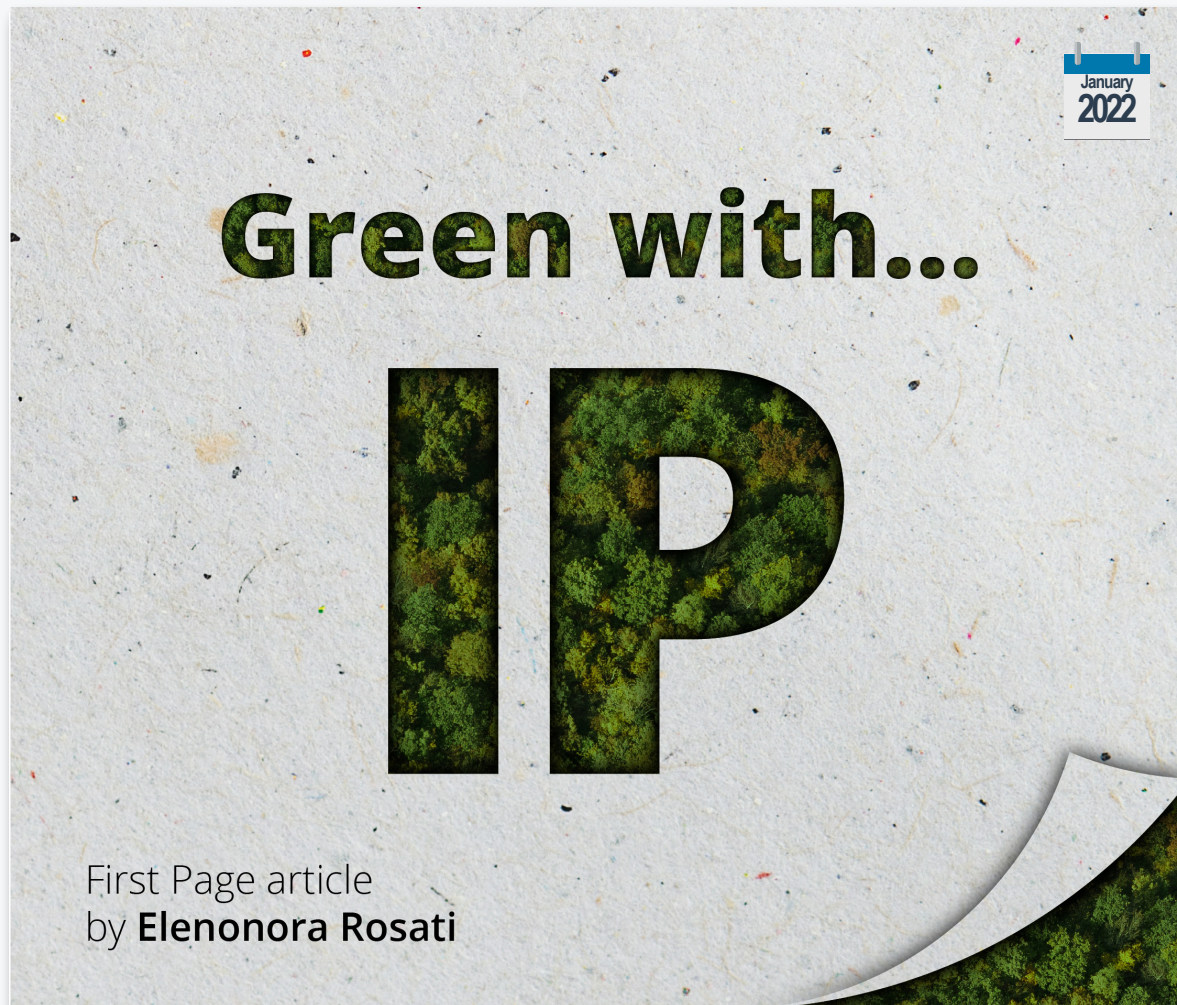


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Green with...

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By *Eleonora Rosati*

Over the past several years, attention towards and concerns relating to the respect and protection of the environment and the sustainability of production and consumption processes have increased. Related policy initiatives to safeguard the environment and tackle climate change have also intensified globally. Among other things, in 2019, the European Commission established action on climate change as a priority, committing to deliver a [European Green Deal](#) with the aim to make Europe the first climate-neutral continent by 2050.

Consumers and brands

Consumer surveys also confirm the above. For example, insofar as fashion is concerned, the [vast majority of consumers believes](#) that limiting impacts on climate change has become even more important today, and so has reducing pollution. A [survey](#) conducted by the European Commission confirmed that, in 2020, EU-based consumers made 'greener' choices as they were willing to pay more for a product that is more durable.

In turn, companies and brand owners have strengthened their efforts to ensure that their products are sustainable and respectful of the environment, and are perceived as such.

The European Union Intellectual Property Office (EUIPO) recently released its [Green EU Trade Marks Report](#). Prepared by the European Observatory on Infringements of Intellectual Property rights, the report examines the frequency with which goods and services ('G&S') specifications of EU trade marks ('EUTMs') reflect issues related to environmental protection and sustainability.

The G&S were analysed for the presence of terms (in the end there were approximately 900 of them) that can be said to be related to the protection of the environment and sustainability, such as 'photovoltaic', 'solar heating', 'wind energy', 'recycling'.

The main finding of the study is that growing interest in sustainability is indeed reflected in the EUTMs filed at the EUIPO since the Office began operations in 1996, both in absolute figures and as a proportion of all EUTM filings. Of the approximately 46,700 EUTM applications received by EUIPO in 1996, 1,588 were green trade marks. Since then, the increase in green trade marks has been continuous, except for 2001 and between 2011 and 2014. In

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2020, the number of green EUTMs filed approached 16,000. Overall, the top green EUTM filing countries in the EU are Germany, Spain, France, Italy, and the Netherlands.

Tackling 'greenwashing'

Of course, 'green' and 'sustainable' claims are not always truthful. Attempts to make consumers believe that an undertaking is doing more to protect the environment than it really is are called 'greenwashing'. Some national authorities have provided guidance to help businesses understand and comply with their existing obligations under consumer protection law when making environmental claims, while others [have been fining](#) companies over inappropriate 'green' claims.

Recently, the European Commission [revealed](#) that half of green claims lack evidence. In over 40% of such instances, it is believed that the claims made may be regarded as false or deceptive and may therefore be a potential case of unfair commercial practice [under EU law](#).

Insofar as greenwashing and trade mark protection are concerned, the [EU trade mark legislation](#) prohibits the registration of signs which are of such a nature as to deceive the public; for instance, as to the nature and quality of the G&S. Closely connected to this, it is also important to recall that

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the misleading use of a trade mark can result in the [revocation](#) of a trade mark registration. Academic research is also contributing to shedding light on the use of trade marks to convey information related to alleged environmentally and socially sound business behaviours.

In parallel to all this, existing legislative instruments and related guidance can also help brand owners communicate their commercial messages correctly and thus avoid the risk of greenwashing. Trade marks are important assets in this sense: several brand owners have been using them to communicate 'green' messages relating to their G&S. Among other things, it has become recently possible to obtain [EU certification marks](#). Because these marks relate to the guarantee of specific characteristics of certain goods and services, they serve to indicate that the goods and services covered by such marks comply with given standards.

All this, of course, must take place in accordance with the limitations inherent to the EU trade mark system, including those relating to deceptive and misleading signs. This said, green trade marks and green IP in general – as expressions of innovative solutions that are better than past ones at protecting the environment – can also stimulate investments in this sense and, in doing so, be an ally in the fight against pollution, climate change and damage to the Earth's diverse ecosystems.

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Towards a greener future

The respect of the environment and the growing sensitivity towards sustainability have accelerated, also as a result of the COVID-19 pandemic and related response measures. In this sense, the [OECD](#) estimates a projected long-term – potentially permanent – downward impact on the levels of environmental pressures like energy-related emissions.

Going forward, it is expected that further policy and legislative initiatives will be undertaken, including in the intellectual property field. An important example is the possibility to protect as [geographical indications](#) ('GIs') at the EU level, not just agricultural products – such as Prosciutto di Parma and Bordeaux – but also non-agricultural ones, such as Vetro di Murano and Emaux de Limoges. GIs are signs used to indicate that a product has a specific geographical origin and possesses a certain reputation or qualities due to that place of origin. It is believed that GIs contribute to the social and environmental sustainability of the economy and serve to support tourism and knowledge of the rich and diverse heritage of countries and regions.

Green with...

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

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IP in the 19th century



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

Following a first article on IP from the Ancient to the Modern Age, we continue to delve into the history of IP. This series of articles, each focused on a specific period of time, will take a close look at the lengths taken to protect what we now call, Intellectual Property (IP).

During the 18th century, ideas around IP started to change. Our understanding today of IP 'rights' rather than 'privileges' granted by a monarch or ruler, emerged, notably through legislation like the 1624 Statute of Monopolies and 1710 Statute of Anne in England, and the 1787 Constitution of the United States of America. Throughout the 19th century this process of evolution continued and what we call intellectual property today continued to be shaped and developed.

Throughout the 1800s, several countries around the world issued their own IP statutes, which

clearly understood IP as legal rights granted by law. What's more, the legislation and case law of the time introduced innovations that are still part of the IP system today. To take just one example, did you know that it was not always a given that photographs could be protected by copyright?

It was also during this period another important idea emerged to do with how IP is functional to building relationships between countries and cultures? Indeed, during the 1800s, the first international IP instruments were adopted, some upon decisive input from the celebrities of that time.

Let's find out what happened and who made all this possible!

IP developments of the 19th century and their legacy today

The IP statutes and case law issued during the 1800s introduced notions and requirements under IP law, which are still valid – in their core essence – still today.

For example, the **1842 Copyright Act** adopted in the United Kingdom considered copyright as personal property and stated that the duration of protection would cover the life of the author of a work plus a few years after their death. Today, in the European Union, copyright is protected as a **fundamental right within the right to property** and its duration covers the **life of the author of a work and 70 years after their death**.

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In 1875, the United Kingdom also introduced its **first ever trade mark statute** (the Trade Mark Registration Act) and, from the following year, it became compulsory to submit a representation of the logo that one sought to register as a trade mark to the Patent Office. Still today, registration of a trade mark requires an application that contains a representation – [in any appropriate form](#) – of the trade mark applied for.

In 1884, the US Supreme Court had to decide whether an iconic photograph of Oscar Wilde could enjoy copyright protection, the main issue being whether the 'objects' created through the then novel medium of photography would be deserving of the same protection as, for example, paintings. The court eventually [answered 'yes'](#), and as they say, the rest is now history. Today, there is no question that photographs, including [portrait photographs](#), may be protected under copyright law.

IP protection goes international

During the 1800s, the first international IP instruments were also adopted. In 1883, it was the turn of the [Paris Convention](#), which applies to industrial property (including patents, trade marks, and designs). For the first time, this convention introduced the principle that it would from then on be the obligation of any participating country to protect the rights of non-nationals in the same way as the rights of its own nationals.

The same principle of national treatment also

found its way into the [Berne Convention](#), the first international copyright instrument. At that time, celebrity authors like Victor Hugo were the victims of massive 'piracy' of their books in certain countries, which did not protect works by non-nationals. Hugo had a decisive role in the adoption of the Berne Convention in 1886. Similarly, Charles Dickens' US tour saw him effectively lobbying the US Congress to change the country's copyright law and protect foreign authors.

A few years later, the precursor of today's World Intellectual Property Organization, the **United International Bureaux for the Protection of Intellectual Property (BIRPI)**, was established to administer both these conventions.

Towards the close of the century, in 1891, the first international trade mark instrument was also adopted: the [Madrid Agreement](#) established a system whereby with one single application you could seek to register your trade mark in multiple territories around the world.

Modernisation and internationalisation as the cornerstones of IP in the 19th century

During the 1800s, IP was characterised by two key features: modernisation and internationalisation.

Through the former, the understanding of IP as conferring 'rights' gained further consolidation. In addition, several key features of today's IP rights, which became common practice, such as how a photograph is protectable by copyright or how a

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trade mark registration requires representation of the sign applied for. Through internationalisation, the various legal systems became increasingly homogeneous, therefore creating a more level playing field for the protection and exercise of the rights granted under IP law.

As we will see, both these features developed further during the 20th century... Stay tuned!

100 million trade marks in TMview



TMview, the world's largest free trade mark database, has recently reached 100 million trade marks. This number represents the commitment of **72 IP offices from all over the world** sharing their trade mark data and underlines their work towards a common goal: the improvement of trade mark information and its dissemination tools.

With so many IP offices on board and the information publicly available within tool, TMview has great value to users worldwide. It allows them to protect their IP rights not only in their home country, but also when they expand their activity beyond their borders.

Since the launch of TMview in 2010, the EUIPO has worked to improve the functionality of the tool, its usability and reliability. TMview contributes to **increase IP transparency**, which in turn encourages users to protect their goods and services through the use of trade marks. This growth in confidence leads to an increase in trade mark applications across the world, as well as TMview participating offices.

TMview is a free online tool, which is updated daily and receives more than 1.2 million searches per month. It contains the trade mark applications and registered marks from all IP offices of the EU, the EUIPO and a number of international partner offices outside the EU. In TMview, businesses and practitioners can consult details of a trade mark, such as the country, goods and/or services, type and registration date.

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Online piracy slows down, new report finds

Online copyright infringement is a serious problem for rights owners and for society as a whole. It deprives artists and creators of compensation for their work, and in the long run it may reduce the range of choices available to consumers.

The new EUIPO report 'Online Copyright Infringement in the European Union, 2017-2020' revealed that digital piracy, as measured by the average number of monthly accesses per internet user to infringing websites, **declined by 34% in 2020** compared to the previous year.

The report examines the consumption of copyright-infringing content in the EU Member States and the UK for TV programmes, music, and films, using a variety of desktop and mobile access methods, including streaming, downloading, torrents and ripping software. Digital piracy is declining for all three types of content, with **television** as the most frequently pirated type of content and **streaming** as the most used access method. According to the report, access to legal offers and knowledge of such offers tend to decrease piracy.

The interesting relationship between an EU Trade Mark and a .eu domain name

The EUIPO and EURid, the .eu domain registry, have been investigating the relationship between European Union Trade Mark (EUTM) and .eu domain name registrations. A sample of 5 000 EUTMs were checked against .eu domain name registrations, in particular to see which were registered first and if the owners could be matched.

From the sample of EUTMs, 56% has a corresponding .eu domain name registered. Notably, in 77% of cases the .eu domain name was registered before the EUTM. 23% of cases saw the EUTM registered ahead of the .eu domain name.

When it comes to comparing ownership, asserting correlations can be a difficult task as the information does not always match exactly. This does not necessarily mean that the EUTM and .eu do not belong to the same entity, rather that they may have used different contact information during the application process. In the analysis carried out, the data of the EUTM owner fully matched the data .eu domain name holder in 28% of cases.

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Latest cooperation updates

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

- Finland completed the [digitisation of its trade mark and design files](#), and was first to implement the 'Robotic Process Automation' tool, aimed to replace repetitive tasks.
- Estonia was also the first to complete the [process mining project](#), with the aim of improving efficiency of trade mark and design examination.
- The EUIPO supported the creation of a new [IP regional framework of CEFTA territories](#).
- Bosnia and Herzegovina [aligned its practice](#) with the Common Practice on Distinctiveness – Figurative Marks containing descriptive/non-distinctive words (CP3).
- [Egypt joined TMview](#) and [Monaco joined DESIGNview](#).
- [Thailand joined TMclass](#), and [Trinidad and Tobago now use the harmonised database](#) of goods and services in TMclass.
- The 'Authenticities' of Sofia, [Plovdiv and Thessaloniki held a series of awareness-raising activities](#) on the importance of IP and the damage of counterfeiting.
- [European Commission's public consultation](#) on the Counterfeit and Piracy Watch List. Deadline: 14/02/2022.

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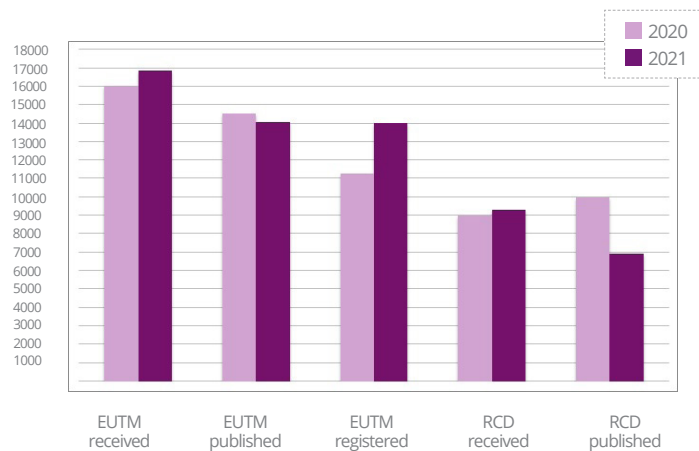
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Statistical Highlights

Monthly statistical highlights November*	2020	2021
European Union Trade Mark applications received	15 997	16 832
European Union Trade Mark applications published	14 523	14 060
European Union Trade Marks registered (certificates issued)	11 245	14 004
Registered Community Designs received	8 987	9 279
Registered Community Designs published	9 965	6 919



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SME Fund 2022

Small and medium-sized enterprises (SMEs) represent 99% of all businesses in the EU, create prosperity and opportunities within local communities and are a source of innovation and creativity. The EUIPO and the European Commission have launched the [Ideas Powered for business SME Fund](#), a grant scheme of up to EUR 47 million over a 3-year period (2022, 2023 and 2024) to help EU-based SMEs to access and benefit from their intellectual property rights.







Under the new scheme, each SME can save up to **EUR 2 250** in trade mark, design and patent application fees. **Professional IP representatives** can also apply for the SME Fund on behalf of their clients. The 2022 application period is now open **and will run until 16 December**.

In particular, the SME Fund offers:

- Up to **EUR 1 500 on trade mark and design application fees** at national, regional or EU level (75% reimbursement) as well as outside the EU (50% reimbursement).
- Up to **EUR 750 on patent fees at national level** (50% reimbursement). Patent fees are included in the SME Fund for the first time this year.

The new scheme is run through the [Ideas Powered for business initiative](#), which is part of the EUIPO's activities to support small and medium-sized businesses. It is carried out in close cooperation with the national and regional IP offices of the EU. The SME Fund was first launched in 2021 as a rapid response mechanism to help SMEs recover from the impact of the COVID-19 pandemic, and almost **13 000 European SMEs** have benefitted from it.

Find out [more on the SME Fund](#) and follow Ideas Powered for Business on [Twitter](#) and [LinkedIn](#) to receive the latest news.

 <p>Up to €2,250 in financial support to manage and protect your company's IP</p>	 <p>Quick and easy application process</p>	 <p>Wide range of activities/services covered (trade marks, designs, and patents)</p>
 <p>Extensive variety of fees eligible for reimbursement</p>	 <p>High reimbursement rates (from 50% to 90% depending on the IP activity)</p>	 <p>You can apply anytime between 10/01/2022 and 16/12/2022</p>

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EUIPO examiners: How can we help you?

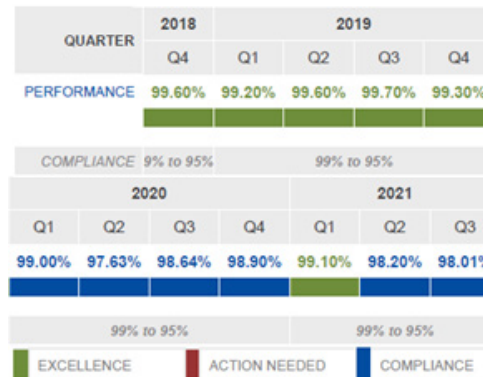
On average, the EUIPO deals with more than 121 000 telephone calls per year.

For specific issues, our [examiners are also available to respond to your queries](#). They respond to an average of 50 calls a day, both direct calls and call-backs. If absent, or in a meeting, an examiner will call you back as soon as possible. Our aim is to return the call in less than 5 business hours. However, although we strive to provide a response within this timeframe, it can exceptionally take up to 15 business hours to respond, which is still within our compliance levels.

You can reach the [EUIPO Information Centre](#) by dialling **+34 965139100** during our business hours (8.30 to 18.30).

For more information on our commitment levels for direct and call-back accessibility, you may check our [Service Charter](#).

DIRECT AND CALL BACK ACCESSIBILITY DIRECT AND CALL BACK ACCESSIBILITY - (%)



2022 version of the Nice Classification

The 2022 version of the 11th edition of the Nice Classification came into force on 1 January 2022, as provided for in [Communication No 4/2021 of the Executive Director of the Office](#).

Please note that although a new edition of the Nice Classification normally comes out every five years, the 12th edition has been delayed by a year due to present circumstances, and will be available in 2023.



Practice tip: Images speak louder than words

In **design applications**, visuals are more effective than the written word.

When it comes to disclaimers, use of a description cannot serve to define the scope of protection of your design. Disclaimers must be apparent from the representation of the design itself.

Visual disclaimers can be achieved either by:

- excluding the features of the design for which **protection is not sought** with broken lines, blurring or colour shading;
- including the features of the design for which **protection is sought** within a boundary.

Remember: to avoid deficiencies that may affect your filing date include images that clearly indicate the features for which protection is sought.

For more information, see the guidelines [5.4 Use of visual disclaimers to exclude features from protection](#).

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IP Enforcement Portal: new eAFA release

The [IP Enforcement Portal](#) has become the single e-filing and management point for customs applications for action (AFA) for 24 Member States, with an alternative system for the other three countries (Germany, Spain and Italy).

If you want customs to be active on your behalf at the EU border, detaining goods suspected of infringing intellectual property rights, you must first file a customs [application for action \(AFA\)](#).

With the latest release in the IP Enforcement Portal, all AFAs can be filed and managed electronically.

How can rights holders access the IP Enforcement Portal?

To file and manage AFAs in the IP Enforcement Portal, rights holders or their legal representatives can access the tool by using either their credentials or their [EU Customs Trader Portal \(UUM/DS\)](#) credentials.

To request an account in the IP Enforcement Portal, rights holders [need to indicate](#) a valid EU trade mark or design on the basis of which the account is requested.

What about legal representatives?

Legal representatives can also request an account on behalf of their rights holder. They can access the tool through a 'legal representative' account in the IP Enforcement Portal created through a client's (rights holder's) account. A legal representative can manage multiple rights holder accounts, depending on how many rights holders they have with accounts in the Portal ([detailed instructions for legal representatives](#)).

Overall AFA management through the IP Enforcement Portal

Thanks to the 'eAFA' release, rights holders can now manage all their AFAs through the IP Enforcement Portal. The tool is fully integrated with the customs database COPIS, which contains all the AFA information.

Once they have logged into their IP Enforcement Portal account, through the EORI numbers entered, users will be able to see all of their AFAs, which will be retrieved from COPIS.

Over the past years, the IP Enforcement Portal has been continuously improved and is growing its community of rights holders and enforcement authorities. This new development is the first step towards a paperless AFA, which will soon be followed by the introduction of the digital signature.



To help the smooth transition of eAFA, the home page of the [IP Enforcement Portal](#) has been updated to include an eAFA toolkit with accompanying training material. For any enquiries, please contact us at ipenforcementportal@euipo.europa.eu

New AI solution for image search

Conducting image searches for trade marks and designs has always been a challenge. The EUIPO has, for the first time, released its first in-house **image search tool** which was plugged into [eSearch plus](#) on 29 November 2021, replacing the previous solution.

The new tool puts the Office in a strategic position in the field of IP search capabilities. Searching for figurative marks is one of the biggest challenges in the IP world. Having an image search tool can contribute to improving our ability to harness the EUIPO's in-house IP expertise.

Background

During the first Strategic Plan of the EUIPO, efforts were made to create an image search tool. Since then, the only solution, for a time, was 'TrademarkVision', a third-party tool, which was implemented by eSearch plus in 2017, followed by [TMview](#).

Before putting the new tool into production, a comparative performance analysis was carried out. In the analysis, the experts listed which trade marks they would expect for given images. The EUIPO image search tool scored 48.6% against TrademarkVision's score of 48.16%.

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An obstacle to enforcement? Data protection meets IPR enforcement

This webinar looks into what intellectual property rights' holders can expect when it comes to requests for personal information for intellectual property rights (IPR) enforcement, with a focus on the role of online intermediaries.

The session covers the current legal framework and recent decisions from the Court of Justice of the European Union (CJEU) as well as practices that have emerged to facilitate disclosure and ensure that both IPRs and personal data are equally protected. From a forward-looking perspective, it briefly comments on relevant EU legislative proposals (e.g. the ePrivacy Regulation, the Digital Services Act, the European Data Strategy).

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Track on case-law: Decisions of the trimester of the EUIPO Boards of Appeal – Decisions of the trimester of the GC and CJEU (Q4)

This webinar provides an overview of the most relevant Judgments of the General Court and the Court of Justice of the European Union (GC/CJEU) as well as decisions of the EUIPO Boards of Appeal during the fourth quarter of 2021.

[Watch the webinar](#)

Upcoming webinars

Webinar: Business-smart IP investment in Africa, [Tuesday 11 January](#), 10.00–11.00 (CET)

Webinar: Assessment of purely figurative marks, [Tuesday 18 January](#), 10.00–11.00 (CET)

Webinar: Dynamic blocking injunctions with CEIPI, [Tuesday 25 January](#), 10.00–11.00 (CET)

On recent case-law

In the recent [T 298/19](#), the Court ruled that decisions of the Office are to be based only on reasons on which the parties have had an opportunity to present their views. However, the Court highlighted that this right does not mean that the Office informs the parties of what evidence they must submit in order to substantiate their arguments.

This [webinar](#) on The right to be heard aims to provide an overview of the EUIPO's practice, and case-law of the General Court and the Court of Justice on the obligation to state reasons and the right to be heard (Articles 94 and 95 EUTMR).

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Luxembourg trade mark and design news

10/11/2021, T-353/20, ACM 1899 AC MILAN (fig.) / Milan et al., EU:T:2021:773

EUTM Application



AC MILAN

Earlier trade mark

Milan

Proof of use — Likelihood of confusion — Reputation — Article 135(2) RPGC — Equity and unreasonable or vexatious costs — Action dismissed

The applicant, Associazione Calcio Milan S.p.A. (AC Milan), sought to register the figurative sign as an international registration designating the European Union for goods in Class 16, such as 'paper; cardboard; book covers' claiming the colours red, black and white. An opposition based on, inter alia, the earlier German word mark 'Milan' designating amongst others goods in Class 16, such as 'paper, paperboards, cardboard', was filed pursuant to



Article 8(1)(b) CTMR [now EUTMR]. The Opposition Division ('OD') upheld the opposition. The Board of Appeal ('BoA') dismissed the applicant's appeal. The BoA held that there was a likelihood of confusion ('LOC') between the signs. The applicant filed an action before the General Court ('GC'), relying on two pleas in law: (i) infringement of Article 10(3) EUTMDR and Article 18(1)(a) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR.

The GC dismisses the action. In its judgment the GC states in particular that only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account to assess whether the similarity of the goods covered by the two marks is sufficient to give rise to a LOC. Moreover the GC applies the provision of Article 135(2) RPGC on equity and unreasonable or vexatious costs occurred in the proceedings before the GC.

As regards the application *ratione temporis* of substantive rules, the filing date of the application is relevant (08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305, § 12; 18/06/2020, C 702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 2). The priority date is the date of filing, according to Article 29(1) and Article 31 CTMR [now Article 34(1) and Article 36 EUTMR], which means that Article 42 CTMR applies (§ 17, 28). However, Article 10 EUTMDR applies, according to Article 82(2)(d) EUTMDR, since the request for proof of use of the earlier mark was filed after 1 October 2017 (§ 17).

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Genuine use of the trade mark presupposes that it is used publicly and externally, and not only within the undertaking concerned. However, external use of a trade mark is not necessarily equivalent to use that is directed towards final consumers. Actual use of the mark relates to the market in which the proprietor of the mark carries on business and in which they hope to exploit their mark. To consider that external use of a trade mark, within the meaning of the case-law, necessarily consists of use that is directed towards final consumers would effectively exclude trade marks used solely in business-to-business relationships from protection. The relevant public to whom trade marks are intended to be directed not only includes final consumers but also specialists, industrial customers and other professional users (07/07/2016, T 431/15, FRUIT, EU:T:2016:395, § 49 and case-law cited) (§ 26, 32, 36).

The commercial life of a product generally extends over a period of time, and continuity of use is one of the indications to be taken into account to establish that the use was objectively intended to create or maintain a market share. Therefore, documents from outside the relevant period must be taken into account and assessed together with the other evidence, as they may provide evidence of real and genuine commercial exploitation of the mark (16/06/2015, T 660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 54 and the case-law cited) (§ 36).

The BoA did not err in considering, in its overall assessment of the evidence adduced by the other party to the proceedings before it, that proof of genuine use of the earlier mark had been adduced in the present case (§ 43).

Only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account to assess whether the similarity of the goods covered by the two marks is sufficient to give rise to a LOC (03/09/2009, C 498/07 P, La Española, EU:C:2009:503, § 84 and the case-law cited). That case-law is in line with the objective of Article 8(1)(b) CTMR (now EUTMR), which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for identical or similar European Union trade marks (29/01/2019, T 336/17, YATEKOMO / YA TE COMERE EL VACIO QUE TE LLENA (fig.), EU:T:2019:36, § 49) (§ 113).

There is an average degree of visual similarity between the signs due to the presence of the common word element 'milan' and a high degree of phonetic similarity. Conceptually, the signs are moderately similar for the part of the relevant general public in Germany that would attribute a meaning to the common word 'milan'. The conceptual comparison is irrelevant for the part of the relevant public for whom the term 'milan' is devoid of meaning. Considering the normal inherent distinctiveness of the earlier mark, there is a LOC between the signs for the goods that are partly identical or partly similar to a high degree (§ 94, 100, 106, 114 115).

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As regards the repartition of costs of the proceedings before the GC, by its conduct, the Office caused the applicant to incur travel expenses that could have been avoided. Therefore, even though the applicant was unsuccessful, as per Article 135(2) of the RPGC, the Office is ordered to pay the travel costs of the applicant's lawyers to the oral hearing that was initially requested by the Office, scheduled and then cancelled following the withdrawal of the Office's request for the oral hearing (§ 117-119).

10/11/2021, [T 755/20](#), **Vdl e-power / e-POWER (fig.) et al.**, EU:T:2021:769

10/11/2021, [T 756/20](#), **Vdl e-powered / e-POWER (fig.) et al.**, EU:T:2021:770

Contested mark

VDL E-POWER
(T-755/20)

VDL E-POWERED
(T-755/20)

Earlier rights

e-POWER



No likelihood of confusion — Impact of weak distinctive character of the earlier mark - Impact of common weak elements — No independent distinctive role — Action dismissed

The applicant sought to register the words signs 'VDL E-POWER' (T-755/20) and 'VDL E POWERED' (T 756/20) as EUTMs for goods in Classes 7, 9, and 12, such as Power installations, machine tools, motors and vehicles. An opposition, based on earlier UK and French figurative marks registered for goods in Classes 9 and 12, was filed pursuant to Article 8(1) (b) EUTMR. The OD upheld the opposition based on the earlier UK figurative mark and refused registration of the marks applied for. The BoA upheld the applicant's appeal and annulled the OD's decision. The BoA found that the conflicting signs were visually and conceptually similar and had an average degree of phonetic similarity. The BoA inferred that, insofar as the element 'vdl' of the mark applied for differentiated the conflicting signs and had to be regarded as distinctive, and given the high level of attention of the relevant public composed of professionals with expertise in the automobile industry and of the English-speaking and French-speaking general public, whose level of attention was likely to be higher than average, there was no LOC on the part of that public. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of the obligation to state reasons.

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The GC dismisses the action. In its judgments the GC considers in particular the impact of the weak distinctive character of the earlier mark and of the common weak elements.

The element 'e-power' refers to electric vehicles, electric motors and systems enabling vehicles or their components to run on electricity, which the parties do not dispute. Therefore, due to its connection to the goods in question, inter alia, vehicles, accessories or parts making up those vehicles, it has, at most, a low degree of distinctiveness (§ 44).

It is apparent from the 'Medium' judgment (06/10/2005, C120/04, Thomson Life, EU:C:2005:594), that 'where the goods or services are identical there may be a LOC on the part of the public where the contested sign is composed by juxtaposing the company name of another and a registered mark which has a normal degree of distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign in question, retains an independent distinctive role therein. However, in the present case, the distinctive character of the element 'e-power' cannot be regarded as normal but is, at most, low, insofar as it is clear that that term alludes to the type of energy ensuring the functioning of the goods in question or related to those goods (§ 53). Accordingly, the applicant's argument based on the 'Medion' judgment must be rejected.

It follows that the visual and phonetic similarity between the conflicting signs and their low degree of conceptual similarity, on account of an element whose distinctiveness is merely low, are likely to be offset by the visual, phonetic and conceptual difference. That difference therefore carries more weight in the global assessment of the LOC, all the more so given that the relevant public will have a higher than average level of attention. The BoA correctly took into consideration the low degree of distinctiveness of that element, the differences between the conflicting signs, the identity or degree of similarity between the goods in question and the level of attention of the relevant public in order to find that there was no LOC on the part of that public (§ 79-80).

01/12/2021, T-700/20, Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE (fig.), EU:T:2021:851

Trade mark including badges, emblems or escutcheons — Protected geographical indications — Article 7(1)(i) CTMR [now EUTMR] — Action upheld (BoA decision annulled)

Ms Schmid is the proprietor of an EU trade mark, registered in respect of the product 'Pumpkin seed oil, corresponding to the protected geographical indication Styrian pumpkin seed oil'. That figurative mark includes the EU symbol for 'protected

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geographical indications' (the PGI symbol). For that reason, an application for a declaration of invalidity was filed by the Landeskammer für Land- und Forstwirtschaft in Steiermark (Regional Chamber of Agriculture and Forestry of Styria, Austria). The Cancellation Division declared the contested mark invalid. The BoA confirmed that mark's invalidity on the ground that the contested mark included the PGI symbol in its entirety and that neither the right nor the obligation to use that symbol covered the right to have it protected as an element of a trade mark.

EUTM application



Earlier trade marks



The GC annuls the decision of the BoA. It considers that the BoA should have examined whether, taken as a whole, the trade mark including an emblem

protected by Article 7(1)(i) CTMR [now EUTMR] was likely to mislead the public as to the connection between, on the one hand, its proprietor or user and, on the other, the authority to which the emblem in question relates. It states that the various elements of which such a trade mark consists must be taken into account in that assessment.

The prohibition laid down in Article 7(1)(i) CTMR [now EUTMR] applies when three cumulative conditions are fulfilled: (i) the badge, emblem or escutcheon in question is of particular public interest, the existence of a connection with one of the activities of the European Union being sufficient to show that a public interest attaches to its protection; (ii) the competent authority has not consented to the registration; (iii) the trade mark including the badge, emblem or escutcheon in question is likely to mislead the public as to the connection between, on the one hand, its proprietor or user and, on the other, the authority to which the element in question relates (§ 20-22).

As regards that third condition, it stems from the fact that the extent of the protection conferred by Article 7(1)(i) CTMR [now EUTMR] cannot be greater than that of the protection conferred upon the emblems of international intergovernmental organisations that have been duly communicated to the States which are parties to the Paris Convention (pursuant

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to Article 7(1)(h) CTMR [now EUTMR]). Such emblems are protected only when, taken as a whole, the trade mark which includes such an emblem suggests, in the public mind, a connection between, on the one hand, its proprietor or user and, on the other, the international intergovernmental organisation in question (Article 6ter(1)(c) of the Paris Convention (§ 23).

Thus, Article 7(1)(i) CTMR [now EUTMR] is applicable where the public may believe that the goods or services designated originate from the authority to which the emblem reproduced in the trade mark refers, or that they have the approval or warranty of that authority, or that they are connected in some other way with that authority (§ 24-28).

The BoA failed to examine the third condition and thus erred in law. It did not assess the way in which the public would perceive the PGI symbol as a component of the contested mark, taken as a whole, or whether that perception might lead the public to believe that the goods covered by such a mark had the warranty of the European Union (§ 34-35).

Lastly, the GC clarifies that the Office must not only examine whether the emblem concerned is reproduced in whole or in part in the trade mark into which it is incorporated. The various elements of

which such a trade mark consists must also be taken into account in that assessment. That obligation to carry out a specific overall examination is not called into question by the fact that the grant of protection under trade mark law to the PGI symbol is, as a general rule, such as to affect adversely the system of protected geographical indications established by the European Union (§ 41-42).

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New decisions from the Boards of Appeal

08/10/2021, R 2034/2018-1, Saaremaa

Invalidity – Article 59(1)(a) EUTMR – Descriptive – Article 7(1)(c) EUTMR – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed – EUTM cancelled

The EUTM for the term ‘Saaremaa’ was applied for on 13 March 2012 and registered on 10 August 2012 in respect of ‘vodkas and vodka-based alcoholic beverages’ in Class 33. A request for a declaration of invalidity of the EUTM was filed for all the goods on the grounds of Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) (lack of distinctive character), Article 7(1)(c) EUTMR (descriptiveness) and Article 7(1)(g) (misleading character). The Cancellation Division declared the invalidity of the contested EUTM on the grounds of Article 7(1)(c) EUTMR. It found that the Estonian public would associate the term ‘Saaremaa’ with the largest Estonian island and, in view of the island Saaremaa being known for its water production and having a history for home-made beer, they would consider the alcoholic beverages bearing the sign ‘Saaremaa’ as originating from the Saaremaa island or having some characteristics or ingredients linked to this geographical region.

The Board confirms the contested decision. It notes, first, that from the arguments and documents submitted by the parties, it appears that it is undisputed that Estonian consumers will recognise the word ‘Saaremaa’ as the name of an island in Estonia. On the other hand, from the evidence provided, it cannot be safely concluded that the term ‘Saaremaa’ will be perceived as the name of an Estonian island by non-Estonian-speaking consumers. In any case, pursuant to Article 7(2) EUTMR a trade mark shall not be registered (or shall be declared invalid, respectively) even if the grounds of non-registrability are met only in part of the European Union. In order to assess the descriptiveness of the sign ‘Saaremaa’ it must be considered whether the relevant public, when seeing that sign, will perceive the geographical name as an indication of the origin of the goods covered by the mark applied for, namely ‘vodkas and vodka-based alcoholic beverages’ in Class 33. The first step in assessing a geographical term is to determine whether it is understood as such by the relevant public. In the present case, it is undisputed that Saaremaa, being the largest island of Estonia, is known to relevant consumers. The second step in the assessment refers to whether it is reasonable to assume a link between the term ‘Saaremaa’ and the goods ‘vodkas and vodka-based alcoholic beverages’. The Board finds that it can be reasonably assumed that at the time of filing the contested EUTM the relevant public might have also been expected to associate the island of Saaremaa

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with 'vodkas and vodka-based alcoholic beverages'. With reference to the findings that Estonia has a long tradition in the production of vodka, the Board notes that the denomination 'Estonian vodka' is protected as a PGI (since 2017) specifically for vodka under Regulation No 110/2008, as amended by Regulation No 2016/1067. This clearly suggests that when the contested EUTM was filed, potentially all the territory of Estonia was already associated with vodka production, thus with the relevant goods. It follows that it can be reasonably assumed that the relevant Estonian public, at the relevant point in time, could have expected that the name of the largest Estonian island could indicate the place of origin of the contested 'vodkas and vodka-based alcoholic beverages'. The Board also notes that the evidence on file also proves that the island of Saaremaa has a history of home-brewed beer. On the basis of evidence adduced by the cancellation applicant it can be reasonably assumed that from the view of the relevant consumer, at the relevant point in time, the Estonian island, Saaremaa, could have been perceived as the name of a place traditionally known as the geographical origin of alcoholic beverages. Finally, the Board considers that the above findings are supported by the practice of the Estonian Patent Office to request a disclaimer in trade marks including the term 'Saaremaa'. This approach of the Estonian Patent Office has been constant within the whole food and beverage sector over the years. This is a clear indication of the fact that at the time of filing the EUTM, the denomination 'SAAREMAA'

was liable to be used by other traders in the 'vodka and vodka-based alcoholic beverages' industry who wanted to indicate that their goods come from the island of Saaremaa. Therefore, the Board concludes that there is sufficient evidence on file to find that, at the relevant point in time, the relevant public might be expected to establish a direct and specific link between the island of Saaremaa and the production of 'vodkas and vodka-based alcoholic beverages'. Consequently, the contested decision correctly upheld the invalidity action under Article 7(1)(c) EUTMR. As regards the claim of acquired distinctiveness pursuant to Article 7(3) EUTMR, the Board holds that the EUTM proprietor failed to demonstrate that a substantial, or even a significant proportion of the Estonian public over the age of 18 within the EU in Estonia, where the mark was inherently devoid of any such character, perceives a connection between the goods offered for sale under the word sign 'Saaremaa' in question and a particular undertaking.

25/10/2021, R 391/2021-2, HU

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

An application for an EUTM for the word sign 'HU' was filed in respect of nut-based products in Class 29 and restaurant, bar and café services in Class

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43. The examiner refused the application on the grounds of Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR for all the goods in Class 29. It was considered that relevant consumers would easily perceive the meaning of the letters 'HU' as the two-letter international code for Hungary and would understand it as a reference to the geographical origin of these goods from Hungary.

The Board confirms the contested decision. The trade mark 'HU' would be understood by the English-speaking public in the EU as the international country code for Hungary. It is therefore irrelevant that Hungary may as well be referred to by other abbreviations. The Board notes that within the EU, Hungary is known for its agricultural products, including sunflower seeds, nuts, and similar products. The EU-wide registered Protected Geographical Indication (PGI) 'Őrségi tökmagolaj', oil pressed from pumpkin seed, is such a product worth mentioning. Hungary is one of the Member States of the EU. Therefore, it is a geographical location known throughout the EU. In addition, the relevant public throughout the EU is used to the fact that country codes are generally used on consumer goods, food products, electronics, clothing etc. They refer to the country of origin in case of export and import. Therefore, it is very likely that the relevant public will immediately perceive the sign as indicating that the goods in dispute originate (are grown, produced or imported) from Hungary. The majority of the public in Hungary will perceive the sign 'HU' as indicating

the geographical origin of the contested goods. Taking into account the size of Hungary and its large population, it constitutes a substantial part of the EU. Therefore, even if only the majority of the Hungarian public were to be taken into account, it alone would correspond to a significant part of the EU public. The Board concludes that the term 'HU' will be perceived by a significant part the relevant public in the EU as an indication of the goods' geographical origin and therefore the sign applied for falls under the prohibition laid down under Article 7(1) (c) EUTMR. The sign is caught also by the absolute ground for refusal under Article 7(1)(b) EUTMR. It is merely informative and hence devoid of distinctive character, because it conveys the message that the goods offered under the contested trade mark differ from the other competing ones because they originate from Hungary.

15/11/2021, R 2911/2019-5, INTEL INSIDE (fig.)



Invalidity – Article 59(1)(b) EUTMR – Bad faith – Decision confirmed – Invalidity rejected

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The EUTM was filed on 2 October 2014 and registered on 6 April 2015 in respect of a wide range of goods and services in Classes 9, 10, 14 and 25, including wearable computing devices in Class 9. A request for a declaration of invalidity of the EUTM was filed on 1 May 2018, on the grounds of bad faith. The cancellation applicant indicated that it is accepted that when the contested EUTM was filed, the EUTM proprietor intended to use the EUTM in relation to the goods that directly relate to its core business, i.e. microprocessors; semiconductors; integrated circuits; computer motherboards; graphic chips, boards and cards. However, there was no evidence that the EUTM proprietor had used, or would use, the contested EUTM with regard other goods that do not form part of its core business. Therefore, the EUTM proprietor acted in bad faith when filing the EUTM in relation to the other goods and the whole registration should be declared invalid. The EUTM proprietor argued that the application for the contested EUTM was intended primarily to cover new uses of the 'INTEL INSIDE' mark in relation to wearable electronic products, as well as other kinds of sensor products and related data-processing and computer equipment and software. It stated that the present case was a classic example of a new area – wearables – involving different sectors of industry: fashion and technology. The Cancellation Division rejected the request for a declaration of invalidity in its entirety finding that bad faith on the part of the EUTM proprietor had not been demonstrated. The Board examines the two limbs of the bad faith

claim: (1) the EUTM proprietor had no intention to use the mark; (2) it made repeat filings of 'INTEL INSIDE' logos in order to avoid having to prove genuine use of the mark. It is for the cancellation applicant, who intends to rely on that ground, to establish the circumstances which make it possible to conclude that the proprietor of an EUTM was acting in bad faith when it filed the application of that mark. There is a presumption of good faith until proof to the contrary is adduced (08/03/2017, T 23/16, Formata, EU:T:2017:149, § 45). As regards the claim of re-filing to circumvent the proof of use, the Board emphasises that there is no provision in the legislation relating to EU trade marks which prohibits the re-filing of an application for registration of a trade mark and that, consequently, such a filing cannot, in itself, establish that there was bad faith on the part of the trade mark applicant, unless it is coupled with other relevant evidence which is put forward by the applicant for a declaration of invalidity or the EUIPO (21/04/2021, T-663/19, MONOPOLY, § 70). The Board notes, firstly, that the cancellation applicant does not allege that the contested EUTM is a repeated filing for any of the goods in Classes 10, 14, and 25. Secondly, even as concerns the goods in Class 9 generally, it is difficult to accept that the EUTM proprietor would wish to circumvent the proof of use requirements inasmuch as the Boards and national courts have constantly

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affirmed the substantial reputation and fame of 'INTEL' and 'INTEL INSIDE' for a range of computer hardware and software products and not only microprocessors. Thirdly, the contested EUTM is not identical in a strict sense to the five earlier EUTMs for the 'INTEL INSIDE' logo (unlike in the 'Monopoly' case, 21/04/2021, T-663/19, MONOPOLY, which concerned repeat registrations of the identical word mark). Furthermore, it is relevant that the contested EUTM, unlike the prior EUTMs, targets principally specific goods for gathering biometric, physiological, fitness and activity data in Classes 10 and 14 and for the major part in Class 9, and not a broad specification of goods. The Board notes that the evolution, over time, of a logo intended as the graphic representation of a mark constitutes normal business practice (13/12/2012, T-136/11, Pelikan, EU:T:2012:689, § 36) and is a factor which cannot be disregarded particularly where a figurative mark is at issue as here. The Board accepts as very plausible the EUTM proprietor's explanation that the contested EUTM reflects the involvement in branding, and that two earlier 'INTEL INSIDE' marks were not renewed because they were no longer used. The fact that the structure consisting of a swirl and the words 'INTEL INSIDE' have remained identical, can, in all reasonableness, indicate that the EUTM proprietor wanted to make sure that consumers would make a link between

the earlier EUTMs and that newest mark. This is a further indication that the contested EUTM was not filed with the intent of circumventing the genuine use requirement, but as explained below in defence of the strategy of the diversification of technological expertise to the specific field of smart connected wearables. The Board also considers that there are no objective, relevant and consistent indicia tending to show that the contested EUTM was filed with the intention of obtaining an exclusive right with no intention to use the contested EUTM for the goods registered. It is important to note in this case that the EUTM proprietor has adduced evidence that at the filing date of the contested EUTM, it had already taken steps to position itself in the field of wearable technology, namely, electronics that can be worn on the body as an accessory or within materials used to make the products. The Board concludes that the EUTM proprietor has provided very plausible explanations concerning the extension of its commercial activities to the goods of the contested EUTM at its filing date, and to the commercial logic underlying the application for registration of the contested EUTM. The information that has been provided by the EUTM proprietor shows that, at the date of filing, it intended to make use of the contested EUTM wholly for purposes falling within the functions of a trade mark.

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04/11/2021, R 1590/2020-5, Modex / Modex (fig.) et al.

Earlier mark

Contested EUTM

MODEX

Bad faith – Article 59(1)(b) EUTMR – Company name – Non-registered trade mark – Article 60(1)(c) EUTMR – Well known trade mark – Article 8(2)(c) EUTMR – Decision confirmed – Cancellation rejected

The EUTM for the word mark 'MODEX' was filed on 21 September 2017 and registered in 2018 for a wide range of goods and services in Classes 9 (computer software), 35 (business management and consultancy services), 36 (services relating to finances, stocks and brokerage), 37 (services relating to computer hardware), 38 (services relating to communication), 42 (computer programming and rental of software) and 45 (legal services and consultancy relating to financial services and stock exchange). An application for a declaration of invalidity of the EUTM was filed based on the following three grounds:

i. Article 60(1)(c) EUTMR in conjunction with Article 8(4) EUTMR with regards to the following earlier rights: (1) Non-registered trade mark, as depicted above, and (2) company name 'MODEX (GIBALTAR) LIMITED', both used in the course of trade in the UK for a wide range of goods and services;

ii. Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) and 8(2)(c) EUTMR for the following earlier rights: word mark 'MODEX' and (4) figurative mark, as depicted above, both well known in the UK pursuant to Article 6bis of the Paris Convention for goods and services in Classes 9, 35, 36, 38, 41 and 42;

iii. Article 59(1)(b) EUTMR (bad faith).

The Cancellation Division rejected the application for a declaration of invalidity in its entirety.

The Board of Appeal confirms the contested decision. First, it is held that earlier rights 1 and 2, both used in the course of trade in the UK, protected under the law of 'passing off' and claimed to be well known in the UK, can no longer constitute a legal basis for the invalidity proceedings. This is based on the fact that the Brexit transition period has ended and earlier rights in the UK can no longer be considered as a legal basis and can therefore no longer be successfully invoked. Since the relevant point in time is considered to be the present decision,

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the application for a declaration of invalidity based on the earlier rights in the UK is rejected. However, with regard to the invalidity request based on the well-known character of earlier rights not in the UK but in the EU countries and based on bad faith, for which the use of a mark also exclusively outside the area of the EU is relevant, the application for a declaration of invalidity cannot be rejected based on this argument. With regard to Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) and 8(2) (c) EUTMR, whilst taking into account the factors to determine the well-known character of an earlier mark, it is held that there is insufficient evidence to clearly, convincingly and effectively show that the earlier marks were well known in any part of the EU at the relevant dates, namely the filing date of the contested EUTM and the date of the application for a declaration of invalidity (4 November 2019) for goods and services in Classes 9, 35, 36, 38, 41 and 42. The Board finds that the cancellation applicant has not provided any evidence for the well-known character in any specific Member State and has not even identified such a specific Member State. The evidence submitted is furthermore insufficient because, despite taking steps to promote the 'MODEX' mark before the filing date of the contested EUTM, it has not been demonstrated that this resulted in the well-known character of the earlier mark, or that the advertising on social media reached the relevant public in the EU at the filing date. Consequently, the claim based on Article 60(1)(a) in conjunction with Article 8(1)(b) and 8(2)

(c) EUTMR is rejected. As regards the claim of bad faith pursuant to Article 59(1)(b) EUTMR, the Board confirms that there are insufficient indicia of bad faith on the part of the EUTM proprietor when filing the mark. There is no prior contractual relationship between the parties. Furthermore, the evidence does not show that the EUTM proprietor must have known of the use of the earlier sign from the promotion taking place before the filing date. The earlier sign is not well known (as established), the parties were not direct competitors at the time of the filing date and the significant promotional effort claimed by the cancellation applicant occurred mostly after the filing date. Despite the evidence that 'MODEX' technology was launched in Switzerland and the Ukraine before the filing date, there is no evidence that these events were attended by the EUTM proprietor or that the mainstream financial press covered the new technology at these events. Moreover, the nine days between the initiation of the advertising campaign and the filing date of the EUTM and the six-week period between the first public use of 'MODEX' by the cancellation applicant and the filing date were not enough for 'MODEX' blockchain technology to come to the attention of the EUTM proprietor. Furthermore, the cancellation applicant's product addressed only a small category of consumers when founded. The Board concludes that the objective circumstances of the case do not point to the EUTM proprietor having been aware of the cancellation applicant's (intention to) use an identical or similar sign for identical or similar

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goods or services at the time of filing the contested EUTM, and to the contested EUTM having been filed with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin.

See also 20/10/2021, R 1591/2020-5, ModEx BY SIMPLITIUM (fig.) / Modex (fig.) et al.

12/11/2021, R 558/2019-2, Global Banking Soluciones Financieras (fig.) / Cirrus (fig.) et al.

Earlier trade marks

1)



2)



Contested sign



Dissimilarity of signs – Likelihood of confusion – Article 8(1)(b) EUTMR – Non-registered trade mark – Article 8(4) EUTMR – Reputation – Article 8(5) EUTMR – Decision confirmed – Opposition rejected

The applicant sought to register the figurative mark, as depicted above, in respect of goods and services in Class 9 (computer software products), Class 35 (advertising, marketing and business management-related services), Class 36 (financial and insurance services), Class 42 (IT technology-related services) and in Class 45 (licensing of computer software [legal services]). An opposition was filed on the grounds of Article 8(1)(b), Article 8(4) and 8(5) EUTMR, invoking several earlier rights, including those depicted above, registered as EUTMs and as national marks in the UK, and as non-registered marks enjoying protection in many EU Member States. The Opposition Division rejected the opposition in its entirety.

The Board, first, deals with, inter alia, the earlier UK rights invoked by the opponent. As from 1 January 2021, in view of the withdrawal of the UK from the EU and the European Atomic Energy Community, UK rights cease as a matter of law to be 'earlier rights' for the purposes of inter partes proceedings. As the UK is no longer part of the EU and its territory is outside the EU, national UK trade marks, both registered and unregistered, no longer enjoy protection in the EU and are on the same footing as registered

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or unregistered trade marks in any other non-EU country. Consequently, the opponent can no longer rely on the earlier registered and non-registered UK rights. The Board recalls that the relevant point in time is the date of the Board of Appeal's decision. An earlier right must not only be valid and in force on the date on which the opposition is filed, but it must still be valid and in force on the date on which the decision is taken, including by the Boards of Appeal, given that the appeal has suspensive effect, Article 66(1), 3rd sentence, EUTMR. At the date of this decision, the earlier UK trade marks invoked by the opponent are no longer valid and enforceable in the EU. As regards the grounds under Article 8(1)(b) EUTMR, the Board finds that both earlier marks are visually, aurally and conceptually dissimilar to the contested mark. A mere coincidence in a part (two out of three circles) of a figurative element which in addition constitutes basic geometric shapes cannot suffice to establish a relevant similarity. Therefore, since one of the necessary conditions of Article 8(1)(b) EUTMR to apply is not met, there can be no likelihood of confusion irrespective of the enhanced distinctiveness of the earlier mark or the identity between the goods and services. Further, with regard to the grounds under Article 8(5) EUTMR, the Board finds that the claimed reputation of the earlier marks has not been proven. Consequently, the opposition based on Article 8(5) EUTMR not only fails on account of the dissimilarity between the signs but also because the reputation of the earlier mark has not been proven. In particular,

the evidence does not provide any basis for the conclusion that the two interlocking blue circles are known and have acquired market recognition among the relevant public on a stand-alone basis, i.e. without the word 'Cirrus'. Insofar as the earlier 'Cirrus' mark is concerned, it is even further away from the contested sign than the earlier purely figurative mark. Due to the dissimilarity between the signs, the opposition based on this mark must be rejected because one of the necessary conditions of Article 8(5) EUTMR is not met. Finally, as regards the opposition based on Article 8(4) EUTMR, the Board notes that the Opposition Division rejected the opposition as based on the earlier non-registered rights because the opponent did not submit any information on the possible content of the relevant national laws in relation to any of the earlier rights invoked or the conditions to be fulfilled for the opponent to be able to prohibit the use of the contested trade mark under the laws in each of the respective Member States. The Board notes that this assessment of the Opposition Division has not been contested by the opponent. Also, no further evidence or information has been submitted in the appeal proceedings. Therefore, the opposition is also rejected in relation to these earlier rights.

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16/11/2021, R 1604/2020-1, OUTLET DEL MOTERO (fig.) / OUTLET MOTO (fig.)

Earlier trade marks



Contested sign



Weak element – Likelihood of confusion – Article 8(1)(b) EUTMR – Agent – Article 8(3) EUTMR – Decision confirmed – Opposition rejected

The applicant sought to register the figurative mark, depicted above, for goods in Classes 12 (vehicles) and 25 (clothing, footwear, headgear, specifically relating to the automotive sector). An opposition was filed on the grounds of Article 8(1)(b) EUTMR (a likelihood of confusion) and Article 8(3) EUTMR (unauthorised filing by an agent) and based on an EUTM and a Spanish trade mark, as reproduced above, registered for goods and services in Classes

25, 35, 39, inter alia, relating to clothing, footwear and headgear for wholesaling and retailing of motorcycles and accessories for motorcycles and distribution and storage of motorcycles and goods and accessories for motorcycles. The Opposition Division rejected the opposition on the grounds that the signs were composed of elements that were principally non-distinctive or weak, and therefore the differences between them, principally in an overall comparison, differentiate them sufficiently so as to exclude safely a likelihood of confusion.

The Board confirms the contested decision. The Board finds that the figurative elements of the trade marks at issue, despite their respective high level of stylisation, are weak in relation to the goods and services at issue, since they are or may be related to motorcycles and motorcycling. Overall, it seems unlikely that the average consumer would link the trade marks at issue because they are represented and stylised in a totally different way in each case. Therefore, it cannot be concluded that the terms 'MOTO' or 'OUTLET' play an independent, autonomous distinctive role in the signs at issue, or that the trade mark applied for will be perceived as a derivation of the earlier trade marks to which only other terms or elements have been added. Consequently, the Board concludes that the relevant consumer, who is deemed to be reasonably well-informed and reasonably observant and circumspect and who has an average level of attention, will not be led to believe that the goods, although

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identical, originate from the same undertaking or from economically linked undertakings. There is therefore no likelihood of confusion between the signs. As regards the opponent's claim under Article 8(3) EUTMR, the Board indicates that it does not follow either from the wording of Article 8(3) EUTMR or from the case-law, which interprets that provision, that the objective of the legislator to adopt that provision was to allow the proprietor of an EU trade mark to oppose the registration of any trade mark, even a dissimilar mark, filed by its agent or former agent for goods and services in the same commercial sector. It should be noted, first, that the registration by a (former) agent of a trade mark that is not sufficiently similar to be associated with the mark of its principal (ex) trade mark in the same commercial sector does not in itself constitute an act of unfair competition. Therefore, the cumulative conditions for the application of Article 8(3) EUTMR have not been met.

18/11/2021, R289/2021-5, The Bakers OIKOFENEIA ΚΩΤΣΗ (fig.) / THE BAKERS (fig.) et al.

Invalidity - Article 60(1)(c) EUTMR - Non-registered trade mark - Article 8(4) EUTMR - Dominant element - Belated evidence - Article 95(2) EUTMR - Decision annulled - EUTM cancelled



Earlier mark



Contested EUTM



The EUTM, as reproduced above, was filed on 18 September 2015 and registered on 20 June 2016 in respect of baked goods and other food products in Class 30 and the 'provision of food and drink' in Class 43. A request for a declaration of invalidity of the EUTM was filed for all the goods and services on the grounds of Article 60(1)(c) EUTMR in conjunction with Article 8(4) EUTMR and Article 60(2)(a) EUTMR, invoking an earlier non-registered Bulgarian figurative trade mark, as depicted above, used in commerce in respect of foodstuffs in Classes 29 and 30, as well as on the basis of the company name

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The Bakers' used in the course of trade in Bulgaria, and the right to the name 'The Bakers' in Bulgaria. The Cancellation Division rejected the application for a declaration of invalidity of the contested EUTM finding that the evidence submitted by the cancellation applicant was insufficient to prove that the earlier sign was used in the course of trade of more than local significance in Bulgaria up to the filing date of the invalidity application. It was also held that the cancellation applicant failed to demonstrate that use of the contested EUTM could be prevented based on the invoked right to a name. The Board annuls the contested decision and rejects the contested EUTM application in its entirety. First, the Board, exercising its discretionary power granted pursuant to Article 95(2) EUTMR, accepts the belated evidence of use of the earlier rights as supplementary and being relevant for the outcome of the case. As regards the cumulative conditions for Article 8(4) EUTMR to apply, the Board finds that both earlier signs, non-registered trade mark and the company name 'The Bakers' were used in Bulgaria in the course of trade of more than just local significance before the filing date of the contested EUTM and before the filing date of the application for a declaration of invalidity. The conditions required by Bulgarian law to prohibit the use of the contested mark are fulfilled. The Bulgarian Law on Marks and Geographical Indications recognises trade mark rights acquired by use and allows to invoke an earlier non-registered mark or company name in opposition and invalidity proceedings against a

posterior trade mark under the conditions of the identity or similarity between the signs and the goods and services (a likelihood of confusion). The Board finds that the goods concerned in Class 30 are partly identical or partly similar to various degrees, whereas the 'services for providing food and drink' in Class 43 have a certain degree of similarity with the earlier goods in Classes 29 and 30 in view of their complementarity. The signs are visually similar to a high degree and aurally identical, since the secondary Greek wording 'ΟΙΚΟΓΕΝΕΙΑ ΚΩΤΣΗ' will not be pronounced by the relevant Bulgarian public, a conceptual comparison is not possible due to the lack of meaning of the common word combination as a whole of both signs for non-English speakers of the relevant public. The earlier mark enjoys a normal degree of inherent distinctiveness. Therefore, the Board concludes that taking into account the principle of imperfect recollection of the signs and the interdependence of the various factors, there exists a likelihood of confusion within the meaning of Article 60(1)(c) EUTMR in conjunction with Article 8(4) EUTMR and in conjunction with Article 38b(1) and Article 12 of the Bulgarian Law on Marks and Geographical Indications. As the application for a declaration of invalidity of the contested mark under Article 8(4) EUTMR is well founded, there is no need to examine the same ground of invalidity for the earlier company name 'The Bakers', or with respect to the right to a name.

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25/11/2021, R 578/2021-5, TO BE (fig.)

Contested EUTM



Revocation grounds – Article 58(1)(a) EUTMR – Evidence of use – Time of use – Use as registered – Decision confirmed – EUTM cancelled

The EUTM, as shown above, was registered, for goods and services in Classes 18, 25 (clothing, footwear, headgear) and 39. An application for a declaration of revocation of the EUTM was filed for all the goods and services on the grounds of Article 58(1)(a) EUTMR, claiming that the EUTM had not been put to genuine use for a continuous five-year period. The Cancellation Division upheld the application for revocation in its entirety. The EUTM proprietor appealed insofar as the Cancellation Division revoked the EUTM in respect of the goods in Class 25.

The Board confirms the contested decision. On the additional evidence filed at the appeal stage, the Board, exercising its discretionary power granted under Article 95(2) EUTMR, finds that the evidence is supplementary to that presented before the

Cancellation Division and prima facie relevant for the outcome of the case. The Board, first, focuses on the nature of use of the contested EUTM, specifically whether the evidence furnished by the EUTM proprietor demonstrates the use of the EUTM in the form in which it was registered.

The Board observes that the evidence shows the marks:



or



affixed on the footwear or on their packaging as well as in the corresponding advertising material, catalogues, magazines and internet printouts. Although the trade mark, as registered, appears on the invoices relating to shoes, there is no solid evidence that it has been affixed on the said goods, namely footwear, nor does it appear on the packaging, in any advertising material, catalogue or brochure. The Board finds that under these circumstances, it has to be considered that the use of the contested sign on the invoices cannot corroborate that it has been used as a trade mark. In the 'Annapurna' judgment (06/03/2014, T-71/13, Annapurna, EU:T:2014:105, § 41), the General Court reached the conclusion that the reproduction of the contested mark in the invoices showed the use of

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the mark as registered because it also appeared in other evidence submitted by the EUTM proprietor. In the present case, the contested EUTM only appears in the invoices, whereas on the footwear and other relevant material the abovementioned marks appear. Therefore, the use of the contested mark in the invoices amounts to use as a company, trade or shop name which has not the purpose in trade to distinguish goods or services of one undertaking from those of other undertakings (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21). The Board considers that in view of striking visual differences between the marks as used and as registered alter the distinctive character of the mark as registered with the consequence that Article 18(1)(a) EUTMR is not applicable. Therefore, since the EUTM proprietor has failed to show genuine use of the contested EUTM as registered or in an acceptable variant, the contested EUTM has to be revoked according to Article 58(1)(a) EUTMR.

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New cancellation decisions

A new summary in the series of interesting decisions in the area of cancellation at the EUIPO.

29/04/2021, [C 42 141](#) (INVALIDITY), 'G LUOMU GLÖGI' (fig) / 'G LUOMU GLÖGI' (fig)

Earlier non-registered trade marks



(figurative marks)

Contested EUTM



(Figurative mark)

Invalidity – Article 59(1)(b) EUTMR – Bad faith, Article 60(1)(b) EUTMR in connection with Article 8(3) EUTMR – Unauthorised filing by an agent or representative of the trade mark owner-Cancelled

The applicant is a Swedish company, specialised in the production and sales of alcoholic beverages including a mulled wine named 'glögg'. In 2018, the applicant entered into a commercial relationship with a Finnish-based importer (the EUTM proprietor). The partnership concerned sales of the applicant's products in Finland. In order to facilitate a favourable expansion into the Finnish market, the applicant decided to create a new 'glögg' product which was marketed under the sign 'G LUOMU GLÖGI'. The parties' relationship turned sour when the importer was acquired by the applicant's direct competitor. Although in September 2019 the applicant was informed of the change in ownership and received assurances that their cooperation with the importer would not be affected, one month later, the applicant was asked to consider disclosing the original recipe for the 'glögg' product and subsequently informed that the sign 'G LUOMU GLÖGI' had already been registered as an EUTM.

Consequently, the applicant filed a request for a declaration of invalidity against the EUTM registration on the grounds of Article 59(1)(b) EUTMR and on the grounds of Article 60(1)(b) EUTMR in connection with Article 8(3) EUTMR.

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The Cancellation Division assessed the invalidity application on the grounds of Article 59(1)(b) EUTMR, namely that the EUTM proprietor was acting in bad faith when filing for the contested EUTM.

The Cancellation Division found that the EUTM proprietor was clearly aware of the applicant's use of the 'G LUOMU GLÖGI' sign and that the parties were locked into a commercial relationship, which was close enough to expect the EUTM proprietor not to file an almost identical trade mark for identical goods without first informing the invalidity applicant and giving them sufficient time to take action against the contested EUTM. In view of the duty of fair play imposed on the EUTM proprietor, the Cancellation Division concluded that when filing for the contested EUTM, the proprietor did not have any other aim besides misappropriating the applicant's trade mark, and in so doing, had not acted in accordance with the accepted principles of ethical behaviour or honest commercial and business practices. By applying for the contested mark, the EUTM proprietor had not pursued a legitimate objective, but had effectively posed a potential obstacle to the applicant's business activities, at least on the Finnish market. The contested EUTM was declared invalid in its entirety.

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 - the conditions under which the appearance of a partial design may be protected as an unregistered Community design ([C 123/20](#), Ferrari);
 - decompilation to correct software errors ([C 13/20](#), Top System).

It also includes national developments regarding injunctions against intermediaries such as Domain Name System (DNS) resolver and messaging service.

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