as a characteristic of the goods in question that influences their purchasing preferences. In other words, the sign ‘Sienna Selection’ will be taken to refer to a choice that is available to the consumer in this case.

Consequently, the appeal is dismissed and the application is rejected.

First Page

- Impact of the UK’s withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



17/12/2019, R1866/2019-4, EASY TO CHOOSE, EASY TO USE

Outcome: Decision confirmed.

Norms: Article 7(1)(b) EUTMR

Keywords: Word mark; Laudatory mark; Slogan mark; Non-distinctive.

Summary: The applicant sought to register the word mark 'EASY TO CHOOSE, EASY TO USE' for goods and services in Classes 3, 35 and 44. The examiner refused the EUTM application on the basis of Article 7(1)(b) EUTMR, for all the goods and services, because the words would be perceived by the relevant public as a laudatory promotional slogan, which served as an indication of positive aspects and they would not indicate their commercial origin. The consumer would understand the sign as an option to choose from several options with no difficulty. Moreover, the examiner argued that although the words 'choose' and 'use' rhymed, this would not change the meaning of the slogan, hence, the perception of the consumer in relation to the goods and services.

The Board also finds that the mark is devoid of distinctive character as it serves as a laudatory and promotional statement rather than indicating the commercial origin of the goods and services specified, namely that they are easy to choose or use. The Board notes that the slogan applied for must be assessed as a whole. Therefore, the

expression 'EASY TO CHOOSE, EASY TO USE' conveys a clear laudatory and promotional message which the relevant public will perceive first and foremost as such, rather than an indication as to their trade origin. In relation to the words which rhyme in the mark applied for, the Board cannot find any innovative or surprising element in order for the sign to be found distinctive. Furthermore, the fact that some of the goods in Class 3 are not cosmetics bears no merit in the decision, since what matters in the case at hand is the meaning of the slogan in connection with the goods and services applied for.

Consequently, the appeal is dismissed and the application is rejected.

17/12/2019, R1507/2019-2, BIO (fig.)

EUTM application



Outcome: IR designating the EU rejected.

Norms: Article 7(1)(b) EUTMR.

Keywords: Figurative mark; Descriptive; Non-distinctive.

First Page

■ Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

■ Malta joins DesignClass

■ Improved e-filing for designs in Romania

More News

■ Quality: knowledge-sharing and training at EUIPO

■ Enhancing TM protection on e-commerce marketplaces: workshop

■ Report on the protection and enforcement of IPR in third countries

Statistical Highlights

■ December 2019

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



Summary: The applicant sought to register the figurative sign 'BIO' for goods in Class 3 (such as cosmetics) and 5 (inter alia, sanitary and hygienic preparations and dietetic substances). The examiner found that the relevant public, even with a high level of attention, would perceive that the sign clearly conveyed obvious and direct information about the nature and quality of the contested goods. The word 'BIO' means 'biological, organic' in English.

The Board endorses the examiner's finding that the relevant public will understand this word as conveying the message that all the contested goods consist of, or contain, biological, organic ingredients. There is a huge market for Class 3 and Class 5 goods just as those at issue, which are promoted as being natural or organic.

Even though the contested goods may also contain goods that do not consist or contain biological, organic ingredients, if the contested mark is descriptive or devoid of distinctive character for specific goods within the category of the goods applied for, the finding of descriptiveness or non-distinctiveness applies to the entire category.

Moreover the letters in the sign are depicted in a rather standard font. Their vertical depiction as well as the blue colour and stylisation of the word 'BIO' are rather banal. The figurative element of the mark, which depicts a green leaf (a commonplace symbol including its colour for biological/organic products)

only reinforces, in the perception of the public at large and the professional public, the descriptive and non-distinctive message conveyed by the verbal element 'BIO' (10/09/2015, T 610/14, BIO organic, EU:T:2015:613, § 20).

Overall, the figurative elements used and the fact that the text is written vertically do not make the expression 'BIO' hard to read, nor do they detract from the descriptive message conveyed to relevant consumers.

Consequently, the appeal is dismissed and the protection of the IR designating EU is rejected.

First Page

- Impact of the UK's withdrawal from the EU: EUTMs and RCDs - updated information

EUIPN Updates

- Malta joins DesignClass
- Improved e-filing for designs in Romania

More News

- Quality: knowledge-sharing and training at EUIPO
- Enhancing TM protection on e-commerce marketplaces: workshop
- Report on the protection and enforcement of IPR in third countries

Statistical Highlights

- December 2019

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal