

Alicante News

Up to date information on IP and EUIPO-related matters

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Looking to the IP Horizon

On 26 and 27 September 2019, the EUIPO will host the ['IP Horizon 5.0 Conference: Mapping opportunities and challenges in a globalised economy'](#) at its premises in Alicante, Spain.

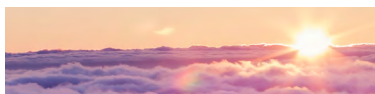
In conjunction with the prestigious [McCarthy Institute](#), the conference will look at the **future of intellectual property and the opportunities and challenges that lie ahead for IP in the age of digital transformation**.

The so-called 'Industrial Revolution 5.0' – the future changes that society will undergo – has been associated with closer cooperation between innovation and humankind.

In general terms, the first industrial revolution featured mechanisation and steam engines, the second one focused on mass production and electricity, the third one on electronics and IT systems, and the fourth industrial revolution is linked to the digitisation of society and interconnectivity.

But how far is the 5.0 horizon and what will be its impact in the field of IP?

The IP Horizon 5.0 Conference will bring together representatives from some of the world's most innovative IP offices, businesses and academic institutions to **explore the impact of new developments and emerging technologies**



applied to IP, including potential policy initiatives and efforts to harmonise IP in a globalised economy.

The challenges for IP in a digital society, IP protection in e-commerce, the future of IP examination and asset evaluation and transformative technologies in IP careers will also be discussed.

Over the course of two days, Alicante will become a beacon of IP expertise. The [conference programme](#) includes **top representatives from leading global companies** including Microsoft, Samsung, Sony, Alibaba and Philips will give the industry view and **key intellectual property figures** from the [WIPO](#), [EPO](#), [TM5 partner offices](#) (United States, Japan, Korea and China), and the EU institutions. Enforcement authorities and academic institutions will also take part in the conference.

The programme is designed to encourage active discussion among participants, with various panel sessions aiming to stimulate debate and reflection.

For more details and to register, visit the [conference page](#). There are still some places available, and registration is open until 12 September.

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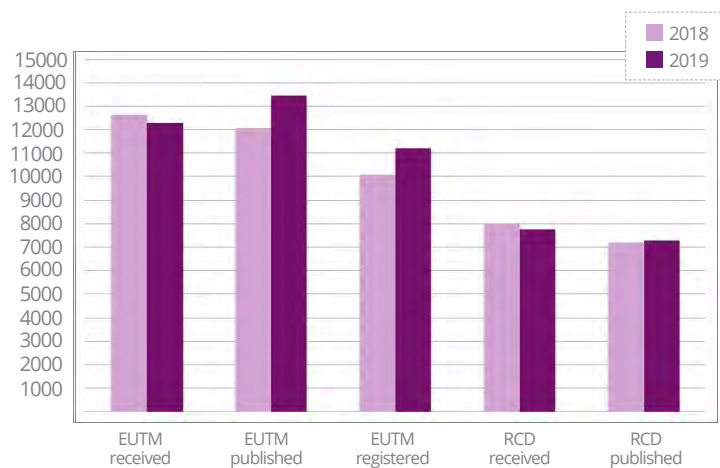


Statistical Highlights



Monthly statistical highlights June*	2018	2019
European Union Trade Mark applications received	12 647	12 273
European Union Trade Mark applications published	12 052	13 446
European Union Trade Marks registered (certificates issued)	10 097	11 217
Registered Community Designs received	8 016	7 755
Registered Community Designs published	7 182	7 300

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



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EUIPN Updates



Portugal launches new online services for trade marks and designs

The National Industrial Property Institute of Portugal (INPI), with the support of the EUIPO's European Cooperation Projects, has launched a set of new online services for filing trade mark and design applications online.

The new digital services platform became available on 1 July 2019 and is expected to serve 80,000 applications every year for trade marks and designs.

To date, INPI has developed 71 new e-services over the last 12 months in cooperation with the EUIPO. The first wave of 10 e-services became available in July 2018. The new e-services will help **modernise the trade mark and design registration system within Portugal, benefitting users across the EU.**

With this implementation, INPI also supports the implementation of the **transposition of the EU Directive to approximate the laws of the Member States relating to trade marks** (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015).

The release comes as a result of the work carried out by the EUIPO and its partners under the [European Cooperation Projects](#), in particular the project 'ECP1 Consolidating and Completing the Cooperation Fund Landscape'.

The project supports intellectual property offices in developing more efficient, reliable and user-friendly tools and services for trade marks and designs within the European Union Intellectual Property Network (EUIPN).

Chile joins DesignView

As of 22 July 2019, the National Institute of Industrial Property Office of Chile (INAPI) has made its design data available to the DesignView search tool.

With INAPI on board, [DesignView](#) now contains data from 69 participating offices.

With the addition of more than 4,500 industrial designs from INAPI, DesignView provides information and access to more than 14.7 million designs in total.

Since the introduction of DesignView in November 2012, the tool has served more than 4.8 million searches from 163 different countries, with users from the UK, Germany and China among the most frequent users.

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Cyprus upgrades online services for trade marks

The Cypriot Department of Registrar of Companies and Official Receiver (CY DRCOR), with the support of the EUIPO's European Cooperation Projects, has upgraded its existing online services for trade marks.

The new e-filing solution for trade marks became available on 15 July, bringing improved e-filing and online services for trade marks to Cypriot users. The project has been carried out with the support of different teams from the EUIPO and DRCOR.

This new version also contains functions which, when released, will be compatible with the regulatory changes brought about by the **transposition of EU Directive to approximate the laws of the Member States relating to trade marks** (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015).

The implementation was carried out within the framework of the [European Cooperation Projects](#), in particular the project 'ECP2 Major improvements to existing tools', for which Cyprus was the **first pilot office to implement this system** (Front Office Release 2).

The overall aim of the projects is to benefit users across the EU by **providing modern, state of the art tools and services for intellectual property offices in the European Union Intellectual Property Network (EUIPN)**.

Monaco to use the list of terms from the harmonised database in TMclass

As of 15 July 2019 the Industrial Property Office of the Business Development Agency of the Principality of Monaco (MCIPO) will use the list of goods and services from the harmonised database (HDB) in TMclass in French.

Following MCIPO's decision to use HDB there are now **6 non-EU IP offices** that use and accept terms from this database.

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Overview of Case Law (2018)

The Legal Practice Service of EUIPO has prepared an overview of the Case-Law from the General Court (GC) and Court of Justice (CJ) in Luxembourg with regard to trade mark and design matters.

This useful legal resource is published for information purposes, and includes abstracts of judgments, preliminary rulings and important orders rendered by GC and the CJ in 2018.

The information is arranged in categories for easy browsing.

Users can find more detailed information in [eSearch Case Law](#), our search tool for decisions of the Office, GC and CJ judgments and from the national courts.

[Overview of General Court / Court of Justice 2018](#)

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Luxembourg trade mark and design news

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

C-118/18 P-REV; BITTORRENT; Hochmann Marketing v EUIPO; Order of 8 May 2019; EU:C:2019:396;

Language of case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility

FACTS: The applicant brought an application for revision of the order of 28/06/2018, C-118/18 P, bittorrent, EU:C:2018:522, pursuant to Article 44 of the Statute of the CJEU.

By that order, the Court had dismissed the appeal brought by the applicant against the judgment of the GC of 12/12/2017, T-771/15, bittorrent, EU:T:2017:887, as being in part manifestly inadmissible and in part manifestly unfounded (Article 181 RPCJ).

The applicant criticises the Court for incorrectly applying Article 181 of the RPCJ, by not permitting the applicant itself, or the parties concerned, to intervene before the adoption of the order under

appeal, or even allowing them to be heard before ruling without an oral procedure. Thereby, there would have been no possibility to discuss allegedly relevant national case-law.

SUBSTANCE: The revision of a decision may only be made on discovery of a fact that is decisive and which, when the judgment was delivered or the order served, was unknown to the Court and to the party claiming the revision, Article 44 of the Statute of the Court of Justice of the European Union (Statute) and Article 159(1) RPCJ (para. 23).

Revision is not an appeal procedure, but an exceptional review procedure that allows the authority of res judicata attaching to a final judgment or to an order to be called into question on the basis of the findings of fact relied upon by the Court.

Revision presupposes the discovery of elements of a factual nature that existed before the judgment or the order and that were unknown at that time to the Court that delivered the judgment or the order, as well as to the party applying for revision and that, had the Court been able to take them into consideration, could have led to a different determination of the proceedings (para. 25).

In light of the exceptional nature of the revision procedure, the conditions governing the admissibility of an application for revision are to be interpreted strictly (para. 26).

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National and European case-law does not constitute new unknown facts, within the meaning of Article 44 of the Statute, any more than the alleged procedural infringements, even assuming that they could have a decisive impact on the outcome of the dispute (paras 27-30).

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

T-152/18 to T-155/18; SOLGAR Since 1947 MultiPlus WHOLEFOOD CONCENTRATE MULTIVITAMIN FORMULA (fig.) / MULTIPLUS; Sona Nutrition v EUIPO; Judgment of 7 May 2019; EU:T:2019:294;

Language of the case: EN

RESULT: Action upheld (BoA decisions annulled)

KEYWORDS: Distinctive element, Figurative trade mark

FACTS: The applicant sought to register four figurative marks SOLGAR Since 1947 MultiPlus WHOLEFOOD CONCENTRATE MULTIVITAMIN FORMULA for goods in Class 5, namely vitamins; dietetic substances; food for babies; pharmaceutical preparations; herbal preparations; all for human use.

An opposition was filed pursuant to Article 8(1) (b) CTMR based on the earlier Irish word mark **MULTIPLUS**, registered for vitamins, minerals, nutritional supplements, dietetic products and tonics in Class 5. The Opposition Division (OD) dismissed the opposition.

The Board of Appeal (BoA) dismissed the appeals. It held that the signs, considered as a whole, were dissimilar in the impressions that they conveyed to the relevant public. It found that the common element ‘multiplus’ was not distinctive in the EUTM applied for since it designated multivitamin and multi-mineral supplements, even though it was distinctive to a low degree in the earlier marks (inasmuch as it had to be acknowledged that a registered national trade mark has at least a certain degree of distinctiveness, 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 47). Since the element ‘multiplus’ was not distinctive in relation to the goods, it did not have an independent, distinctive role in the marks applied for. Thus, the element could not play a decisive role and led to the conclusion that the signs were similar overall.

The applicant filed four actions before the General Court (GC), relying on two pleas: (i) infringement of Article 8(1)(b) EUTMR, and (ii) infringement of the obligation to state reasons under Article 94(1) EUTMR. The GC upheld the appeal.

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EUTM applications



in 4 different colours

Earlier trade mark

MULTIPLUS

SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

The relevant public consists of the general public and health professionals or nutritionists in Ireland with a level of attention that is higher than average in view of the fact that the goods might affect the health of consumers (not disputed) (para. 25).

Both 'Multi' and 'Plus' are non-distinctive elements. The combination of these elements, 'Multiplus', designates the goods and is not 'fanciful' (para. 37).

Despite the potentially descriptive nature of the element 'multiplus', the earlier national mark, which consists exclusively of that word element, has some independent, distinctive character because it has been registered (24/05/2012, C-196/11 P, F1-

Live, EU:C:2012:314, § 47) (para. 39). However, this cannot mean that that term must be acknowledged as having such a high degree of distinctiveness that it gives rise to an unconditional right to oppose the registration of every later trade mark in which it appears (para. 40).

The BoA was wrong to decide that 'Multiplus' is not distinctive in the EUTM application (para. 41). This would amount to denying any distinctiveness to the earlier mark (para. 43). The degree of freedom that the BoA has in assessing the distinctive character of the element 'multiplus' when it is included in the EUTM application, is limited. Furthermore, it cannot culminate in the finding that an element that is identical to an earlier mark, which has been registered in a Member State, is devoid of distinctive character when it is included in a later composite mark (para. 45). The BoA should have accorded 'Multiplus' at least a very low degree of distinctiveness (para. 46).

The facts are different from those underlying these cases: 13/07/2018, T-847/16, COWBOYS HALLOUMI (fig.) / HALLOUMI et al., EU:T:2018:481; 13/07/2018, T-825/16, Pallas Halloumi (fig.) / HALLOUMI, EU:T:2018:482; 23/11/2018, T-702/17, Papouis Halloumi Papouis Dairies LTD PAP since 1967 (fig.) / HALLOUMI (Collective Mark), EU:T:2018:832; 23/11/2018, T-417/17, fino Cyprus Halloumi Cheese (fig.) / HALLOUMI (CERTIFICATION MARK) et al., EU:T:2018:833; 23/11/2018, T-416/17, fino Cyprus

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Halloumi Cheese (fig.) / HALLOUMI (Collective Mark), EU:T:2018:834 and 13/05/2015, T-102/14, TPG POST / DP et al., EU:T:2015:279. The GC did not state in these cases that the element in the contested mark, identical to the earlier mark, was devoid of any distinctive character (paras 48-49).

Even though the perception of an element may vary according to whether it is used on its own or as part of a composite mark, a finding that an element which is identical to a national mark does not have any distinctive character is incompatible with the EUTMR (para. 50).

Thus, the GC annulled the BoA decisions.

T-55/18; LIEBLINGSWEIN; Team Beverage v EUIPO; Judgment of 8 May 2019; EU:T:2019:311; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS: The applicant sought to register the figurative mark LIEBLINGSWEIN for goods and services in Classes 21, 33 and 43.

The examiner refused the application pursuant to Article 7(1)(b), (c) and (g) and Article 7(2) CTMR.

The Board of Appeal (BoA) dismissed the appeal. It held that the relevant German-speaking public associated the term 'LIEBLINGSWEIN' with the meaning 'wine which one prefers to drink/consume'. It would not consist of an unusual neologism but be perceived as a concrete and promotional message that the wine must be regarded as 'favourite wine'. Moreover, the sign was held to be deceptive for goods that are not related to wine.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and (iii) infringement of Article 7(1)(g) EUTMR in conjunction with Article 7(2). The GC dismissed the action.

EUTM application



SUBSTANCE: (i) Infringement of Article 7(1)(c) AND ARTICLE 7(2) EUTMR. The relevant public consists of German-speaking general and professional consumers, whose level of attention is average (not disputed) (para. 28).

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The sign is perceived by the relevant public, in the context of the goods in Class 21, as an indication that those goods relate to their favourite wine or are intended for use with it (para. 38). All the goods claimed in Class 33 are wines, contain wine, are made from wine or can be mixed particularly well with wine (para. 41). In the context of the services in Class 43, the relevant public perceives the sign as an indication that their favourite wine is served or that such a good wine is offered that they would choose this wine as their favourite wine in future (paras 45 and 48). The minimalist figurative elements are merely decorative (para. 52).

The overall impression created by the combination of the word and figurative elements of the sign is not sufficiently distant from the descriptive and clear message of the word elements. Thus the sign is descriptive for the goods and services (para. 53).

(ii) and (iii) Infringement of Article 7(1)(b) and (g) and ARTICLE 7(2) EUTMR. The pleas are rejected as ineffective since one absolute ground for refusal is sufficient (paras 56-61 and 62-64).

T-56/18; WEIN FÜR PROFIS (fig.); Team Beverage v EUIPO; Judgment of 8 May 2019; EU:T:2019:312; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS: The applicant sought to register the figurative mark 'WEIN FÜR PROFIS' for goods and services in Classes 16, 20-22, 30, 32, 33, 35, 39-41 and 43.

The examiner refused the application pursuant to Article 7(1)(b), (c) and (g) and Article 7(2) CTMR.

The Board of Appeal (BoA) dismissed the appeal. The sign was held to be devoid of distinctive character and descriptive of the goods and services (wine products or the sale of such). The BoA found that the relevant public would associate the mark with the consumption of wine by 'pros' and the minimalist figurative elements would merely be decorative. Furthermore, the signs would lack distinctive character since they would merely convey a laudatory message and would not enable consumers to ascertain the commercial origin. In terms of not being descriptive, the sign would in any case be deceptive for the remaining goods and services since they would not have a relationship with wine.

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The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 7(1)(g) in conjunction with Article 7(2) EUTMR. The GC dismissed the action.

EUTM Application



SUBSTANCE: (i) Infringement of Article 7(1)(c) AND ARTICLE 7(2) EUTMR. The relevant public consists of German-speaking general and professional consumers, whose level of attention is average (not disputed) (para. 34).

The expression 'WEIN FÜR PROFIS' has a clear meaning for the goods and services that describe wine or are closely related to wine for 'wine connoisseurs' and professionals. It refers to the high level of quality of the goods and services, which therefore meet the particular demands of these wine connoisseurs or professionals (paras 36-37).

The GC confirms the BoA's assessment of descriptiveness of the sign and, more explicitly, its

specific reasoning, establishing a direct and specific connection to each homogenous group within the wide range of goods and services (paras 35-72).

The minimalist figurative elements are merely decorative and do not detract from the descriptive meaning of the word elements when considered as a whole (para. 71).

(ii) and (iii) Infringement of Article 7(1)(b) and (g) and ARTICLE 7(2) EUTMR. The other pleas are rejected as ineffective since one absolute ground for refusal is sufficient (paras 74-79 and 80-82).

T-57/18; WEIN FÜR PROFIS (fig.); Team Beverage v EUIPO; Judgment of 8 May 2019; EU:T:2019:313; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS: The applicant sought to register the figurative mark 'WEIN FÜR PROFIS' for goods and services in Classes 16, 20-22, 30, 32, 33, 35, 39-41 and 43.

The examiner refused the application pursuant to Article 7(1)(b), (c) and (g) and Article 7(2) CTMR.

The Board of Appeal (BoA) dismissed the appeal

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The sign was held to be devoid of distinctive character and descriptive of the goods and services in question (wine products or the sale of such). The BoA found that the relevant public would associate the mark with the consumption of wine by 'pros' and the minimalist figurative elements would merely be decorative. Furthermore, the signs would lack distinctive character since they would merely convey a laudatory message and would not enable consumers to ascertain the commercial origin. In terms of not being descriptive, the sign would in any case be deceptive for the remaining goods and services since they would not have a relationship with wine.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 7(1)(g) in conjunction with Article 7(2) EUTMR. The GC dismissed the action.

EUTM Application



SUBSTANCE: (i) Infringement of Article 7(1)(c) AND ARTICLE 7(2) EUTMR. The relevant public consists of German-speaking general and professional consumers, whose level of attention is average (not disputed) (para. 34).

The expression 'WEIN FÜR PROFIS' has a clear meaning for goods and services that describe wine or are closely related to wine for 'wine connoisseurs' and professionals. It refers to the high level of quality of the goods and services, which therefore meet the particular demands of these wine connoisseurs or professionals (paras 36-37).

The GC confirms the BoA's assessment of descriptiveness of the sign and, more explicitly, its specific reasoning, establishing a direct and specific connection to each homogenous group within the wide range of goods and services (paras 19-73).

The minimalist figurative elements are merely decorative and do not detract from the descriptive meaning of the word elements when considered as a whole (para. 71).

(ii) and (iii) Infringement of Article 7(1)(b) and (g) and ARTICLE 7(2) EUTMR. The other pleas are rejected as ineffective since one absolute ground for refusal is sufficient (paras 74-79 and 80-82).

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T-465/18: EUROLAMP pioneers in new technology; Eurolamp AVEE Eisagogis kai Emporias Lamptiron v EUIPO; Judgment of 14 May 2019; EU:T:2019:327; Language of the case: EL

RESULT: Action dismissed

KEYWORDS: Distinctive element, Distinctiveness acquired by use, Laudatory mark, Slogan mark

FACTS: The applicant sought to register the word mark EUROLAMP pioneers in new technology for goods in Class 11, such as lamps and lighters.

The examiner refused the application pursuant to Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal finding that the sign is devoid of distinctive character in the English-speaking parts of the EU, namely, Ireland, Malta and the United Kingdom. The sign conferred a simple laudatory message. The BoA did not examine Article 7(1)(c). It found, moreover, that there was no proven acquired distinctiveness through use in these Member States.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 7(3) EUTMR.

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

The relevant public consists of the German-speaking general and professional public (undisputed) (para. 25). As the verbal element, 'pioneers in new technology', is composed exclusively of English words, the relevant public is limited to the English-speaking Member States (para. 27).

The sign is devoid of distinctive character. The relevant public will perceive the word element, 'eurolamp', as a factor which provides information about the nature of the goods in question, or their geographical origin, rather than as an indication of their commercial origin (para. 34). The word elements, 'pioneers in new technology', contain no unusual element (para. 37) and possess no originality capable of endowing them with distinctive character. The relevant public will not perceive them as anything other than a mere promotional message (paras 37-39). The mark applied for, taken as a whole, is not greater than the sum of its parts. It does not possess any originality or memorable element and does not require any interpretative effort (paras 40-41). Thus, the sign is devoid of any distinctive character (para. 42).

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

The plea is rejected as ineffective since one absolute ground for refusal is sufficient (paras 43-44).

(iii) INFRINGEMENT OF ARTICLE 7(3) EUTMR.

As the mark applied for was devoid of distinctive character for the English-speaking public of the European Union, including Member States where English is an official language, namely Ireland, Malta and the United Kingdom, distinctiveness acquired through use needed to be proved, in particular with regards to this public (paras 54-55). The evidence provided mostly targeted the Greek territory and marginally other Member States where English is understood (Cyprus, the Netherlands, Sweden) for a period of less than 3 years (paras 58-62). Thus, there is no sufficient proof of distinctiveness acquired through use (para. 66).

T-466/18; EUROLAMP pioneers in new technology; Eurolamp AVEE Eisagogis kai Emporias Lamptiron v EUIPO; Judgment of 14 May 2019; EU:T:2019:326; Language of the case: EL

RESULT: Action dismissed

KEYWORDS: Distinctive element, Distinctiveness acquired by use, Laudatory mark, Slogan mark

FACTS: The applicant sought to register the figurative mark EUROLAMP pioneers in new technology for goods in Class 11, such as lamps and lighters.

The examiner refused the application pursuant to Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal, finding that the sign is devoid of distinctive character in the English-speaking parts of the EU, namely Ireland, Malta and the United Kingdom. The sign conferred a simple laudatory message. The BoA did not examine Article 7(1)(c). It found, moreover, that there was no proven acquired distinctiveness through use in these Member States.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 7(3) EUTMR.

EUTM application



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

The relevant public consists of the German-speaking general and professional public (undisputed) (para. 25). As the verbal element, 'pioneers in new technology', is composed exclusively of English words, the relevant public is limited to the English-speaking Member States (para. 27).

The sign is devoid of distinctive character. The relevant public will perceive the word element, 'eurolamp', as a factor which provides information about the nature of the goods in question, or their geographical origin, rather than as an indication of their commercial origin (para. 35). The word elements, 'pioneers in new technology', contain no unusual element (para. 37) and possess no originality capable of endowing them with distinctive character. The relevant public will not perceive them as anything other than a mere promotional message (paras 37-39). The figurative elements (green and black colour, font, ® sign) do not enhance the distinctive character of the mark (paras 41-42). The mark applied for, taken as a whole, is not greater than the sum of its parts (para. 41). It does not possess any originality or memorable element and does not require any interpretative effort (paras 42-43). Thus, the sign is devoid of any distinctive character (para. 44).

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

The plea is rejected as ineffective since one absolute ground for refusal is sufficient (paras 43-44).

(iii) INFRINGEMENT OF ARTICLE 7(3) EUTMR.

As the mark applied for was devoid of distinctive character for the English-speaking public of the European Union, including Member States where English is an official language, namely Ireland, Malta and the United Kingdom, distinctiveness acquired through use needed to be proved, in particular with regards to this public (paras 54-56). The evidence provided mostly targeted the Greek territory and marginally other Member States where English is understood (Cyprus, the Netherlands, Sweden) for a period of less than 3 years (paras 60-64). Thus, there is no sufficient proof of distinctiveness acquired through use (para. 67).

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T-795/17; NEYMAR; Carlos Moreira v EUIPO; Judgment of 14 May 2019; EU:T:2019:329; Language of the case: EN

RESULT: Action dismissed

FACTS: The EUTM proprietor filed an application on 17 December 2012 and obtained registration of the word mark NEYMAR for goods in Class 25, namely clothing, footwear and headgear.

In February 2016, the Brazilian footballer Neymar Da Silva Santos Júnior filed an invalidity application pursuant to Article 52(1)(b) CTMR. The Cancellation Division upheld the invalidity application.

The EUTM proprietor appealed against this decision. The Board of Appeal (BoA) dismissed the appeal, finding that the applicant had acted in bad faith when he filed the application for registration of the contested mark, because he had known that Neymar Da Silva Santos Júnior — internationally known under his first name Neymar — was a rising star in football, whose talent was recognised internationally on the relevant date, and that the applicant had no motive other than to exploit Neymar's renown to benefit from it.

The EUTM proprietor filed an action with the General Court (GC), relying on a single plea in law: (i) infringement of Article 52(1)(b) CTMR.

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

The concept of bad faith relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct that departs from accepted principles of ethical behaviour or honest commercial and business practices (para. 23).

The evidence submitted shows that Neymar Da Silva Santos Júnior was already recognised as a very promising football player, having drawn the attention of top-flight clubs in Europe for future recruitment several years before his actual transfer to FC Barcelona in 2013. He was therefore already well known in the 'world of football' at the time the application for registration of the mark NEYMAR was filed (paras 31-33).

The EUTM proprietor possessed more than a little knowledge of the world of football, proven by the fact that he had filed an application for registration of the word mark IKER CASILLAS, corresponding to the name of another famous football player, on the same day that he sought registration of the mark 'NEYMAR' (paras 34 and 50).

As the mark, which consists of the single word element 'NEYMAR', corresponds precisely to the name under which Neymar Da Silva Santos Júnior became known for his football performances, it

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was inconceivable that the EUTM proprietor had not been aware of the footballer's existence on the relevant date (paras 36, 44 and 46).

The existence of bad faith on the part of the applicant for registration must be assessed, inter alia, in light of his intention. The intention of the applicant for registration at the relevant time is a subjective factor, which must be determined by reference to the objective circumstances of the particular case (para. 49).

It can be deduced from the objective fact that Neymar was already recognised as a very promising football player on the relevant date, and from the other objective fact that the EUTM proprietor had filed an application for registration of the word mark IKER CASILLAS on the same day, that the EUTM proprietor possessed more than a little knowledge of the world of football. In the light of only those factors and the particular circumstances of the case, the real purpose of the commercial logic behind the application for registration of the EUTM was to 'free-ride' on Neymar's reputation and take advantage of that reputation (paras 50-51).

T-197/16; ANDREA INCONTRI / ANDREIA et al.; Andrea Incontri v EUIPO; Judgment of 22 May 2019; EU:T:2019:347; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Lack of reasoning, Personal name mark, Right of defence

FACTS: The applicant sought to register the word mark ANDREA INCONTRI as an EUTM for the goods in Class 3. An opposition based on several earlier national marks and international registration (IR) ANDREIA, registered in respect of goods in Class 3, was filed pursuant to Article 8(1)(b) CTMR. The opposition was upheld on the basis of the earlier Portuguese mark for all the contested goods except for air fragrancing preparations.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal based on the earlier IR designating France and the United Kingdom. The BoA held that the words of which the mark applied for was comprised had no meaning, irrespective of whether or not they were perceived as a first name and surname, and that they were co-dominant in the overall impression. The first name does not convey a concept. Should the relevant public perceive the terms 'andrea' and 'andreaia' as first names, it would understand them as two versions of the same first name. The 'incontri' element might be considered a surname of Italian origin, though without any clear

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concept for a French or English consumer. It was not established that surnames were, in principle, of greater distinctiveness than first names.

The applicant filed an action to the General Court (GC). The GC annulled the BoA decision.

SUBSTANCE: (i) PROCEDURAL ISSUES

The application to alter a decision cannot be allowed in the absence of a claim for annulment. However, the head of claim may be interpreted in the light of the contents of the application as including a claim for annulment, even though it is not explicitly expressed in the head of claim itself (paras 18-19). For reasons of procedural economy and without it being challenged by the parties, the BoA based its examination on the IR which was not under the proof of use requirement. The applicant's argument in relation to the evidence of use of the goods designated by the earlier Spanish and Portuguese marks is therefore ineffective (para. 36).

(ii) ARTICLE 8(1)(B) CTMR

The BoA failed to have regard to whether the first name 'Andrea' and the surname 'Incontri' were common or rare, even though the applicant had claimed in the administrative proceedings that the 'andrea' element was a common first name and the 'incontri' element was rather a rare surname (para. 47). The Office only claimed (at the stage before

the GC) that the rarity of the first names 'andrea' and 'andrei' in France and the United Kingdom is based on a well-known fact. Non-compliance with the duty to state reasons cannot be regularised by the fact that the person concerned becomes cognisant thereof during proceedings before the EU judicature. The possibility for an EU institution or body to plead supplementary grounds for the first time before the GC, even if they are claimed to be well-known, in order to complete the grounds set out in the contested decision would undermine the rights of defence of the party concerned and its right to an effective judicial remedy, as well as the principle of equality of parties before the EU judicature (paras 53, 55-56). Since the BoA based its reasoning on two hypotheses without settling which of those hypotheses was correct, the GC cannot give precedence on any of them without substituting its own reasoning for that of the BoA (para. 57). The GC thus annulled the BoA decision.

T-609/18; d:ternity / iTernity; Fujifilm Recording Media v EUIPO; Order of 23 May 2019; EU:T:2019:366; Language of case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility

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FACTS: The EUTM proprietor obtained registration of the word mark d:ternity as an EUTM for goods and services in Classes 9, 35 and 42.

An invalidity application was filed pursuant to Article 53(1)(a) CTMR in conjunction with Article 8(1) (b) CTMR and Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR based on the earlier German word mark iTernity registered for goods and services in Classes 9, 35 and 42 and the company name iTernity. The Cancellation Division (CD) dismissed the invalidity application.

By a decision of 25 July 2018, the Board of Appeal (BoA) upheld the invalidity applicant's appeal. It annulled the decision of the CD and declared the contested trade mark invalid.

On 26 September 2018, the invalidity applicant informed the Office of the withdrawal of its invalidity application.

Subsequently, the EUTM proprietor requested that the BoA find that its decision of 25 July 2018 had become devoid of purpose as a result of the withdrawal of the invalidity application.

On 3 October 2018, the Office informed the applicant that the invalidity proceedings had been closed as a result of the withdrawal of the invalidity application and that the Office was unable to uphold the request for a declaration that the contested

decision had become devoid of purpose, since the proceedings before the BoA had been closed with the adoption of the contested decision.

On 16 October 2018, the Office informed the EUTM proprietor that, as a result of the withdrawal of the invalidity application, the BoA decision had become final on 3 October 2018, and the trade mark consequently remained registered.

On 5 October the EUTM proprietor brought an action before the General Court (GC), seeking the annulment of the contested decision or, alternatively, a declaration that the action before the GC had become devoid of purpose. It further asked the GC to order that the Office and the invalidity applicant bear the costs incurred in the proceedings before the BoA and before the GC.

SUBSTANCE: ADMISSIBILITY OF THE ACTION

(i) FORM OF ORDER SEEKING ANNULMENT OF THE CONTESTED DECISION

The admissibility of an action must be judged by reference to the situation prevailing when the application was lodged (para. 24). The applicant's interest in bringing proceedings must — in light of the purpose of the action — exist at the moment of lodging the action. The interest in bringing proceedings presupposes that the action must be liable, if successful, to procure an advantage to the

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party bringing it. If this is not the case, the action is inadmissible (para. 25).

The purpose of the action must prevail, as well as the interest in bringing proceedings, until the final decision. Failing this, there would be no need to adjudicate.

According to Article 71(3) EUTMR, 'decisions of the Board of Appeal shall take effect as from the date of expiry of the [2 months] period referred to in Article 72(5) or, if an action has been brought before the General Court within that period, as from the date of dismissal of such action or of any appeal filed with the Court of Justice against the decision of the General Court' (para. 26).

The invalidity application was withdrawn before the introduction of the action before the GC and before the expiry of the period for bringing an action before the GC. At the time of the withdrawal of the invalidity application, the contested decision had not yet taken effect and was not final (para. 27).

Where the invalidity application is withdrawn before the contested decision becomes final, the proceedings are otiose and become devoid of purpose (03/07/2013, T-10/01, Lichtwer Pharma v OHIM — Biofarma (Sedonium), EU:T:2003:182, § 16 and 02/12/2015, T-213/15, Super-Samstag, EU:T:2015:967, § 4) (para. 28).

Consequently, the contested decision had become otiose and obsolete before the applicant introduced the action before the GC. The decision could not take effect and become final 18/11/2003, T-383/02, GD Searle v OHIM — Phyto-Esp (CELEBEX), EU:T:2003:306 and 22/09/2016, T-237/15, NANO (fig.), EU:T:2016:529, § 70 (para. 29).

The EUTM proprietor did not have any interest in bringing proceedings since the annulment of the obsolete decision cannot procure any advantage for it (para. 30).

This finding is not called into question by the EUTM proprietor's argument that there is a risk for its international registration based on the EUTM to be cancelled if the Office notifies the contested decision to the International Bureau of the World Intellectual Property Organisation (WIPO) pursuant to Article 29(4) EUTMIR. According to that provision, a communication to WIPO is only required in cases where proceedings concerning an EUTM, which forms the basis of an international registration, have been closed by a final decision (para. 32).

Thus, the form of order seeking annulment of the contested decision is rejected as inadmissible.

(ii) FORM OF ORDER SEEKING THAT THE ACTION BEFORE THE GC BECAME DEVOID OF PURPOSE

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The action did not become devoid of purpose in the course of the proceedings before the GC. Since the contested decision was obsolete at the moment of the introduction of the action before the GC, the action was therefore already devoid of purpose at the moment of its introduction (para. 37).

(iii) COSTS

For reasons of equity, the GC ordered each party to pay its own costs since the information given by the Office before the introduction of the action was capable of questioning whether the contested decision was able to take effect, Article 135(3) RPGC.

T-364/18; MicroGarden; Arçelik v EUIPO; Judgment of 23 May 2019; EU:T:2019:355; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive

FACTS: The applicant sought to register the word sign MicroGarden for goods in Classes 7, 8, 9 and 11, such as machines, apparatus and tools for viticulture and agriculture.

The examiner refused the application pursuant to Article 7(1)(b) and Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal. The mark was held to be descriptive and devoid of distinctive character for English-speaking (average and professional) consumers. The two elements 'micro' and 'garden', and the word as a whole, designate a 'micro garden', that is to say a place for 'intensive cultivation in a small space'. Hence, the sign was found descriptive for all the goods as there was a sufficiently direct and specific link.

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

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

The relevant public consists of English-speaking general and professional consumers (not disputed) (para. 11).

The two terms are understood separately, without any thought being necessary, as designating, first, a very small element or object and, second, a place to grow plants. As the terms are combined in accordance with the rules of English grammar and common English linguistic practice, the relevant public will readily and immediately understand the compound expression 'microgarden' as designating a place for gardening or for 'intensive cultivation in a small space'. There is no perceptible difference

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between the meaning of the sign and that of the mere sum of its two components, 'micro' and 'garden'. Thus, the sign does not in itself constitute a neologism that is suggestive or allusive (para. 22). There is a direct and specific link between the sign applied for and the goods (paras 24-26).

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

The plea is rejected as one absolute ground for refusal is sufficient (paras 32-33).

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11/07/2019, R 381/2019-4, Light blue, dark blue, red

EUTM application



Outcome: IR designating EU allowed.

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

Keywords: Combination of colours.

Summary: The examiner issued an ex officio provisional partial refusal for the international registration designating the European Union for the combination of colours represented above (§ 2). Article 193(1) EUTMR provides that international registrations designating the EU shall be examined

on absolute grounds for refusal in the same way as directly filed applications for EU trade marks (§ 9). The Board notes that the three colours making up the representation of the mark are clearly separated, they can be remembered relatively easily, and their proportion is clearly defined, each of the three sections having an equal width. None of these colours represents the typical natural colour of the goods at stake (§ 15). It is not a sequence of irregularly arranged coloured fields or boxes, or a rainbow-like sequence representing the totality of the colour spectrum, or any other type of colour pattern which would be too complex for an average consumer to memorise easily (§ 18). Whilst it may be true that some of the goods refused regularly come in various colours (cars, shirts), it has not been established that these goods regularly come in a combination of three colours, vertically arranged. Especially as regards vehicles, the appellant correctly points out that it is not normal that cars are painted in three different colours, in equal proportions and prominence. For the other goods refused, a presentation in a combination of three colours is barely conceivable taking into account the nature of those goods, e.g. sunglasses or jewellery (§ 21). The appeal is upheld.

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10/05/2019, R 2378/2018-5, [Payper / Payper et al.](#)

Contested EUTM

PAYPER

Earlier EUTM and national TM

PAYPER

Outcome: Decision partially annulled.

Norms: Article 8(1)(b) EUTMR.

Keywords: Complementary goods and services, Conceptual identity, Identity of the signs, Likelihood of confusion, Phonetic identity, Similarity of the goods and services, Visual identity, Word mark.

Summary: The Opposition Division partially upheld the opposition on the grounds that there was a likelihood of confusion, for certain goods and services in Classes 9, 38 and 42. The opposition was, however, rejected for 'science services' in Class 42 (§ 6). The opponent filed an appeal; the applicant did not submit any observations in reply.

The Opposition Division took the view that the services in question are dissimilar (§ 29). It is a well-known fact that scientific entities deliver their

services through scientific apparatuses. Although the goods and services differ in their nature they are similar in purpose (§ 33-34). The opposing goods and services may target the same consumers; they are complementary (§ 37).

In the present case, as the marks are identical (§ 21) even a low degree of similarity between the goods and services is enough to conclude that there is likelihood of confusion (§ 47).

The appeal must therefore be upheld and the contested decision annulled in so far as it rejected the opposition for the contested 'science services' in Class 42 (§ 48).

17/05/2019, R 1839/2018-4, [Carmen](#)

Contested IR

CARMEN

Outcome: Decision confirmed.

Norms: Article 8(4) EUTMR, Article 137 EUTMR, Article 138 EUTMR.

Keywords: Ownership of IP right, Substantiation of earlier right.

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Summary: The cancellation applicant filed a request for a declaration of invalidity against the IR, based on Article 8(4) EUTMR in conjunction with Article 60(1)(c) EUTMR, alleging that the cancellation applicant is 'the proprietor of a non-registered trade mark CARMEN and the national top level domain name CARMEN.HU' (§ 2). The cancellation applicant filed additional pleadings and submitted items of evidence regarding use of the sign in Hungary (§ 5, 7). The Cancellation Division rejected the request in its entirety considering that the cancellation applicant had not submitted sufficient information concerning the interpretation of the legal protection granted to the non-registered trade mark invoked and any evidence to show that the IR holder was present on the Hungarian market (§ 8).

The Board finds that the Hungarian Act on the Prohibition of Unfair Trade Practices and Unfair Competition do not relate to 'earlier rights' within the meaning of Article 8(4) EUTMR (§ 15-16). The Competition Act does not contain any provision that establishes rights in a sign through use. It merely bans practices in trade which are unfair. This prohibits certain activities as such, but does not generate subjective exclusive rights, industrial property rights, in the name of a plaintiff (§ 21).

Article 63(2) EUTMR (a provision that was not expressly relied on by the cancellation applicant and must not be taken into account as a basis for cancellation) refers to 'other earlier rights', which can be adduced only in a cancellation request, but which still must be 'rights'. Upholding claims of the kind presented by the cancellation applicant would clearly be contrary to the structure of the EUTMR (§ 27).

Also for the sign 'CARMEN.HU' characterised by the cancellation applicant as a 'national top level domain name', the same legal provisions were invoked by the cancellation applicant. Conversely, the cancellation applicant has not even argued that there is any provision in Hungarian law that protects domain names as a separate category of industrial property right. Therefore the same conclusions apply as in respect of the sign 'CARMEN' (§ 28). The appeal is dismissed.

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17/06/2019, R 0033/2019-5, christian SINGLES (fig.)

17/06/2019, R 0035/2019-5, christian SINGLES (fig.)

17/06/2019, R 0036/2019-5, cristianos SOLTEROS (fig.)

17/06/2019, R 0037/2019-5, cristianos SOLTEROS (fig.)

17/06/2019, R 0038/2019-5, chrétiens CELIBATAIRES (fig.)

17/06/2019, R 0039/2019-5, chrétiens CELIBATAIRES (fig.)

Contested EUTM(s)



Outcome(s): Application partially rejected

Norms: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR

Keywords: Figurative trade mark

Summary: The examiner rejected the EUTM applications (as represented above) under Article 7(1)(b) and (c) EUTMR, for part of the goods and services (§ 1).

The word elements 'christian SINGLES', 'cristianos SOLTEROS' and 'chrétiens CELIBATAIRES' are purely descriptive in the context of the services applied for (entertainment, sport, cultural activities in Class 41 and matchmaking or related services in Class 45). The relevant English-, Spanish- and French-speaking consumers will immediately understand the signs as: Single Christian faith and/or Single Christians.

All the services in Class 41 can be tailored to the Christian faith, such as the use of religious values and leadership of the Christian faith. At the same time, these services may be targeted at single people (this is clearly indicated in the text of the services). The same applies to the services in Class 45, which may correspond to, or be tailored to, Christian values. The nature of such services depends, in particular, on those who wish to make new contacts or enter into new partnerships.

The figurative element of the Eucharistic fish symbolises Christianity (it is one of the oldest symbols) and merely reinforces and underlines the meaning of the word elements. The Board notes that it increases the relevant consumer's impression that the word elements represent services aimed

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at Christians (singles). The figurative element has no special features or details that could be easily memorised by the relevant public. As a whole, the contested applications describe the nature and the intended purpose of the services in question. The appeal is dismissed.

07/06/2019, R 982/2018-2, DEVICE OF A SILHOUETTE OF A MAN WITH A PIPE (fig.)

Contested EUTM



Outcome: Decision confirmed.

Norms: Article 58 EUTMR, Article 95(2) EUTMR, Article 27(4) EUTMDR.

Keywords: Function of trade mark, Belated evidence.

Summary: The Cancellation Division revoked the figurative trade mark representing the silhouette of the famous Conan Doyle character, Sherlock

Holmes, for goods in Class 16 (for, inter alia, books, publications, stationery) Class 28 (inter alia, toys) and services in Class 41 (related to, inter alia, entertainment) because of its lack of genuine use (§ 6).

The EUTM proprietor filed additional evidence before the Boards. The Board will exercise its discretion to review the evidence submitted outside the time limit and accepts such belated evidence since it could strengthen and clarify the genuine use claim and it was submitted due to the result of the contested decision (§ 34).

However, the Board considers the evidence not sufficient to prove the genuine use of the trade mark because it mostly consists of agreements of a different nature (such as royalty or licence agreements) that do not show exactly if, and how much, the EUTM has been effectively used in the European Union (§ 36, 42). Screen-shots do not establish the intensity of the alleged commercial use of the rights relied on. Moreover, most of the evidence has not been accompanied by necessary details such as the date or the place to which it refers (§ 40).

Despite the abundant exhibits filed by the EUTM proprietor, the only conclusion to be reached is that the fictional character, Sherlock Holmes, is the subject of countless books, novels and films, and that his fame has a global reach. However, the evidence does not come close to establishing use of the challenged mark in relation to the goods and services covered (§ 46). The contested decision is upheld.

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