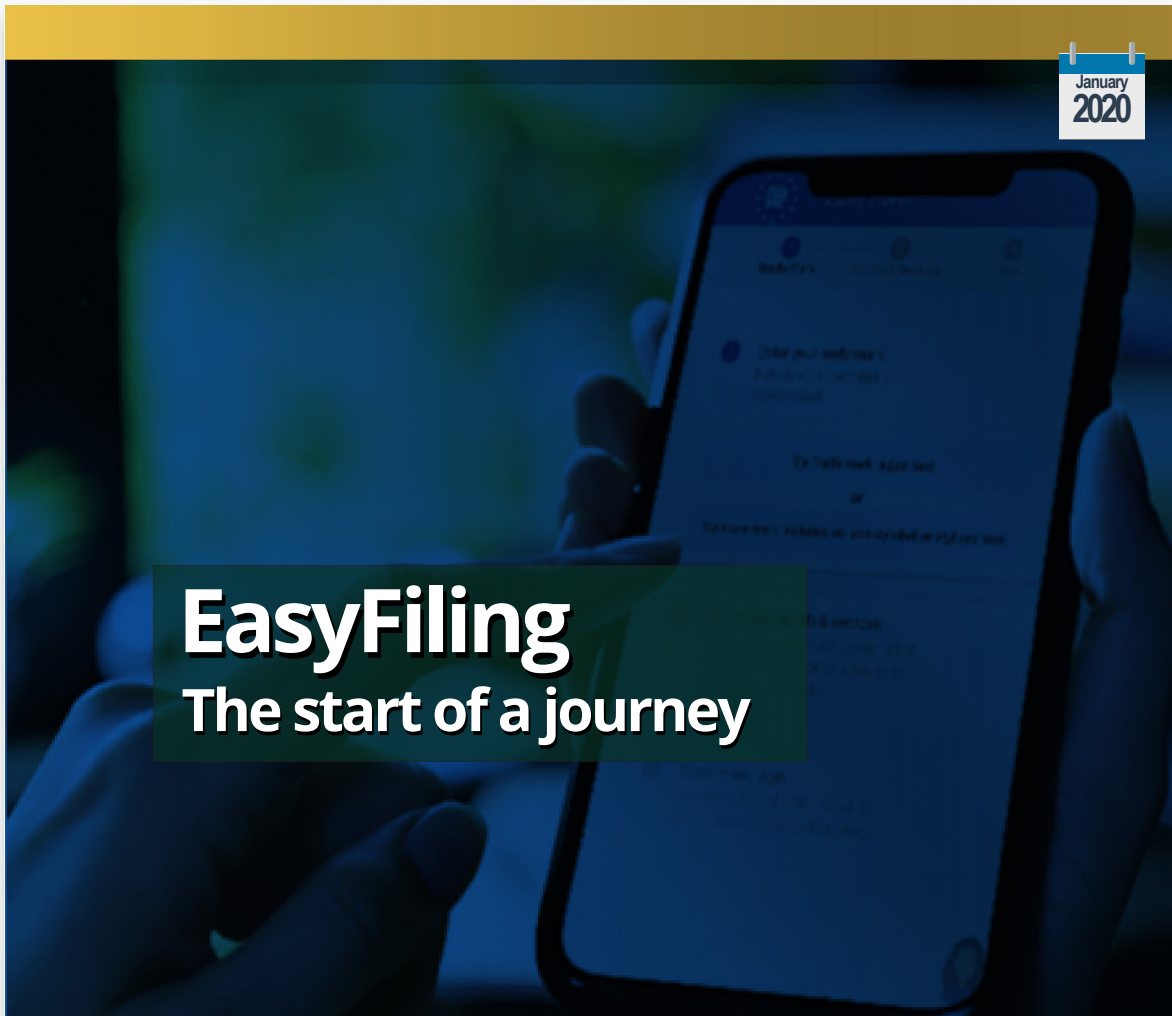


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EasyFiling – the start of a journey

The EUIPO's new [EasyFiling](#) tool, designed for direct filers of EU trade marks, was successfully launched in mid-January and is now regularly serving customers including the SMEs for which it is primarily intended.

Even though the tool is designed to meet the needs of first-time applicants - given its mobile-friendly format, combining artificial intelligence and the latest technologies to simplify e-filing - it is important to all customer sectors for a number of reasons.

Helping SMEs was part of the EUIPO's strategy even before Covid-19, and these efforts have been accelerated, in cooperation with the European Commission's recovery plan. The goal is to encourage small companies to become larger companies, leveraging their IP rights in increasingly sophisticated ways. This will effectively increase the overall importance of the IP sector.

The EUIPO's contribution includes almost €20m from the Office reserves to an SME Fund, operated in cooperation Member State Intellectual Property Offices under the European Commission's COSME programme for competitiveness. This Fund, which is already receiving its first applications, subsidises advice on all IP rights for EU SMEs and applications for trade marks and designs at the national, regional or EU levels.

EasyFiling is an important part of the strategy as it makes EU trade marks more accessible for SMEs and first-time filers. This is vital as they increasingly

move into online platforms and can face new threats as well as opportunities.

Applicants who choose the tool are guided by an interactive virtual assistant to prevent mistakes and avoid delays in the registration of their trade mark. In addition the application process is reduced to three simple steps by including the selection of pre-approved terms of goods and services and helping inexperienced filers understand the risks of conflict with similar, pre-registered trade marks.

While first-time filers may be the main target, EasyFiling is part of a drive to provide more tailored services to all customers, whether SMEs, or large or small IP representatives. It includes some important facilities, permitting direct access by customers' own systems via an Application Programming Interface or API, which potentially allows data to be securely interchanged without being pre-packaged so it can go directly into the customers' own systems without copying or re-typing.

As Raymond Klaassen, Head of the EUIPO's digital architecture and development service explains, "APIs open up opportunities for customers to increase efficiency or create completely new services. EasyFiling is therefore the start of a journey towards more open and extensible systems that will benefit all customers."

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Bulgaria joins Authenticities network

On 18 November and 22 December 2020, the municipalities of **Sofia** and **Plovdiv** became the first certified Bulgarian cities under the framework of the European Cooperation Project (ECP8) 'European Network of Authenticities'. Together with **Thessaloniki**, in Greece, there are now three officially certified 'Authenticities'.

This cooperation project aims to raise awareness, among local policy-makers, businesses and the European citizens, on both the **value of IP and the damaging effects of counterfeiting** in European cities. A series of awareness-raising activities in the field of IP will take place over the next two years in the newly certified cities of Sofia and Plovdiv.

Sofia, the capital of Bulgaria and its largest city, is also the country's main administrative, cultural and educational centre, generating one-sixth of Bulgaria's industrial production.

Plovdiv, European Capital of Culture in 2019, is the second largest city in Bulgaria, with over 8 000 years of history and a growing economy based on industry, services, tourism and information technology.

Through this EUIPO project, the Patent Office of the Republic of Bulgaria, in close collaboration with the

two municipalities and several local stakeholders, aims to combat counterfeiting and to increase IP awareness on a local level. In that sense, it will also be joining the recent Authenticity of Thessaloniki in the task of building a **European network of certified Authenticities**, where best practices can be shared and new synergies created.

Public consultation on EU geographical indications scheme

The European Commission has launched a [public consultation](#) inviting citizens and organisations as well as national and regional authorities to contribute to the assessment of **how to strengthen the geographical indications system**.

The EU protects almost 3 400 names of specific products – agricultural products and foodstuffs, fishery and aquaculture products, wines, spirit drinks and aromatised wine products – under one of its EU quality schemes: Geographical Indication (GI), Protected Designations of Origin (PDO), Protected Geographical Indication (PGI) and Traditional Speciality Guaranteed (TSG).

The goal of the consultation is to gather views on the major challenges identified that would need to be addressed in the planned revision as well as their underlying causes, the set of policy options that can be envisaged to address these challenges and the impacts stemming from these different options.

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The questionnaire is available in all EU languages and it can be accessed via the [consultation web page](#). The deadline for contributions is **9 April 2021**.

TMview's visual search extended to Denmark

The Danish Patent and Trademark Office (DKPTO), with the support of the EUIPO's European cooperation projects, has made its trade mark images available to the visual search tool in [TMview](#).

TMview's visual search facility allows users to search for trade mark images in the world's largest online trade mark database.

Since 2017, when the first image search facility was implemented in TMview, additional intellectual property offices have incorporated this function into their search facilities. With the addition of DKPTO, the total number of IP offices using this function is 26.

OSIM enhances its front and back office systems

The Romanian State Office for Inventions and Trademarks (OSIM) has enhanced its front office and back office applications.

In particular, the front office system has been expanded with **five new online services for trade marks**: limitation, withdrawal, licensing rights,

oppositions and observations. As a result, users will be able to easily file trade mark applications in a more efficient way.

In addition, enhancements to the user interface and the new back office software functionality will allow OSIM users to experience a better performance during day-to-day activities.

OSIM and the EUIPO will continue to work together to further enhance the front office and back office applications during 2021.

International Cooperation: Norway in TMclass

On 20 January 2021, the Norwegian Industrial Property Office (NIPO) enhanced its participation in [TMclass](#). NIPO now uses and accepts terms from the harmonised database of goods and services (HDB) in TMclass in Norwegian.

In total, 81 IP offices participate in TMclass and the tool offers the opportunity to search and translate goods and services to and from any of the 44 languages available. Following NIPO's decision to adopt the HDB, there are now 13 IP offices outside the EU using and accepting terms from this database.

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IP Mediation Conference: 22-23 March 2021

The EUIPO Boards of Appeal, together with the EUIPO Academy and the International Cooperation and Legal Affairs Department, are organising the third edition of the [IP Mediation Conference](#), which will be held virtually on 22-23 March 2021.

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

For further information, please take a look at the [conference programme](#). Registration is now open via the conference page.

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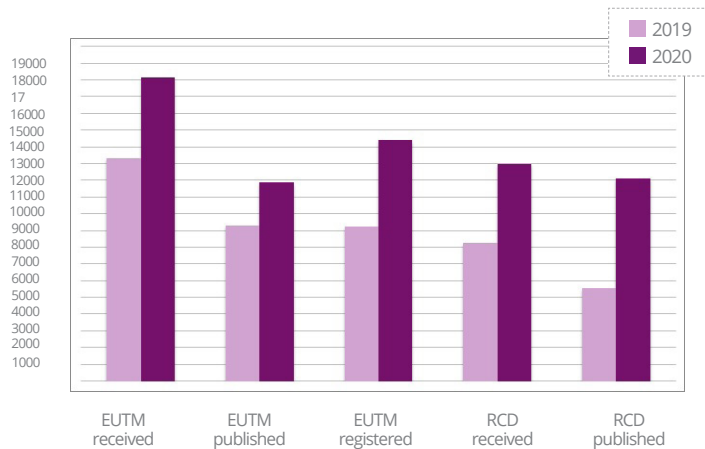
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Statistical Highlights

Monthly statistical highlights December*	2019	2020
European Union Trade Mark applications received	13 293	18 126
European Union Trade Mark applications published	9 284	11 882
European Union Trade Marks registered (certificates issued)	9 217	14 431
Registered Community Designs received	8 252	12 994
Registered Community Designs published	5 574	12 094



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IP vouchers for SMEs: first window now closed

Available to EU enterprises that meet the [official definition of a SME](#), the [Ideas Powered for Business SME fund](#) offers financial support in the form of reimbursements for trade mark and design applications' fees and for IP pre-diagnostic services (IP Scan), **up to a maximum amount of EUR 1 500 per business.**

The first application window for the SME fund grants concluded on 31 January. Hundreds of SMEs from all EU Member States have already applied to benefit from the new IP voucher scheme. This was the first of five application windows that will run throughout 2021. The next window will open from 1 to 31 March 2021.

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

The requirements, timing and other information relevant to the scheme can be consulted on the [Ideas Powered for Business hub](#).

Ideas Powered for Business Network continues to grow

The Ideas Powered for Business Network of SME stakeholders is growing fast with 9 important EU organisations already signed up and many more in the pipeline for 2021. These organisations, in different fields such as accounting, crowdfunding, technology and innovation, have members at national level who in turn are in touch with SMEs all over Europe.



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New Decision on technical requirements for annexes submitted on data carriers

A [new Decision of the Executive Director](#) on the technical requirements for annexes submitted on data carriers repeals previous [Decision EX-17-6](#). The new decision will enter into force on **1 March 2021** and will bring in the following changes:

- **Removal of CDs and DVDs:** CDs and DVDs will no longer be considered as an acceptable 'format' of data carrier, however USB flash drives, pen drives or similar USB type memory units will continue to be allowed.
- **Reducing the size of individual files:** the acceptable file size of an individual annex as submitted on a data carrier will be reduced to 20 MB, to be aligned with the sizes of files accepted in all online eActions (through the UserArea).

By implementing these changes, the annexes submitted on data carriers will be able to be incorporated automatically into the content of the electronic file of the IP right or proceeding in question, and therefore also available for free online inspection of files to all parties. This change is also aimed at preventing loss or corruption of

data saved on disks as they are more susceptible to damage over time.

The [decision](#) also includes information on file(s) format, structure and name, as well as the processing of illegible annexes.

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Latest webinars

Digital Services Act: new rules of the game

The new EU-wide rules will protect you online and ensure that businesses can compete fairly. In practice, this means that:

- illegal content will be removed faster;
- sellers of illegal goods will be better tracked down;
- blocking users from un-installing pre-installed software will be prohibited;
- algorithms will be more transparent;
- sanctions for non-compliance may be imposed.

The new framework will rebalance the rights and responsibilities of users, intermediary platforms, and public authorities. Want to know more? Find all the answers to these questions in our first webinar of the year.

Watch the webinar [here](#).

Ideas Powered for Business Support Services for SMEs: What's new in 2021

The Ideas Powered for business SME Fund was launched on the 11th January 2021 by the EUIPO with the collaboration of the European Commission and national IP offices.

This 20 million grant scheme for European SMEs offers financial support, namely 50% off trade mark and design application fees (national and European) and also 75% off on IP-Pre-diagnostic services.

EUIPO speakers Jose Ignacio MALDONADO and Lynn Burtchaell will present the SME Fund together with other interesting services such as the free personalised consultations for SME offered by IP experts.

Watch the webinar [here](#).

Discover how to moderate like a professional

Build, develop and improve your online moderating skills thanks to this webinar.

After this webinar, as a moderator, you will:

- understand your role and objectives;
- be able to effectively prepare a moderation session;
- be able to engage participants;
- learn how to manage and challenge the speakers.

Join us and benefit from tips and tricks from Claire Doole, a famous professional moderator.

Watch the webinar [here](#).

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Farewell to the Fax! - Find out about the new rules applicable from 1 March 2021

Thanks to this webinar, you will:

- get an overview of the Executive Director's decision No EX 20 9, of 3 November 2020, on communication by electronic means;
- understand the reasons for this change and the deadlines;
- discover the existing alternatives, especially the 'Fax Alternative' button (soon to be renamed 'communication backup').

Watch the webinar [here](#).

Upcoming webinars

Webinar: **New kinds of evidence deriving from the internet : How should right holders present evidence to ensure success** [Tuesday 02 February](#), 10.00 a.m. – 11.00 a.m.

Webinar: **The multifaceted notion of bad faith** [Tuesday 09 February](#), 10.00 a.m. – 11.00 a.m.

Webinar: **Artificial intelligence and IP right** [Tuesday 16 February](#), 10.00 a.m. – 10.30 a.m.

Webinar: **New Edition of EUIPO Guidelines** [Tuesday 23 February](#), 10.00 a.m. – 10.30 a.m.

On current case-law

In case C 490/19, the CJ states that, in certain cases, reproducing the visual appearance of a product with a protected designation of origin (PDO) is forbidden as it could mislead consumers into believing that the product containing that reproduction is a product covered by that registered name. In this case, it was a horizontal black stripe inside a cheese and the PDO 'Morbier'.

For a closer look at other GI-related judgments watch our recorded webinar on '[How much protection for GIs? Recent case law](#)'.

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

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



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

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

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



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

Luxembourg trade mark and design news

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

02/12/2020, T 35/20, DEVICE OF CLAW-LIKE SCRATCH (fig.) / DEVICE OF CLAW-LIKE SCRATCH (fig.) et al, EU:T:2020:579

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Claim for alteration of EUIPO decision, Conceptual similarity, Examination of facts ex officio, Passing off, Visual similarity

NORMS: Article 8(1)(b) EUTMR, Article 8(4) EUTMR, Article 8(5) EUTMR, Article 7(2)(d) EUTMDR, Article 72(3) EUTMR

KEY POINTS: Where it is called upon to assess the legality of BoA decisions, the Court cannot be bound by an incorrect assessment of the facts by the BoA, since that assessment is part of the findings, the legality of which is being disputed before it (18/12/2008, C 16/06 P, Mobilix, EU:C:2008:739,

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§ 48; 05/02/2020, T 44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 88) (§ 49).

Although the opponent did not challenge the BoA's conclusion in relation to the conceptual comparison, it did call into question the BoA's assessment relating to the likelihood of confusion (LOC). Thus, by virtue of the principle of interdependence, the Court has jurisdiction to examine the BoA's findings on the conceptual comparison (05/12/2019, T 29/19, Idealogistic Verhoeven Greatest care in getting it there (fig.) / IDÉA (fig.) et al., EU:T:2019:841, § 89) (§ 50).

The opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, invoked pursuant to the law of a Member State. However, according to Article 7(2)(d) EUTMDR, the opponent must provide a clear identification of the content of the national law relied on by adducing publications of the relevant provisions or case-law (§ 80). To that end, a mere reference in a footnote to the case-law on which the applicant intends to rely, does not suffice to fulfil the obligations arising from Article 7(2)(d) EUTMDR (§ 81).

The Office is not required to supplement the missing information on national law on its own motion, because its power of verification can be exercised only where the Office already has information relating to national law, either in the

form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced (20/03/2013, T 571/11, Club Gourmet, EU:T:2013:145, § 41), which is not the case here (§ 83).

FACTS: The applicant sought to register a figurative mark representing a claw-like scratch for, inter alia, goods and services in Classes 18, 25 and 35.

Pursuant to Articles 8(1)(b), (4) and (5) EUTMR, an opposition was filed based on earlier EU and UK figurative marks representing claw-like scratches covering, inter alia, goods and services in Class 18, 32, 25 and 35. The Opposition Division (OD) rejected the opposition.

The opponent appealed the decision. The Board of Appeal (BoA) dismissed the appeal and rejected the opposition in its entirety. It found that the opponent had proven reputation and use in the course of trade in relation to some of the earlier marks for 'energy drinks' in Class 32. It also assumed, for reasons of procedural economy, that all the contested goods and services were identical to those covered by the earlier marks. However, the signs were: visually similar to a very low degree; conceptually, they were either similar to a low degree, or dissimilar, or they were not comparable; phonetically, they could not be compared. The BoA concluded that there was no likelihood of confusion and that it was unlikely that the relevant public would establish a link between

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the marks pursuant to Article 8(5) EUTMR. As regards Article 8(4) EUTMR, it was unlikely that the public would be misled where the goods and services covered by the EUTM were dissimilar to those in respect of which goodwill has been acquired.

The opponent filed an action before the General Court (GC), relying on five pleas in law alleging: (i) and (ii) infringement of Article 8(1)(b) EUTMR, (iii) and (iv) infringement of Article 8(5) EUTMR and v) infringement of Article 8(4) EUTMR. The GC partially upheld the action.

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

THE RELEVANT PUBLIC

The goods and services in Classes 18, 25 and 35 are directed at the public at large and business customers with specific professional knowledge or expertise. Their degree of attention may vary from average to high (not disputed). The relevant territories are the European Union and the UK (§ 28 29).

COMPARISON OF THE GOODS AND SERVICES

The goods and services covered by the EUTM and those covered by earlier marks Nos 1 to 5 were assumed to be identical (not disputed). The merits of this approach are assessed by the Court at the stage of the LOC (§ 30-31).

EUTM application



Earlier UK and EU trade marks



COMPARISON OF THE SIGNS

Both the EUTM and the earlier marks may, inter alia, be perceived as claws or scratches. Irrespective of their perception, all these signs are distinctive for the goods and services in question (§ 35).

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The signs have an average degree of visual similarity (and not a low one, as stated by the BoA): the particular stylisation of the vertical lines in all the signs is very similar and outweighs the differences (§ 38 39). Phonetic comparison is not possible, since the EUTM is a purely figurative sign and cannot be pronounced (§ 45 46).

As regards the conceptual comparison, for the part of the public that will perceive the signs in question as scratches or claws, the degree of conceptual similarity is average (and not low, as stated by the BoA) (§ 52). The Court has jurisdiction to examine the BoA's findings in that regard: Where it is called upon to assess the legality of BoA decisions, the Court cannot be bound by an incorrect assessment of the facts by the BoA, since that assessment is part of the findings, the legality of which is being disputed before it (18/12/2008, C 16/06 P, Mobilix, EU:C:2008:739, § 48; 05/02/2020, T 44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 88) (§ 49).

Although the opponent did not challenge the BoA's findings on the conceptual comparison, it did call into question the BoA's assessment relating to the LOC. Therefore, by virtue of the principle of interdependence, the Court has jurisdiction to examine the BoA's findings on the conceptual comparison (05/12/2019, T 29/19, Idealogistic Verhoeven Greatest care in getting it there (fig.) / iDÉA (fig.) et al., EU:T:2019:841, § 89) (§ 50).

GLOBAL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

In light of the average degree of visual similarity of the signs and, for a part of the relevant public, conceptual similarity, the average level of attention, at least in relation to some of the goods and services in question, and the average degree of inherent distinctiveness of the earlier marks, the BoA could not, relying on the assumption that the goods and services concerned were identical, rule out the existence of a LOC (§ 58, 61).

Therefore, the first and second pleas in law must be upheld and the contested decision must be annulled in so far as it rejected the opposition based on Article 8(1)(b) EUTMR (§ 62).

iii) iv) INFRINGEMENT OF ARTICLE 8(5) EUTMR

The contested decision must also be annulled as far as concerns the examination of the opposition based on Article 8(5) EUTMR since it was also based on an incorrect comparison of the signs carried out in the context of Article 8(1)(b) EUTMR (§ 64).

v) INFRINGEMENT OF ARTICLE 8(4) EUTMR.

Where the opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, invoked pursuant to the law of a Member State, according to Article 7(2)(d) EUTMDR, the opponent must

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provide a clear identification of the content of the national law relied on by adducing publications of the relevant provisions or case-law (§ 80). To that end, a mere reference in a footnote to the case-law on which the applicant intends to rely is insufficient to fulfil the obligations arising from Article 7(2)(d) EUTMDR (§ 81).

The Office is not required to supplement the missing information on national law on its own motion, because its power of verification can only be exercised where the Office already has information relating to national law, either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced (20/03/2013, T 571/11, Club Gourmet, EU:T:2013:145, § 41), which is not the case here (§ 83).

Accordingly, the fifth plea is dismissed.

The heads of claim seeking that the Court exercise its power to alter decisions in order to annul the OD's decision and uphold the opposition are dismissed. Power to alter decisions is limited to situations in which the Court is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (24/10/2019, T 498/18, Happy Moreno choco (fig.) / MORENO (fig.) et al., EU:T:2019:763, § 129) (§ 91).

This is not the case here. Since the BoA did not carry out a specific assessment of the goods and services, relying on the assumption that they were identical, the Court – whose role does not include assessing matters, for the first time, which have not already been examined by the BoA – is not in a position to determine the goods and services in respect of which the opposition under Article 8(1)(b) EUTMR was to be upheld and, consequently, is not able to exercise its power to alter decisions (§ 93).

The same applies in relation to Article 8(5) EUTMR, since the BoA merely found that there was no link between the marks in question without having assessed all the conditions for the application of that article (§ 94).

02/12/2020, T 639/19, 5MS MMMMM (fig.) / 5J (fig.), EU:T:2020:581

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Admissibility, Conceptual similarity, Identity of the goods and services, Likelihood of confusion, Numerical mark, Phonetic similarity, Visual similarity

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

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KEY POINTS: The degree of phonetic similarity between the signs 5Ms (fig.) and 5J (fig.) is average since they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the mark applied for (12/12/2017, T 815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when, for a significant part of the relevant public, the pronunciation of the number five is longer than the pronunciation of the second part of the word elements of the signs, i.e. the letter 'j' or the combination of letters 'ms' respectively (§ 50).

The signs also have a high degree of conceptual similarity since they both convey a common concept, namely that of the combination of a number and a letter, which is a consonant represented in capital letter (§ 54).

FACTS: The applicant sought to register the figurative sign '5Ms MMMMM' as an EUTM for meat; poultry, not live; game; meat extracts; cured sausages; processed meat products; meat preserves; charcuterie in Class 29.

Pursuant to Article 8 (1)(b) and Article 8 (5) CTMR an opposition was filed based on the earlier figurative mark '5J', registered in the EU for goods in Class 29 such as meat, fish, poultry and game; meat extracts. The Opposition Division (OD) upheld the opposition

in its entirety. It found that the EUTM would take unfair advantage of the reputation of the earlier mark and that it was not necessary to examine the opposition based on Article 8 (1)(b) CTMR.

The applicant filed an appeal. The Board of Appeal (BoA) upheld the appeal and rejected the opposition. It found that, in spite of the identity of the products under comparison, there is no likelihood of confusion between the signs, since they only share a low degree of visual and phonetic similarity and, conceptually, the reference to the same number plus a letter (a different one) does not entail a conceptual similarity. Additionally, the lack of conclusive evidence on the reputation of the earlier mark precluded the application of Article 8(5) CTMR.

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

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

The relevant public

The relevant public is made up of the general public in the EU, whose level of attention is normal (not disputed) (§ 27).

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EUTM application



Earlier trade mark



The comparison of the goods

The contested meat; poultry, not live; game; meat extracts are identically contained in the list of goods in Class 29 of the earlier mark. The contested cured sausages; processed meat products; meat preserves; charcuterie are also included in the opponent's meat. Therefore, the BoA rightly held that the goods under comparison are identical (§ 29 and § 31 32).

The comparison of the signs

The signs have a low degree of visual similarity, as stated by the BoA: in spite of sharing the number

5 within a circle, they present important visual differences such as their colours, the additional consonant 'm' reproduced five times in the EUTM and the representation of an acorn in the earlier mark (§ 40 44).

The degree of phonetic similarity of the signs is average (and not low, as stated by the BoA, § 51): they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the EUTM (12/12/2017, T 815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when for a significant part of the relevant public the pronunciation of the number five is longer than the pronunciation of the letter 'j' or the combination of letters 'ms' (§ 50).

BoA incorrectly found the signs not conceptually similar. The signs have a high degree of conceptual similarity: they both convey a common concept, namely that of the combination of a number and a letter, which is a consonant represented in capital letter (§ 54-55).

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Likelihood of Confusion

Taking into account the average inherent distinctive character of the earlier mark, there is a likelihood of confusion between the signs considering their visual, phonetic and conceptual similarities, without it being necessary to rule on the enhanced distinctive character of the earlier mark claimed by the opponent (§ 65 66).

The BoA decision is annulled without it being necessary to examine the second plea concerning Article 8(5) CTMR.

02/12/2020, T 687/19, Marq / MARK (fig.) et al., EU:T:2020:582

RESULT: Action dismissed

KEYWORDS: Complementary goods and services, Conceptual dissimilarity, Figurative trade mark, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Visual similarity.

NORMS: Article 8(1)(b) CTMR [now EUTMR], Article 53(1)(a) CTMR [now Article 60(1)(a) EUTMR]

KEY POINTS: There is a low degree of similarity between goods in Class 11, such as electric lights; electric lighting fixtures; flashing strobe light apparatus and lighting mixers in Class 9 (§ 50 53).

The signs in question are conceptually different, since the earlier mark has a specific meaning, whereas the contested mark has no meaning (19/09/2017, T 768/15, RP ROYAL PALLADIUM (fig.) / RP, EU:T:2017:630, § 88 89) (§ 87).

FACTS: The proprietor registered the word sign MARQ as an EUTM for goods in Classes 9 and 11.

Pursuant to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR an application for declaration of invalidity was filed on the basis of the earlier Spanish figurative mark 'MARK', registered for goods in Class 9 and the international figurative mark 'MARK' designating Benelux, Germany, France, Italy, Portugal and the United Kingdom, registered for goods in Class 9.

The Cancellation Division (CD) upheld the application for a declaration of invalidity in respect of certain goods in Class 9 (such as Sound and lighting mixers) and in respect of all the goods in Class 11 (such as Electric lights; electric lighting fixtures; flashing strobe light apparatus).

The Board of Appeal (BoA) dismissed the proprietor's appeal. Their appeal was limited to the contested goods in Class 11 and stated that the CD's decision, insofar as the goods in Class 9 are concerned, had become final. Relying on the earlier international registration of the figurative mark, it found that the relevant territory consisted of Benelux, Germany,

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France, Italy, Portugal and the United Kingdom and that, depending on the goods concerned, the level of attention of the relevant public varied from average to high. It found that there was a low degree of similarity between the goods and that the signs were visually similar to an average degree and were phonetically identical. It held that no conceptual comparison could be carried out in the absence of a clear meaning of the sign comprising the contested mark. It found that the moderate degree of similarity between the goods was offset by the overall similarity between the signs, which was not cancelled out by any conceptual difference. The BoA concluded that there was a likelihood of confusion (LOC) on the part of the relevant professional consumers.

The proprietor filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 53(1)(a) CTMR read in conjunction with Article 8(1)(b) CTMR. The GC dismissed the action.

EUTM application

Marq

Earlier trade marks



SUBSTANCE: INFRINGEMENT OF ARTICLE 53(1)(a) CTMR READ IN CONJUNCTION WITH ARTICLE 8(1)(b) CTMR.

The BoA correctly found that the goods covered by the earlier mark are aimed in part at the general public and at the specialist public and in part at professionals and that, depending on the goods, the level of attention of the relevant public varied from average to high (§ 29, 32 34, § 40).

The BoA correctly found that the goods in Class 11 covered by the contested mark were similar, to a low degree, to the lighting mixers covered by the earlier mark, in so far as those goods were regarded, in essence, as being complementary and could be produced by the same manufacturers and sold by the same retail outlets, in particular, by specialist shops for lighting technology, and were aimed at the same public (§ 42, 46 53).

The word element 'mark' is dominant in the earlier mark (§ 59-62); it is more distinctive than the figurative element in relation to the goods (§ 63).

The signs display, at most, an average degree of visual similarity. The fact that the sole word element 'marq' in the contested mark is almost identical to the dominant visual element of the earlier mark, namely the word element 'mark', is sufficient to establish a visual similarity between the signs (§ 71). Neither the presence of a figurative element in the

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earlier mark nor the graphic difference between the letters 'k' and 'q' at the ends of the word elements of the signs is such as to eliminate the visual similarity resulting from the sequence of the letters 'm', 'a' and 'r' (§ 72). The signs are phonetically identical (§ 82). Whereas the term 'marq' in the contested mark has no meaning and does not convey any concept, the word element 'mark' of the earlier mark will be perceived as a symbol or sign, a blemish or a male first name. The signs in question are conceptually different, since the earlier mark has a specific meaning, whereas the contested mark has no meaning (19/09/2017, T 768/15, RP ROYAL PALLADIUM (fig.) / RP, EU:T:2017:630, § 88-89) (§ 87). Therefore, contrary to the BoA's finding, a conceptual comparison can be carried out, but there is no conceptual similarity between the signs (§ 88).

The BoA correctly found that, in view of the average degree of visual similarity and the phonetic identity between the signs, as well as of the average inherent distinctiveness of the earlier mark (not disputed), there is a LOC on the part of the relevant specialist consumers in respect of the goods in Class 11. The low degree of similarity between the goods is offset by the overall similarity. The similarity of the signs is not cancelled out by their conceptual differences. The possible meanings of the word element 'mark' in the earlier mark are not such as to offset the visual and phonetic similarities of those signs (§ 91 92, 97 99).

02/12/2020, T 26/20, Forex, EU:T:2020:583

RESULT: Action dismissed

KEYWORDS: Admissibility, Descriptive, Specialised public

NORMS: Article*7(1)(c) CTMR [now Article*7(1)(c) EUTMR]

KEY POINTS: None

FACTS: The proprietor registered the word mark Forex for goods and services in Classes 6, 9, 16 and 36.

An application for declaration of invalidity pursuant to Article 52(1)(a) CTMR, based on Article 7(1)(b) to (d) CTMR, was filed. The Cancellation Division (CD) granted the application for a declaration of invalidity in respect of certain goods in Class 9 (such as coded and uncoded magnetic cards, in the form of bank- and debit cards) and in Class 16 (such as printed matter, printed information material, printed publications) and declared the contested mark to be partially invalid.

The proprietor filed an appeal. The Board of Appeal (BoA) dismissed the appeal. The BoA found that the goods targeted both the general public displaying an average degree of attention, and professionals with a degree of attention which was held to be high

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for the technical goods in Class 9 and higher than average for the other goods.

The BoA found that the disputed mark was descriptive of the goods. It stated that the term 'forex' was known as the abbreviation of 'foreign exchange market; foreign exchange' by professionals such as traders, business people and economic experts and was also known by part of the English-speaking general public. As regards the goods in Class 9, it stated that the submitted evidence had established that the sign Forex indicated to consumers that those goods related to the cashing and transfer of currency and was thus descriptive of the kind and intended purpose of those goods. As regards the goods in Class 16, the term 'forex' described the subject matter of printed matter; printed information material, printed publications, given that forex was a topic that had been the subject of various publications. Furthermore, the sign Forex described the intended purpose of printed forms, as there could be forms to be sent which were specially made for currency-trading operations.

The proprietor filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 51(1)(a) CTMR and Article 7(1)(c) CTMR.



SUBSTANCE: ADMISSIBILITY ISSUES

The documents submitted by the applicant for the first time before the GC are inadmissible (§ 12 14).

The application is further inadmissible in so far as it contains only a general reference to the facts and pleas relied on before the Office, without providing further details (§ 15 18).

INFRINGEMENT OF ARTICLE 51(1)(a) CTMR AND ARTICLE 7(1)(c) CTMR

The BoA was right in taking into account the English-speaking public consisting of both professionals and the general public, and it correctly assessed its level of attention with regard to the goods (§ 33 39). It was also right to find that the term 'forex' is known as an abbreviation of 'foreign exchange market; foreign exchange' by a non negligible part of the target public (§ 40 49).

The BoA correctly found that, for the relevant public, the sign Forex was descriptive of the nature and intended purpose of the goods in Class 9 (§ 50 56) and of the subject matter and intended purpose of the goods in Class 16 (§ 57 63).

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09/12/2020, T 819/19, BIM READY (fig.) / BIM freelance (fig.), EU:T:2020:596

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Conceptual similarity, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Restriction of the list of goods and services, Similarity of the signs, Visual similarity

NORMS: Article 49 (1) EUTMR, Article 188 RPGC, Article 8(1)(b) EUTMR

KEY POINTS: If a restriction of the services of the mark applied for, requested by the applicant after the BoA decision, is not limited to reducing the subject matter of the dispute by withdrawing certain services in the same category of those applied for, but is capable of changing the subject matter of the dispute by altering the composition of the relevant public and its level of attention. Therefore, it cannot be taken into account by the GC for the purposes of examining the legality of the contested BoA decision (§ 22 23).

The level of attention of the relevant public with regard to training services in Class 41 is high: these services are aimed at expanding knowledge and developing skills, usually through a commitment in terms of time and resources on the part of the relevant public; they do not satisfy a current or recurring need, but a personal or leisure interest (§ 35).

FACTS: The international registration holder designated the EU for the figurative mark 'BIM READY' claiming protection for provision of training in Class 41.

Pursuant to Article 8(1)(b) EUTMR, an opposition was filed based on the earlier figurative EUTM 'BIM freelance', registered for inter alia educational centre services; creation of educational content relating to engineering, architecture and construction in Class 41. The Opposition Division (OD) upheld the opposition. It found that there was likelihood of confusion (LOC) on the part of the relevant public.

The opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal.

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

LAW: RESTRICTION OF THE SERVICES COVERED BY THE MARK APPLIED FOR

After the BoA decision, the applicant restricted the list of services covered by the mark applied for thereby replacing the reference to the general category 'provision of training' with the reference to the more specific 'provision of training relating to building information modeling for engineers, constructors, architects and other technical experts' in Class 41 (§ 20).

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IR designating the EU

bim✓ready

Earlier trade mark



The requested restriction is not limited to reducing the subject matter of the dispute by withdrawing, from the services covered by the mark applied for, certain services in the same category. By contrast, it is capable of changing the subject matter of the dispute by altering the composition of the relevant public and its level of attention. Therefore, it cannot be taken into account by the GC for the purposes of examining the legality of the contested BoA decision (§ 22 23).

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

Comparison of the services and the relevant public

Provision of training' covered by the mark applied for are identical to the 'educational centre services' covered by the earlier mark (§ 29 and 33).

The relevant public consists both of the public at large and of professionals, whose level of attention is high for both categories (and not average, as stated by the BoA) (§ 33 35). This is due to the fact that the training services at issue are aimed at expanding knowledge and developing skills, usually through a commitment in terms of time and resources on the part of the relevant public. They are services that do not satisfy a current or recurring need, but rather a personal or leisure interest (§ 35).

The comparison of the signs

The combination of letters 'bm' or 'BIM' of the signs at issue will not be understood either by the part of the relevant public consisting of the public at large, or professionals other than those operating in the field of construction. For that part of the relevant public, that combination of letters has no specific meaning and therefore has a normal degree of distinctiveness (§ 47 and 51).

However, for the relevant public consisting of specialists in the field of construction, the combination of the letters 'bm' or 'BIM' will be considered descriptive of training services relating to 'building information modeling' technology. Therefore, the earlier mark will have a low degree of distinctiveness for that public (§ 48 and 51).

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The signs have, at best, a very low degree of visual similarity (and not an average degree, as stated by the BoA). This is due, inter alia, to the differences relating to the second part of the verbal elements, the figurative elements, the colours used in the signs at issue and the typefaces of the verbal elements of those signs (§ 57).

The degree of phonetic similarity of the signs is average since the first part of the verbal element of the sign in the mark applied for will be read as 'bim' and the signs coincide partially on account of the pronunciation of that element (§ 60).

For the part of the relevant public that will not recognise the acronym for 'building information modeling' in the combination of letters 'bm' or 'BIM', any conceptual similarity of the signs must be excluded (§ 64). On the other hand, for the part of the relevant public that will recognise the acronym, there is a certain degree of conceptual similarity between the signs which is, however, at most, low because it is based on an element which is descriptive. Furthermore, the second part of the verbal elements of the signs has a different meaning (§ 65).

Likelihood of Confusion

Firstly, the average degree of phonetic similarity is offset by a very low degree of visual similarity and by a lack of, or low degree of, conceptual similarity,

which make the signs similar to a low degree overall. Secondly, the identity of the services covered by the signs is offset by the high level of attention of the relevant public consisting both of the public at large and of professionals. Therefore, in accordance with the principle of interdependence between the factors to be considered, there is no LOC on the part of the relevant public (§ 71).

09/12/2020, T 30/20, Promed, EU:T:2020:599

RESULT: Action dismissed

KEYWORDS: Laudatory mark, Non-distinctive, Principle of legality

NORMS: Article⁹7(1)(b) CTMR [now Article⁹7(1)(b) EUTMR], Article 51(1)(a) CTMR [now Article⁹51(1)(a) EUTMR], Article 95(1) EUTMR

KEY POINTS: The head of claim 'to alter the contested decision with a view to reimbursement of the appeal fees' can be interpreted as a request for an order requiring the Office to reimburse the appeal fee paid (Article 68 EUTMR) under Article 190(2) RPGC (§ 20).

In order to determine the grounds on which an application for a declaration of invalidity is based, it is necessary to examine all of the application,

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especially in light of the detailed statement of reasons in support of it (18/03/2016, T 501/13, WINNETOU, EU:T:2016:166, § 26) (§ 27).

FACTS: The EUTM proprietor registered the word mark Promed for test strips for medical purposes in Class 5, apparatus for measuring body temperature and functions in Class 9 and goods in Class 10 such as surgical, medical, dental and veterinary instruments and apparatus. Pursuant to Article 52(1) (a) CTMR, an application for declaration of invalidity was filed based on Article 7(1)(b) and (c) CTMR. The Cancellation Division (CD) granted the application for a declaration of invalidity and declared the contested mark to be invalid.

The proprietor filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. Firstly, it found that the purpose of the application for a declaration of invalidity had to be assessed not only in the light of the form completed by the applicant for a declaration of invalidity but also by taking into account the statement of grounds for invalidity. Secondly, the BoA defined the relevant public as consisting of health sector professionals and English-speaking end consumers. Thirdly, the BoA pointed out that, in English, the term 'pro' means 'professional' and was therefore used for purely laudatory purposes in the marketing of goods and services to emphasise their quality. In addition, the abbreviated term 'med' is commonly used in English to refer to medicine or a medicinal product. The

proprietor of the contested mark did not dispute those well-known facts. Therefore, according to the BoA, the combination of those terms is immediately understood by the relevant public as an indication of the nature of the goods concerned as medical products meeting the highest standards of quality and reliability. The BoA claims that it is therefore a purely promotional term encouraging the relevant public to purchase the medical products, without revealing any element capable of constituting an indication of the commercial origin of the products. The BoA concluded that the contested mark was devoid of distinctive character.

The proprietor filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 95(1) EUTMR and (ii) infringement of Article 59(1)(a) EUTMR and Article 7(1)(b) EUTMR.

SUBSTANCE: (i) ADMISSIBILITY OF CERTAIN HEADS OF CLAIM

The head of claim 'to alter the contested decision with a view to reimbursement of the appeal fees' can be interpreted as a request for an order requiring the Office to reimburse the appeal fee paid (Article 68 EUTMR) under Article 190(2) RPGC (§ 20). The head of claim concerning the costs incurred for the purposes of the proceedings before the CD is inadmissible, since Article 190(2) RPGC does not provide that these costs are recoverable (§ 21).

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(ii) INFRINGEMENT OF ARTICLE 95(1) EUTMR IN COMBINATION WITH ARTICLE 51(1)(a) CTMR AND ARTICLE 7(1)(b) CTMR

In order to determine the grounds on which an application for a declaration of invalidity is based, it is necessary to examine all of the application, especially in light of the detailed statement of reasons in support of it (18/03/2016, T 501/13, WINNETOU, EU:T:2016:166, § 26) (§ 27). In the present case, in the form introducing the application for a declaration of invalidity, the invalidity applicant defined the scope of that application as covering the goods of the contested mark in Classes 9 and 10. However, it follows from its conclusions made in the statement of grounds for the application for a declaration of invalidity that it requested that the contested mark also be declared invalid for the goods in Class 5, in respect of which the application was also upheld. In addition, it expressly formulated grounds for invalidity with respect to the goods falling within Class 5 in several points in that statement of grounds (§ 28). The BoA was right in finding that the CD had not ruled outside the scope of the application for a declaration of invalidity (§ 29).

The BoA based its conclusion on considerations relating to the meaning of the terms making up the contested mark, which are well-known elements. In that context, the applicant cannot validly call into question the legality of the contested decision by

criticising the BoA for having taken that meaning into account in order to justify its conclusion that the contested mark was not distinctive, despite the fact that the invalidity applicant had not expressly invoked the meaning (§ 32).

(iii) INFRINGEMENT OF ARTICLE 51(1)(a) CTMR AND ARTICLE 7(1)(b) CTMR

The word element 'pro' may be laudatory for the sake of advertising, the purpose of this being to highlight the positive qualities of the goods or services. It is perceived by the English-speaking public in the sense of 'professional' or 'favourable, positive or supportive' (16/05/2017, T 472/16, LegalPro, EU:T:2017:341, § 27 and the case-law cited), whether it is placed at the beginning or end of the mark. The BoA did not make an error of assessment in considering that the relevant public attributed to it the meaning denoting a product or service of excellent quality and reliability (§ 49), and set out the reasons demonstrating the promotional character of the term 'pro' (§ 50). The BoA also correctly found that the term 'med' is immediately perceived as designating goods of a medical nature and purpose (§ 51).

The combination of a term designating a characteristic of the goods, such as the term 'med', with one or more laudatory terms, such as the term 'pro', does not mean that the mark applied for, considered as a whole, is greater than the sum of its

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parts (§ 52) (see, to that effect, 20/11/2002, T 79/01 & T 86/01, Kit Pro / Kit Super Pro, EU:T:2002:279, § 29 and 30) (§ 52). Therefore, the BoA was right to find that the contested mark, viewed as a whole, had a purely promotional character (§ 53) and that is devoid of distinctive character (§ 58).

09/12/2020, T858/19, easycosmetic, EU:T:2020:598

RESULT: Action dismissed

KEYWORDS: Descriptive

NORMS: Article^o7(1)(b) CTMR [now Article^o7(1)(b) EUTMR], Article 52(1)(a) CTMR [now Article 59(1)(a) EUTMR]

KEY POINTS: None

FACTS: The EUTM proprietor registered the word mark easycosmetic for Cosmetics and perfumes in Class 3 and Market research in Class 35.

An application for declaration of invalidity pursuant to Article 52(1)(a) CTMR, based on Article 7(1)(b) and (c) CTMR, was filed. The Cancellation Division (CD) granted the application for a declaration of invalidity and declared the contested mark to be invalid.

The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. Referring to the CD's decision,

the BoA found that the trade 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) CTMR and (ii) infringement Article 7(1)(b) CTMR. The GC dismissed the action.

SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 7(1)(c) CTMR

The relevant public consists of the English-speaking general public and professionals in the EU (not disputed) (§ 27 28).

The word combination 'easycosmetic' is composed of two terms of basic vocabulary of English and is perceived by the relevant public as referring to 'simple cosmetic product'. The neologism is not unusual or fanciful in relation to the goods or services and is therefore not more than the sum of its parts (§ 29 33). The sign thus describes in at least one of its possible meanings the characteristics of the goods and services (§ 38).

(ii) INFRINGEMENT OF ARTICLE 7(1)(b) CTMR

Since one absolute ground for refusal is sufficient for a EUTM to be rejected, there is no need to examine Article 7(1)(b) CTMR.

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09/12/2020, T 190/20, ALMEA (fig.) / MEA, EU:T:2020:597

RESULT: Action dismissed

KEYWORDS: Ending of a mark, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

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

KEY POINTS: Although the first component of word marks may be more likely to catch the consumer's attention than the components which follow, that does not apply in all cases (23/10/2015, T 96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 35 and the case-law cited). The additional letters 'A' and 'L' in the first part of the sign applied for ('ALMEA') do not prevent consumers from perceiving the element 'MEA' contained in both the EUTM application and the earlier mark 'MEA' (§ 35).

There are many cases in which the similarity of the signs and the likelihood of confusion (LOC) have been confirmed, despite the identical part of the signs at issue lacking meaning and despite the fact that the beginnings of the signs were different (see, for example, 15/06/2011, T 229/10, Syteco, EU:T:2011:273, which compared the signs 'SYTECO' and 'TECO'; 22/05/2012, T 546/10, Milram, EU:T:2012:249, which compared the signs 'MILRAM'

and 'RAM'; or 23/10/2015, T 96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 68, which compared the signs 'VIMEO' and 'MEO') (§ 47).

FACTS: The applicant sought to register the figurative sign 'ALMEA' as an EUTM for, inter alia, goods in Classes 3 and 5.

An opposition based on the earlier German word mark MEA registered for, inter alia, goods in Classes 3 and 5, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) dismissed the opposition. It found that there was no LOC between the signs.

The opponent filed an appeal. The Board of Appeal (BoA) upheld the appeal. It found that in view of, inter alia, the identity or strong similarity of the goods at issue, the fact that the earlier sign was completely included in the EUTM application, and the at least low degree of visual and phonetic similarity between the signs, there was a LOC (even if the level of attention of the public was higher than average in relation to some of the goods at issue).

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

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EUTM application

Aimea

Earlier trade mark

MEA

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

The relevant public and comparison of the goods

The relevant public is made up essentially of the general public in Germany and, as regards certain goods in Class 5, also professional consumers with specific knowledge and expertise. The level of attention varies from average to high according to the goods concerned (not disputed) (§ 22).

The goods at issue in Classes 3 and 5 are all identical or very similar (not disputed) (§ 23).

The comparison of the signs

The signs have a low degree of visual and phonetic similarity on account of the common element, 'MEA' (§ 33 and 50).

Although the first component of word marks may be more likely to catch the consumer's attention than the components which follow, that does not apply in all cases (23/10/2015, T 96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 35 and the case-law cited). In the present case, the additional letters 'A' and 'L' in the first part of the EUTM application do not prevent consumers from perceiving the common element 'MEA' contained in both signs (§ 35).

Even though the signs at issue are short (and it is therefore easier for the consumers to perceive the differences between them), that element is not decisive: the earlier sign is completely included in the EUTM application, of which it represents the major part, namely three out of five letters, reproduced in the same order, or two consecutive syllables out of three (§ 40).

There are many cases in which the similarity of the signs and the LOC have been confirmed despite the identical part of the signs at issue lacking meaning and despite the fact that the beginnings of the signs were different (see, for example, 15/06/2011, T 229/10, Syteco, EU:T:2011:273, which compared the signs 'SYTECO' and 'TECO'; 22/05/2012, T 546/10, Milram, EU:T:2012:249 which compared the signs 'MILRAM' and 'RAM'; or 23/10/2015, T 96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 68, which compared the signs 'VIMEO' and 'MEO') (§ 47).

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No conceptual comparison of the signs is possible, since they have no meaning for the relevant German consumers (not disputed) (§ 51-52).

The likelihood of confusion

In view of the degree of similarity between the goods and signs, the level of inherent distinctiveness of the earlier mark, which can be defined as average (since the earlier mark has no meaning in relation to the goods at issue), and the principle of imperfect recollection, there is a LOC, even for the goods in respect of which consumers have a high level of attention (§ 54-55).

09/12/2020, T 722/18, BASIC (fig.) / BASIC et al., EU:T:2020:592

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Remittal from GC/ECJ

NORMS: Article 65(6) CTMR [now Article 72(6) EUTMR], Article 1(d) Regulation No 216/96.

KEY POINTS: The provision on the basis of which a case should have been reallocated to a Board of Appeal (BoA) following the GC annulment of the BoA decision, was Article 1(d) of Commission Regulation No 216/96 and not Article 35(4) of Delegated Regulation 2017/1430 (§ 30). The latter provision

does not apply to appeals filed before the BoA before 1 October 2017, which is the case here (§ 31). Accordingly, pursuant to Article 1(d)(1) of Regulation No 216/96, the decision to reallocate a case to a BoA following a judgment annulling a decision was a matter for the Presidium of the BoA and not for the President of the BoA (§ 34).

FACTS: The proprietor registered the figurative sign 'BASIC' as an EUTM for, inter alia, services in Classes 35 and 39.

Pursuant to Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR, an application for declaration of partial invalidity was filed against the EUTM on the basis of, inter alia, the earlier signs used in the course of trade 'basic' and 'basic AG'.

The Cancellation Division (CD) upheld the application for a declaration of invalidity and declared the partial invalidity of the EUTM to the extent that it was registered in respect of the services in Classes 35 and 39.

The First BoA dismissed the proprietor's appeal. It found, inter alia, that the evidence furnished by the applicant for invalidity established that the earlier signs had been used in the course of trade of more than mere local significance, within the meaning of Article 8(4) CTMR.

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The proprietor filed an action with the General Court (GC). By judgment 21/09/2017, T 609/15, BASIC (fig.), EU:T:2017:640, the GC annulled the decision of the First BoA on the grounds that the evidence used as the basis for the decision was not sufficient for the GC to conclude that the condition requiring use of the earlier signs in the course of trade was satisfied.

Following that judgment, the President of the BoA referred the case back to the Second BoA, which adopted a new decision partially annulling the CD's decision.

The proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 65(6) CTMR and ii) infringement of Article 8 (4) CTMR. The GC upheld the action.



SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 65(6) CTMR

The provision on the basis of which the case should have been reallocated to a BoA following the GC annulment of the First BoA decision, was Article 1(d) of Commission Regulation No 216/96 and not Article 35(4) of Delegated Regulation 2017/1430 (§ 30).

Article 35(4) of Delegated Regulation 2017/1430 does not apply to appeals filed before the BoA before 1 October 2017.

The GC judgment T 609/15, which annulled the entirety of the decision of the First BoA of 11 August 2015, had the effect of retroactively eliminating that decision from the legal order, thus making the appeal against the CD's decision of 2 December 2013, (i.e. before 1 October 2017), pending again (§ 31).

Accordingly, pursuant to Article 1(d)(1) of Regulation No 216/96, the decision to reallocate a case to a BoA following a judgment annulling a decision was a matter for the Presidium of the BoA (whereas, under Article 35(4) of Delegated Regulation 2017/1430, that decision was previously a matter for the President of the BoA).

Therefore, in the present case, the decision to reallocate the case to the Second BoA following the GC judgment T 609/15, was taken by an authority

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(the President of the BoA) which was not competent to do so (§ 34).

The fact that the Presidium was informed of that decision on reallocation and raised no objections to it does not mean that the Presidium must be regarded as having actually taken the decision; therefore, the illegality established cannot be deemed not to have occurred (§ 36).

16/12/2020, T 118/20, FORM EINER VERPACKUNGS-FORM (3D), EU:T:2020:604

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Non-distinctive, Shape mark, Three dimensional mark

NORMS: Article 7(1)(b) EUTMR

KEY POINTS: None

FACTS: The applicant sought to protect a three-dimensional mark consisting of the shape of packaging as an EUTM for dental preparations and articles in Class 5 and packaging materials; blister packs for packaging in Class 16. The examiner refused the mark pursuant to Article 7(1)(b) EUTMR.

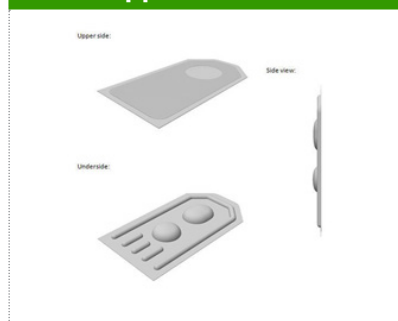
The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the sign



was devoid of any distinctive character as it does not significantly depart from the rectangular packages which are common on the dental market, as can be inferred from the examples mentioned by the examiner.

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

EUTM Application



SUBSTANCE: The relevant public for the majority of goods in Class 5 is the specialised public in the dental sector whose level of attention is high (§ 31). On the other hand, goods in Class 16 are addressed to the public at large, as well as to the specialised public (§ 31, 32-33). The fact that the BoA decision incorrectly referred to Class 10, instead of Class 16, is a mere clerical error that does not appear to have consequences on the BoA's reasoning (§ 32-33).

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Only a mark which departs significantly from the standard or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of distinctive character for the purposes of Article 7(1)(b) EUTMR (§ 41, 28-29).

The BoA has not established that the flat rectangular packaging applied for is common on the dental market (§ 42). This conclusion cannot be drawn from the examples mentioned by the examiner and reproduced by the contested decision. They are neither relevant nor sufficient to prove that the flat packaging is common on the dental market. They differ substantially from the EUTM application since, inter alia, the EUTM application presents a flat packaging while the examples provided have elevated edges (§ 43). Additionally, those examples do not show packaging for liquid preparations (§ 46).

Therefore, the BoA failed to establish that the form in question does not depart significantly from the packaging common on the dental market (§ 48).

16/12/2020, T 883/19, Helix elixir / Helixor et al., EU:T:2020:617

RESULT: Action dismissed

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

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

KEY POINTS: Health food supplements made principally of vitamins; nutritional supplements; food supplements; dietary supplements consisting of vitamins are similar to pharmaceutical preparations (§ 40-43).

FACTS: The applicant sought to register the word mark Helix elixir for goods in Class 5, namely Health food supplements made principally of vitamins; nutritional supplements; food supplements; dietary supplements consisting of vitamins.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on the earlier EU word mark Helixor registered for goods in Class 5, namely Pharmaceutical preparations and medicines, in particular for the treatment for leukaemia and cancer; veterinary preparations. The Opposition Division upheld the opposition.

The opponent filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that, given the degree of similarity between the signs and between the goods, the normal inherent distinctiveness of the earlier mark and the principle of imperfect recollection, there was a likelihood of confusion (LOC) on the part of the relevant public, even though that public's level of attention was deemed to be higher than average.

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

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

The relevant public consists of the Slovak-speaking public within the EU (§ 23). It is composed of medical professionals with a high level of attentiveness when prescribing medicines, and patients as end users who display a heightened level of attention as regards medicines, irrespective of whether they are issued on prescription (§ 28-29). Those considerations are also applicable where the goods are dietetic products in general and dietary supplements, which are not medicines, but nevertheless constitute goods in the field of health (§ 30). Therefore, the BoA was right to assess the LOC by focusing on the perspective of the average consumer, whose level of attention with respect to the various categories of goods was higher than average, but nevertheless could not be deemed to be as high as that of a medical professional (§ 33).

The goods under comparison, namely the various food, nutritional and dietary supplements covered by the mark applied for and the goods belonging to the general category 'pharmaceutical preparations' covered by the earlier mark, are similar (§ 40 43).

The signs are visually similar to an average degree since they coincide in the initial group of letters, 'helix', which, in addition, is the first of the two word elements of the sign applied for (§ 49-54).

The signs are phonetically similar to an average degree, despite the differences in the number of syllables and their order, since their first two syllables are pronounced in the same manner by the relevant Slovak public and the earlier sign is almost entirely incorporated in the sign applied for (§ 61-64).

As the Slovak-speaking public does not find any meaning in the word elements 'helix' and 'helixor' the signs are conceptually not comparable. The additional element 'elixir' of the sign applied for is not sufficient to introduce a clear conceptual difference between the signs (not disputed) (§ 65-66).

On the basis of an overall assessment taking into account a level of attention on the part of the relevant public that was at the very least high, there is a LOC between the signs that are visually and phonetically similar to an average degree for the similar goods (§ 71).

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18/12/2020, T 289/20, Facegym, EU:T:2020:646

RESULT: Action dismissed

KEYWORDS: Descriptive

NORMS: Article 7(1)(c) EUTMR

KEY POINTS: None

FACTS: The applicant sought to register the word mark Facegym for goods and services in Classes 5, 8, 9, 10, 41 and 42. The examiner partially rejected the application insofar as it covered the goods and services in Classes 8, 10 and 41, such as hand tools for use in beauty care, instruments for massage and training services in relation to face, body and skincare services pursuant to Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the sign was made up of the English words 'face' and 'gym'. The first word referred to the front of the head from the forehead to the chin. The second word referred to 'gymnastics', that is to say, exercises developing or displaying physical agility and coordination. It concluded that, when used together, these words referred to exercises for the face. As the words were juxtaposed in a grammatically correct way in the English language, the sign as a whole would provide information, in the mind of the relevant English-

speaking consumer, that the devices in Classes 8 and 10 would all be used for facial gymnastics and that the services in Class 41 would be intended for teaching and training these facial exercises or gymnastics, including through the organisation of workshops and seminars. The BoA therefore found that the mark described the intended purpose of all these goods and services in a straightforward manner, requiring no interpretative effort on the part of the relevant consumer. It added that there was nothing about the expression 'facegym' that suggested that it meant more than the sum of the two words, regardless of the level of attention displayed by the public. The BoA concluded that the sign had a clear descriptive meaning and thus was also devoid of any distinctive character.

The applicant filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action as manifestly lacking any foundation in law.

SUBSTANCE:

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

The relevant public consists of the English-speaking average consumer and professionals, whose level of attention varies from average to high (not disputed) (§ 21 22). The GC rejects the applicant's arguments challenging the BoA's finding that the contested

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sign is descriptive for the goods and services in its entirety (§ 24-53). The fact that the UK IPO had registered the mark in respect of the goods and services is not decisive since the EU trade mark regime is an autonomous legal system. The Office is not bound by a decision given in a Member State, or indeed in a third country (§ 52). The BoA was also fully entitled to find that the sign is devoid of any distinctive character (§ 54).

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Cases referred to the Grand Board

25/11/2020, [R 0964/2020-G](#), [Zoraya / Viña zoraya](#)

Outcome: No decision on opposition

Norms: Article 165(3) EUTMR, Article 37 EUTMDR

Keywords: Similarity of the goods and services

Summary:

On 25 November 2020, the Fourth Board of Appeal decided to refer case R 0964/2020-4, [Zoraya / Viña zoraya](#) to the Grand Board.

The case concerns the assessment of the similarity between ‘non-alcoholic beverages; flavoured carbonated drinks; waters; vitamin-enriched mineral waters [beverages]’ and ‘wines, spirits and liqueurs’ within the context of an opposition based on Article 8(1)(b) EUTMR. The Boards of Appeal have taken different approaches when making this assessment.

Their findings cannot all be reconciled with the decision of 21 January 2019 in Case R 1720/2017-G, [ICEBERG \(fig.\) / ICEBERG et al.](#) (relating to ‘vodka’ in Class 33). With a view to avoiding further divergent decisions, it was deemed necessary to refine the case-law on this point.

In the light of the importance of the legal issues concerned, the case was remitted to the Grand

Board which should take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the Fourth Board in the EUIPO OJ on 1 February 2021 (language of the proceedings: German).

New Decisions from the Boards of Appeal

04/12/2020, [R 2385/2019-2](#), [RS RockStar Hotels \(fig.\) / Rock Star Suite et al.](#)

Earlier trade mark
<h2>Rock Star Suite</h2>
Contested EUTM


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Invalidity – Article 60(1)(a) EUTMR – Article 8(1)(b) EUTMR – Dissimilarity of the goods and services – Cancellation partially rejected

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR in respect of all of the services covered by the registration, namely 'hotel management' in Class 35 and 'hotel reservations' in Class 43. The application for a declaration of invalidity was based on the earlier EUTM and Spanish trade mark 'ROCK STAR SUITE' registered in respect of 'hotel services' in Class 43. The Cancellation Division declared the contested EUTM registration partially invalid, i.e. for 'hotel reservations' in Class 43, but dismissed the application for a declaration of invalidity in respect of 'hotel management' in Class 35 finding these services dissimilar to 'hotel services' in Class 43 of the earlier marks.

The Board confirms the finding of the Cancellation Division as regards the lack of similarity between the services at stake. The Board indicates that 'hotel services' are primarily directed at members of the general public wishing to find temporary accommodation at a hotel, whereas 'hotel management services' are directed at hotel businesses for the purpose of supporting and

helping them to carry out or improve their hotel business and to acquire, develop and expand their market share. Consequently, 'hotel management services' are not aimed at the public at large, but rather exclusively at a specialised, professional public in the hotel sector. Therefore, as the relevant publics do not coincide, this is sufficient on its own to rule out the similarity between the services under comparison. The market sectors and the purpose of these services are distinct. There is no complementarity, because the services do not share the same relevant public, nor are the providers in competition with one another, given that 'hotel services' are generally rendered by a hotel, while 'hotel management services' are rendered on behalf of a hotel by a hotel management specialist.

Thus, since the services under appeal are dissimilar there can be no likelihood of confusion with respect to them, given that the similarity between the goods and services is a condition for a finding of a likelihood of confusion according to Article 8(1)(b) EUTMR.

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11/12/2020, R 305/2020-5, JC de Castelbajac (fig.) / CASTELBAJAC et al.

Earlier sign

CASTELBAJAC

Contested EUTM



Bad faith – Article 59(1)(b) EUTMR – Right to a name – Article 60(2)(a) EUTMR – Copyright – Article 60(2)(c) EUTMR – Cancellation rejected

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Articles 59(1)(b), 60(2)(a) and 60(2)(c) EUTMR in respect of all of the goods and services covered by the registration. Alongside the bad faith claim, the application for a declaration of invalidity was based on the right to the name 'CASTELBAJAC' and copyrights related to the following designs:



The Cancellation Division rejected the application for a declaration of invalidity in its entirety. It found that the merits of the case did not demonstrate that the EUTM proprietor acted in bad faith when filing the EUTM application. The Cancellation Division also found the application for a declaration of invalidity not well founded insofar as it was based on the right to a name and copyright under French law and inadmissible insofar as the right to a name and copyright in the United Kingdom, Belgium, Germany, Spain and Italy were invoked.

The Board concurs with the Cancellation Division that the contested EUTM should remain registered, since it was not applied for in bad faith, nor does

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it violate the right to a name or copyright under French law. As regards the alleged bad faith filing, the Board notes that the contractual relationship between the EUTM proprietor and the cancellation applicant demonstrates that the former had legitimate grounds to transform the trade mark portfolio and to seek protection for it. The filing of an EUTM for goods for which there is already a number of national and international trade marks does not constitute bad faith, but a legitimate act in view of the existing assignment deed. The Board notes that if the cancellation applicant had a problem with the interpretation or scope of the assignment act, he would have had to have acted before the respective national court. However, in any event, the cancellation applicant was fully aware of the terms of the assignment deed and its inevitable consequences, specifically the acquisition by the EUTM proprietor of a large number of trade marks reproducing the cancellation applicant's surname. As regards the figurative element of the contested EUTM depicting a man's head with a hand, a star and a heart, which has been designed by the cancellation applicant, the Board confirms that the use of this figurative element in the EUTM cannot constitute an indicator of bad faith, as the merits of the case show that the cancellation applicant expressly consented to the use of this design by the EUTM proprietor.

The Board also dismisses the cancellation applicant's claim based on the provisions of French law relating to the protection of a surname. It notes in this regard that the deed of assignment of the intangible assets of the company 'Jean-Charles DE CASTELBAJAC' to the EUTM proprietor expressly

included a clause providing for the assignment of the commercial designation composed entirely of the name of the cancellation applicant and numerous trade marks containing the surname 'CASTELBAJAC'. Therefore, in view of established French case-law, the cancellation applicant in fact 'detached' his name from himself as a person for use in commerce by a third party, his name thus becoming another industrial property right that can be an object of registrations and licences.

Finally, the Board also rejects the cancellation applicant's claim based on the copyright under French law. The Board indicates in this regard, first, that there is no evidence that the cancellation applicant is the author of the design included in the contested EUTM. Second, the allegation that the design element of the contested EUTM resembles the cancellation applicant's four artistic works is not well founded.

09/12/2020, R 2729/2019-1, Хозяин / Хозяюшка (fig.)

Earlier trade mark

ХОЗЯЮШКА

Contested EUTM

Хозяин

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Invalidity – Article 60(1)(a) EUTMR – Article 8(1)(b) EUTMR – Likelihood of confusion – Similarity of signs – EUTM partially cancelled

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR in respect of part of the goods covered by registration, namely those in Classes 29, 30 and 31. The application for a declaration of invalidity was based on the earlier German registration for the figurative mark, as depicted above, registered in respect of goods in Classes 29, 30 and 31. The Cancellation Division partially upheld the application for a declaration of invalidity declaring the EUTM invalid for part of the contested goods which were found identical or similar to the goods of the earlier mark. The EUTM proprietor appealed requesting that the decision of the first instance be annulled insofar as the EUTM was declared invalid.

The Board confirms that there is a likelihood of confusion between the conflicting marks. The Board defines the relevant public as composed of the Russian-speaking public in Germany. As regards the signs, the Board finds them visually and aurally similar to an average degree in view of the identical beginnings 'хозя'. As follows from settled case-law, the consumer usually attaches more importance to the beginning of words. The Board finds the signs also conceptually similar. The verbal element 'хозяюшка' of the earlier mark is a diminutive of

the Russian term 'хозяйка' that means 'lady of the house' (or 'hostess'). Such a diminutive form is customary in Russian-speaking cultural circles. The contested EUTM has the same concept, as the word 'хозяин' means, in Russian, 'man of the house' (or 'host'). The fact that this term in the earlier mark is in the feminine gender and in the diminutive form, whereas in the contested EUTM it is in the masculine gender, does not counteract the finding of a conceptual similarity.

Consequently, to the extent that the goods are identical or similar, there is a likelihood of confusion on the part of the relevant public in Germany.

16/11/2020, R 109/2020-1, Titanic

Proof of use – Revocation grounds – Article 58(1)(a) EUTMR – Extent of use – Use for the goods at issue – Application partially rejected

A request for a declaration of revocation of the EUTM registration was filed on the grounds of non-use pursuant to Article 58(1)(a) EUTMR in respect of all the goods covered by the registration, namely 'alcoholic beverages (except beers)' in Class 33. The Cancellation Division upheld the application for a declaration of revocation on the grounds that the EUTM proprietor did not prove genuine use of the contested EUTM for any of the goods for which it was registered. Specifically, it was found that the materials adduced were not convincing to

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demonstrate that the EUTM proprietor had seriously tried to maintain or create a commercial position on the relevant market. There was insufficient information concerning the commercial volume, duration and frequency of use of the contested EUTM.

The Board comes to a different conclusion finding that the materials adduced by the EUTM proprietor are sufficient to prove genuine use of the contested EUTM during the relevant five-year time period in respect of 'whiskey'. The Board considers that the material in the file, viewed in its totality, provides sufficient information regarding the time, place, extent and nature of use of the contested EUTM. Notably, as regards the extent of use, the Board indicates that the owner is not obliged to reveal the total volume of sales, its turnover figures or the individual prices actually billed to different clients. It is sufficient to submit evidence which proves that the minimum threshold for a finding of genuine use has been passed. In contrast to the contested decision, the Board finds that 18 invoices showing sales of 118 cases and 105 bottles of 'Titanic' Irish whiskey, respectively, which result in a total quantity of 1 521 bottles, over a period of three years and two months, represents use which cannot be construed ab initio as merely 'token'. It is noted in this regard that the characteristics of the market for Irish whiskey should be taken into account, specifically that Irish whiskey is rather a spirit having its own amateurs, is appreciated by connoisseurs

and its market is not comparable to that of, for example, Scotch whiskey. In addition, it should be borne in mind that whiskey is a spirit with a high alcoholic content which is consumed, rather, on special social occasions. It is clearly not a very cheap mass-consumption product, for everyday use, such as fruit juices, for example, which were at issue in the 'Vitafruit' judgment (08/07/2004, T-203/02, VITAFRUIT, EU:T:2004:225, § 48), where it was found that 293 cases of 12 fruit juices, for a total amount of EUR 4 800, sold to a single client, were sufficient to prove genuine use in the EU. As regards the nature of use, the Board finds that the evidence adduced by the EUTM proprietor shows use of the contested EUTM only in relation to 'whiskey' which, applying the criteria established in the 'Aladin' judgment (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45-46), constitutes a sufficiently distinct subcategory within the broad category of 'alcoholic beverages (except beers)' covered by the contested EUTM. Therefore, the Board concludes that the use shown by the EUTM proprietor in relation to 'whiskey' is sufficient to maintain or create a market share on the specific market.

Consequently, the Board partially annuls the decision of the Cancellation Division and declares that the contested EUTM should remain registered for 'whiskey' in Class 33.

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16/12/2020, R 687/2020-2, netgenomics (fig.) / igenomix (fig.)

Earlier trade mark

Contested sign

Likelihood of Confusion – Article 8(1)(b) EUTMR – Similarity of the signs – Non distinctive elements – Decision confirmed

The applicant sought to register the figurative mark above for services in Class 44, namely ‘medical and health services relating to DNA, genetics and genetic testing; genetic counseling’. An opposition was filed on the grounds of Article 8(1)(b) EUTMR based on an earlier EUTM registration for the figurative mark above in respect of goods and services in Classes 5, 42 and 44. The Opposition Division rejected the opposition on the grounds that, although the services in Class 44 were identical, the similarities

between the signs that lay in the non-distinctive or weak concept of ‘genomics’ did not give a sufficient basis to conclude that there was a likelihood of confusion on a part of the relevant public.

The Board endorses the outcome of the contested decision and dismisses the appeal. The Board finds that the identical services in Class 44, that in various ways relate to DNA, are highly specialised services to which a high degree of attention will be displayed by the relevant public comprising both average consumers and professionals. Both signs will be perceived as referring to ‘genomics’, i.e. a study of the structure, function and inheritance of the genome (entire set of genetic material) of an organism. Having regard to the context of the DNA-related services in question, the overwhelming majority of the EU targeted public will perceive the word element ‘genomics’ in the contested sign as a purely descriptive or weak distinctive concept. The same applies to the word element ‘genomix’ in the earlier mark, as it would merely be seen as a misspelling of the descriptive term ‘genomics’. Thus, the similarities between the signs at issue are confined solely to their references to non-distinctive or weak concepts of genomics and in much more vague similarities in the utilisation of the somewhat ‘x’ shaped figurative elements. The differences between the marks are significant, in particular visually. The highly attentive public targeted will generally encounter and inspect the marks visually. Therefore, the visual aspect plays a greater role in

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the global assessment of the likelihood of confusion. The differences between the marks are sufficient to offset the similarities lying in non-distinctive or weak elements, despite the identity between the services covered by the conflicting marks. Consequently, there is no likelihood of confusion.

11/01/2021, R 204/2020-4, MAX (fig.) / MAX et al.

Earlier trade marks

MAX
WALKERS MAX

Contested sign



Article 8(2)(a)(ii) EUTMR – Likelihood of Confusion – Article 8(1)(b) EUTMR – Weak element – Opposition rejected

The applicant sought to register the figurative mark above for a range of goods in Classes 29, 30 and 31. An opposition was filed on the grounds of Article 8(1)(b) and Article 8(5) EUTMR based on an earlier UK trade mark registration for the word mark 'MAX'

and an earlier EUTM registration for the word mark 'WALKERS MAX'. The Opposition Division upheld the opposition and rejected the contested EUTM on the grounds of a likelihood of confusion with the earlier UK trade mark.

The Board annuls the contested decision and allows the EUTM application to proceed to registration. As regards the earlier UK trade mark on which the contested decision was based, the Board finds that this trade mark no longer constitutes an earlier right within the meaning of Article 8(2)(a)(ii) EUTMR on the basis of which the Board can carry out a full new examination, in terms of both law and fact. The outcome of the appeal depends on whether or not a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling. The Board notes in this regard that at the filing date of the opposition, as well as at the date when the contested decision was rendered, the United Kingdom was a member of the European Union. However, as of 1 January 2021 the United Kingdom left the European Union and European Union law is no longer applicable in the United Kingdom. Consequently, with effect from 1 January 2021, UK trade marks no longer constitute earlier rights within the meaning of Article 8(2)(a)(ii) EUTMR. Since an earlier right must enjoy protection within the EU on the day the decision is rendered, which in the present proceedings is no longer the case with respect to the UK trade mark, the Board rejects the opposition to that extent as unfounded.

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As regards the other earlier right invoked, i.e. EUTM 'WALKERS MAX', the Board finds that there is no likelihood of confusion between the marks at hand, as the only common element is the term 'max' which is a highly allusive element, moreover being in the secondary position in the earlier mark it is likely to be perceived by the relevant public as an element purely indicating quality.

09/12/2020, R 487/2020-1, SKYLLA (fig.)

EUTM application



Public policy or accepted principles of morality – Article 7(1)(f) EUTMR – Decision annulled – Application allowed

The applicant sought to register the figurative mark above for goods in Classes 12 and 28. The examiner refused the EUTM application pursuant to Article 7(1)(f) EUTMR for all the goods applied for on the basis that the indication 'SKYLLA' was a transliteration of the Greek word σκύλα meaning 'bitch' and therefore the sign applied for would be

perceived by an average Greek-speaking consumer as offensive.

The Board confirms that the word 'SKYLLA' in the sign applied for can be read, by Greek-speaking consumers, as a transliteration of a vulgar term meaning 'bitch'. However, the Board observes that this Greek term also has other, neutral, meanings. Having regard to various possible meanings that can be attributed to this term, it is unlikely that in the context of the goods at issue (boats, boat equipment, fishing equipment) it will be associated with a vulgar meaning. Furthermore, even if an association with its vulgar meaning were to be made, the term could be considered inappropriate but not contrary to accepted principles of morality. There is an increasing use of such words in public. Consequently, the contested decision is annulled and the EUTM applied for is allowed to proceed to registration.

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