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Cultural heritage through the IP lens

By Eleonora Rosati

When you travel to France, the Eiffel Tower in Paris will be one of the key sites to visit; when you think of Italy, one of that country's symbols is Michelangelo's David; as you enjoy the sun setting down in the Spanish city of Logroño, you may well order some Chorizo Riojano to go with your glass of Rioja wine; when you stroll down the streets of Copenhagen, you will admire the beautiful furniture and the distinctive Scandinavian design style on display in local stores.

Architecture, art, food, wine, design: they are all part of a community's own history, expertise, values, aesthetics and identity. In short: a community's own cultural heritage (CH).

But does the law, including intellectual property (IP) law, protect CH? The answer is … yes (of course)!

From David to Classic Nudes: cultural heritage in recent legal disputes

Several legal provisions offer tools to protect CH, including international law and national laws. An example of the latter is the Italian Cultural Heritage Code (CHC), which sets the general principle that the Italian state, regional, and local authorities regulate the use of CH that they control by issuing relevant authorisations or taking action where no such authorisations have been granted or even requested.

Cases in which the Italian state has enforced (or threatened to enforce) the CHC include commercial advertisements of rifles in which Michelangelo's *David* was portrayed in full armour and unlicensed ticket offerings for the main museums in Florence, which again displayed an image of *David*. More recently, the CHC was invoked against an adult entertainment website, which wanted to make 'live' versions of some of the paintings exhibited in the collection of Florence's Uffizi museum as part of its 'Classic Nudes' series.

IP and cultural heritage: copyright, trade marks and geographical indications

IP law also offers (several) tools to protect CH.

Take the Eiffel Tower: a search on the EUIPO database reveals that the city of Paris has successfully registered trade marks related to the famous tower. Furthermore, while copyright no longer protects the tower itself due to the expiry of the relevant term, the lighting on it, which is visible at night and makes

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a walk along the Seine unforgettable (and very romantic), enjoys its own copyright protection!

IP can also be a tool to support local communities. Outside of Europe, a well-known example is Maasai, an ethnic group that has traditionally led a semi-nomadic life across southern Kenya and northern Tanzania. The Maasai Intellectual Property Initiative Trust seeks to reclaim ownership of and license the use of the Maasai name, image and reputation, including through trade mark licensing. The overarching goal of this initiative is to redistribute licensing revenues among a community where 80% of the people live below poverty levels.

In all this, geographical indications (GIs) stand as an increasingly powerful IP right to protect CH. In Europe, there is already a strong legal regime in place to protect agricultural products and foodstuffs, wine and spirit drinks through GIs: for example, both Chorizo Riojano and Rioja are registered GIs at the EU level. In addition to the regime for agricultural GIs, there may soon also be a legal system to protect craft and industrial products as GIs at the EU level: in spring 2022, the European Commission unveiled a legislative proposal, which will now need to be considered and discussed by the European Parliament and the Council, to introduce such a system. Once adopted, this legislation will offer an 'EU-wide mechanism to protect the names of products such as Murano glass, Solingen cutlery, Donegal tweed, Halas lace or Gablonz jewellery'.

More IP in the future of CH, but also a fair balance of rights and interests

So, what does the future hold for CH? There will likely be more EU and more IP. One of the tasks of the EU is to help the cultures of the Member States blossom while respecting their national and regional diversity and bringing their common heritage to the fore.

In all this, it is also important to remember that the IP system strives to establish a fair balance between the protection of IP and the public interest. It is for these reasons that the EFTA Court considered that the city of Oslo's attempt to register – as trade marks – a series of artworks created by Norwegian artist Gustav Vigeland, which are broadly regarded as being part of Norwegian CH, would need to be assessed from a public policy perspective, among others. The Court warned that trade mark law should not be used to circumvent the natural expiry of copyright protection available to such artworks.

More recently, following a high-profile dispute in Germany over the digitisation of a museum's collection, the EU adopted legislation that prohibits individual EU countries from protecting simple reproductions of artworks in the public domain through copyright or related rights. This means that, in most cases, museums and galleries across the EU will no longer be entitled to use the copyright

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symbol © in connection with the digitised images of older works in their collections that they make available online.

In summary: creating a balanced legal regime for the protection of CH requires constant work. At the end of the day, Michelangelo's final words were 'Ancora imparo' ('I am still learning'). We can all be inspired by his wisdom ... including when it comes to shaping appropriate legal solutions to protect CH!

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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Alicante News: New year, new format!

One of the EUIPO's longest-standing publications, Alicante News, is currently undergoing a makeover!

As of **February 2023**, your go-to newsletter for staying up-to-date on all the latest IP news and developments will have a brand-new look.

Significant modifications include a change in format to an email newsletter, to replace the current downloadable pdf document, and clickable links which lead directly to the article of interest. The new structure of the newsletter will enable readers to locate content easier than ever before, whether it is regarding events, case-law, IP tips or any other topics of interest.

These changes are the result of the feedback received from a survey conducted by the EUIPO in March-April 2022. The survey aimed to better understand the interests and preferences of our readers. We are extremely grateful to all you who took the time to complete the survey.

The feedback was very valuable and assisted us with understanding the needs of our readers. Following an in-depth analysis of this feedback, the team worked on a proposal to improve the quality and format of Alicante News. One of the key findings was that 85 % of respondents read Alicante News on a computer, 20 % on a mobile device and 20 % in print. This discovery prompted our decision to adapt to an email newsletter format.

The new Alicante News will be available as of February, however if you can't wait until then, here's a sneak peek of what you can expect!

About Alicante News

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

For any questions, you may contact us at informacion@euipo.europa.eu.

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IPnetwork
strategic driver 01

The Authenticities network continues to grow

Lisbon (Portugal), **Targovishte** (Bulgaria) and **Zaragoza** (Spain) have recently joined the European Network of Authenticities.

The Authenticities project is an EUIPO project that aims to r**aise awareness at local level** among citizens and other stakeholders, of both the value of intellectual property and the **damaging effects of counterfeiting in European cities**.

Following an agreement signed between each municipality and the relevant national intellectual property office, a series of IP-related activities will be carried out in the newly certified Authenticities over the next 2 years.

Lisbon, Targovishte and Zaragoza are the latest additions to the network of certified Authenticities. The other cities are **Thessaloniki**, **Corfu** and **Mykonos** (Greece), **Sofia**, **Plovdiv** and **Burgas** (Bulgaria), **Banská Bystrica** (Slovakia), and **Madrid** (Spain).

Recent studies by the EUIPO Observatory show that on average nearly 1 in 10 consumers were misled into buying counterfeit goods, and a third of Europeans wondered whether a product that they had bought was genuine or not.

Discover the Authenticities network

DesignEuropa Awards: nominate your clients

The nomination and application period for the DesignEuropa Awards is now open.

The DesignEuropa Awards, now in their fourth edition, is a must-attend event on the international industrial design agenda. Organised every two years by the EUIPO, the awards give recognition to outstanding designs and industry pioneers who have registered their ideas and products as registered Community designs (RCD).

If you know any designer or you **represent any clients that have registered their designs as RCDs**, you may apply for the awards via the DesignEuropa Awards website.

There are 3 award categories: Industry, Small and Emerging Companies, and Lifetime Achievement Award. The application period runs until 10 March 2023.

The Awards Ceremony will be held before the end of 2023 in **Berlin, Germany**.

Apply to enter or nominate your favourite design now!

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strategic driver 02

New rules on submitting evidence to the EUIPO

From 1 February 2023 new requirements will apply when submitting annexes on data carriers, such as USB flash drives, pen drives or similar memory units.

The changes are part of the recently published Decision No EX-22-7 which stipulates several changes on the EUIPO's rules on submitting evidence on data carriers, including:

- **Only unlayered PDFs** (i.e. standard, static PDF files) are acceptable. Encrypted, executable and/or compressed files **are not acceptable**;
- **20 Mb** is the maximum size of each individual file saved on the data carrier.

The changes are intended to reduce delays and to align, where applicable, the requirements with e-communication through the user area. Failure to comply may lead to evidence being disregarded.

ATTENTION: The Office will deem an annex, or part of an annex, not to have been filed – and will not invite the party to overcome the deficiency – when the requirements as stipulated in the Decision have not been met.

Where an annex submitted on a data carrier complies with the requirements of this Decision, the Office will upload it into the electronic file (DAS). If the **combined size of all files** on the data carrier **exceeds 1 GB**, the data carrier is still accepted but the Office is not obliged to upload the data carrier content into the electronic file as there may be technical constraints to do so.

More on PDFs

Only standard, static PDF files are permitted when submitted on a data carrier. A static PDF file cannot be modified by the recipient: its structure, content, and layout cannot be changed. The new Decision gives further detail on what is **NOT** considered a **static file**.

From 1 February 2023 non static PDF files received on data carriers will be refused and no deficiency letter will be sent.

Consult our previous Notice, Filing PDF documents in e-communications (November 2021), and watch this webinar, How to avoid errors when filing documents in inter partes proceedings.

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strategic driver 02

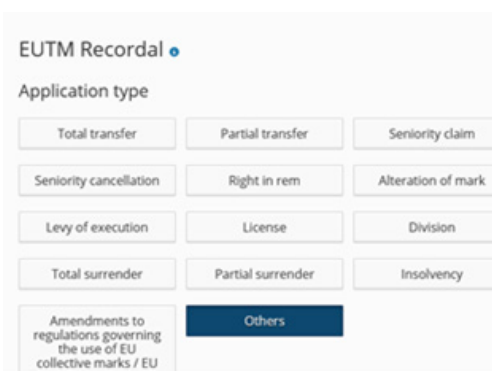
Practice tip: Efficient entries to the register

When requesting updates and modifications to the register, use this online request form available from the user area, under 'Online services'.

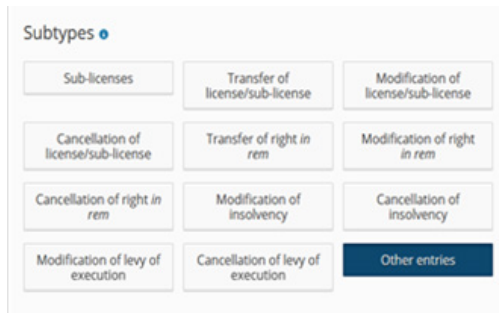
Use the correct 'type of action' for each case:

- Inspection: EUTM, RCD, international application
- Recordal: transfer, seniority, surrender, license, right in rem, levy of execution, division, insolvency, etc.
- Renewal: EUTM, RCD
- Change of representative: appointment, replacement, deletion
- Conversion: EUTM, international registration

If you cannot find what you are looking for in 'Recordal', go to 'Others':



There are these other options



The online request form is designed to ensure you have completed all relevant information.

If you have something to add, add a document in 'attachments'.

Please do not use the option 'communication back-up' if the correct application type (or subtype) is available, as it may lead to a delay, or even to a refusal of your request if the necessary information is missing.

For any questions, contact us at information@euipo.europa.eu.

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strategic driver 02

Court of Justice accepts EUIPO's third appeal under the new 'filter' system

On 16 November 2022, the Court of Justice of the European Union admitted to hear EUIPO's appeal in Case C-337/22 P – EUIPO / Nowhere – Ape Tees, filed by EUIPO's Litigation Service against a decision of the General Court. This is at the same time the third appeal (the first two being C-382/21 P KaiKai and C-801/21 P Basmati) ever admitted by the Court of Justice on the ground that it raises an issue which is significant with respect to the unity, consistency or development of EU law.

While around 150 appeals have been filed before the Court of Justice since the introduction of the new admissibility system in 2019, the EUIPO has been so far the only party able to convince the Court that its appeal is admissible and therefore worth examining on its merits. The Ape Tees case concerns the effect on pending proceedings of earlier UK rights which are no longer valid in the EU due to Brexit, but, in general, is relevant for any situation of disappearance of an earlier right during the EUIPO proceedings based on relative grounds.

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IPinnovation
strategic driver 03

Have you tried the EUTM Filing form?

Every year the EUIPO receives over 250 000 trade mark and design applications, mostly submitted online.

The new EUTM filing form for IP representatives, designed with input from IP experts, was launched in August 2022. It is intuitive, easy to use and has new features, including:

- new design with full guidance and contextual help;
- faster goods and services management;
- configuration options that allow you to tailor your filing experience.

Start using the new EUTM filing form and tell us what you think. We are finetuning the form and we will take your feedback into account if possible.

The EUIPO plans to replace the existing 5-Step Form and Advanced Form with the new EUTM filing form as of **31 January 2023**.

Do you need more guidance?

Watch the short training video or the full training webinar. If you have queries during the application process itself, use the live-agent chat option.

Top 10 most watched webinars of 2022

2022 has proved to be a successful year for the EUIPO's engaging webinars, with a number of professionals and students attending webinars to level up their skills and discover more about IP and the EUIPO for their professional development.

It is not surprising that the most watched webinars of 2022 relate to **IP and the Metaverse**. "Trade marks and designs in the metaverse: legal aspects/ EUIPO practice" took the top spot, receiving a total of 1744 views. This webinar provides an insight into the Metaverse and NFTs, highlights the areas of EU trade marks and registered Community designs that are most impacted and explains what the Office is currently doing in relation to registration proceedings.

Webinars focusing on **Blockchain and EUIPO AI tools** also feature in the top 10 webinars of 2022. In a day and age when the internet is constantly evolving, with advances in Blockchain technology, the Metaverse and the role of Artificial Intelligence, it is clear that these technologies and their application to IP have become sources of intrigue.

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Relive, or watch for the first time, the EUIPO's 10 most popular webinars of 2022:

- 1) Trade marks and designs in the metaverse: legal aspects/EUIPO practice
- 2) The Metaverse – is it relevant for your (IP) strategy?
- 3) 2022 Edition of the EUIPO Guidelines
- 4) Blockchain in the EU and the IP sector
- 5) BOA Track on Case Law: Boards of Appeal decisions and GC/CJ judgments (2022 Q3 and Q4)
- 6) Power your business with the SME Fund
- 7) Classifying Trade Mark Services – steering clear of common pitfalls
- 8) Track Case Law: GC/CJEU judgments and EUIPO BoA decisions (Q1)
- 9) Conveying meaning - options and limits for protecting new forms of marks in collaboration with the Max Planck Institute
- 10) New EUIPO AI tools empowering customer services

ACADEMY webinars

Upcoming webinars

On time limits and what you can do if you missed a deadline
Tuesday, 17 January 2023,10.00 AM – 11.00 AM (CET)

Business-Smart IP Enforcement Strategies for Africa
Tuesday, 24 January 2023, 10.00 AM – 11.00 AM (CET)

SME Fund 2023
Tuesday, 31 January 2023, 10.00 AM – 11.00 AM (CET)

On recent case-law

In case T-768/20, The Standard, for the first time, the General Court answered the question, 'Can the provision of services outside the European Union constitute genuine use in the European Union?'

In our recent webinar Track case-law: Boards of Appeal decisions and GC/CJ judgments (2022 Q3 and Q4), you will find the tools and analysis needed to better understand when consumers are exposed to trade marks in advertisements.

For more on this or other developments in intellectual property law, make the most of our extensive online learning offering in the EUIPO Academy Learning Portal.

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Case-law comment: Has this Louis Vuitton pattern acquired distinctiveness?

By Liesbeth Marijnissen, Member of the Fourth Board of Appeal of the EUIPO

This case-law analysis reflects the opinion of the author and does not reflect the position of the EUIPO.

19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2022:654

Background

On 22 November 2018 (22/11/2018, R 274/2017 2, DEVICE OF A CHEQUERBOARD PATTERN (fig.)) the Boards of Appeal ('BoA') found that the international registration designating the EU territory since 2008 for Louis Vuitton's 'Damier Azur' pattern, for goods in Class 18 (depicted above) lacked inherent distinctive character. The evidence submitted in support of the Article 7(3) EUTMR claim was insufficient to prove acquired distinctive character through use in Bulgaria, Latvia, Lithuania, Slovakia or Slovenia.

The BoA's decision was annulled by the General Court ('GC') (T 105/19). The Court found that the Board selected pieces of evidence which expressly referred to the above Member States and disregarded others which did not, but which might relate globally to all relevant Member States. The case was remitted to the BoA to perform a new global assessment of all the evidence submitted. On 25 February 2021, the Fifth Board decided that Louis Vuitton failed to show the acquired distinctiveness in the Member States specified above (25/02/2021, R 1307/2020 5, DEVICE OF A CHEQUERBOARD PATTERN (fig.)). This judgment was also appealed before the General Court.

The judgement

On 19 October 2022 (T 275/21) the GC ruled that the Fifth Board correctly decided that Louis Vuitton had not provided convincing evidence of acquired distinctiveness through use in the Member States indicated above, apart from in Estonia. The GC upheld the Board's assessment of evidence relating to the:

- value and the market shares of the applicant's brand;
- information concerning the history of the contested mark;
- sales invoices;
- excerpts from catalogues;
- advertising campaigns and the media coverage of the contested mark;
- statements concerning the distribution of magazines containing advertisements for goods in Class 18 bearing the contested mark in the Member States concerned;
- evidence concerning the use of the contested mark on the internet;
- statements from experts;
- opinion polls; and
- evidence concerning infringement proceedings.

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Regarding the evidence from Estonia, the GC found that the sworn experts' statements had high probative value since they were sourced independently and corroborated by the other relevant evidence with regard to the relevant public in Estonia. An overall assessment of all the evidence led the Court to find that the applicant had demonstrated the acquired distinctive character of the contested mark through its use in Estonia. This was not the case for Bulgaria, Latvia, Lithuania, Slovakia or Slovenia.

The Court rejected Louis Vuitton's argument that the Board's analysis was incorrect because 'it ignores the fact that, throughout the European Union, consumers engage in homogeneous behaviour as regards luxury brands, particularly because they travel and use the internet regularly'. The Court found that argument 'too general in nature'.

The burden of proof for establishing distinctive character through use lies with the proprietor of the mark who must 'adduce specific and substantiated evidence for that purpose'. Moreover, the applicant had not adduced any evidence to show that there would be a geographical and cultural proximity between the five Member States for which the evidence did not suffice and others for which acquired distinctiveness would be proved. Nor was it demonstrated that Louis Vuitton had grouped those Member States in the same distribution network or that it had treated them from a marketing strategy perspective as if they constituted one and the same market. The argument that they were 'in a strategic area for the circulation of counterfeit products in Eastern Europe' also failed as it was considered too general.

Practical significance

The decision of the Court reaffirms that proving acquired distinctiveness through use for non-traditional marks is difficult, particularly for more recent registered EU trade marks with, or claiming, protection in numerous Member States. For trade mark proprietors and their representatives, this is a rigorous, timely and costly procedure, with a frustrating end result when the lack of sufficient evidence for a few Member States means that the mark fails for protection in the whole EU.

However, given the very detailed reasoning of the Court on each item of evidence submitted, as specified above, this judgment provides practical guidance on what kind of evidence is acceptable, good or even stronger to prove acquired distinctiveness for a non-traditional trade mark. The Court concluded that while Louis Vuitton correctly argued that the burden of proof required could not be unreasonable, it was not impossible for Louis Vuitton to adduce various types and means of accessible evidence concerning either a single Member State or several Member States, taken together, or the whole of the European Union, provided that it was sufficiently specific, substantiated and credible. And there, indeed, lies the challenge!

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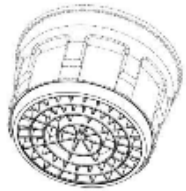
07/12/2022, T-487/21, DARSTELLUNG EINES ZYLINDRISCHEN SANITÄREN EINSETZTEILS (posit.), EU:T:2022:780

Contested sign



Tactile mark – No precise and self-contained graphic representation of the tactile impression – Obligation to determine the subject-matter of protection before examining the distinctive character – Decision annulled – EUTM application refused

The contested sign was applied for as a 'position tactile mark' in 2016. The description in the EUTM application stated that protection was claimed for a circular structure, arranged at one end of a cylindrical sanitary insert and having elastic lamellae being deformable by pressing a finger. The examiner noted a lack of precision in the application, in that it sought registration of a tactile mark. However, the Board of Appeal (BoA) refused the trade mark application for its lack of distinctive character [Article 7(1)(b) EUTMR]. The General Court (GC) finds that the sign is not represented in a precise and self-contained manner. Therefore, it is not capable of being represented graphically [Article 4 CTMR].

While examining ex officio whether the sign complies with Article 4 CTMR, the GC recalls that the graphic representation of a mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (§ 34). It notes that protection is sought both for the structure of the spray regulators and for the tactile aspect of the contested sign (§ 54). Although the structure of the sign is capable of being represented graphically, this is not the case for the tactile impression produced by this structure regarding the lamellae's elasticity (§ 55). Moreover, while the EUTM application may contain a description [Rule 3(3) CTMIR], this description cannot give rise to doubts as to the subject matter and scope of that graphic representation (§ 56). The tactile impression is not clearly apparent from the graphic representation itself but at most, from the description. Therefore, the description does not specify graphic representation of the sign but attempts to broaden the subject-matter of the protection (§ 57). Consequently, the sign does not comply with Article 4 CTMR and should be refused on the basis of Article 7(1)(a) CTMR.

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Furthermore, the GC annuls the BoA decision for having examined the distinctive character of the mark without assessing first whether the sign constitutes a trade mark within the meaning of Article 4 CTMR. The distinctive character of a sign can only be assessed once it has been found that it constitutes a trade mark (§ 36). The GC finds that it is necessary to determine the subject-matter of the protection conferred by the registration of a sign before examining its inherent distinctiveness (§ 45).

23/11/2022, T-701/21, Cassellapark, EU:T:2022:724

Contested sign

CASSELLAPARK

Not descriptive – Not deceptive – Sign including geographical name – Assessment criteria – Non-negligible part of the relevant public – Duty to state reasons – Decision confirmed – Application for invalidity rejected

The Board of Appeal (BoA) confirmed the findings of the Cancellation Division that the contested word sign 'CASSELLAPARK' is neither descriptive nor deceptive in relation to the services in Classes 36, 37 and 39 (mainly in the field of real estate business, construction, repair business and the rental of warehouses and parking lots). Therefore, both instances rejected the application for a declaration of invalidity in its entirety.

The General Court (GC) confirms the BoA decision. It points out that the Article 7(1)(c) EUTMR does not preclude the registration of geographical names that are unknown to the relevant public, in particular for the category of goods or services concerned (§ 47, 48). The term 'Cassellapark' is an industrial park in Frankfurt-Fechenheim, Germany. In addition, the term 'Cassella' refers to a former company with the same name in Frankfurt am Main and has been also used to name a street and a bridge there (§ 61-63). As a result of these factors combined with no convincing evidence in the file, the GC notes that it has not been established that the relevant public in Germany is aware of the term 'Cassellapark' as a designation of a place. Furthermore, the GC agrees with the BoA's findings that there is no evidence in the file which would prove that the relevant public outside the city of Frankfurt am Main is familiar with the term 'Cassellapark' or any other name containing the element 'Cassella' (§ 64, 65).

As the applicant has not succeeded in proving that the relevant public in Frankfurt am Main constitutes a non-negligible part of the relevant public in Germany, which would be necessary for the refusal

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of the sign due to its descriptive character [Article 7(1)(c) EUTMR], this ground for refusal cannot apply (§ 70, 71). The mere fact that the relevant services may be provided at a certain location is not sufficient to assume that that name of that location is descriptive of the geographical origin of these services.

Considering all the circumstances of the case, the GC concludes that it cannot be considered that the term 'Cassellapark' is associated by the relevant public with the services covered by the contested mark, nor is it reasonable to expect that it may, in the future, identify the geographical origin of those services (§ 88, 89). The cancellation applicants argues that the relevant public will associate the term 'Cassella' of the contested sign with the industrial property from which the headquarter of former Cassella AG was located, with the result that its combination with the component 'park', which is descriptive, is capable of misleading the relevant public as to the place of provision of the services in question [Article 7(1)(g) EUTMR]. The GC points out that neither the evidence nor the arguments submitted by the cancellation applicant allow the inference that the significant part of the relevant public will link the contested sign to the geographical origin (§ 110).

07/12/2022, T-623/21, Puma / Puma (fig.), EU:T:2022:776

Earlier trade mark

PUMA

Contested sign

Puma

Reputation – Goods belonging to different economic sectors – No link between the marks – Decision confirmed – Opposition rejected

The word mark 'Puma' was applied for *apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply* (Class 11). The Opposition Division, confirmed by the Board of Appeal (BoA), rejected the opposition based on the reputed mark 'PUMA', registered for clothing, footwear, headgear (Class 25) [Article 8(5) EUTMR]. The General Court (GC) confirms that the goods belong to such dissimilar economic sectors that consumers will not establish any link between the marks.

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The GC notes that the relevant public of the earlier mark is the general public. Regarding the contested mark, some of the goods are intended for the professional public and others for both the professional and general public (§ 38). The GC underlines that the mere fact that professionals in their capacity as private persons are also members of the public at large, does not automatically mean that the public at large forms part of the relevant public addressed by the goods and services of the mark concerned (§ 37). Moreover, even if there is an overlap in the relevant public, the goods or services can be so dissimilar that the contested mark is unlikely to bring the earlier mark to the mind of the relevant public (§ 41).

Even though the earlier mark is highly reputed and the signs are similar to a high degree, the GC finds no links between the marks. It recalls that, even in the absence of any similarity between the goods, the intensity of the earlier mark's reputation may justify recognising the existence of a link between the marks (§ 80). However, the high degree of similarity of the signs and the earlier mark's reputation is not automatically sufficient to establish a link. All the relevant factors must be considered (§ 83). In this case, there is no evidence that the characteristics of the goods at issue could lead to an image transfer between the marks (§ 97). It has not been proven that, irrespective of the commercial context, the consumers make an association with the earlier mark when confronted with the word 'Puma' (§ 96). Since the goods at issue belong to fundamentally different economic sectors and markets, the alleged knowledge of the earlier mark by the contested mark's relevant public is not sufficient to demonstrate a link (§ 100).

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15/12/2022, R 1238/2019-G, Iceland
15/12/2022, R1613/2019-G, Iceland (fig.)

Descriptive - Geographical origin – Belated evidence - Article 7(1)(c) EUTMR, Article 59(1)(a) EUTMR, Article 27(4) EUTMDR

On 15 December 2022, following the oral hearing in September, the Grand Board rendered two decisions (R 1238/2019-G, Iceland & R1613/2019-G, Iceland (fig.)) confirming the finding of invalidity of the word mark 'ICELAND' and of the figurative mark:

Iceland

Both marks had been registered by Iceland Foods, a UK chain of supermarkets specialising in frozen food for a range of goods and services in Classes 7, 11, 29, 30, 31, 32 and 35.

Invalidity requests were filed, inter alia, by the Icelandic Ministry for Foreign Affairs and Business Iceland (a.k.a Ìslandsstofa a public-private partnership established to improve the competitiveness of Icelandic companies in foreign markets).

The Grand Board confirmed the two contested decisions of the Cancellation Division. Following a recap of the case-law relating to trade marks containing a geographical name, the Grand Board applied the 'Chiemsee' criteria and found that the marks in question would be perceived by the relevant public as indicating that the goods and services so indicated originate from Iceland.

The Grand Board was particularly mindful of the fact that the geographical name in question is that of a Member State of the European Economic Area, with deep economic, historical and socio-cultural ties with the European Union and, in particular, Denmark from whom it obtained independence in 1944. The cancellation applicants filed evidence relating to the economic importance of Iceland and its capacity to produce a wide range of goods and services. It was also shown that Iceland, in addition to being one of the most eco-friendly countries in the world, enjoys significant economic prosperity as measured by its high per capita GDP and its ranking by Brand Finance, as the world's most valuable nation brand in 2017.

The Grand Board emphasised that it was not necessary for the cancellation applicants to demonstrate that Iceland enjoyed reputation or was well-known for all the goods and services for

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which the contested marks had been registered. It only needed to be established that the geographical term was – or might be in the future – associated with the goods and services of the contested mark.

Evaluating the degree of familiarity of the relevant public with Iceland, the characteristics of the country and its capacity to produce a wide range of goods and services, the Grand Board concluded that both marks had been registered contrary to the provisions of Article 7(1)(c) EUTMR. The graphic elements of the figurative mark were unable to avoid the application of that article

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New decisions from the Boards of Appeal

09/11/2022, R 1433/2020-2, Shavette

Invalidity – No proof of customary use at the date of filing – Not descriptive – Evidence – Brexit – Decision annulled – Invalidity application rejected

The Cancellation Division (CD) partially declared the invalidity of the contested EUTM for the word mark 'Shavette' in relation to '*razors, non-electric, and parts therefor; containers and cases for razors*' and '*holders for razors*' in Classes 8, 21. It dismissed the invalidity for the remaining goods of the same classes '*razors, electric, and parts therefor*' and '*shaving brushes; holders for shaving brushes*'. The CD noticed that although the term 'Shavette' was an invented term and had no meaning when it was coined by the EUTM proprietor in the 1980s in Germany, it became customary by the date of the EUTM filing for the above-mentioned goods covered by that mark. This is because a significant part of the relevant public (in Sweden and the United Kingdom) uses and understands this term as a descriptive reference to or synonym for any 'razor with interchangeable blades'.

The Board of Appeal (BoA) annuls the CD decision and rejects the request for a declaration of invalidity in its entirety. It points out that albeit neither the CD nor BoA are required to examine of their own motion, the relevant facts that might have led them to apply the absolute ground for refusal set out in Article 7 EUTMR in invalidity proceedings, they may consider obvious and known facts from the time of the contested EUTM filing. Since the cancellation applicant has the burden of proving the facts needed to show that the contested mark falls under the relevant absolute ground, general knowledge is to be taken into account ex officio. However, any specific documents must be adduced by the cancellation applicant.

As far as the evidence from the United Kingdom is concerned, the BoA considers that it can no longer be considered in invalidity proceedings based on Article 7(1)(c) and (d) EUTMR since the BoA decision is rendered after 31 December 2020. As for the remaining evidence, the BoA concludes that it is not sufficient to prove in a consistent and unequivocal way that there was a customary use of the term 'Shavette' by the majority of the relevant public for the goods concerned at the time of filing the contested EUTM (5 May 2014) [Article 7(1)(d) EUTMR]. As regards the evidence concerning the time after the date of filing, the BoA notes that the cancellation applicant did not provide any relevant reasoning as to why the evidence from 2018 and 2019 is relevant for the filing date. Furthermore, the BoA finds that the term 'Shavette' is not descriptive [Article 7(1)(c) EUTMR] since there are too many mental steps between the term 'Shavette' and the intended purpose of the goods in question.

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11/11/2022, R 1005/2022-4, PEANUT EXTASY

Trade mark contrary to public policy – Decision confirmed – EUTM application rejected

The Board of Appeal (BoA) confirms the examiner's decision to refuse the registration of a word mark 'PEANUT EXTASY' in relation to foodstuff and confectionary in Classes 29 and 30 pursuant to Article 7(1)(f) EUTMR, considering that the relevant French-speaking public will understand the meaning of the word element 'EXTASY' as a reference to the illicit drug, ecstasy.

The BoA notes that the seriousness of the physical and mental health threat from drug consumption corresponds to the commitment of the EU and Member States to reduce drug-related health damage, and to implement preventive measures and awareness-raising against illicit drugs.

There are several legal acts at both the EU and the Member-State level that address the security and health impacts of drug trafficking and use. The BoA then points out that the assessment of the existence of the ground for refusal referred to in Article 7(1)(f) EUTMR [trade marks which are contrary to public policy or to accepted principles of morality] must be carried out on the basis of the criteria of a reasonable person with an average sensitivity and tolerance threshold. Furthermore, the relevant public cannot be limited to the public directly targeted by the goods and services in which registration is sought. It is necessary to consider the fact that the signs covered by that ground for refusal will shock not only the public to whom the goods and services covered by that sign are addressed, but also other persons who will encounter that sign accidentally in their daily lives.

The BoA confirms that the word 'ECSTASY' could be written in French either as 'EXTASY' (i.e. transcription referred to in the sign applied for) or as 'Ecstasy'. In any event, these terms are very close to each other and phonetically almost identical for the French-speaking public, which will understand its meaning without any doubt. This meaning will not be altered by the other verbal element of the sign 'peanut', irrespective of whether this English word will be understood or not. Therefore, the BoA concludes that the reference to the most common illicit drugs produced in the EU, which has serious consequences for human health, will be clearly perceived in the contested sign by the relevant French-speaking public. Since the recreational use of psychoactive substances is prohibited by legal systems in most Member States, including France, Belgium and Luxembourg, the contested sign must be refused as being contrary to the public policy.

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29/11/2022, R 824/2022-5, BLACK IRISH (fig.)

Contested EUTM application

BLACK IRISH

Deceptive – Public deceived about an ingredient of the alcoholic beverages – Descriptive – Decision confirmed – EUTM application partially rejected – Partial remittal to the examiner for examination of Article 7(3) EUTMR

The examiner, confirmed by the Board of Appeal (BoA), found the figurative sign 'BLACK IRISH' deceptive, within the meaning of Article 7(1)(g) EUTMR, for *alcoholic beverages not containing whisky, cream-based liqueurs and/or poteen* (Class 33). The BoA notes that 'IRISH' is, inter alia, defined as the short form for 'Irish whiskey'. Therefore, a significant part of the relevant English-speaking public will perceive 'BLACK IRISH' as meaning very dark 'Irish whiskey'. In the context of alcoholic beverages, the reference to (dark) 'Irish whiskey' will be perceived by the relevant public as an ingredient of the alcoholic beverages concerned.

Therefore, when confronted with the contested sign, a significant part of the English-speaking public will then assume that the alcoholic beverages contain 'Irish whiskey', which however, they clearly do not contain. The contested sign is therefore capable of deceiving that public about an important ingredient and, therefore about the nature of the alcoholic beverage at issue. The black and golden figurative elements are of purely decorative nature and these colours are customary in the field of alcoholic beverages. Therefore, they cannot counteract the deceptive character of the verbal element of the sign.

Regarding *hot chocolate; coffee; tea* (Class 30), *beers* (Class 32) and *alcoholic beverages containing whisky, cream-based liqueurs and/or poteen* (Class 33), the BoA confirms the descriptiveness of the contested sign [Article 7(1)(c) EUTMR]. It notes that the sign merely informs the relevant public about the goods' colour and geographical origin. In that regard, it complies with the General Court judgment 14/09/2022, T-498/21, Black Irish, EU:T:2022:543, which found the word mark 'BLACK IRISH' descriptive of those goods. The BoA also finds the contested sign devoid of distinctive character for the said goods [Article 7(1)(b) EUTMR]. Regarding cocktail shakers (Class 21), contrary to the examiner, the BoA considers the sign not descriptive, since the link between the sign and those goods is very vague.

The case is remitted to the examiner for examination of the applicant's subsidiary claim under Article 7(3) EUTMR only in relation to the goods that are refused based on Article 7(1)(b) and (c) EUTMR.

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04/10/2022, R 816/2021-1, LAGUIOLE (fig.)

Contested EUTM

Bad faith – Misappropriation of the name of a municipality and its reputation for knives – Decision confirmed – EUTM cancelled

This case is part of a 30-year dispute between the French Municipality of Laguiole and the contested EUTM proprietor's family, owning a series of Laguiole trade marks. The invalidity of the contested EUTM, registered for *knives* and *cutlery* (Class 8), was requested by the Municipality of Laguiole. It argued that, due to the reputation enjoyed by the Municipality, inseparable from that of the Laguiole knife with the emblematic bee, the mark was applied for in bad faith [Article 59(1)(b) EUTMR]. The Board of Appeal (BoA) confirms the existence of bad faith.

Firstly, the BoA points out that the allegations of the EUTM proprietor cannot exclude bad faith. In that regard, the BoA underlines that the Municipality does not have to prove that it owns an earlier right on 'LAGUIOLE' or the bee device. Bad faith is an absolute ground for invalidity, which may be invoked by anyone. Moreover, the difficulties encountered by the cutlers of the Municipality of Laguiole in obtaining a Protected Denomination of Origin, due to the contestations of the cutlers of the Municipality of Thiers, cannot excuse the bad faith of the EUTM proprietor. The BoA adds that neither the alleged distinctive character of the contested mark nor the 'non-appropriable' character of the name 'Laguiole' exclude bad faith. A distinctive trade mark could have been applied for in bad faith. Furthermore, nothing precludes a 'non-appropriable' sign – such as generic or descriptive sign – from being cancelled for bad faith. Therefore, it is irrelevant that 'Laguiole' may be perceived as purely generic or as descriptive of the geographical origin of the knives coming from the Municipality. Finally, the BoA finds that, contrary to what the contested EUTM's proprietor claimed, the application for a declaration of invalidity for filing in bad faith is not aimed at 'monopolising' the term Laguiole.

Secondly, the BoA assesses the EUTM proprietor's bad faith. It notes that the reputation of the Municipality, inseparable from that of the famous Laguiole knife born and manufactured on its territory since the 19th century, is indisputably established

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by the evidence in the file. Moreover, the choice of this figurative element is not incidental since the bee device is emblematic of the Laguiole knife. The filing clearly aims at taking undue advantage of the efforts of the Municipality and its citizens to relaunch traditional cutlery in the Municipality since 1985, and of the significant prospects and economic potential of the Laguiole knife made in Laguiole. Moreover, the EUTM proprietor filed the contested trade mark in the knowledge of the usual use of the sign by several Laguiole knives' cutlers. Therefore, the filing of the contested mark for *knives* aims at creating a link in the public's mind with the Laguiole knife and the emblematic bee. Furthermore, the BoA adds that the EUTM proprietor is the director of the company 'Laguiole', which has been aggressively exploiting a series of Laguiole trade marks vis-à-vis the Municipality and its citizens since 1993. It notes that, in 2019, the Paris Court of Appeal cancelled approximately 20 of those trade marks for bad faith. Therefore, the EUTM proprietor is wrong to claim that it would never have sought to prohibit the Municipality or its citizens from using the name 'Laguiole'. Consequently, the contested EUTM was applied for in bad faith.

29/11/2022, R 473/2022-2, eppla (fig.) / APPLE et al.

Earlier trade mark

APPLE

Contested sign

eppla

Mark with reputation – Link between the signs – Assessment of all the relevant factors including the actual use of the contested mark – Decision annulled – Opposition allowed

The Board of Appeal (BoA) finds that the Opposition Division (OD) did not apply correctly all the relevant factors in the assessment of the existence of a link between the signs [Article 8(5) EUTMR], and therefore annuls the OD decision.

Contrary to the contested decision, the BoA considers that the relevant public will reasonably establish a mental association between the contested trade mark and the earlier trade mark, considering the

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partial identity and partial similarity between the goods at issue (mainly smart gadgets, computers, tablets, accessories in Class 9); and that they target the same consumers; as well as considering the inherent distinctiveness and the high level of reputation of the earlier trade mark. It further notes that the coincidence in the same five letters while differing only in the inversion of the initial and final letters create sufficient overall similarities between the two signs, which cannot be disregarded on the basis of an absence of conceptual similarity between them. The BoA further notes that the way in which the contested mark is actually used may also support the finding of free-riding (unfair advantage) in accordance with the judgment of 07/12/2017, T 61/16, 29/11/2022, R 473/2022-2, eppla (fig.) / APPLE et al., MASTER (fig.) / COCA-COLA (fig.) et al., EU:T:2017:877. The contested sign is used on some of the products without the figurative element and on the packaging that could be associated with the opponent's brand (all-white case):

Therefore, bearing in mind all factors relevant to the circumstances of the case, including the actual use of the contested mark in a particular form, the BoA concludes that the use of the contested sign constitutes a misappropriation of the earlier mark's attractiveness and advertising value. This may stimulate the sales of the applicant's products to an extent which may be disproportionately high in comparison with the size of its own promotional investment. Therefore, it leads to the unacceptable situation where the applicant is allowed to take a 'free-ride' on the opponent's investment in promoting and building-up good will for its trade mark.

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This section includes a new summary of an interesting decision of the EUIPO's cancellation division.

31/08/2022, C 50 262, 10X (word mark)

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

The contested EUTM, '10X' (word mark), was registered for goods and services in Classes 9, 14 and 35. An application for a declaration of revocation was filed on the grounds of Article 58(1)(a) EUTMR, claiming that the mark had not been put to genuine use for any of the registered goods and services.

The EUTM proprietor submitted evidence showing use of the sign 'Honor 10X Lite' in relation to smart/mobile phones.

The most 'eye-catching' legal issue at hand was that of the use of the mark 'as registered'. In this regard, the applicant argued that the sign featured in the evidence was substantially different from the contested EUTM. It claimed that 'Honor' alters the distinctive character of the mark as registered, that '10X' would be perceived as a series code for IT goods and hence as very weakly distinctive, while 'Lite' (albeit placed at the end of the sign) would be of great importance in the public's perception of the sign.

The Cancellation Division dismissed the applicant's claims. It noted that '10X' is neither intrinsically non-distinctive, nor otherwise weak for smart/mobile phones and therefore, its distinctiveness per se is average. 'Lite' will not be attributed any trade mark significance, since it is frequently used in the relevant market to indicate a product with slightly lower specifications than the 'real' model (a 'light/'lighter' version). Finally, 'Honor' and '10X' would be perceived as separate, independent signs. There are no syntactical, grammatical or conceptual connections between these terms, and they appear separated from one another in the evidence. Moreover, it is common practice in the respective industry to use a house mark ('Honor') and different product-line identifiers/sub-brands ('10X').

In an overall assessment of the evidence, the Cancellation Division found that the documents submitted, although not particularly extensive, did reach the minimum threshold to show that the EUTM proprietor had made real efforts to at least try to carve out a portion of the relevant market in relation to the registered mobile phones and smartphones in Class 9. Genuine use was therefore acknowledged only for those goods. In the absence of persuasive evidence of use or any claimed and proven reason for non-use, the proprietor's rights were revoked for the remaining goods and services in Classes 9, 14 and 35.

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