

# Alicante News

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Up to date information on IP and EUIPO-related matters



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### Effective Dispute Resolution for SMEs at the EUIPO

Europe's economy depends on SMEs. They make up over 99% of all EU businesses, generated EUR 4.3 billion worth of value in 2019 and account for two thirds of overall employment.

The EUIPO's SME Scoreboard study, launched in 2019, showed that, after registering their IP rights, 54 % of SME owners claimed to have seen a positive impact. The main impacts identified were an increase in reputation (52 %), turnover (39 %) and ability to access new markets (37 %).

But the economic crisis caused by the COVID-19 pandemic has repercussions for SMEs too, and supporting them is at the heart of the EUIPO's Strategic Plan 2025. In fact, the EUIPO brought forward measures due to be launched next year to respond effectively to the current crisis, creating a special [Ideas Powered for Business hub](#) aimed at SMEs which hosts a number of services geared to allowing them to access their IP rights more effectively and efficiently.

A key component of this initiative is personalised IP support for SMEs, available on application, which can take the form of IP pro-bono services offered by legal volunteer experts or effective dispute resolution, a new initiative which aims to provide a range of tailored mechanisms to best suit the varied



needs of SMEs in inter-partes proceedings pending before the EUIPO.

Effective dispute resolution consists of mediation, conciliation, assisted negotiation and expert determination, all managed by experienced EUIPO case handlers, and all free of charge to SMEs. Online dispute resolution has also been developed, allowing all of the services offered to be accessed remotely.

Mediation has been offered by the EUIPO since 2011, and is a process in which the two parties to a dispute, guided by a mediator, reach an amicable settlement of their differences pending at the EUIPO. The decision to enter into mediation is purely voluntary and requires the consent of both parties; it can be requested directly via the EUIPO website.

Conciliation is a related, but different, process in which a conciliator, once appointed by the parties, suggests possible solutions to the dispute, which are then discussed with the parties involved.

Assisted negotiation allows an expert EUIPO case handler (facilitator) to coach and guide an unrepresented SME towards reaching the best possible settlement. The facilitator can assess the underlying circumstances of the dispute, coach on appropriate strategies, manage relationships and engage the opposing party in effective dialogue.

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Expert determination is a process in which an EUIPO case handler appointed by the parties gives a binding or non-binding opinion on the matters that have been submitted for determination. Typically these matters would be technical or legal issues that form part of the overall dispute, but on which the parties are unable to agree.

The aim of effective dispute resolution is to provide a full range of options to SMEs; options that can assist them in accessing their IP rights. Given the limited resources at the disposal of many SMEs, effective dispute resolution provides a cost-effective way to try to resolve a dispute, which can in turn benefit all parties.

[Find out more about EDR at the EUIPO.](#)

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## Enhanced front office goes live in Ireland

The Intellectual Property Office of Ireland (IPOI) has successfully implemented a new front office for e-filing, as well as various improvements on e-filing and e-services for both trade marks and designs.

The IPOI implemented the Technical Stack Upgrade (TSU) of Software Package Front Office (SPFO) and the improvements on 30 June 2020.

The enhanced digital platform brings to the IPOI the full benefits of the latest version of front office, including a more modern portal functionality and improved performance, which contribute to a **better user experience**.

E-filing and e-services improvements for trade marks and designs have also been developed and implemented with the EUIPO support. IPOI users can now electronically **submit their applications in a user-friendly and simple way with improved registration times**.

In addition to significant operational efficiencies to processing fees, the IPOI can now electronically accept 58 different types of fees (34 for trade marks and 24 for designs).

## HDB in TMclass extended to Georgia

On 13 July, the National Intellectual Property Center of Georgia ([Sakpatenti](#)) began to use the list of terms from the harmonised database of goods and services (HDB) in [TMclass](#).

Georgian speaking users can now search and select almost 60 000 goods and services in their own language for their trade mark applications.

## Montenegro joins DesignClass

On 13 July, the [Ministry of Economy of Montenegro](#) became part of [DesignClass](#).

Montenegro will now use and accept the list of terms from the harmonised database of product indications (HDBPI) in [DesignClass](#).

## European Cooperation: Over 600 certifications for IP offices

The EUIPO has attained 635 certifications in the framework of the European Cooperation Project 'ECP5 Project Management Certification for IP offices', reaching the majority of the participating intellectual property offices of the EU since the project began in 2016.

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Within the EUIPO's Strategic Plan 2020, this cooperation project aimed to support staff members from all national and regional IP offices of the EU to get certified in two different levels of the PRINCE2® Project Management methodology, Foundation and Practitioner.

The PRINCE2® (PRojects IN Controlled Environments) is a widely used methodology, which is scalable and easily tailored to any kind of project and recognised by all EU institutions and international organisations.

During the five years of the project, 464 Foundation certifications have been obtained, surpassing the initial objective of 400 Foundation certifications. Despite the current constraints for physical training sessions with the COVID-19 pandemic, more certifications are expected in the next months, building the ground for a raising number of Practitioner certifications and Project Management Offices (PMO).

As requested by IP offices, the project will continue, also including new types of certifications, as part of the portfolio of [European Cooperation Projects](#) under the new [Strategic Plan 2025](#).

## European Cooperation: Completion of ECP5 Capture and Store Historical Files in Bulgaria

More than 3.3 million pages, amounting to 77 000 separate trade mark dossiers, have been digitised in the [Patent Office of the Republic of Bulgaria](#) (BPO) as a result of the Capture and Store Historical Files project.

The project, carried out within the framework of the European Cooperation Projects, aims at digitising paper files across the national and regional intellectual property offices of the EU to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

The Bulgarian Patent Office started the project in 2019 with the support of the different teams at the EUIPO and BPO. Despite challenges in recent months due to COVID-19, the project was completed by June 2020, as scheduled.

One of the important contributions of this implementation for the IP community has been the development by BPO of the MEST Metadata Extraction Support Tool (MEST). The tool allows for the introduction of an Optical Character Recognition scanning process that is capable of extracting data from scanned documents, in order to facilitate the decisions capture process.

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Seven Intellectual Property Offices have now completed the project, with another five in progress.

**The total number of dossiers digitised currently stands at more than 850,000.**

The completion of the digitisation process in the Bulgarian office marks the next step in the ultimate goal of the project: to support the participating offices in creating a paperless working environment and to help users interact digitally with the national and regional intellectual property offices of the EU.

## The Dominican Republic and Saint Kitts and Nevis join TMclass

On 27 July 2020, the [National Industrial Property Office of the Dominican Republic](#) (ONAPI) and the [Intellectual Property Office of Saint Kitts and Nevis](#) (IPOSKN) became part of TMclass.

ONAPI will use and accept the list of terms from the harmonised database of goods and services (HDB) in TMclass and IPOSKN will join the tool with a list of common terms between HDB and WIPO's Madrid Goods and Services (MGS).

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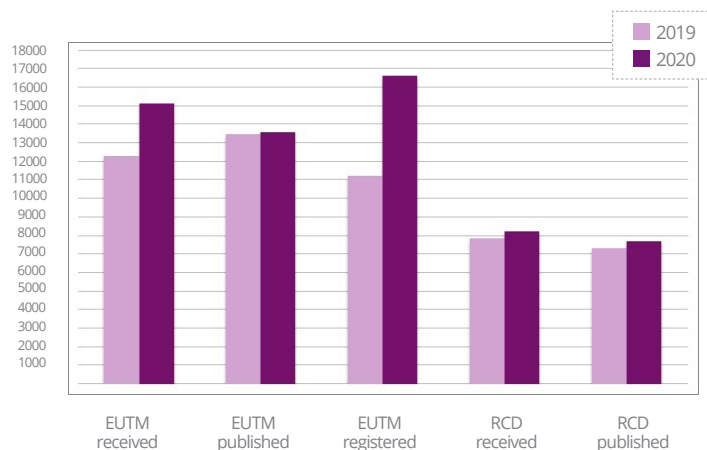
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## Statistical Highlights

Monthly statistical highlights June*	2019	2020
European Union Trade Mark applications received	12 299	15 117
European Union Trade Mark applications published	13 457	13 563
European Union Trade Marks registered (certificates issued)	11 212	16 624
Registered Community Designs received	7 823	8 199
Registered Community Designs published	7 300	7 672

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



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## EUIPO Trade Mark Focus Report: 2010-2019 Evolution

This new report, showing the progressive success of the European Union trade mark (EUTM) over the last decade, builds upon and updates the first edition of the Trade Mark Focus Report published in 2018.

Nearly 1.27 million EUTM filings in over 3.4 million goods and services classes were filed from 2010 to 2019, which equates to an average annual growth rate of 5.6 % and an overall growth rate of 63.1 % when comparing the 2019 and 2010 filing volumes.

The commercial appeal of the European Union common market is highlighted by the presence of the world's two largest economies (the United States of America and the People's Republic of China) in the Top 10 ranking of countries with the most EUTM filings. The United States occupies second position overall and China has experienced remarkable growth that has vastly outpaced the other Top 10 countries. Indeed, the EU share of total filings fell from 71.3 % at the beginning of the decade to 64.7 % in 2019, while China evolved from being a small player in 2010 (1.4 %) to being the third largest country of origin by the end of the decade (9.5 %).

The Top 10 EUTM applicants are all large multinational enterprises and market leaders in their respective sectors. However, they collectively represent just 1.3 % of overall EUTM applications,

or some 497 000 different applicants, the majority of which are small and medium enterprises (SMEs).

Applications from the EU and other regions of the world seeking protection for electrical apparatus and computers and/or scientific and technological services experienced significant increases during the last decade, while filings for goods such as clothing, pharmaceutical, cosmetics and food grew at lower rates.

Detailed information on filing volumes and rates per top countries, applicants and classes are included in the report for analysis, as well as pertinent data on associated administrative procedures such as examination, publication, registration, opposition, cancellation and renewal.

[Read the report.](#)

## Trends in Third Party Observations filed for Trade Marks in 2019

Third-party observations (TPOs) enable the general public to intervene in the registration procedure by informing the European Union Intellectual Property Office (EUIPO) that a European Union trade mark application (EUTM application) should have been refused, in particular, under Article 7 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (EUTMR).

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The legal basis for TPOs lies in Article 45 EUTMR and the Communication No 02/09 of the Executive Director. After receiving TPOs, the EUIPO analyses whether the examination of the corresponding EUTM application should be reopened.

Let's have a look at the trends of the TPOs filed during 2019 and compare it with previous years (2009-2019).

## 1. TPOs filed

As shown in Table 1 below, 289 TPOs were filed in 2019. Compared to the 160 408 EUTM applications filed in that year, the number of TPOs filed is small, corresponding to just 0.18 % of the EUTM applications.

The number of EUTM applications nearly doubled during the period 2009-2019. However, the number of TPOs filed, despite some fluctuations, has remained quite stable in proportion.

The percentage of TPOs filed during this period has never exceeded 0.24 % of the EUTM applications filed, with the lowest percentage occurring in 2009 (0.13 %), and the highest in 2011 with 0.24 %. The average percentage of TPOs over this period has been around 0.20 %.

Table 1: Comparison EUTM applications/TPOs filed

	Total EUTMAs	TPOs filed	%
2009	88,289	117	0.13%
2010	98,349	186	0.19%
2011	105,914	249	0.24%
2012	107,962	201	0.19%
2013	114,413	232	0.20%
2014	117,456	230	0.20%
2015	130,407	191	0.15%
2016	135,259	227	0.17%
2017	146,409	216	0.15%
2018	152,495	297	0.19%
2019	160,408	289	0.18%

Source: EUIPO, TPO Database

**Chart 1** below shows an overall analysis of the EUTM applications per type filed during the period 2009-2019.

The most popular trade mark types filed during this period are word and figurative marks, whereas the other types of marks, such as colour and position marks, represent a much smaller number.

This trend reflects on the types of marks for which the TPOs were filed, as shown in Table 2 below. In 2019, almost all the TPOs filed concerned word and figurative marks (97.9 %), and only a small percentage concerned 3D marks (0.7 %). The remaining 1.4 % concerned marks other than these three types, such as colour and position marks.

During 2009-2019, most EUTM applications were filed for word marks, and this trend was reflected in the numbers of TPOs until 2016. Since 2017, the

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trend has reversed, and most TPOs filed concerned figurative marks.

Table 2: TPOs filed per type

	TPOs	Word	Figurative	3D
2009	117	61.5%	38.5%	0.0%
2010	186	53.2%	46.2%	0.5%
2011	249	50.6%	49.0%	0.4%
2012	201	53.7%	44.3%	2.0%
2013	232	56.9%	41.4%	1.7%
2014	230	55.2%	44.8%	0.0%
2015	191	50.8%	49.2%	0.0%
2016	227	55.9%	43.2%	1.0%
2017	216	49.1%	50.5%	0.5%
2018	297	44.4%	54.5%	0.7%
2019	289	46.0%	51.9%	0.7%

Source: EUIPO, TPO Database

## 2. TPOs that reopen the examination

If the analysis of a TPO raises doubts, the EUIPO reopens the corresponding EUTM application for a further examination.

**Chart 2** shows how many TPOs were filed per year from 2009 to 2019, and how many of them led to the reopening of the examination of the EUTM applications.

In 2019, 75 out of 289 TPOs were reopened for a re-examination of the EUTM application, representing 26 % of the TPOs filed.

The number of EUTM applications reopened for examination has been irregular since 2009, fluctuating between 22 % in 2009 and 2010, and 36 % in 2013.

The figure for 2019 (26 % of cases reopened) is in line with the average of 27 % of cases reopened for the period 2009-2019. (In total, 2 435 TPOs have been received since 2009 and only 676 triggered the re-examination of the file).

## 3. Geographic TPOs

Geographic TPOs include protected geographical indication (PGI) or protected geographical designation of origin (PDO) and 'simple' geographic terms. Those TPOs mainly claimed refusal on the basis of Article 7(1)(g) EUTMR [deceptiveness], Article 7(1)(j) EUTMR [protection of PDOs/PGIs] and Article 7(1)(f) EUTMR [marks against public policy and morality].

In 2019, 109 TPOs involving a geographic term were filed, representing 38 % of the total number of TPOs filed. Out of those cases, only 23 led to the reopening of the case (21 %), which is less than the overall average rate of reopening (26 %).

The average number of geographic TPOs for 2019 has slightly decreased compared with the broader period going from 2009 to 2019 when 42 % of the TPOs filed involved a geographic term with a peak of 67 % in 2015.

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## 4. TPOs filed by Absolute Grounds

As shown in **Chart 3 below**, the most frequently invoked grounds in 2019 were:

- Article 7(1)(c) EUTMR, on the descriptiveness of the sign (135 instances);
- Article 7(1)(b) EUTMR, on lack of any distinctive character (133 instances);
- Article 7(1)(g) EUTMR, on deceptiveness (129 instances).

On the contrary, the least frequently invoked grounds in 2019 were:

- Article 7(1)(l) EUTMR, on traditional specialties guarantee, with no instances;
- Article 7(1)(m) EUTMR, on the protection of plant variety denominations, with one instance;
- Article 7(1)(e) EUTMR, on the natural or functional shape of a good, with two instances.

One noticeable trend is that of filing TPOs with multiple grounds. In 2019, almost all the TPOs, 253 out of 289, were based on more than one ground (representing 87 % of the total TPOs filed, against 67 % the previous year).

In 2016, the new EUTMR merged the texts for paragraphs (j) and (k) of Article 7 in one ground, (j), which covers conflicts with a PDO and PGI irrespective of the agricultural sector. It explains

the peak of Article 7(1)(j) TPOs after 2017. The new EUTMR also introduced new grounds under Article 7(1)(k), traditional terms for wines, (l), traditional specialties guaranteed, and (m), plant variety denominations.

Regarding these 'new absolute grounds for refusal', in 2019, and as shown in Chart 3 below, 75 TPOs were based on Article 7(1)(j) EUTMR, 19 on Article 7(1)(k) EUTMR, only one on Article 7(1)(m) EUTMR, and none on Article 7(1)(l) EUTMR.

Throughout the relevant period, the three most invoked grounds have always been Articles 7(1) (b), (c) and (g) EUTMR, and the least invoked ones Articles 7(1)(e) and (i) EUTMR (the 'new absolute grounds' are not included).

The general trend seems to be one of fluctuating grounds. The most invoked grounds had continual ups and downs, as did the other grounds, in particular Articles 7(1)(d), (f) and (j) EUTMR.

In conclusion, the number of TPOs received and reopened for examination by the Office in 2019 remained stable compared to previous years and small compared to the number of the EUTM applications filed. There is a tendency to refer to more than one ground in these observations. The number of TPOs in relation to geographical terms remain relatively high.

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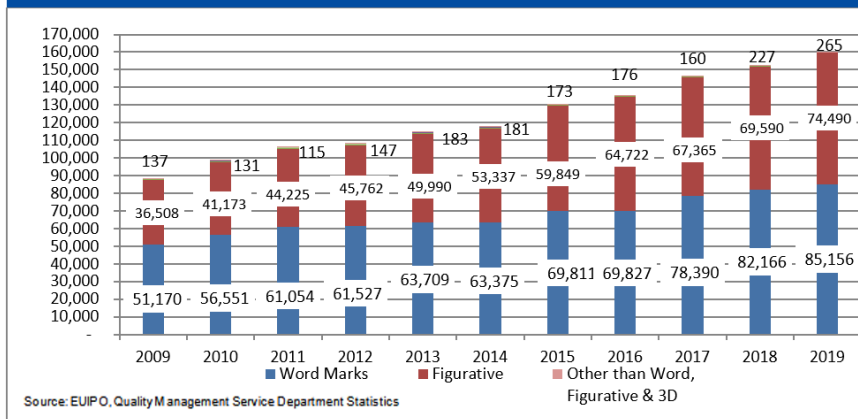
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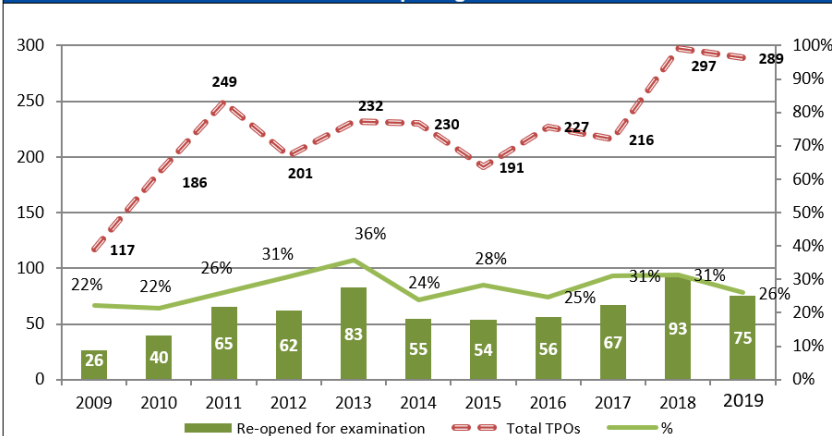
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**Chart 1. Total EUTM applications filed per type**



**Chart 2. TPOs that led to reopening the examination 2009-2019**



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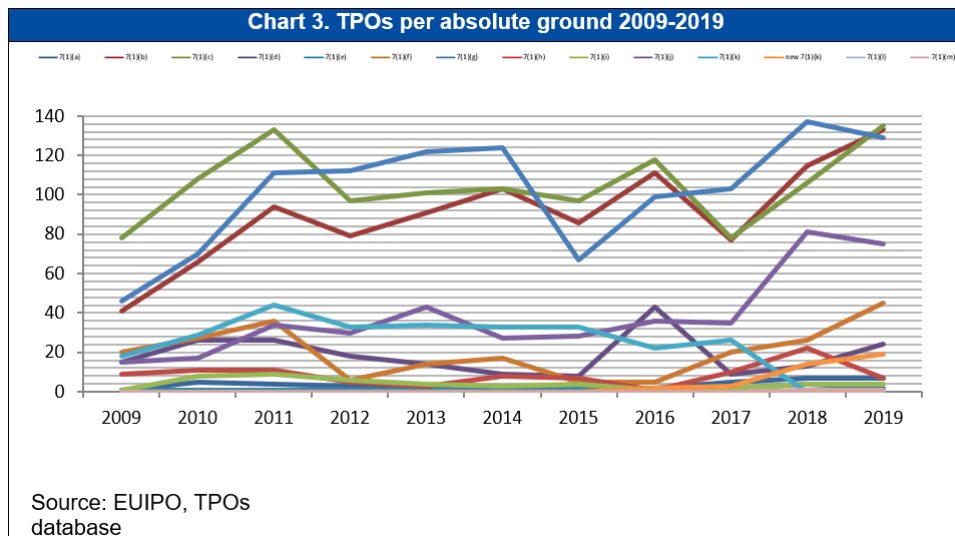
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Chart 3. TPOs per absolute ground 2009-2019



Source: EUIPO, TPOs database

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## EUIPO joins the WIPO Digital Access Service (DAS)

From 11 July 2020, the EUIPO became an Office of First Filing, making priority documents for designs (RCD) available in DAS.

The WIPO Digital Access Service (DAS) helps you meet the [Paris Convention's](#) requirements for providing priority and similar documents to participating offices, without the need to obtain and send multiple certified paper copies of an application. Instead, simply ask the office where you are claiming the priority (the Office of Second Filing) to directly download a copy of the document from DAS.

By agreeing to allow the EUIPO to send a record of your RCD application (first filing) to WIPO, the EUIPO will provide you with a DAS code that can be used to claim priority for subsequent filings made with other [participating intellectual property \(IP\) offices](#).

To use this feature, applicants should leave the corresponding checkbox ticked in the EUIPO RCD e-filing form. Upon completing the RCD e-filing, the DAS code will be provided in the application receipt, which is generated upon the submission of the application online. The corresponding DAS code can then be used to claim priority for subsequent filings made to other IP offices.

The EUIPO has introduced fast-track changes to its [guidelines](#) to reflect this new service.

The EUIPO will be acting as an Office of Second Filing later in the year, whereby we will accept priority claims indicated by a DAS code. There will be no need for the applicant to submit any documents. Instead, the code provided in the priority claim will allow the EUIPO to request the immediate download of the priority document registered in DAS.

## Academy webinars

This month, the EUIPO Academy has a number of new courses to explore, as well as a rundown of the most popular webinars to date.

The nine module e-learning [Proof of Use course](#) gives an overview of the legal framework and Office practice (as reflected in the EUIPO Guidelines) in opposition cases involving a request for proof of use under Article 47 EUTMR (including how the evidence submitted is assessed). All modules contain supporting material (e.g. previous EUIPO decisions, webinars, articles and CJEU decisions, as well as real examples and items of evidence).

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## Our most popular webinars throughout 2020:

These webinars are all available to watch again through the EUIPO Academy Learning Portal.

- Arguments of the parties: most frequent arguments presented by parties and how to deal with them: In opposition and cancellation proceedings, parties very often repeat the same arguments, which are dismissed for a variety of reasons. This webinar explores recurrent arguments and gives tips on how to present them in a better light. It also provides an insight into the impact such arguments have on the decision-taking process. [View the webinar here.](#)

- New EUIPO Guidelines: In this webinar, some of the main changes to the latest edition of the EUIPO Guidelines are explained in a panel discussion with experts from the areas affected. The new edition of the EUIPO Guidelines entered into force on 1 February 2020. [View the webinar here.](#)

- Joint EUIPO/EPO webinar: video gaming and how to play the game. This webinar investigates the intricate bundle of technical and non-technical IP rights behind video games. With the video game design, development and commercialisation landscape evolving so rapidly, the 'what' and the 'how' of protecting the IP of video game components can

present a challenge. [View the webinar here.](#)

- How much protection for GIs? Recent case-law: This webinar provides some insight into the 2019 CJEU judgments and BOA decisions in the area of geographical indications (including Manchego, Aceto Balsamico, and Glenn). [View the webinar here.](#)

- Decisions of the trimester of the GC and CJEU, first trimester 2020: An overview of the most relevant decisions taken by the Court of Justice of the European Union in the first trimester (including SKY, Fack Ju Göthe, and BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al. [View the webinar here.](#)

Remember, you can access all our webinars and e-learning materials through [euipo.europa.eu/knowledge](http://euipo.europa.eu/knowledge)

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### Overview of CJ/GC Case-law (Status: 01/01/2019 – 30/04/2020)



The Litigation Service of the International Cooperation and Legal Affairs Department prepares this [Overview of CJ/GC Case-law](#).

It contains a systematic compilation of the key points of judgments and of orders rendered by the Court of Justice and the General Court of the European Union on actions brought against decisions taken by the Office's Boards of Appeal (BoA) in trade mark and design matters. It also contains key points of judgments rendered by the Court of Justice in preliminary rulings on IP rights and their enforcement. The key points consist of new or infrequent statements or statements that, while not new, are relevant in confirming established case-law. Please note that the key points do not necessarily reproduce the exact wording of the judgments or orders. Each key point is preceded by keywords to allow the user to quickly identify the case-law of interest and the relevant issues.

The hyperlinks in the case reference lead to the Office's eSearch Case Law database, giving the user easy access to the full text of the judgment or order, together with any available translations of them, a summary of the case, and also further relevant information and documents (e.g. first instance and BoA decisions) and a link to the InfoCuria Database of the Court of Justice of the European Union. This compilation will be constantly updated with the corresponding key points of future judgments and orders, allowing users to search quickly and easily the most recent case-law.

### Luxembourg trade mark and design news

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

**18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA, EU:C:2020:489.**

**RESULT:** Appeal well founded (GC decision entirely annulled and case referred back to the GC)

**KEYWORDS:** Admissibility, Examination of facts ex officio, Modification of subject-matter before Court, Weak element

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### FACTS:

The applicant sought to register the figurative sign 'PRIMART' as an EUTM for goods in Class 30. Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on the earlier Spanish word mark PRIMA, registered for goods in Class 30. The Opposition Division dismissed the opposition in its entirety.

The opponent filed an appeal. The BoA upheld the appeal, refusing the trade mark application in its entirety. The BoA found that, due to the identity and similarity of the goods and the similarity of the signs, there was likelihood of confusion (LOC) on the part of the relevant public. The BoA also found that the level of inherent distinctiveness of the earlier mark was average, because it has no meaning with regard to the goods concerned. The BoA also noted that the Spanish consumer would understand the word 'prima' as meaning 'female cousin' or 'bonus payment', and not as denoting the excellence of something, as is the case in other languages of the European Union.

The applicant filed an action with the General Court (GC), relying on a single plea in law alleging infringement of Article 8(1)(b) CTMR. The GC dismissed the action in its entirety (12/09/2018, T 584/17, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:T:2018:530) and upheld the BoA's findings. In particular, it held that the applicant's argument concerning the weak distinctive character of the earlier mark inadmissible on the basis of Article

76(1) CTMR, as that argument had been put forward before it for the first time.

The applicant appealed against this judgment to the Court of Justice (CJ) relying on a single ground of appeal: infringement of Article 76(1) CTMR, read in conjunction with Article 65 CTMR.

### EUTM Application



### Earlier trade mark

PRIMA

### SUBSTANCE:

#### ADMISSIBILITY.

The allegation that the GC misinterpreted and misapplied Article 76(1) CTMR by declaring the appellant's argument concerning the weak distinctive character of the earlier mark inadmissible on the ground that that argument had been put

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forward before it for the first time, is a question of law that may be subject to review on appeal (§ 26).

INFRINGEMENT OF ARTICLE 76(1) CTMR.

SCOPE OF REVIEW BY THE GC.

The BoA is required to decide on all issues that, in the light of the facts, evidence and arguments provided by the parties and the relief sought, are necessary to ensure a correct application of the CTMR and in respect of which it has all the information required in order to be able to take a decision, even if no element of law related to those issues has been relied on by the parties before it (§ 41).

In opposition proceedings based on Article 8(1) CTMR, the assessment of the inherent distinctive character of the earlier mark constitutes an issue of law that is necessary to ensure the correct application of that regulation: the instances of the Office are required to examine that issue, of their own motion if necessary, and it forms part of the subject matter of the proceedings before the BoA within the meaning of Article 188 of the RoPGC (§ 43).

Therefore, the GC erred in law by declaring the appellant's argument concerning the allegedly weak distinctive character of the earlier mark inadmissible

on the ground that that argument had been put forward before it for the first time (§ 47).

That error of law is capable of leading to the setting aside of the judgment under appeal: it cannot be ruled out that the GC would have reached a different conclusion if it had regarded the applicant's arguments relating to the weak distinctive character of the earlier mark as admissible and found that there was no LOC (§ 52-53, 12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 55).

Even assuming that the GC, in paragraphs 91-92 of the judgment under appeal, briefly examined the arguments put forward by the applicant concerning the weak distinctive character of the earlier mark and rejected them as unfounded, the judgment under appeal should be set aside on the ground of inadequate reasoning, that is a matter of public policy (20/12/2017, C-677/15 P, EUIPO v European Dynamics Luxembourg and Others, EU:C:2017:998 § 36) (§ 59-62).

Since the state of the proceedings in the present case does not permit a final judgment to be issued, the case must be referred back to the GC (§ 65-66).

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18/06/2020, C 142/19 P, PLOMBIR, EU:C:2020:487

**RESULT:** Appeal dismissed

**KEYWORDS:** Descriptive element, Distortion of facts or evidence, Lack of reasoning

### FACTS:

The proprietor registered the word sign PLOMBIR for goods in Classes 29 and 30. An application for declaration of partial invalidity was filed pursuant to Article 59(1)(a) EUTMR and Article 7(1)(c) EUTMR. The Cancellation Division granted the application for a declaration of invalidity for milk and milk products and ices. The proprietor filed an appeal.

The BoA annulled the Cancellation Division's decision, finding that the invalidity applicant had not shown that the Russian word was understood in the EU, and in particular not in Germany.

The invalidity applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of the principle of ex officio examination of the facts provided for in Article 95(1) EUTMR and (iii) infringement of the obligation to state reasons provided for in Article 94 EUTMR. The GC upheld the action (13/12/2018, T-830/16, PLOMBIR, EU:T:2018:941). It stated that the BoA had infringed Article 95(1) EUTMR since it had not taken account of the invalidity applicant's argument, according to which many consumers

of the Baltic States were familiar with the Russian language, and had not examined whether this was a well-known fact. It stated that the BoA had committed an error of assessment in determining the relevant public and had infringed Article 7(2) EUTMR, since the relevant public was the Russian-speaking public, including the part of the general public within the EU who understood or spoke Russian living in Germany and the Baltic States. It concluded that, insofar as the term 'plombir' constituted a faithful transliteration of the term 'Пломбир' into letters of the Latin alphabet and was understood by the relevant Russian-speaking consumer within the EU, the sign was descriptive for the goods.

The proprietor appealed against this judgment to the CJ, relying on four grounds of appeal: (i) distortion of evidence, (ii) default on the obligation to state reasons provided for by Article 296 TFEU, (iii) infringement of Article 85(3) RPGC and (iv) infringement of Article 85(1) RPGC.

### SUBSTANCE:

(i) DISTORTION OF EVIDENCE.

The first plea is rejected as ineffective in part as it cannot lead to the annulment of the judgment. Whether or not Russian is understood in Germany, and whether the GC committed an error in finding that Russian was understood in Germany, is

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irrelevant, as the judgment still stands on the basis of the well-known fact established by the GC that Russian is understood in the Baltic States. The GC therefore did not distort the facts in that regard (§ 41-43).

The remaining parts of the plea are rejected as unfounded since distortion of evidence can be found only where, without recourse to new evidence, the assessment of the existing evidence appears to be substantially incorrect or where it is manifestly apparent that the GC has distorted the evidence (§ 44-48, 50-55).

(ii) DEFAULT ON THE OBLIGATION TO STATE REASONS.

The plea is rejected as unfounded. Although the GC did not state whether the level of command of Russian in the Baltic States is that of a native speaker, it did adequately reason that it had been proven that 'Plombir' was used in everyday Russian (§ 68-71, § 72-74).

(iii) INFRINGEMENT OF ARTICLE 85(3) RPGC.

The appellant's plea that the GC infringed Article 85(3) RPGC by refusing to consider the judgment of the 'Bundesgerichtshof', submitted belatedly at the hearing, is rejected as ineffective since the judgment could not have any effect on the operative part of the contested judgment (§ 82 87).

(iv) INFRINGEMENT OF ARTICLE 85(1) RPGC.

The plea directed against a ground included in the GC's judgment purely for the sake of completeness cannot lead to the judgment being set aside and is therefore rejected as ineffective (§ 91-93).

**11/06/2020, C 115/19 P, CCB (fig.) / CB (fig.) et al., EU:T:2020:469**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Distinctive element, Lack of reasoning, Similarity of the signs

**FACTS:**

The applicant sought to register the figurative mark CCB as an EUTM for the following services in Class 36: banking; financial evaluation (insurance, banking, real estate); financing services; credit card services; deposits of valuables; antique appraisal; brokerage; guarantees; fiduciary.

Pursuant to Article 8(1)(b) and Article 8(5) CTMR, an opposition was filed based on the earlier figurative EUTM CB for services in Class 36, including insurance and finance; financial affairs, monetary affairs, banking; ... management of banking and monetary flow by electronic means; ... issuing of and services relating to prepayment cards, debit cards, credit cards, cash withdrawal cards ...; electronic

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payment ...; financial transactions by card holders via automated teller machines; authentication and verification ...; financial information via all means of telecommunication. The Opposition Division (OD) upheld the opposition. It found that there was a LOC and did not examine the ground under Article 8(5) CTMR.

The BoA dismissed the applicant's appeal. It found that the earlier mark enjoyed a reputation in France, as was previously established in case R-944/2013-4 relating to the opposition proceeding between the opponent and the applicant. Due to the identity of the services covered by the signs, the signs' similarity, the earlier mark's reputation in France, and the relevant public's above-average level of attention, the BoA concluded that there was a LOC.

The applicant filed an action before the GC alleging the infringement of Article 8(1)(b) CTMR. The GC dismissed the action.

The applicant filed an action before the CJ, relying on three pleas in law: (i) infringement of Article 8(1)(b) CTMR, (ii) infringement of Article 36 Statute of CJEU and (iii) distortion of the facts and evidence.



### EUTM Application



### Earlier trade mark



#### SUBSTANCE:

Unlike the factor of the similarity of the signs, the factor of the earlier mark's reputation and distinctive character does not involve a comparison between signs, but only concerns the sign registered by the opponent. Since those two factors are fundamentally different in scope, examination of one of them does not allow conclusions to be drawn concerning the other. Even where the earlier mark has a high degree of distinctive character by reason of its reputation, that fact does not make it possible to determine whether, or to what extent, that mark is visually, phonetically and conceptually similar to the mark for which registration is sought (§ 58).

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The CG erred in law in assessing the similarity of the signs in the light of the reputation of the earlier mark (§ 59, 64).

The identification of the dominant element of the sign may be relevant for the purpose of comparing the signs, but it does not necessarily mean that the sign's reputation and degree of distinctive character, that concern it as a whole, make it possible to determine which of that sign's components is dominant in the relevant public's perception (§ 61).

The CTMR cannot be understood as meaning that a trade mark's reputation or high level of distinctive character may lead to a finding that one of its constituent elements dominates over another for the purposes of assessing the similarity of signs (§ 62).

The GC found that the earlier mark's reputation might influence the perception of the connections between the various elements of that mark. However, the reputation of a highly stylised mark, such as the earlier mark, is exactly based on a significant part of the relevant public's knowledge of all the elements, both verbal and figurative, that make up that mark (§ 63).

In order to determine whether there was a LOC and a risk that the public might erroneously believe that the services offered by the applicant under the contested mark come from the opponent or an

undertaking connected with them, the GC should have examined not only the services relating to bank card payments, but also the other services relating to financial affairs, monetary affairs, and banking, that are among those protected by the earlier mark and essentially identical to those of the contested sign (§ 74-76).

Therefore, the GC's conclusion that the earlier mark's distinctive character was correctly assessed in the BoA's decision is inadequate. That defect in the statement of reasons also vitiates the overall assessment of the existence of a LOC (§ 77).

In view of the error of law affecting the first ground of appeal, and the failure to state reasons in the second ground, the judgment under appeal must be set aside, without examining the other grounds of appeal (§ 78).

The CJ has the information necessary to give the final judgment on the action (§ 80). Since the BoA failed to examine the earlier mark's distinctive character taking into account the services covered by it and relied on the earlier mark's reputation for assessing the similarity of the signs, the decision must be annulled (§ 82-84).

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

**16/06/2020, T 558/19, HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER (fig.) / C LUZCLINICA LA LUZ (fig.) et al., EU:T:2020:274**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Right to be heard

#### **FACTS:**

The applicant sought to register the figurative mark 'HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER' for services in Classes 42 and 44, such as scientific analysis; scientific research for medical purposes and medical assistance.

Pursuant to Article 8(1)(b) CTMR and Article 8(4) CTMR, an opposition was filed based on the earlier Spanish figurative mark 'C LUZCLINICA LA LUZ', registered for medical services, in particular services of a medical-surgical hospital in Class 44. The OD partially upheld the opposition.

The applicant appealed. The BoA dismissed the appeal, finding that the relevant territory for the purpose of assessing the LOC was Spain and that the degree of attention of the relevant public was

high for the health-related services in Classes 42 and 44. It found that the services were partly similar to an average degree and partly identical. The BoA considered that, visually, the signs were only similar to a low degree; phonetically, they were similar to a below-average to average degree; and, conceptually, they were similar. The BoA concluded that it cannot be excluded that even a public with a high level of attention may be led to believe that the research, testing, analysis, consultancy and healthcare services come from the same undertaking or economically linked undertakings. Therefore, the BoA confirmed the existence of a LOC within Article 8(1)(b) EUTMR and did not examine Article 8(4) EUTMR.

The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action as manifestly lacking any foundation in law.

#### **SUBSTANCE:**

The GC decides, pursuant to Article 126 RPGC, to rule without taking further steps in the proceedings, notwithstanding the fact that a hearing was requested (see by analogy, 06/10/2015, T 545/14, engineering for a better world, EU:T:2015:789, § 13) (§ 18).

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### EUTM application (fig.)



### Earlier trade mark



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

The applicant's arguments raised in the present action are identical to those that were rejected as unfounded in the dispute that gave rise to the judgment of 13/06/2019, T 357/18, HOSPITAL DA LUZ (fig.) / clínica LA LUZ (fig.) et al., EU:T:2019:416. That judgment became final following the order of 05/11/2019, C 622/19 P, HOSPITAL DA LUZ (fig.) / clínica LA LUZ (fig.) et al., EU:C:2019:925, whereby the CJ decided not to allow the applicant's appeal to proceed (§ 22). Insofar as (i) the earlier mark in the present case is identical to that cited in opposition in the case that gave rise to the judgment in case

T 357/18, and the marks applied for are similar; (ii) the grounds of the contested decision are similar to those of the BoA's decision in that case; and (iii) the applicant's arguments put forward in the present case are identical to those put forward in the case that gave rise to the judgment in case T 357/18, it is necessary to reject them as unfounded for reasons similar to those set out therein (§ 23).

As to the remaining arguments, the BoA rightly considered that (i) the element 'learning health' is visually co-dominant but that, for the part of the relevant public that has a command of English, it is weak and non-distinctive in respect of the services and (ii) even for the part of the relevant public for which that element has no meaning, the element 'luz' plays an independent distinctive role and would be perceived as the name of the hospital, despite the fact that it is smaller than the element 'learning health' (§ 26). The fact that the element 'laluz' is displayed as a single word does not call into question that the element 'luz' is the most distinctive element in the signs and that the elements 'da' in the mark applied for and 'la' in the earlier mark have only a limited impact (§ 28).

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25/06/2020, T 104/19, Juvédem, EU:T:2020:283

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Right to be heard

### **FACTS:**

The proprietor registered the word mark Juvéderm as an EUTM for pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles in Class 5.

An application for revocation was filed pursuant to Article 51(1)(a) CTMR. The proprietor provided evidence seeking to prove genuine use of the contested mark. The Cancellation Division (CD) dismissed the revocation application.

The revocation applicant filed an appeal. The BoA dismissed the appeal, on the ground that the proprietor had proved genuine use of the mark during the relevant period in connection with the goods in respect of which the mark was registered, namely pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles.

The applicant for revocation filed an action before the GC, relying on a single plea in law: infringement of Article 15 CTMR in that the BoA erred in finding that the contested mark (i) had been put to genuine use in connection with the goods in respect of which

it was registered; (ii) had been used in the form in which it was registered; and (iii) had been used by the proprietor or on its behalf. The GC dismissed the action.

### **SUBSTANCE:**

INFRINGEMENT OF ARTICLE 15 CTMR.

(i) PROOF OF GENUINE USE IN CONNECTION WITH THE GOODS FOR WHICH THE MARK IS REGISTERED

The applicant claims in essence that the goods to which the evidence of use relates, even though they are in Class 5 of the Nice Classification, are not pharmaceuticals, that is to say medicines, registered and authorised in accordance with Directive 2001/83/EC on the Community code relating to medicinal products for human use, but rather other preparations for medical use within the meaning of that class, namely injectable dermal fillers, regulated by Directive 93/94 (§ 23). It refers inter alia to the 'EC' declarations of conformity issued by the manufacturer of the goods and the 'EC' certificate relating to the marketing of the goods in the EU.

The alleged EU legislative measures however do not necessarily have an influence on the way in which the goods and services are classified in the Nice Classification. In that regard, the essential function of the mark should not be confused with the other functions that the mark may also fulfil, such as that of guaranteeing the quality of the goods in question

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(07/06/2018, T-72/17, Steirisches Kürbiskernöl (fig.), EU:T:2018:335, § 52). Consequently, the classification of goods according to other rules of EU law, is not in principle decisive with regard to their classification for the purposes of the registration of an EU trade mark (§ 27-28). The contested mark has been put to genuine use in connection with the goods in respect of which it was registered, namely pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles (§ 29-32).

### (ii) USE OF THE MARK IN THE FORM IN WHICH IT WAS REGISTERED

The verbal elements that were added are only minor additions in relation to the term 'juvéderm', that is the distinctive element in those combinations of words. The added words such as 'ultra' or 'voluma', are ancillary, because they refer to the characteristics of the goods, such as the extraordinary effects (ultra) or the volume (voluma). Although the contested mark had not been used only as a word mark, but also in a figurative form, neither of the variants used altered the distinctive character of the contested mark as registered (§ 40, 42, 44).

### (iii) USE ON BEHALF OF THE PROPRIETOR

The applicant submits that the contested mark was not used with the prior and implicit consent of the proprietor of the mark (§ 45). The use of a trade

mark by a company that is economically linked to the proprietor of the mark is however presumed to be use of that mark with the consent of the proprietor and is therefore to be deemed to constitute use by the proprietor, in accordance with Article 15(2) CTMR (30/01/2015, T 278/13, now, EU:T:2015:57, § 38) (§ 50). The BoA was right in finding that the proprietor of the trade mark belonged to a group of companies linked to Allergan Inc. and that it is apparent from the two submitted witness statements that the proprietor and the companies that used the contested mark belong to the same group of companies. The BoA correctly stated that the mark had been used by other entities in the Allergan group with the consent of the proprietor of the mark (§ 48-51).

**25/06/2020, T-114/19, B (fig.) / B (fig.), EU:T:2020:286**

**RESULT:** Action partially upheld (BoA decision partially annulled)

**KEYWORDS:** Dissimilarity of the goods and services, Likelihood of confusion, Misuse of power, Similarity of the signs

#### **FACTS:**

The proprietor registered the figurative mark 'B' as an EUTM for goods and services in Classes 18 (inter alia, leather and imitations of leather, goods

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made of the aforesaid materials, such as: laces, cords, braids, boxes, straps, furniture fittings, heels, purses, handbags, decorative studs for materials of leather and imitations of leather; animal skins, hides), 25 and 35.

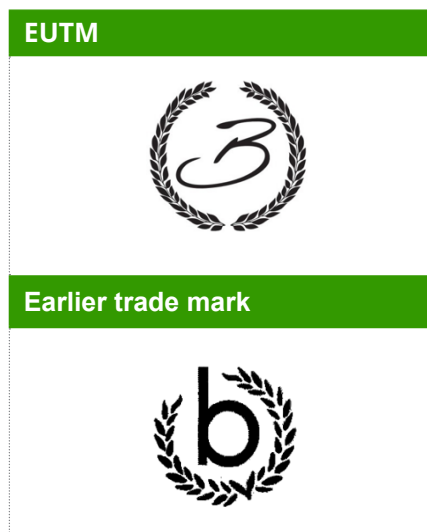
An invalidity application was filed for all the goods and services covered by the EUTM pursuant to Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR, based on the earlier figurative international registration designating the European Union 'B'. The earlier mark was registered for goods in Classes 18 (such as goods made of leather and imitations of leather, included in this class, in particular bags, trunks and travelling bags), 24 and 25.

The CD partially upheld the action and declared the EUTM invalid for all the goods concerned in Classes 18 (except for leather and imitations of leather; animal skins, hides) and 25.

Both the EUTM proprietor and the invalidity applicant filed appeals. The BoA dismissed the EUTM proprietor's appeal in its entirety and partially upheld the invalidity applicant's appeal. The BoA confirmed that the goods in Class 25 were identical and the contested services in Class 35 were dissimilar to the goods covered by the earlier mark. As regards the goods in Class 18, the BoA considered that leather and imitations of leather covered by the contested mark were similar, albeit to a low degree, to the goods made of leather and imitations of leather covered by the earlier mark, and animal skins, hides covered by the contested mark had a certain similarity with the home textiles in Class 24

of the earlier mark. In view of the similarity of signs, there was a LOC and the EUTM was also declared invalid for leather and imitations of leather; animal skins, hides in Class 18.

The EUTM proprietor filed an action before the GC, relying on three pleas in law: (i) infringement of Article 60(1)(a), read in conjunction with Article 8(1)(b) EUTMR (ii) misuse of power within the meaning of Article 72(2) EUTMR and (iii) lack of evidence showing that the presence of the EUTM on the market is detrimental to the public interest. The GC partially upheld the action.



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### SUBSTANCE:

#### ADMISSIBILITY.

The EUTM proprietor's first head of claim, seeking annulment of the contested decision, must be declared admissible, since that decision declared the EUTM invalid for all the goods in Classes 18 and 25.

The second head of claim, containing a request for alteration that seeks to have the court maintain the registration of the EUTM, must be declared inadmissible (§ 24).

(i) ON THE INFRINGEMENT OF ARTICLE 60(1)(a), IN CONJUNCTION WITH ARTICLE 8(1)(b) EUTMR.

#### RELEVANT PUBLIC.

Leather and imitations of leather and animal skins, hides in Class 18 are raw materials that go to industry for further processing and are intended principally for a professional public (§ 35). Since a section of the relevant public consists of professionals with a higher level of attention, but another section of the relevant public consists of reasonably observant and circumspect average consumers, the public that has the lowest level of attention must be taken into consideration for assessing LOC (24/01/2013, T-189/11, Disco Designer, EU:T:2013:34, § 31) (§ 36).

### THE COMPARISON OF THE GOODS.

The list of goods and services for which a mark is applied for must be worded in such a way as to indicate clearly the nature of those goods and services (23/11/2011, T-483/10, Pukka, EU:T:2011:692, § 37) and the scope of the desired protection (18/10/2018, T 533/17, nuuna (fig.) / NANU et al., EU:T:2018:698, § 62) (§ 48-49).

The goods covered by the earlier mark are not described solely as goods made of leather and imitations of leather, but have been listed more precisely, namely, in particular bags, trunks and travelling bags; suit bags, wallets, purses, key cases, cases for writing utensils, cases for cutlery; umbrellas, parasols and walking sticks (§ 51).

Therefore, taking into account the intention of the earlier mark's proprietor at the time the application for registration was submitted and contrary to the BoA finding, the protection of the earlier mark cannot extend to all goods made of leather and imitations of leather, but only to those finished goods primarily used to carry, bring and contain small items, (§ 52-53).

The goods under comparison have a different nature and purpose, are normally produced by different manufacturers, are sold through different distribution channels and have no competitive relationship (§ 54-55). The BoA's finding that

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similarity could be established because the use of raw materials is necessary to manufacture finished products cannot be upheld: given the wide variety of goods that can be made of leather or imitations of leather, that factor alone is not sufficient to establish that the goods are similar (01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 55) (§ 57).

The semi-finished goods leather and imitations of leather in Class 18 covered by the contested mark are not similar to goods made of leather and imitations of leather in Class 18 of the earlier mark, that are finished products (§ 59).

Animal skins, hides in Class 18 covered by the contested mark and home textiles in Class 24 covered by the earlier mark are dissimilar (§ 62). Home textiles are functional and decorative goods and serve both practical and ornamental purposes. They are intended for the average consumer belonging to the general public. By contrast, animal skins, hides have a different nature and purpose and are sold through different distribution channels. They are raw materials intended for a specialised public and the mere finding that a product can be used for the manufacture of another is not sufficient to establish similarity (§ 60-61).

### THE COMPARISON OF THE SIGNS.

The assessment of LOC is to be carried out by comparing the two signs as they were registered

or as they appear in the trade mark application (13/09/2007, C-234/06 P, Bainbridge, EU:C:2007:514, § 62, and 08/12/2005, T 29/04, Cristal Castellblanch, EU:T:2005:438, § 57), regardless of whether they are used alone or together with other marks or indications (18/10/2016, T-109/16, RESPIMER / RESPIMAT, EU:T:2016:627, § 46) (§ 70).

The signs did not contain any dominant elements and the distinctive character of the figurative and verbal elements is average (§ 71).

Since the graphic differences between the signs are of minor importance compared to the similarities that they share (§ 75), the signs are visually similar to an average degree (§ 77).

The signs are phonetically identical (§ 80). Conceptually, single letters of the alphabet might have their own conceptual content (08/05/2012, T-101/11, G, EU:T:2012:223, § 56) and there may be conceptual identity where the signs refer to the same letter of the alphabet (13/03/2018, T-824/16, K (fig.) / K (fig.) et al., EU:T:2018:133, § 66 and 67 and the case-law cited) (§ 82-83). Therefore, the signs are conceptually identical: they refer to the same letter of the alphabet and, through the presence of a wreath of laurels, to the idea of success or high quality (§ 83-85).

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### LIKELIHOOD OF CONFUSION.

There is LOC for the contested goods in Class 18, other than leather and imitations of leather; animal skins, hides, and for all of the goods in Class 25. For the goods in Class 18 held to be dissimilar, one of the cumulative conditions necessary for the application of Article 8(1)(b) EUTMR is missing and there is no LOC (§ 102).

(ii) MISUSE OF POWER WITHIN THE MEANING OF ARTICLE 72(2) EUTMR.

A decision may amount to a misuse of power only where it appears, on the basis of objective, relevant and consistent factors, to have been taken in order to achieve an end other than that stated (17/02/2017, T-811/14, Fair & Lovely (fig.) / NEW YORK FAIR & LOVELY et al., EU:T:2017:98, § 41). The BoA carried out a full and specific examination of the signs in order to compare them for the purpose of assessing whether there was LOC within the meaning of Article 8(1)(b) EUTMR. The proprietor does not put forward any evidence showing the existence of a misuse of power and that argument must therefore be rejected as unfounded (§ 107-108).

(iii) LACK OF EVIDENCE SHOWING THAT THE PRESENCE OF THE CONTESTED MARK ON THE MARKET IS DETRIMENTAL TO THE PUBLIC INTEREST.

The proprietor's claims that the BoA failed to demonstrate that the existence of the EUTM was detrimental to the public interest is rejected: the case-law cited in support relates to absolute grounds for refusing registration of marks that are devoid of distinctive character and is not applicable in the present case that concerns invalidity proceedings whose purpose is to protect the individual interest of the applicant for a declaration of invalidity in order to prevent registration of a sign that is detrimental to his or her earlier rights (§ 113-114).

**25/06/2020, T 133/19, OFF-WHITE (fig.),  
EU:T:2020:293**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Absolute grounds, Descriptive

#### **FACTS:**

The applicant sought to register the figurative mark OFF-WHITE as an EUTM for goods in Classes 3, 9, 14 and 20. The examiner partially refused the application insofar as it related to the goods in Classes 9, 14 and 20, pursuant to Article 7(1)(b) and (c) EUTMR and Article 7(2) EUTMR.

The BoA allowed the applicant's appeal in relation to some goods in Class 14 and dismissed the appeal as regards all the goods in Class 9 (spectacle frames and sunglasses, their cases, and cases, bags, straps

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and covers for various electronic goods; protective helmets), Class 20 (pillows; cushions; beds; mattresses; furniture), and watches; wall clocks; horological and chronometric instruments; watch bands; watch cases; presentation boxes for watches; jewelry cases and precious stones, semi-precious stones in Class 14, on the ground that the mark was descriptive and lacked distinctive character.

The applicant filed an action before the GC relying on two pleas in law: (i) infringement of the principles of sound administration, legal certainty and equal treatment as well as of the obligation to state reasons, (ii) infringement of Article 7(1)(b) and (c) EUTMR.

The GC upheld the action.

### EUTM Application



#### SUBSTANCE:

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

The English term 'off-white' will be perceived as referring to a colour very close to white, frequently having a grey or yellow tinge; almost white and denoting a very light shade of colour (§ 29-32).

#### THE LINK BETWEEN THE VERBAL ELEMENT 'OFF-WHITE' AND THE GOODS IN QUESTION

Within the meaning of Article 7(1)(c) EUTMR, a characteristic must be 'objective' and 'inherent to the nature of that product' or service, and 'intrinsic and permanent' with regard to that product or service (07/05/2019, T 423/18, *vita*, EU:T:2019:291, § 44). It is irrelevant whether that characteristic is commercially essential or ancillary (§ 37).

The BoA concluded that, due to its reference to the colour and to the visual aspect of the goods in Classes 9, 14 and 20, the verbal element 'off-white' would clearly be perceived as descriptive of the colour of those goods. Although it cannot be ruled out a priori that the colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR, it does not follow from the considerations on which the BoA based its conclusion, that the colour 'off-white' (or even the shades of white) constitutes a characteristic that is objective and inherent to the nature of the goods in question, as well as being intrinsic and permanent for those goods, within the meaning of the *VITA* judgment (§ 42-43).

The BoA's considerations regarding the elegant and discreet character of the colour off-white and the improved visual impression it produces in relation to certain goods (such as protective helmets), do not make it possible to establish that it constitutes

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a characteristic that is objective and inherent to the nature of the goods in question. Those considerations in referring to the aesthetic value and contribution of that colour involve an element of subjective assessment, likely to vary greatly according to the individual preferences of each consumer, that cannot be used to determine how a sign may be perceived by the public as a whole (§ 44; 13/12/2018, T 98/18, MULTIFIT, EU:T:2018:936, § 31).

Therefore, the BoA infringed Article 7(1)(c) EUTMR.

The deduction that the mark applied for has no distinctive character as a consequence of its supposedly descriptive character is unfounded (§ 58; 07/05/2019, T 423/18, vita, EU:T:2019:291, § 72).

Since the action must be upheld in its entirety, there is no need to rule on the other plea raised by the applicant (§ 61).

**25/06/2020, T 379/19, Serviceplan, EU:T:2020:284**

**RESULT:** Action dismissed

**KEYWORDS:** Lack of reasoning, Non-distinctive, Principle of legality

**FACTS:**

The applicant sought to register the word mark Serviceplan for goods and services in Classes 16,

35, 37, 39, 41 and 42. The examiner refused the application pursuant to Article 7(1)(b), Article 7(1)(c) and Article 7(2) EUTMR. The Board of Appeal (BoA) annulled that decision for lack of reasoning. The case was referred back and the examiner refused the application pursuant to Article 7(1)(b) and Article 7(2) EUTMR as devoid of distinctive character for the goods in Class 16 and the services in Classes 35 and 42.

By the contested decision the BoA partially allowed the applicant's appeal. The BoA found the level of attention of the target professionals to be high because the use of the services could involve high costs and required specific specialist knowledge and skills. As the sign contained English words the BoA focused on the English-speaking public of UK, Ireland and Malta. The BoA annulled the examiner's decision, insofar as the application was refused in respect of the goods of Class 16 since the sign was considered distinctive for printed matter in Class 16. The BoA however rejected the appeal pursuant to Article 7(1)(b) and Article 7(2) EUTMR for services in Classes 35 and 42 since the mark was found to be non-distinctive as these services can be offered in the form of a service plan.

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 94(1) EUTMR. The GC dismissed the action.

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### SUBSTANCE:

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

The BoA correctly found that the relevant public primarily consisted of specialists with a high level of attention, namely traders of all sectors that the services primarily targeted, because the use of these services could involve high costs and required specific specialist knowledge (not disputed) (§ 24, 26). The obiter dictum that the level of attention was considered lower in case of purely informative factual statements and advertising messages does not affect the reasoning of the contested decision (§ 27-29).

The BoA correctly found the word sign 'Serviceplan' does not convey any different concept than the mere sum of its constituent elements 'service' and 'plan' and does not deviate from the rules of English language (§ 45, 48). The absence of a space between the two words does not change the conceptual perception by the public (§ 47). The mark merely denotes a 'service plan', namely a wide-ranging bundle of various individual services that can be offered throughout a period of time as a special scheme of customer care (§ 56). The sign conveys nothing more than a purely informative or laudatory message in relation to the services in Classes 35 and 42 and is thus devoid of distinctive character (§ 54-56).

#### (ii) INFRINGEMENT OF ARTICLE 94(1) EUTMR.

The contested decision does not lack reasoning since the BoA categorised the services that were interlinked in a sufficiently direct and specific way according to their common characteristics in homogeneous groups that could be subject of general reasoning; it formed three such groups of services in Class 35, namely advertising and marketing services, business management services and office functions that are targeted at all in particular but not exclusively at specialist circles (§ 72) and divided the services in Class 42 in groups covering design and IT (§ 74). The BoA's assessment of the lack of distinctive character is therefore valid for all the services, on account of their common characteristics assigned to the various homogeneous groups of services (§ 75).

The legality of the BoA's decisions must be assessed solely on the basis of the EUTMR as interpreted by the EU courts (§ 81). As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with respect for the principle of legality. Decisions taken at national level are irrelevant since the EU trade mark regime is an autonomous system that applies independently of any national system (§ 82-87).

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25/06/2020, T 380/19, **Serviceplan Solutions**,  
EU:T:2020:285

**RESULT:** Action dismissed

**KEYWORDS:** Lack of reasoning, Non-distinctive,  
Principle of legality

### **FACTS:**

The applicant sought to register the word mark Serviceplan Solutions for goods and services in Classes 16, 35, 37, 39, 41 and 42. The examiner refused the application pursuant to Article 7(1)(b), Article 7(1)(c) and Article 7(2) EUTMR. The BoA annulled that decision for lack of reasoning. The case was referred back and the examiner refused the application pursuant to Article 7(1)(b) and Article 7(2) EUTMR as devoid of distinctive character for the goods in Class 16 and the services in Classes 35 and 42.

By the contested decision the BoA partially allowed the applicant's appeal. The BoA found the level of attention of the target professionals to be high because the use of the services could involve high costs and required specific specialist knowledge and skills. As the sign contained English words the BoA focused on the English-speaking public of UK, Ireland and Malta. The BoA annulled the examiner's decision, insofar as the application was refused in respect of the goods of Class 16 since the sign was considered distinctive for printed matter in Class 16.

The BoA however rejected the appeal pursuant to Article 7(1)(b) and (2) EUTMR for services in Classes 35 and 42 since the mark was found to be non-distinctive as these services can be offered in the form of a service plan.

The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 94(1) EUTMR. The GC dismissed the action.

### **SUBSTANCE:**

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

The BoA correctly found that the relevant public primarily consisted of specialists with a high level of attention, namely traders of all sectors that the services primarily targeted, because the use of these services could involve high costs and required specific specialist knowledge (not disputed) (§ 25, 27). The obiter dictum that the level of attention was considered lower in case of purely informative factual statements and advertising messages does not affect the reasoning of the contested decision (§ 28 29).

The BoA correctly found the word sign 'Serviceplan Solution' does not convey any different concept than the mere sum of its constituent elements 'service' and 'plan' and 'solution' does not deviate from the rules of English language (§ 46, 47). The absence of a

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space between the two words does not change the conceptual perception by the public (§ 48). The mark merely denotes a 'service plan solution', namely a wide-ranging bundle of various individual services that can be offered throughout a period of time as a special scheme of customer care (§ 57). The sign conveys nothing more than a purely informative or laudatory message in relation to the services in Classes 35 and 42 and is thus devoid of distinctive character (§ 54-58).

(ii) INFRINGEMENT OF ARTICLE 94(1) EUTMR.

The contested decision does not lack reasoning since the BoA categorised the services that were interlinked in a sufficiently direct and specific way according to their common characteristics in homogeneous groups that could be subject of general reasoning; it formed three such groups of services in Class 35, namely advertising and marketing services, business management services and office functions that are targeted at all, in particular, but not exclusively, at specialist circles (§ 73) and divided the services in Class 42 in groups covering design and IT (§ 75). The BoA's assessment of the lack of distinctive character is therefore valid for all the services, on account of the common characteristics assigned to the various homogeneous groups of services (§ 76).

The legality of the BoA's decisions must be assessed solely on the basis of the EUTMR as interpreted

by the EU courts (§ 82). As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with respect for the principle of legality. Decisions taken at national level are irrelevant since the EU trade mark regime is an autonomous system that applies independently of any national system (§ 83-88).

**25/06/2020, T 550/19, Noster / Foster, EU:T:2020:290**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:**

The applicant sought to register the word mark Noster as an EUTM for goods in Class 5, including pharmaceutical preparations; reagent paper for medical purposes; oiled paper for medical purposes.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on the earlier EU word mark Foster, covering pharmaceutical preparations and substances; pharmaceutical products for treating respiratory diseases in Class 5. The OD rejected the opposition on the ground that there was no LOC.

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The opponent filed an appeal before the BoA. The BoA upheld the appeal as regards pharmaceutical preparations; reagent paper for medical purposes; oiled paper for medical purposes; gauze for dressings; eyepatches for medical purposes; ear bandages; menstruation bandages; menstruation tampons; sanitary napkins; sanitary panties; absorbent cotton; adhesive plasters; bandages for dressings; liquid bandages; cotton swabs for medical use; dental materials; dietary supplements for humans; dietetic beverages adapted for medical purposes; dietetic food adapted for medical purposes; beverages for babies; food for babies; dietary supplements for animals on the grounds that for those goods that were identical or similar to varying degrees to those covered by the earlier mark a LOC could not be excluded.

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

### SUBSTANCE:

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

The BoA took into account the perception of the signs on the part of the Polish- or German-speaking public that did not speak English, Danish or Swedish as a foreign language (not disputed) (§ 20). The relevant public consists of the general public and professional consumers with a level of

attention that is at least above average in relation to the goods in Class 5, that might affect the end consumer's state of health or may be necessary for his or her well-being, and with an average degree of attention in relation to the remaining goods, such as sanitary napkins; sanitary panties; absorbent cotton; adhesive plasters (§ 21, 28).

The GC confirms the BoA's assessment as to the comparison of the goods and in particular that there was a very low degree of similarity between menstruation bandages; menstruation tampons; sanitary napkins; sanitary panties and pharmaceutical preparations and substances (§ 34).

The signs are visually similar to an average degree since the signs consist of six letters, the last five of which are identical and in the same order, and neither of the signs contains any additional word or figurative element that is capable of constituting a distinguishing feature that is sufficient to preclude any visual similarity (§ 43-48).

Likewise, the signs are phonetically similar to an average degree since the group of letters 'oster' are pronounced in the same way, irrespective of the different rules of pronunciation that might apply in different parts of the relevant territory (§ 49, 51-53).

A conceptual comparison is not possible, since neither of the signs have a meaning from the perspective of the Polish- and German-speaking

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public that do not speak English, Danish or Swedish as a foreign language (not disputed) (§ 56-59).

Given the very low degree of similarity between those goods and pharmaceutical preparations and substances and the average degree of similarity found to exist between the signs, and taking into account the principles of interdependence and imperfect recollection, there is a LOC for the relevant Polish and German-speaking public within the territory of the EU (§ 68).

**25/06/2020, T-651/19, Credit24 (fig.), EU:T:2020:288**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive

### **FACTS:**

The applicant sought to register the figurative mark 'Credit24' as an EUTM for services in Class 36.

The examiner refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, in conjunction with Article 7(2) EUTMR, for being descriptive and devoid of distinctive character.

The BoA dismissed the appeal, stating that the term 'credit' and the number '24' constituted a descriptive combination for the services covered and the figurative elements of the mark were relatively basic

and could not divert the attention of the consumer from the descriptive message conveyed by the sign. In addition, the BoA dismissed the plea alleging infringement of Article 7(3) EUTMR as inadmissible, since it had been raised before it for the first time and, in any event, was unfounded.

The applicant filed an action with the 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 the principles of equal treatment and 'consistency of case-law' in relation to the assessment of distinctiveness within the meaning of Article 7(1)(b) EUTMR. The GC dismissed the action

### EUTM Application



### **SUBSTANCE:**

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

The services in Class 36 of the trade mark application target both the average consumer and professionals displaying a high level of attention (not disputed) (§ 30).

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Since the English word 'credit' and its meaning are part of the English basic vocabulary (§ 38), this word will be understood, at least, by the English-speaking part of the relevant public (namely consumers in the United Kingdom, Ireland and Malta) and by the part of the public that has a command of basic English vocabulary (namely consumers in Finland, Sweden, Denmark, the Netherlands and Cyprus), as well as by French- and Romanian-speaking consumers, insofar as this word has the same meaning of 'credit' in French and Romanian (§ 39).

It is not necessary that the trade mark applied for is actually used for describing the services covered by the application, or their characteristics. It is sufficient that at least one of its potential meanings can be linked to a characteristic of the services concerned (19/12/2019, T 54/19, BIANCOFINO, EU:T:2019:893, § 41) (§ 43).

The term 'credit' will be understood by the relevant public as describing the nature of the services covered by the mark applied for, namely loan financing operations (§ 46, 50). Likewise, the number '24', being an abbreviation for '24 hours a day', merely indicates that the services in question are available around the clock (§ 49, 50).

A mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services applied for, is itself descriptive of

those characteristics, unless there is a perceptible difference between the word and the mere sum of its parts (25/02/2010, C 408/08 P, Color Edition, EU:C:2010:92, § 62) (§ 53).

This is not the case here: the combination of the descriptive elements 'credit' and '24' does not present any unusual changes, the elements are joined together in a natural and logical manner and the figurative elements are inconspicuous and do not change the meaning of the mark (§ 54-60).

The GC is not bound by (i) the previous decision of the Office to register as an EUTM a sign allegedly similar to the mark applied for, nor (ii) the 2018 decision by the United Kingdom IPO, as already acknowledged by well-settled and consistent case-law (15/09/2005, C 37/03 P, BioID, EU:C:2005:547, § 47 and 06/06/2018, C 32/17P, PARKWAY (fig.), EU:C:2018:396, § 34) (§ 65-66).

Since one of the absolute grounds for refusal listed in Article 7(1) EUTMR applies, it is not necessary for the GC to rule on the second and third pleas in law (§ 68).

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08/07/2020, T 633/19, figurative mark / TOTTO (fig.), EU:T:2020:312

**RESULT:** Action dismissed

**KEYWORDS:** Database printout, Dissimilarity of signs, Likelihood of confusion

### **FACTS:**

The applicant sought to register a figurative mark allegedly containing the element 'TOTU', as an EUTM for, inter alia, goods in Class 18.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on earlier EU figurative marks 'TOTTO' registered for goods in Class 18. The OD dismissed the opposition: the marks under comparison were considered different and thus no LOC was possible.

The opponent filed an appeal. The BoA confirmed the OD's decision and dismissed the appeal.

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

### EUTM application



### Earlier trade marks



### **SUBSTANCE:**

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

The GC upheld the following findings by the BoA (not disputed): i) the goods may be deemed to be identical, ii) the relevant territory is the EU, and iii) the relevant public corresponds to the general public, whose level of attention will vary from average to high (§ 25-26).

Where the signs are different, the opposition must be rejected irrespective of the presence of other

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relevant factors, such as the degree of similarity or the identity of the goods and services (12/09/2018, T 112/17, NEW ORLEANS PELICANS (fig.) / Pelikan et al., EU:T:2018:528, § 59) (§ 30).

The relevant public would not identify the verbal element 'totu' in the mark applied for: it would be more likely to perceive the red dots as separating and highlighting the elements formed by the black lines as opposed to completing the black elements to form capital letters making the term 'totu', especially considering the lack of obvious meaning of this term in relation to the goods in question (§ 36).

The description of the mark that an applicant might file pursuant to Rule 3(3) CTMIR is not relevant for the assessment of the perception of the mark by the relevant public: it provides information on the applicant's perception of the trade mark rather than that of the relevant public. LOC between trade marks must be assessed by reference to the perception of those trade marks by that public (22/03/2011, T 486/07, CA, EU:T:2011:104, § 58; 14/07/2016, T 567/15, DEVICE OF A BLACK SQUARE WITH FOUR WHITE STRIPES (fig.) / DEVICE OF THREE VERTICLE WAVY LINES (fig.), EU:T:2016:408, § 27) (§ 38).

The manner in which the mark applied for is referenced in databases managed by the Office (eSearch plus or TMview), is also ineffective as it reflects the applicant's perception of the mark applied for and not that of the relevant public (§ 40).

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### New Decisions from the Boards of Appeal

30/06/2020, R 1688/2019-2, Beaches Jamaica Bloody Bay

**Word mark – Descriptive element – Geographical Origin – Article 7(1)(b) and (c) EUTMR – Decision partially rejected – EUTM partially accepted.**

The applicant sought to register the words ‘Beaches Jamaica Bloody Bay’ for several goods and services in Classes 16, 25, 35, 36, 39, 43, 41, 44 and 45. The examiner partially rejected the application on the basis of Article 7(1)(b) and (c) EUTMR, in particular for goods and services in Classes 16, 35, 39, 41, 43, 44 and 45, as consumers would perceive the sign applied for as providing information that the goods in Class 16 and the services in Class 35 were about, or related to, Bloody Bay Beach in Jamaica. In relation to the rest of the classes applied for such as Classes 39, 41, 43, 44 and 45 the sign would be understood as an indication of the destination of the services.

The Board confirms the contested decision. The word combination ‘Beaches Jamaica Bloody Bay’ will be understood as the resort of Negril in Jamaica, where ‘Bloody Bay’ is one of the favorite Jamaican beaches. The Board notes that, for the services in Class 39 such as transport, the sign indicates the content of the services in the sense of transport

to ‘Bloody Bay’ and hence should be counted as being descriptive. Furthermore, in relation to goods and services in Classes 31, 41, 43 and 45, the Board confirms that the sign is understood as an indication of origin within the meaning of Article 7(1)(c) EUTMR. The sign will be understood by the relevant public as descriptive in the sense of the destination of the journey, the place where the provision of the services takes place or the subject matter of advertising services or goods. Moreover, the sign conveys a positive message in relation to the goods and services applied for in order to highlight their quality and their positive aspects. Hence, the sign does not possess the required level of distinctiveness within the sense of Article 7(1)(b) EUTMR. Consequently, the decision is confirmed and the application is partially rejected.

03/07/2020, R 2308/2019-1, YOuNGStYle (fig.)

#### EUTM application



**Figurative Mark – Non-Distinctive – Article 7(1)(b) and (c) EUTMR – Decision confirmed – EUTM Application rejected**

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The applicant sought to register the figurative mark consisting of several elements. The examiner rejected the application on the basis of Article 7(1) (b) and (c) EUTMR for goods in Classes 18, 20, 24 and 25.

The Board agrees with the examiner's conclusions and rejects the appeal. The mark consists of two words 'YOUNG' and 'STYLE' which means, in English, youthful and elegance, respectively, and thus should be assessed in relation to the English-speaking public. The Board indicates that the sign as a whole means a style specific to young people and will be related to the purpose and the characteristics of the goods, i.e. clothing and accessories for young people and thus should be considered as being descriptive. Furthermore, the Board notes that the mark emphasises the advantages of the goods since the sign 'YOUNGSTYLE' on goods such as clothing and accessories will be seen as a promotional message by relevant consumers. In relation to the graphic representation of the mark, the Board notes that the sign lacks distinctive character since the stylisation does not contain any elements that would divert the public's attention away from the non-distinctive message of the word element (paragraph 38). Consequently, the application is rejected.

29/06/2020, R 2600/2019-5, TIER SHOP

### EUTM application



**Figurative mark - Descriptive element - Non-distinctive - Article 7(1)(b) and (c) EUTMR - Decision confirmed - Application partially allowed.**

The applicant sought to register its figurative trade mark in the European Union, claiming priority from its German mark. The examiner rejected the mark for all the goods and services on the basis of Article 7(1)(b) and (c) EUTMR.

The Board partially upholds the appeal. Firstly, the Board notes that the verbal part of the figurative sign contains German words, 'TIER SHOP', for this reason the relevant public comprises the general German-speaking public. The goods and services are directed at average consumers, as well as professional animal breeders. All the goods and services registered, which are mainly veterinarian products, animal foodstuffs, other related products and services, have a direct connection with animals.

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The Board also notes that the figurative and verbal elements in the sign, to which the consumer normally pays more attention, indicate an animal shop and will be directly recognised as a dog and a cat by the relevant public. Therefore, the figurative element only describes the verbal element of the sign. The trade mark applied for is devoid of distinctive character pursuant to Article 7(1)(b) EUTMR.

However, the Board finds that the services in Class 35 'advertising' do not have a direct connection with pet shops. According to the Board, the professional public will not expect such services to be provided in a pet shop, thus the sign cannot be regarded as being descriptive in relation to these services.

07/07/2020, R 2387/2019-4, SULA

### EUTM application



**Figurative mark - Public policy or accepted principles of morality - Article 7(1)(f) EUTMR and Article 7(2) EUTMR - Decision confirmed - Application rejected.**

The applicant sought to register the figurative trade mark in the European Union for goods in Classes 29 and 32. The examiner rejected all the goods applied for on the basis of Article 7(1)(f) EUTMR.

The Board dismisses the appeal. Firstly, the Board notes that the verbal element 'SULA' is a word in Romanian and, therefore, the Romanian relevant public must be considered in order to assess the applicability of this absolute ground. The contested sign is composed of the verbal element 'SULA' and a figurative element of a red and yellow medal. The Board confirms that 'SULA' is a colloquial word which means 'male organ, penis, cock' in Romanian and declares the sign contrary to public policy and accepted principles of morality. The Board also confirms that the word 'SULA' can have two other definitions in Romanian 'tool' and 'a kind of fish', however, the word will be understood by the relevant public with the abovementioned definition.

Regarding the goods in Classes 29 and 32, even if they do not have a direct connection with a 'male organ', the Board notes that signs which are particularly offensive may be considered contrary to public policy and accepted principles of morality, without taking into consideration the contested goods.

(see also [07/07/2020, R 2388/2019-4, SULA](#))

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02/07/2020, R 2126/2019-1, PINAR Tam kıvamında Süzme Peynir Yumusacık ve Leziz (fig.) / Süzme Peynir (fig.)

### Earlier trade marks



### Contested sign



**Figurative Mark – Common element – Similarity of the signs – Likelihood of confusion – Article 8(1) (b) EUTMR – Decision confirmed – IR designating the EU rejected – Opposition allowed**

The applicant sought to register the figurative mark 'PINAR' for goods in Class 29 such as butter, yoghurt and dairy products. The Opposition Division rejected the IR designating the European Union on the basis of Article 8(1)(b) EUTMR.

The Board dismisses the appeal. The two signs

coincide in the word element 'Suzme Peynir' and differ as regards the rest. However, the figurative elements in both signs are descriptive or secondary in nature and therefore do not affect the visual comparison. As such, the signs are similar at least to a below average degree visually. Aurally, the sound of the words 'Suzme Peynir' are the same while the extra words 'Tam kıvamında' and 'Yumusacık ve Leziz' are not likely to be pronounced and do not impact on the aural comparison. Therefore, the signs are aurally similar to an average degree. Conceptually, the Board notes that the two marks convey two different concepts. The earlier mark presents the concept of a farm while the contested sign contains a concept of a block of white cheese. The fact that these concepts cannot indicate commercial origin as well as their differences, makes the marks conceptually dissimilar. The Board concludes that the signs are similar overall from the perspective of a substantial part of the relevant public. Furthermore, the Board indicates that the similarities primarily result from the fact the most distinctive element of the earlier mark is entirely reproduced in the contested sign. The different concepts depicted in the signs do not impact on the comparison, and hence they cannot counterbalance the aural and visual similarities. Consequently, the Opposition Division correctly took the view that a likelihood of confusion between the marks could not be excluded and upheld the opposition on the grounds of Article 8(1)(b) EUTMR for all of the contested goods.

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■ EUIPO joins the WIPO Digital Access Service (DAS)

■ Academy webinars

## Case Law

■ Overview of CJ/GC Case-law (Status: 01/01/2019 – 30/04/2020)

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal