

Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links 

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



New eAppeal Version 2
New improvements for users

First Page



New eAppeal Version 2: new improvements for users

The eAppeal tool, which allows users to file an appeal online, has been improved to make it quicker and easier than ever to use.

eAppeal was initially launched in 2017 as one single electronic channel to file a Notice of Appeal for all users. The tool is accessible through the user area of the EUIPO website, complementing the suite of e-filing tools and other electronic services.

The tool is available in 23 languages, and allows all aspects of filing an appeal, including the submission of Statement of Grounds and payment, to be done online.

The latest improvements will save users time when filing online and will simplify the entire process, with features that make it simpler to input data and which add validation checks throughout the process.

eAppeal now automatically loads and displays the “Date of decision”, “Language of proceedings” and the “outcome” associated with the contested decision once the decision number is entered.

There are automatic checks and warning messages if the appeal period of the relevant contested decision has expired, and the tool also automatically loads and shows the associated appellant party once the contested decision has been successfully found and imported.

In addition, users are now categorised only as either an appellant or a representative; the “requester” designation has been removed.

The simple, four-step process appeal filing process remains: electronic submission; identification of the contested decision; uploading the statement of grounds; and signature.

However, users should note that the section concerning the “Annexes to the Statement of Grounds” will now be visible only in the event that the user has previously opted for attaching the statement of grounds. This will make the process shorter and clearer for applicants.

eAppeal is part of a wider journey of digital improvement undertaken by EUIPO, in which the tools and services provided are continuously updated and made more efficient and user-friendly. It is part of the commitment of the Office – and of the Boards of Appeal – to provide a full electronic experience for users throughout the trade mark and design process.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

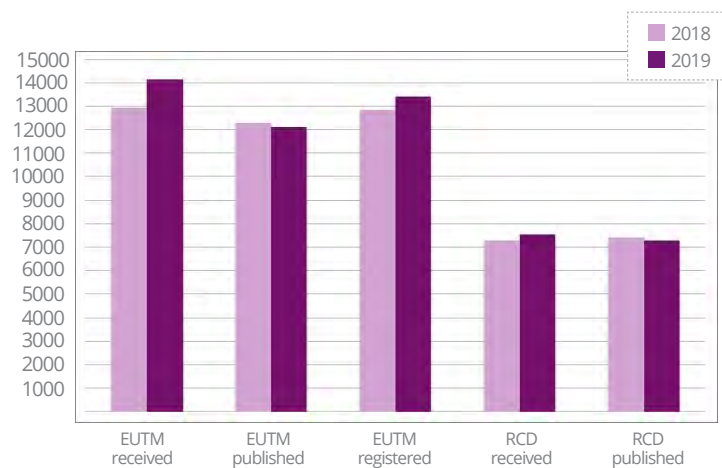


Statistical Highlights



Monthly statistical highlights May*	2018	2019
European Union Trade Mark applications received	12 935	14 142
European Union Trade Mark applications published	12 287	12 094
European Union Trade Marks registered (certificates issued)	12 843	13 398
Registered Community Designs received	7 271	7 549
Registered Community Designs published	7 427	7 292

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



First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



Visual search for TMview extended to Croatia

TMview's visual search facility, which allows users to search for trade marks in the world's largest free, online trade mark database, has been extended to one more intellectual property office.

The intellectual property office of Croatia (DZIV) has enabled the functionality of TMview's visual search facility with their trade mark database on 22 June. This allows for the image search function to be used on trade marks from these countries that have an image, further enriching TMview as a whole.

The extension to this Office in TMView's visual search follows the addition of Estonia, Bulgaria, France, Greece, Lithuania, Romania, Spain, UK, Malta, Sweden, Italy, Ireland, Slovakia and Czech Republic bringing the total number of countries participating to 15. The EUIPO aims to further extend this functionality to other Intellectual Property Offices.

Draft Common Practice of the CP8 project published

The draft Common Practice of the CP8 project USE OF A TRADE MARK IN A FORM DIFFERING FROM THE ONE REGISTERED has been published in English on www.tmdn.org.

The CP8 Working Group made significant progress towards completing the Common Practice during a Working Group meeting in March and a drafting workshop in May. As a result, the second draft of the Common Practice is now available for review and suggestions by all stakeholders.

The EUIPO welcomes your comments, which should be addressed to CommonPractices@euipo.europa.eu by 17 July (Wednesday).

Austria launches new online services for designs

The Austrian Patent Office-ÖPA (Österreichisches Patentamt) has implemented the Software Package Front Office (SPFO) for filing design applications online, supported by the European Cooperation projects at EUIPO.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

EUIPN Updates



Previously it was not possible to file design applications online at ÖPA.

The new digital platform helps users to file design applications in a simple and efficient way.

It is easy to access, including from mobile devices, and it provides guidance and tips for users through the different steps in the application. It is able to process standard and multiple designs as well as divisional design applications.

The release follows the recent implementation of e-filing for trade marks. ÖPA is also the first intellectual property office to integrate DesignClass, the online tool for harmonised product indications, in its e-filing for designs.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



More News



Public consultation on EUIPO's strategic plan

The second round of consultation for EUIPO's next strategic plan, SP2025, has been launched following the presentation of a preliminary draft to the Office's governing bodies.

The preliminary draft Strategic Plan for the years up until 2025 received general support for its main directions from Members and observers of the Office's Management Board and Budget Committee (MBBC) in their meeting earlier in June.

The preliminary draft was prepared after a first round of consultation based on a number of strategic drivers outlining the challenges posed by technology, globalisation and enforcement, as well as the need to enable SMEs to make more effective use of IP rights. A number of comments and suggestions were made at the MBBC meeting, which were taken into account in the current full draft text, which has been released for public consultation with a deadline for contributions by September 17. Comments should be submitted via the [consultation form](#) and sent to SP2025@euipo.europa.eu

After further revision, the final draft of SP2025 will be submitted for adoption to the next meeting of the MBBC in November, followed by the start of implementation in July 2020.

2 million trade mark applications received at EUIPO

The Czech company Crefoport s.r.o has become the two millionth EU trade mark applicant at the European Union Intellectual Property Office (EUIPO).

Crefoport s.r.o. is a business consultancy based in Prague, which has been assisting both Czech and international companies to manage credit risks since 1993.

The two millionth EU trade mark application represents an important milestone for the EUIPO, coming as it does 25 years after it was founded as a decentralised agency of the EU in Alicante. Spain.

During its two and a half decades of existence, the EUIPO has become an EU agency with a global reach. It received its one millionth application in 2011, and since then has experienced a rapid growth in demand for the EU trade mark, from nearly every country and region in the world.

In 2018 alone, the EUIPO received 152 488 applications, a 4.16% increase when compared with 2017.

The EU trade mark has therefore become an important support to the Internal Market of the European Union, and a vital tool for both EU and international enterprises doing business in the EU-28.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



More News



EUIPO and EPO renew cooperation agreement

The EUIPO and the European Patent Office (EPO) have strengthened their bilateral relationship with the renewal of a Memorandum of Understanding for closer cooperation.

The agreement, signed by the EUIPO's Executive Director, Christian Archambeau, and the EPO's President, António Campinos, seeks to deepen cooperation in areas of joint work and carry out common projects on European and international cooperation, training and interchange of human resources and best practices, and awareness raising and promotion of the Intellectual Property system.

The two offices have previously cooperated in a number of projects as a result of the signing of a Memorandum of Understanding in May 2011.

The cooperation activities implemented in the framework of the new agreement will be formalised in the Annual Work Plans discussed and agreed on a yearly basis, ensuring the alignment of strategic and operational activities.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Luxembourg trade mark and design news

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

C-690/17; ÖKO-Test; ÖKO-Test Verlag GmbH v Dr. Rudolf Liebe Nachf. GmbH & Co. KG; Preliminary Ruling of 11 April 2019; EU:C:2019:317; Language of the case: DE

KEYWORDS: Certification mark, Identity of the goods and services, Identity of the signs, Infringement, Preliminary Ruling, Reputation

FACTS: ÖKO-Test Verlag GmbH (ÖKO-Test Verlag) is the owner of the figurative mark **ÖKO-Test** registered both in the European Union and Germany (the 'ÖKO-Test marks') for conducting product tests and providing consumer information and consultancy services. The mark represents a label intended to present the results of product testing.

ÖKO-Test marks



ÖKO-Test Verlag selects the products it wishes to test and publishes the results of these tests in its magazine. In some cases, ÖKO-Test Verlag allows the manufacturers of the tested products to affix the **ÖKO-Test** marks to their goods, for which a licence agreement is concluded.

Dr. Rudolf Liebe Nachf. GmbH & Co. KG (Dr. Liebe) produces and markets toothpastes. In 2005, one of Dr. Liebe's toothpastes was tested by **ÖKO-Test** Verlag and was rated as 'sehr gut' ('very good'). Dr. Liebe obtained a licence to affix the **ÖKO-Test** marks to its products.

In 2014, ÖKO-Test Verlag became aware that Dr. Liebe was marketing toothpastes, affixing the **ÖKO-Test** marks to the packaging of the toothpastes it produced. Therefore, **ÖKO-Test** Verlag brought infringement proceedings against Dr. Liebe, submitting that the latter was not authorised to use the **ÖKO-Test** marks as the licence agreement was not in force anymore.

ÖKO-Test marks



First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) found that Dr. Liebe had infringed the ÖKO-Test marks by using them for 'consumer information and consultancy services'.

Dr. Liebe appealed to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), which referred two questions to the Court of Justice (CJ) for a preliminary ruling, asking, in essence, the following questions.

1. Whether Article 9(a) and (b) CTMR and Article 5(1)(a) and (b) Directive (EC) 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark consisting of a 'test seal' or 'quality label' registered for, inter alia, 'consumer information and consultancy with regard to the selection of goods and services, in particular using test and investigation results and by means of quality judgments', to oppose the affixing by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods and services for which that mark is registered.
2. Whether Article 9(1)(c) CTMR and Article 5(2) Directive (EC) 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a 'test seal' or 'quality label', to oppose the affixing by a third party, of a

sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods and services for which that mark is registered.

SUBSTANCE

THE FIRST QUESTION

Article 9(1)(a) CTMR and Article 5(1)(a) Directive (EC) 2008/95 refer to the so-called 'double identity' situation. In order for them to be applicable, there must be **identity** not only between the sign used by the third party and the registered trade mark, but also between the goods and the services supplied by the third party and the goods and services for which the proprietor has registered its mark (paras 28-30).

The CJ has already held that Article 9(1)(a) CTMR and Article 5(1)(a) Directive (EC) 2008/95 can be applied, **exceptionally**, to situations in which a service provider makes unauthorised use of a sign identical to the registered trade mark of a manufacturer of goods in order to inform the public that he is a specialist in those products (25/01/2007, C-48/05, Opel, EU:C:2007:55, § 27-28). In those cases in which the services are indissociably linked to the goods for which the mark is registered, the fact that the sign is used as a **badge of origin** makes those provisions applicable (paras 31-32).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



However, in this case, Dr. Liebe is not affixing the **ÖKO-Test** marks to its products for the purpose of providing consumer information and consultancy services, nor does it appear that Dr. Liebe seeks to present itself as an expert in the field of product testing. On the contrary, it is apparent that the **ÖKO-Test** trade marks are affixed to the toothpaste packaging for the **sole purpose** of drawing the consumers' attention to the quality of the toothpastes and, as a consequence, this situation is different from the exceptional case described above. Therefore, Article 9(1)(a) CTMR and Article 5(1)(a) of Directive (EC) 2008/95 cannot apply to this case (para. 33).

As regards Articles 9(1)(b) CTMR and 5(1)(b) Directive (EC) 2008/95, the protection granted to the proprietor of the trade mark applies only in cases where there is **identity or similarity** not only between the sign used by the third party and the registered trade mark, but also between the goods and the services supplied by the third party and the goods and services for which the proprietor registered its mark. In the absence of any similarity between the goods and services, the protection granted by those provisions is not applicable (paras 34-35).

It follows from the foregoing that the proprietor of an individual trade mark which is a quality label registered in relation to printed matter and providing product testing and consumer

information services **may not rely on the rights conferred by Article 9(1)(a) and (b) CTMR and Article 5(1)(a) and (b) of Directive (EC) 2008/95 against manufacturers of the tested consumer products who affix the identical sign, or a similar one, to those consumer products** (paras 38 and 43).

The above interpretation will not unduly reduce the protection of proprietors of individual trade marks consisting of a quality label such as the **ÖKO-Test** marks (paras 39-40) mainly because EU legislature supplemented the EU trade mark regime by providing **certification trade marks**. These differ from individual trade marks by allowing the proprietor to specify (in the regulations governing their use) the persons authorised to use the mark (para. 41).

THE SECOND QUESTION

Exercise of the right provided for in Articles 9(1) (c) CTMR and (5)(2) Directive (EC) 2008/95 is not conditional upon there being likelihood of confusion on the part of the relevant sector of the public (para. 45).

It is apparent from the request for a preliminary ruling, that the referring Court has some doubts as to whether the **ÖKO-Test** marks afford the protection laid down by those provisions, particularly as, for the relevant public, **it is the quality label that has reputation and not its registration as a trade mark** (para. 46).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The concept of 'reputation' assumes a certain degree of knowledge by the relevant public — which must be determined by reference to the products and services covered by the trade mark concerned — and this degree of knowledge must be considered to have been reached when the trade mark is known by a significant part of that public (para. 47). It follows that the reputation of the **ÖKO-Test** marks depends on whether a significant part of the target public knows the quality label (para. 48). This knowledge requirement **cannot be interpreted as meaning that the public must be aware that the quality label has been registered as a trade mark; it is sufficient that a significant part of the public knows that sign** (para. 49).

It is common knowledge that the **ÖKO-Test** marks are known by a significant part of the public. In which case, **ÖKO-Test Verlag** enjoys the protection afforded by Article 9(1)(c) CTMR and Article 5(2) Directive (EC) 2008/95 (para. 50).

It would therefore be for the referring Court to further examine the following points.

1. Whether Dr. Liebe's affixing of the **ÖKO-Test** marks to its products enabled it to take unfair advantage of the distinctive character or reputation of those marks or was detrimental to that distinctive character or reputation. Should this not be the case, then it would have to be concluded that **ÖKO-Test Verlag** is not entitled to prohibit this use (para. 52).

2. Whether Dr. Liebe has established, in this case, a 'due cause' within the meaning of Article 9(1)(c) CTMR and Article 5(2) Directive (EC) 2008/95. Should this not be the case, then it would have to be concluded that **ÖKO-Test Verlag** is not entitled to prohibit this use (para. 52).

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

T-910/16 and T-911/16; TESTA ROSSA (fig.); Hesse v EUIPO; Judgment of 4 April 2019; EU:T:2019:221; Language of the case: DE

RESULT: Actions dismissed

KEYWORDS: Evidence of use, Nature of use, Proof of use, Use by another undertaking

FACTS: The EUTM proprietor registered the figurative mark **TESTA ROSSA** for goods and services in Classes 7, 11, 20, 21, 25, 28, 30, 34 and 38. An application for partial revocation pursuant to Article 51(1)(a) CTMR was filed in respect of all the goods and services except for coffee, tea, cocoa, sugar, chocolate, chocolate-based beverages and sweets in Class 30. The Cancellation Division (CD) revoked the mark with respect to all the goods and services covered by the application for revocation.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The EUTM proprietor appealed. The Board of Appeal (BoA) partially annulled the CD's decision insofar as it maintained the registration of the mark in respect of household, kitchen containers; glassware, porcelain, in particular tableware; glass beverage ware in Class 21 and clothing, namely aprons, shirts, polo shirts and tee-shirts; headgear in Class 25 (the contested goods in Classes 21 and 25). The BoA considered the evidence of use submitted late by the EUTM proprietor to be admissible, and stated that it could not be ruled out that the use was genuine solely because the commercial acts invoked were not directed at end consumers but at industrial customers. The BoA found the evidence insufficient for the remainder of the goods and services covered by the mark.

The EUTM proprietor and the revocation applicant respectively filed actions for annulment before the General Court (GC). The GC joined the cases and dismissed both actions.

EUTM



SUBSTANCE: Outward use does not necessarily mean use aimed at end consumers. The relevant public does not comprise of only the end consumer, but also of specialists, industrial customers and other professional users. Genuine use of the mark relates to the market in which its proprietor pursues its commercial activities (paras 38, 39). It is common in a market such as that of the EU to direct commercial acts at professionals in the sector concerned, and particularly at resellers, in order to create or preserve an outlet for goods such as those at issue (para. 40). Even though the contested goods in Classes 21 and 25 might be offered with the ultimate goal of encouraging the relevant public to purchase the coffee sold by the EUTM proprietor, they are not handed out as a reward for the purchase of other goods (the coffee) or to encourage the sale of those goods. The contested goods in Classes 21 and 25 are accounted for and offered separately. They are independent goods which have their own outlet (para. 48). The contested goods in Classes 21 and 25 are also in competition with other similar goods from other undertakings on the market which are also likely to provide these goods in order to promote their main product (para. 49). As regards the remaining goods, the EUTM proprietor did not provide sufficient evidence of genuine use (paras 56-58). The mere provision of a direct line for customers does not constitute an independent service but only a service of assistance connected with the sale of the goods actually marketed by the proprietor of the mark (para. 58). When assessing

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

genuine use of a mark, small and large undertakings cannot be treated differently depending on their size, since the genuine nature of that use is assessed based on the same objective criteria (paras 68-69).

T-277/18; PICK & WIN MULTISLOT (fig.); Zitro IP Sàrl v EUIPO; Judgment of 9 April 2019; EU:T:2019:230; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Distinctive element, Laudatory mark, Slogan mark

FACTS: The applicant sought to register the figurative sign **PICK & WIN MULTISLOT** as an EUTM for goods and services in Classes 9, 28 and 41.

The Office refused to register the EUTM application pursuant to Article 7(1)(b) CTMR.

The applicant appealed. The Board of Appeal (BoA) dismissed the appeal, considering the sign to be a purely laudatory promotional message devoid of distinctive character.

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



EUTM



SUBSTANCE: RELEVANT PUBLIC. The relevant public consists of English-speaking general and professional consumers of the European Union (not disputed) (para. 20).

DISTINCTIVE CHARACTER. The word elements of the sign are 'pick & win multislot' and not 'pic & K win multislot' as claimed by the applicant since the word 'pick' constitutes a unit, taking into account its colours and size (para. 24). The expression does not contain any original elements that would allow the relevant public to easily and immediately memorise it and is therefore not distinctive for the goods and services (para. 26). The word 'win' is commonly used in the field of gambling and does not require any effort of interpretation or cognitive process in order to establish a relationship between that sign and the goods. Thus, the word element 'pick & win multislot' will be perceived by the relevant public as a purely promotional message highlighting the positive aspects of its goods and services (paras 30-33).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



GLOBAL IMPRESSION. The graphic representation of the sign only contains figurative elements in attractive colours, commonly used in the gambling sector, which simply emphasise the laudatory and promotional character of the expression (paras 40-42, 44 and 47).

T-403/18; W S WELLPHARMA SHOP (fig.) / WELL AND WELL; Pharmadom v EUIPO; Judgment of 11 April 2019; EU:T:2019:248;

Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Dissimilarity of signs, Distinctive element, Dominant element, Figurative element, Likelihood of confusion

FACTS: The applicant sought to register the figurative mark '**w s wellpharma shop**' as an EUTM for goods and services in Classes 5, 10, 35, 42 and 44.

An opposition based on the earlier French word mark **WELL AND WELL**, registered for goods and services in Classes 3, 5, 10, 35 and 44, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition finding that there was no likelihood of confusion (LOC).

The opponent filed an appeal, which the Board of Appeal (BoA) dismissed, finding that there was no LOC.

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

EUTM application



Earlier trade mark

WELL AND WELL

SUBSTANCE: RELEVANT PUBLIC. The relevant public is the French public and consists of both the public at large and health professionals; the level of attention ranges from average to high (not disputed) (para. 21).

COMPARISON OF GOODS. For reasons of procedural economy, it is assumed that all the goods and services are identical (not disputed) (para. 22).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



DOMINANT ELEMENT. The stylised figurative element in the EUTM application is the dominant element, due to its size and position (paras 31 and 35). The word elements 'wellpharma' and 'shop', while not being negligible, are less eye-catching.

DISTINCTIVE ELEMENT. The word 'well' refers to the concept of 'well-being' and therefore has a weak distinctive character (paras 37-38). The word 'pharma' in the EUTM application is descriptive of the products and services (para. 39). Finally, the word 'shop' in the EUTM application has a weak distinctive character as it refers to the place where it is possible to purchase the goods and services (para. 41).

VISUAL SIMILARITY. The visual similarity between the marks is limited to the presence of the common element 'well' and the letter 'w' (para. 52). However, the additional elements 'pharma' and 'shop' and, in particular, the dominant figurative element in the EUTM application reduce the degree of similarity (para. 53). Thus, the marks are visually similar to a low degree (para. 54).

PHONETIC SIMILARITY. The marks only coincide in the first word element 'well' (para. 58). However, the EUTM application includes the other word elements 'pharma' and 'shop'. In addition, the earlier trade mark features the repetition of the word 'well' ('well and well'), which gives it its own pace and sound (para. 59). Consequently, the marks are phonetically similar to a very low degree (para. 60).

CONCEPTUAL SIMILARITY. For the part of the relevant public that understands English, there is a certain degree of conceptual similarity, whereas for the part of the relevant public that does not understand English, the marks are not conceptually similar (paras 61-63).

LIKELIHOOD OF CONFUSION. The visual, phonetic and conceptual similarities do not offset the differences between the marks, namely, the dominant figurative element and the presence of the words 'pharma' and 'shop' in the EUTM application (paras 65-67). Therefore, there is no LOC.

T-779/17; VIÑA ALARDE / ALARDE; United Wineries, S.A v EUIPO; Judgment of 4 April 2019; EU:T:2019:220;

Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Likelihood of confusion, Proof of use

FACTS: The applicant sought to register the word mark **VIÑA ALARDE** as an EUTM for goods in Class 33, namely, alcoholic beverages (except beers).

An opposition based on the earlier Spanish word mark **ALARDE**, registered for goods in Class 33, namely alcoholic beverages (except beers), was

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



filed pursuant to Article 8(1)(b) CTMR. The applicant requested proof of genuine use, for which the opponent produced evidence of the sale of 1 200 bottles of wine amounting to EUR 4 200 and other smaller transactions.

The Opposition Division (OD) considered the proof of genuine use sufficient and upheld the opposition on the grounds that there was likelihood of confusion (LOC).

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal, finding that the opponent had demonstrated use of the earlier mark and that, given that the products covered by the marks were identical and that the signs were highly similar from a visual, aural and conceptual point of view, there was LOC.

The applicant went on to file an action before the General Court (GC), relying on two pleas in law: infringement of Article 47(2) EUTMR and infringement of Article 8(1)(b) EUTMR.

SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE 47(2) CTMR.

TYPE OF PROOF OF USE. No rule of law requires that the proof of genuine use must consist of different types of evidence (para. 26). Genuine use can be proved by invoices only, provided they contain

all the relevant indications required by Rule 22(3) CTMR, notably place, time, extent and nature of use (para. 27).

TERRITORIAL SCOPE OF USE. Article 42(2) and (3) CTMR and Rule 22 CTMR do not require proof of genuine use in a substantial part of the relevant territory (paras 37 and 41).

DURATION OF USE. The invoices correspond to the years 2011, 2012, 2013 and 2014 which shows a certain constancy and proves genuine use of the earlier mark at least for part of the relevant period (paras 45-46).

EXTENT OF USE. The invoices originate from different companies in different regions of Spain and relate to different aspects of the marketing of wine, namely labelling, encapsulation, promotion and sales (para. 51). According to the invoices submitted, there is an important difference between the volume of capsules and labels purchased and the number of bottles sold. This fact reinforces the assumption that the evidence submitted does not reflect the total number of sales made but represents only a sample of invoices (para. 54). In any event, even a small volume of products marketed, notably 1 200 bottles of wine for a total value of EUR 4 200 can be considered sufficient to prove actual commercial activity (paras 55 and 58-59).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



GLOBAL ASSESSMENT OF PROOF OF GENUINE USE. The earlier trade mark has been put to stable, continuous and relatively widespread use, characterised by the regularity of the commercial activity and the commercial relations with a number of different customers and providers in several regions of Spain (paras 65 and 67).

(ii) INFRINGEMENT OF ARTICLE 8(1)(b) CTMR

RELEVANT PUBLIC. The relevant public consists of the Spanish public at large whose level of attention is average.

VISUAL SIMILARITY. The signs are visually similar to a high degree. The average consumer of wine products will immediately focus their attention on the common element 'ALARDE'. The word element 'VIÑA' is not distinctive for the products and the consumer usually recognises wine by reference to the verbal element which designates the grower or the estate on which the wine is produced (para. 86).

PHONETIC SIMILARITY. As the attention of the consumer will largely be attracted by the common element 'ALARDE', the signs are phonetically similar to a high degree (para. 91).

CONCEPTUAL SIMILARITY. The signs are conceptually similar to a high degree since the meaning of the common word is identical (para. 94).

LIKELIHOOD OF CONFUSION. Given that the goods are identical and that the conflicting signs are similar to a high degree, there is LOC for the relevant public (para. 96).

T-323/18; DARSTELLUNG EINES SCHMETTERLINGS; Fomanu v EUIPO; Judgment of 11 April 2019; EU:T:2019:243;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Promotional material, Proof of use

FACTS: The figurative mark was registered for goods and services in Class 9, such as computer programs and software, in particular software for the exchange, storage, reproduction and systematic acquisition of data, Class 16, such as printed matter, paper, stationery, Class 38, such as telecommunications, Class 40, namely bookbinding and several services in Class 42.

The revocation application was lodged on 9 July 2015 claiming that the mark had not been genuinely used pursuant to Article 51(1)(a) CTMR. The cancellation division (CD) partially upheld the application and revoked the mark for all the goods and services except for printed matter (in particular photobooks and calendars) printed with individual photos in Class 16.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The EUTM proprietor (whose business is printing pictures) gives DVDs, USB keys, etc., free of charge to buyers of its photobooks either as giveaways, or in order to allow the customer to place his order online. Consequently it appealed to the Board of Appeal (BoA). The BoA partially upheld the appeal, confirming the CD's decision insofar as the EUTM was revoked for goods and services in Classes 9, 38 and 40. However, it annulled the decision with respect to the goods in Class 16.

The EUTM proprietor filed an action before the General Court (GC), relying on a single plea in law divided into three parts: infringement of Article 58(1) (a) EUTMR in conjunction with Article 58(2) EUTMR and Article 18(1) EUTMR and Article 19(1) EUTMDR. The GC dismissed the action.

EUTM



SUBSTANCE: Infringement of Article 58(1)(a) EUTMR in conjunction with Article 58(2) EUTMR and Article 18(1) EUTMR and Article 19(1) EUTMDR.

(i) PROMOTIONAL USE for goods in Class 9, namely computer programs and software, in particular software for the exchange, storage, reproduction and systematic acquisition of data.

The EUTM proprietor sold more than 1 250 000 photobooks and 550 000 calendars and distributed 5 000 CDs and DVDs. Over the same period, there were a million deliveries, including downloads, of the software. CDs and DVDs — as carriers of the software which is indispensable for the design and order of the photobooks — were offered free of charge (para. 34).

The CDs and DVDs were not distributed in an autonomous manner; rather their free distribution was made exclusively in the context of marketing the photobooks and calendars (para. 36). The software only constitutes a tool, albeit indispensable, for the order and design of the goods and is not a product which is sold independently (para. 37). The EUTM proprietor does not compete on the software and DVD market. The items are not distributed with the aim of penetrating the market for goods in the same class. Affixing the trade mark on such products does not aim to create an outlet for them (para. 38).

Consequently, the free distribution of the CDs, DVDs and software on which the contested trade mark is affixed does not constitute genuine use of this trade mark for the goods in Class 9 (paras 38-39).

(ii) PARTIAL USE for goods in Class 16, namely printed matter

If a trade mark has been registered for a category of goods or services which is sufficiently broad to

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



be divided into sub-categories capable of being viewed independently, proof that the mark has been genuinely used in relation to a part of those goods or services affords protection only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong (para. 47).

However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition (para. 48).

The printed matter category is broad enough to be sub-divided (para. 52). The sub-category printed matter printed with individual photos is sufficiently homogeneous (para. 53). Therefore, the trade mark proprietor does not prove that the BoA incorrectly restricted the protection of the contested trade mark to the sub-category printed matter printed with individual photos (para. 55).

(iii) USE in respect of services in Class 38, such as telecommunications and in Class 40, such as bookbinding.

The services of Classes 38 and 40 were not independently provided in the corresponding markets. Therefore, they do not reveal that the EUTM proprietor intended to penetrate those markets using these services (paras 61-62).

T-558/18; Djili DS (fig.) / DJILI; Lupu v EUIPO; Judgment of 30 April 2019; EU:T:2019:268;
Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Suspension of the proceedings

FACTS: The applicant sought to register the figurative mark Djili DS for goods in Classes 29, 31 and 32.

An opposition based on the earlier Romanian word mark DJILI covering, inter alia, goods in Classes 29 and 31, was filed pursuant to Article 8(1)(a) and (b) CTMR. The only earlier trade mark invoked was subsequently declared invalid by the Romanian authorities, later confirmed by a decision of the Romanian Supreme Court. Based on the submission of this judgment by the applicant, the OD lifted the suspension it had previously granted and rejected the opposition.

The opponent filed an appeal, arguing that since the parties did not receive the reasoning of the decision of the Romanian Supreme Court, the suspension should have been maintained. Once it knows the reasons for the decision of the Supreme Court, the opponent may file an action before the European Court of Human Rights (ECHR).

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



The Board of Appeal (BoA) considered that it was not appropriate to suspend the proceedings, and dismissed the appeal. Since the only earlier right invoked had been declared invalid by a decision of the Romanian Supreme Court which did not have suspensive effect, the opposition was held unfounded. In addition, no relative ground for refusal under Article 8(4) CTMR was raised within the period prescribed, so the applicant had no valid reason to request an extension to the opposition filing period.

The opponent filed an action with the General Court (GC), relying on a single plea in law: infringement of his rights as the proprietor of an earlier mark, notably infringement of Article 6 ECHR, Rule 20(7)(a) and (c) CTMR and, by analogy, Article 53(2)(c) and (d) CTMR. The GC dismissed the action.

SUBSTANCE:

INFRINGEMENT OF ARTICLE 6 ECHR AND RULE 20(7) (a) AND (c) CTMR

The final national decision, by which the only earlier Romanian right was declared invalid, does not justify maintaining the suspension of the procedure before the BoA, even if the reasons for the rejection of the appeal by the Romanian Supreme Court are not yet known (paras 26-28). Even though the six-month period for the applicant to bring an action before the ECHR had not elapsed, when the Board made

EUTM application



Earlier trade mark

DJILI

its ruling, the national courts had ruled definitively on the invalidity of the earlier mark which had been removed from the national register of marks (para. 31).

The applicant cannot rely on an unregistered trade mark or another sign used in the course of business on the basis of Article 8(4) CTMR, since the opposition was brought pursuant to Article 8(1)(a) and (b) CTMR. Following the expiry of the time limit for submitting a statement of opposition pursuant to Article 41 CTMR, the applicant may no longer rely on new earlier rights or new grounds for opposition (without prejudice to the possibility of making an

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



application for a declaration of invalidity pursuant to Article 60 EUTMR) (paras 34-35).

The second head of claim, by which the applicant requests that the Court uphold its opposition or declare the mark applied for invalid, thus, in essence, seeking to change the contested decision, is rejected, since the contested decision is not vitiated by any defects which render it unlawful.

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

RESULT: Action upheld (BoA decision annulled)

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

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

The applicant appealed. The Board of Appeal (BoA) dismissed the appeal based on the earlier IR

designating France and the United Kingdom. The BoA held that the words of which the mark applied for was comprised had no meaning, irrespective of whether or not they were perceived as a first name and surname, and were co-dominant in the overall impression. The first name does not convey a concept. Should the relevant public perceive the terms 'andrea' and 'andreaia' as first names, it would understand them as two versions of the same first name. The 'incontri' element might be considered to be a surname of Italian origin, though without any clear concept for a French or English consumer. It was not established that surnames were, in principle, of greater distinctiveness than first names.

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

SUBSTANCE:

(i) PROCEDURAL ISSUES

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

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



designated by the earlier Spanish and Portuguese marks is therefore ineffective (para. 36).

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

The BoA failed to have regard to whether the first name 'Andrea' and the surname 'Incontri' were common or rare, even though the applicant had claimed in the administrative proceedings that the 'andrea' element was a common first name and the 'incontri' element was rather a rare surname (para. 47). The Office only claimed, at the stage before the GC, that the rarity of the first names 'andrea' and 'andreaia' in France and the United Kingdom is based on a well-known fact. Non-compliance with the duty to state reasons cannot be regularised by the fact that the person concerned becomes cognisant thereof during proceedings before the EU judiciary. The possibility for an EU institution or body to plead supplementary grounds for the first time before the General Court, even if they are claimed to be well-known, in order to complete the grounds set out in the contested decision would undermine the rights of defence of the party concerned and its right to an effective judicial remedy, as well as the principle of equality of parties before the EU judiciary (paras 53, 55-56). Since the BoA based its reasoning on two hypotheses without settling which of those hypotheses was correct, the GC cannot give precedence on any of them without substituting its own reasoning for that of BoA (para. 57). The GC thus annulled the BoA decision.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law

New Decisions from the Boards of Appeal

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4/05/2019, R 2094/2018-5, [Rechter Winkel \(fig.\)](#)

Contested EUTM



Outcome: Decision confirmed.

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

Keywords: Figurative trade mark, Non-distinctive.

Summary: The examiner rejected the application for the sign as represented above in relation to medical diagnostic and surgical goods and services in Classes 9, 10 and 44 (§ 3).

The relevant public consists of both professionals and the general public (§ 15-19). The figurative



sign consists of a simple geometric symbol, which serves only a decorative purpose and is not able to distinguish the goods and services applied for (§ 24, 27, 30). The applicant's line of reasoning, that it represents a stylized L and that the specialised public would immediately link this with the applicant, has not been supported by any evidence and cannot be upheld (§ 34).

17/05/2019, R 2425/2018-4, [sans OGM](#)

Contested EUTM



Outcome: Decision confirmed.

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

Keywords: Descriptive (yes), Figurative trade mark, Non-distinctive.

Summary: The examiner refused the registration of the figurative mark represented above for goods in Class 29 (§ 2).

The sign applied for as an individual trade mark informs the relevant French-speaking consumers that the goods (dairy products and their substitutes; eggs and egg products) do not contain genetically

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



modified organisms or a share of less than 0.9 %. The graphic elements are commonplace and insufficient to render the sign distinctive (§ 13). The graphic design of the label in no way alters the narrative nature of the text (§ 15). The sign in its entirety directly describes the nature, production method, and quality of the goods claimed. The sign, as the pure combination of descriptive elements, does not have distinctive character in respect of the goods applied for (§ 18).

22/05/2019, R 2110/2018-2, Presentation of an emblem (fig.)

Contested EUTM



Outcome: Decision confirmed.

Norms: Article 7(1)(h) EUTMR, Article 14 EUTMR.

Keywords: Emblem, Legitimate expectations.

Summary: The examiner rejected the application for the sign as represented above in relation to all the goods and services applied for (§ 3).

The sign applied for consists of the representation of the Maltese cross within a shield similar to a coat

of arms (§ 19). According to Article 7(1)(h) EUTMR, the registration of the sign in question as an EUTM would require the authorisation of the Republic of Malta (§ 22). The argument of the applicant, according to which an International Catholic Rescue Organisation of the Order of Malta gives enough historical reason to justify the registration of the sign without the consent of the Republic of Malta, cannot be followed, although it may be entitled to use the mark under the conditions laid down in Article 14 EUTMR (§ 23-24).

17/04/2019, R 2048/2018-5, SEAWATER EXPERIENCE MEDITERRANEA (fig.)/ Mediterranean nut company

Contested EUTM



Earlier EUTM

MEDITERRANEAN NUT COMPANY

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Outcome: Decision confirmed.

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

Keywords: Descriptive element, Figurative element, Figurative trade mark, Non-distinctive.

Summary: The examiner upheld the opposition in its entirety on the basis of the existence of a likelihood of confusion between the contested and the earlier EUTM (§ 6).

The relevant customers are the general public, whose level of attention is medium (§ 22). The goods under appeal are identical or similar (§ 28, 31-32), namely prepared olives; stuffed olives compared to canned fruit on the one hand, and pizzas compared to cereal preparations on the other hand. The signs have an average degree of similarity (§ 51). Although the signs analysed differ in the verbal elements, “NUT COMPANY” of the earlier mark, and “SEAWATER EXPERIENCE” of the contested mark, given its limited distinctiveness, and its minor size, they go unnoticed in the eyes of the consumer. Therefore, such verbal differences and the graphical elements of the contested sign are not sufficient to exclude the existence of a risk of confusion. Furthermore, the public tends to pay more attention to similarities rather than differences (§ 55).

Reference was made to the Common Practice of Relative Grounds of Refusal (CP5), applied by the 25 EU and three non-EU implementing offices, according to which a coincidence in an element with a weak distinctive character will not in itself give rise

to a risk of confusion, except in the case where the other components have a lower distinctive character (or are similarly weak or with little visual impact), and the impression of the marks is the same (§ 60).

25/04/2019, R 2495/2018-5, apo (fig.) / DEVICE OF AN APPLE WITH A BITE (fig.) et al.

Contested EUTM



Earlier sign



Outcome: Decision confirmed.

Norms: Article 8(5) EUTMR.

Keywords: Figurative element, Reputation, Similarity of the signs, Remittal from GC/CJ.

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Summary: The Opposition Division rejected the opposition based on Articles 8(1)(b) and (5) EUTMR, reasoning that the overall impressions of the signs are different (§ 7). An appeal was brought against that decision which was dismissed by the Fourth Board of Appeal (R 698/2016-4). With judgment of 13 September 2018 in case T-104/17, the General Court annulled the decision of the Fourth Board of Appeal of Appeal (§ 10, 12).

In the present decision the Board, following the findings of the General Court, finds that the signs were conceptually and visually similar to a certain degree, both of them referring to an apple (§ 24).

The Board also confirms that the evidence submitted by the opponent before the Opposition Division provides sufficient proof to determine that the earlier Apple logo had acquired a high degree of reputation in the relevant territory before the filing of the contested application (§ 36). Because of the uniqueness and high reputation of the earlier mark, the contested sign's figurative element, the representation of a part of an apple, will trigger and establish a mental 'link' with the earlier Apple logo (§ 53). As regards unfair advantage, the Board finds that the characteristics associated with the Apple brand are likely to be transferred to the applicant. Since the applicant would be benefitting from the reputation of the Apple brand, without paying any compensation to the opponent, or expending the money necessary to create a market for its products in the EU, it is effectively riding on the coat-

tails of the opponent which constitutes an unfair advantage (§ 58). As regards due cause, the Board finds that, in the absence of any indications in the evidence providing an apparent justification for the applicant's use of the contested mark, the lack of due cause must be generally presumed (§ 65). The decision was annulled and the EUTM was rejected.

10/04/2019, R 31/2018-3, Building blocks from a toy building set

Outcome: Decision annulled.

Norms: Article 8(1) CDR, Article 65 CDR.

Keywords: Technical function of design.

Summary: A declaration for invalidity was filed against the RCD represented above, indicated as 'building blocks from a toy building set' (§ 1). It was rejected by the Invalidity Division (§ 4).

The Board rejected the appointment of an expert, agreeing with the design holder that it is not necessary because the technical information that the expert would provide is already known by the Board and the parties (§ 15).

As regards the applicability of Article 8(1) CDR, the Board finds that what the design holder identifies as a 'building block' is in fact a brick and will thus be referred to hereinafter as simply 'the brick'. What the design holder identifies as 'a toy building set' is

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

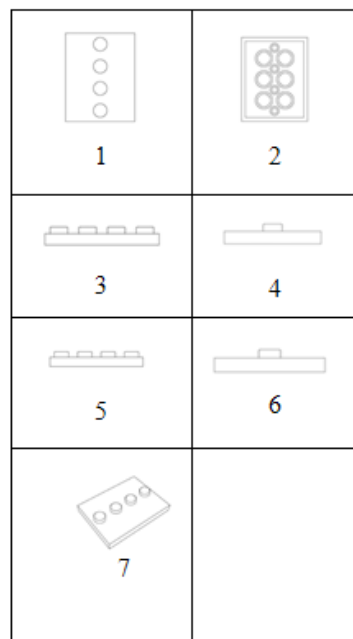
Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case law



Contested RCD



blocks in order to play (§ 32, 34). The Board also considers that the findings made by the Grand Board of Appeal in relation to the design holder's EUTM application No 107 029 may be transposed, mutatis mutandis, to the contested RCD in view of the fact that the features of appearance of the brick are the same (§ 52) (see R0856/2004-G, T-270/06, C-48/09P, 3D Shape of Lego brick).

clearly the set of bricks that children may assemble in order to build the mentioned objects (§ 26). The technical function that the brick must fulfil is the capability of being assembled with sufficient stability with other bricks so that it can form part of a toy building (§ 31).

All the features of the appearance of the product are solely dictated by the technical function of the brick, namely to be assembled with other similar

First Page

- New eAppeal Version 2: new improvements for users

Statistical Highlights

- May 2019

EUIPN Updates

- Visual search for TMview extended to Croatia
- Draft Common Practice of the CP8 project published
- Austria launches new online services for designs

More News

- Public consultation on EUIPO's strategic plan
- 2 million trade mark applications received at EUIPO
- EUIPO and EPO renew cooperation agreement

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal