

# Alicante News

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Up to date information on IP and EUIPO-related matters



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## EUIPO's Strategic Plan 2025

*By Christian Archambeau, Executive Director of the EUIPO*

The launch this month of our Strategic Plan 2025 is another milestone for us, and one which we reach at a very challenging time for many businesses across Europe and beyond.

Our Strategic Plan is our roadmap for the future; it will shape everything we do over the next five years. We built it on a strong basis of consultation with our stakeholders and partners, receiving contributions from EU national and regional IP offices, international IP partner offices, user groups, academia, cultural organisations and individuals. Of course, our staff played a big part too in sending feedback and ideas during the Plan's development.

What we launch today is a collective and collaborative document, which brings us towards the goal of becoming a true IP hub of excellence. With this in mind, our actions for the next four years are grouped within three Strategic Drivers, each one uniting us, our stakeholders, and our customers around a common purpose.

Each Driver has a different, but interlinked focus. The first, 'An interconnected, efficient and reliable IP System for the Internal Market' (SD1), is related mainly to the external activities of the Office. It

builds on the cooperation work carried out under our first two Strategic Plans, in particular the creation of the powerful EU-wide networks that are the focus of so much of our work, and which have delivered concrete benefits to users of the EU IP system over the past years. Here, our focus towards 2025 is to sustain and build on those networks and their impact, during this period of unprecedented technological change and development. Through the work and projects nested under this Driver, we aim to deliver an interconnected, effective and reliable IP system to EU businesses, citizens and other IP stakeholders both within the EU's internal market and in the global environment.

The second Strategic Driver focuses on our customers. 'Advanced customer-centric services' (SD2), guides the actions that will be taken in order to provide the Office's customers, including SMEs, large businesses and intermediaries, with the state-of-the-art tools, services and guidance that they need to succeed in this new business and digital environment. Quality customer service is at the heart of this Driver, and as an Office, we will be centering our approach even more on our customers, segmenting our efforts and activities to ensure that we deliver a tailored approach to every type of customer. Initiatives like the Customer Panels, which actively seek customer feedback on our tools and services, will be key to informing the success of our activities here.

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Finally, the third Strategic Driver, 'Dynamic organisational skill sets and an innovative workplace of choice' (SD3), truly brings us into the future. It encompasses our evolution in terms of skill sets and working practices, which will enable us to provide state of the art registration services. Underpinning and reinforcing the work of the first two Drivers, this set of projects and actions will support us on how we can best leverage emerging technology, develop skills, and deepen knowledge to achieve our full potential as an Office. This Driver also encompasses our commitment to sustainability and best-in-class environmental performance, both at organisational and individual level.

But our Strategic Plan 2025 is launched against the backdrop of a global crisis. The repercussions of the COVID-19 pandemic on our economies and society are becoming apparent. Many businesses will struggle in these challenging times, and SMEs are no exception. And for Europe to thrive, its SME community must thrive too.

SMEs are the backbone of economic activity in the EU. They make up 99% of all businesses here, supporting around 100 million jobs, and produce 57% of the Union's GDP. They are, quite simply, a powerful economic engine.

We know that SMEs are very different; not all of them will need IP rights in the future. But for those who will, we want to be able to provide the services

and the tools that allow them to access information about IP and secure their IP rights, at whatever level that might be. We will work in partnership with the European Union Intellectual Property Network – the EUIPN – the national and regional offices that administer IP rights at national level across the EU to ensure they get information and support, close to them and in their own language. We will launch a range of actions to support them to access the IP rights that they need – from simplified e-filing tools to awareness campaigns.

And this month, in response to the COVID-19 crisis, we've brought forward key actions we had planned for SMEs, to fully support them in this time of difficulty, in line with EU priorities. The Ideas Powered for Business hub is now live on our website, with information on trade marks and designs, an IP pro bono scheme, effective dispute resolution mechanisms and e-learning especially geared towards SMEs. We'll continue adding to these actions over the coming weeks and months, with a dedicated SME website due to be launched during the lifetime of our Strategic Plan.

The coming years promise to be ones of great challenge and change. As one of the largest IP offices in the world, our mission is to support our customers, across the EU and beyond, to help them overcome those challenges and thrive in these fast-moving times. Through our Strategic Plan 2025, we aim to fulfil that mission.

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## Management Board and Budget Committee meet virtually

The Management Board and Budget Committee meetings of the EUIPO have taken place for the first time in a virtual environment.

EUIPO's Management Board and Budget Committee are composed of representatives of the Member States of the EU, the European Commission and the European Parliament, with the Benelux Office of Intellectual Property (BOIP), the European Patent Office (EPO), the World Intellectual Property Office (WIPO), the Community Plant Variety Office (CPVO), and user associations acting as observers during the non-confidential parts of the meetings.

During the two-day meeting period, Management Board members agreed to propose to the Council a list of candidates for the post of President of the Boards of Appeal of the Office. The Management Board also decided to extend the term of office of three members of the Boards of Appeal.

During the Management Board and Budget Committee joint meeting, Members were informed of the Progress Report on the implementation of the Office's activities during the first quarter of 2020. Within the context of the outbreak of the COVID-19 pandemic, the Executive Director also informed about the series of the measures taken for staff, users and other stakeholders. Considerations on

the impact of the global health crisis on the volumes of incoming applications, the workload as well as the output of the Office were also detailed.

Moreover, the 2020 Satisfaction Surveys, both the User Satisfaction Survey and the Staff Satisfaction Survey, were presented to the Management Board and Budget Committee Members.

Finally, Members were briefed on the steps taken to launch the Strategic Plan 2025 during the Joint meeting.

During the Budget Committee meeting, Members received information on the budget implementation for 2019 and 2020 and, in addition, the Office also provided an update on its treasury management.

In parallel, the governing bodies have adopted in the past weeks a number of decisions by written procedure, such as the decision to discharge the ED for the budget execution 2018, the adoption of the 2019 annual report among others. The information related to these decisions is available at <https://euipo.europa.eu/ohimportal/en/governance>.

Consultation on Convergence Projects CP11 and CP12

The EUIPO has published the third draft of the Common Practices CP11 'New Types of Mark: Examination of formal requirements and grounds

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for refusal' and CP12 'Evidence in Trade Mark Appeal Proceedings', following two successful drafting workshops for the CP11 and CP12 Convergence Projects during May 2020.

The workshop took place in a virtual environment, coordinating multiple connections and contributions among Working Group members and the project teams.

During the sessions, Working Group members from each project addressed the feedback from stakeholders of the second consultations and incorporated amendments into the Common Practice documents. The CP11 sessions took place over three days for work-stream 1 and four days for work-stream 2, while CP12 concluded in 2 days.

As a result of the **joint efforts of the Working Group members** from IP offices, user associations and appeal bodies, in the case of CP12, the final drafts of the Common Practices have been published. Both Common Practices have been made available in English on [www.euipn.org](http://www.euipn.org) for a final review by all stakeholders before being presented to the Extended Working Group of each project in September 2020:

- [CP11: New types of marks: Examination of formal requirements and grounds for refusal and invalidity](#)
- [CP12 : Evidence in Trade Mark Appeal Proceedings](#)

The EUIPO welcomes comments, which should be addressed to [CommonPractices@euipo.europa.eu](mailto:CommonPractices@euipo.europa.eu) by **Monday, 6 July 2020** through the following Confirmation Forms:

- [CP11 Confirmation Form](#)
- [CP12 Confirmation Form](#)

The CP11 and CP12 project are part of the [European Cooperation Projects](#) under the heading ECP4 Shared Services and Practices, which aim to enhance and harmonise the European trade mark landscape for the benefit of users.

## Digitisation of paper books at the Greek Trademark Office

On 3 June, the Greek Trademark Office (GGE) has successfully completed the digitisation of paper books, within the framework of the EUIPO's European Cooperation Projects.

The digitisation process in GGE has been carried out in scope of the ECP5 'Capture and Store Historical Files' subproject, which aims at **digitising paper files across the EU intellectual property** offices to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

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The implementation began in 2019 with the support of different teams at the EUIPO and GGE. Despite the recent challenges related to the COVID-19 pandemic, including restrictions on movement and reduced staff members, the digitisation phase of the implementation has been finalised as scheduled, in June 2020, thanks to the close cooperation between the two offices.

As a result, more than 1.3 million pages, forming 390,000 trade mark dossiers, have been digitised. In terms of stored books, a total of 2,600 have been digitised.

Five offices have completed the subproject, with another five in progress, including GGE. The total number of digitised dossiers has now reached more than 600,000.

The ultimate goal of the project is to support the participating offices in **creating a paperless working environment and to help users interact digitally with the intellectual property offices of the EU.**

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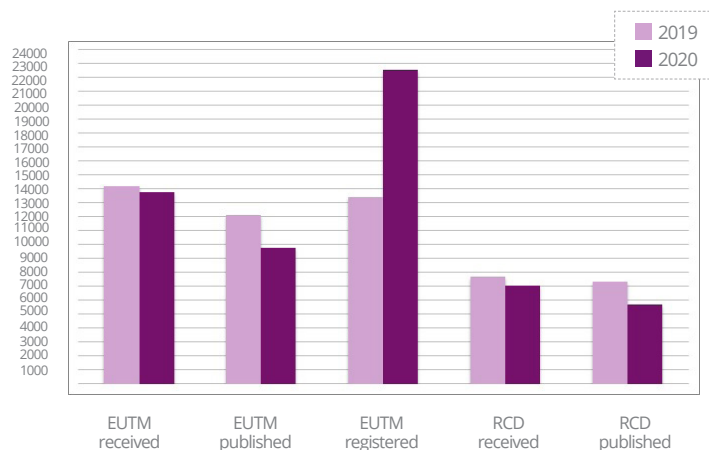




## Statistical Highlights

Monthly statistical highlights May*	2019	2020
European Union Trade Mark applications received	14 184	13 732
European Union Trade Mark applications published	12 095	9 708
European Union Trade Marks registered (certificates issued)	13 398	22 547
Registered Community Designs received	7 697	7 035
Registered Community Designs published	7 292	5 662

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



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## Customer Panel on IP Dissemination

The EUIPO Customer Panel on IP Dissemination met on 5 June, for the last of a series of three online sessions dedicated to the dissemination of IP information.

During the sessions, 13 users (representing 9 user associations) discussed the different categories of IP information they need, how effectively the EUIPO's dissemination tools and services are supporting their work, as well as discussing possible priority areas to improve EUIPO's information dissemination.

The EUIPO would like to thank its users and their user associations for taking part in this panel.

The Customer Panels, launched by the EUIPO in 2020, aim to involve users in shaping the EUIPO's services.

Through this initiative, the EUIPO confirms its commitment to improving its customer service – identifying customers' needs and behaviour, integrating their feedback and delivering solutions adapted to the different customer segments.

## Looking for IP pro bono providers

The COVID-19 crisis has had a severe impact on small and medium-sized enterprises (SMEs) in the European Union, threatening massive job losses and closures.

At the EUIPO we want to help SMEs and you can help them too.

The EUIPO COVID-19 pro bono hub offers a tailor-made service to match SMEs to providers of free-of-charge intellectual property (IP) legal representation and advice throughout the EU during this unprecedented period.

The service focuses on the needs of small businesses, ensuring that they get the IP-related legal advice they need to protect and maximise their rights, and the proper professional representation to defend those rights when challenged. Businesses will be able to obtain practical guidance on how to handle their IP legal matters, which will help them refocus their attention on overcoming the competitive and economic challenges caused by the pandemic.

Apply via [this form](#)

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## COVID-19 measures to complete e-communications

In light of the difficulties that customers have reported when working from home, the EUIPO has accelerated work on e-communications so that all communications sent to the Office can be carried out online.

The Reply button is now available for all e-communications where a reply is permitted. Furthermore, a 'fax alternative' option has been added as an additional fall-back solution. The screenshot below shows how both these options appear.

### **New e-reply option for ALL e-communications**

eComm users, who make up the vast majority of our customers, can now reply to all e-communications – where a reply is permitted – directly from the communications tab in the User Area by clicking on the Reply button. This new feature allows you to draft your reply immediately and add an attachment in just a few clicks.

### **'FAX ALTERNATIVE' option**

While helping those working from home without access to a fax machine, the 'fax alternative' option will also pave the way for a smooth transition to eComm for all, as the use of fax as an option when

communicating with the Office is gradually phased out. The terms and conditions of use of this option can be found [here](#).

We hope you find these new options useful in your dealings with the Office. Your feedback is welcome: [information@euipo.europa.eu](mailto:information@euipo.europa.eu)

## Academy webinars

### **Latest webinars**

#### **Disclosure of design on the internet – Convergence Programme 10**

Due to the growth of e-commerce and the importance of social media, the disclosure of designs is increasingly made via these channels of communication, giving rise to questions on how to prove online disclosures. **The CP10 Common Practice** provides criteria for assessing the disclosure of designs on the internet and recommendations on sources of design disclosure on the internet, the types of evidence used for proving disclosure on the internet, the different means for establishing the date of disclosure and, lastly, exceptions to the availability of designs on the internet.

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## Boundaries of exclusive IP rights in entertainment content

Intellectual property rights grant exclusive rights to the holders of patents, trade marks, copyright or industrial designs. However, these rights are not unconditional as their respective legislation provides for some limitations which have also been developed by case-law. In this webinar, the speaker will explain the extent to which third-party content can be included in entertainment products (e.g. music, movies, video games) and some recent cases in which this issue has been analysed.

## Artificial Intelligence

This webinar provides a comprehensive overview of developments in AI from a conceptual point of view as well as looking at how these developments can be applied to certain business problems. The speaker will also provide a basic explanation of some of the mathematical and technical foundations of AI and the tools and platforms for its deployment.

## Design decisions of the EUIPO Boards of Appeal

This webinar provides an overview of recent design decisions of the EUIPO Boards of Appeal.

## Decisions of the trimester of the GC and CJEU

This webinar provides an overview of the most relevant decisions of the GC and the CJEU during the second quarter of 2020.

## The Brompton bicycle CJEU decision – Where do functional shapes now stand in EU copyright law?

The famous Brompton bicycle can be folded up after use. The bike was originally protected by a patent. Following its expiry, the defendant (Chedech/Get2Get) embarked on selling a similar bike in Belgium. Brompton then sued for copyright infringement. This webinar comments on the CJEU's decision of 11 June 2020 ([Case C 833/18, SI, Brompton Bicycle Ltd. v. Chedech / Get2Get](#)). This decision explains how copyright law applies to functional shapes and beyond.

## The most viewed one: recent trends in LOC

### Likelihood of confusion: The 3-step test and recent trends in the case law of EU Courts

Dive into likelihood of confusion! Highlighting key aspects of the confusion test, this webinar will focus on the 3-step test developed by the case-law of EU courts and identify some of the trends in recent case-law. It will recap the general principles and provide some tips and tricks for practitioners.

[Take advantage of the online learning offer in the Academy Learning Portal.](#)

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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 has prepared an [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

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

**13/05/2020, T 86/19, BIO-INSECT Shocker, EU:T:2020:199**

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

**KEYWORDS:** Contrary to public policy or principles of morality, Deceptive element, Descriptive element

**FACTS:**

The word mark BIO-INSECT Shocker was applied for on 26/11/2015 and registered on 10/03/2016 as an EUTM for goods in Classes 1 (biocidal products for manufacture; chemical preparations for the manufacture of biocides; chemical additives for insecticides), 5 (including products for destroying vermin, parasiticides; insecticides; biocides; insecticide preparations) and 31.

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An application for declaration of invalidity, based on, inter alia, Article 7(1)(b), (c), (f), and (g) CTMR, was filed for all of the contested goods. The Cancellation Division dismissed the application for declaration of invalidity.

The invalidity applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the contested mark was not descriptive, nor was it contrary to public policy or deceptive.

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

### **SUBSTANCE:**

#### (i) INFRINGEMENT OF ARTICLE 7(1)(b) AND (c) CTMR

The meaning of the term 'Shocker' refers to something shocking and does not specifically refer to killing or repelling. Therefore, the link between the word 'shocker' and the insect-repellent goods is not direct and strong enough to allow the public, without any further consideration, to immediately understand this as a description of the contested goods or their characteristics (§ 44-45).

In an invalidity action, the evidence for the descriptive character of a mark must relate to the time of the application to make it possible to draw conclusions about the situation at that time (§ 58).

The BoA was right in considering that the evidence submitted by the invalidity applicant was insufficient to prove the general use of the word 'shocker' for insect-repellent goods at the date of the filing of the trade mark application (§ 62).

#### (iii) INFRINGEMENT OF ARTICLE 7(1)(g) CTMR

The term 'bio' refers, generally speaking, to the idea of respect for the environment, the use of natural materials, or organic products (§ 80-81).

The use of the term 'bio' on biocidal goods (§ 75) for which the contested mark is registered establishes a sufficiently serious risk of misleading the consumer as to the purpose of the contested goods, namely that they serve to destroy or prevent pests (§ 83). Article 7(1)(g) CTMR applies even where non-misleading use of the mark at issue is possible (§ 84). The possibility of non-misleading use of the mark in question, if that were to be established, is unable to exclude an infringement of Article 7(1)(g) CTMR (§ 85).

Therefore, the BoA was wrong in considering that the contested mark was not misleading for goods in Classes 1 and 5 identified as biocidal products and the BoA decision is to be annulled as far as those goods are concerned (§ 87-88).

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(ii) INFRINGEMENT OF ARTICLE 7(1)(f) CTMR

Since the second plea in law relates to the same goods as the third plea, it is not necessary to examine the second plea (§ 89).

**13/05/2020, T 172/19, FORME D'UN TRESSAGE SUR UNE BOUTEILLE (3D), EU:T:2020:202**

**RESULT:** Action dismissed

**KEYWORDS:** Non-distinctive, Shape mark, Three-dimensional mark

### FACTS:

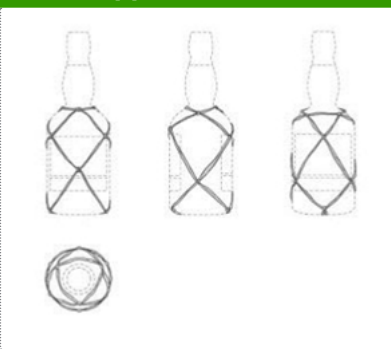
The applicant sought to register the three-dimensional sign reproduced in black and white as an EUTM for Rum in Class 33.

The examiner refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the mark was devoid of distinctive character for the goods as the average consumer would perceive the mark as an aesthetic or decorative finish that does not depart significantly from the norms or customs of the sector.

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 application



### SUBSTANCE:

INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR.

The assessment of the distinctive character of three-dimensional marks consisting of the shape of the product itself is not different from that of other types of trade marks. Only marks with shapes that depart significantly from the norms or customs of the sector are not devoid of any distinctive character (§ 24-26). Case-law concerning three-dimensional marks consisting of the appearance of the product itself, or of the packaging of goods that are packaged because of their nature, such as liquids, is applicable if the contested mark consists of the specific aspect of the packaging (§ 27).

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In its analysis of whether the mark departed from the norms or customs of the sector, the BoA was right to take into consideration the alcoholic beverages sector in general rather than just the sector dedicated to rum (§ 37). Considering the nature of the product, a broader sector could be taken into account (§ 38).

The sector, cannot be limited to the sector dedicated to rum since it cannot be excluded that rum consumers' perception of the mark might be influenced by the marketing methods developed for other drinks of the same kind and intended for the same consumers, including, in particular, alcoholic drinks (§ 41).

The BoA could base its analysis on facts resulting from the generally acquired practical experience in the marketing of widely consumed products, as those facts were likely to be known to the consumers of these products (§ 42).

The applicant's rum is not the only product to use bottles decorated with braiding (tressage) (§ 48). The BoA was not required to indicate, in a general and abstract manner, all the norms and customs of the sector concerned (§ 49).

The fact that examples of bottles decorated with braiding (tressage) do not appear among the first results of a specific internet search is not, in itself, enough to call into question the conclusion that

the decoration of bottles in the alcoholic beverages sector with braiding (tressage) is one of the customs of that sector (§ 50).

Novelty or originality are not relevant criteria for assessing the distinctive character of a trade mark. The mark must depart significantly from the basic shapes of the goods in question, commonly used in trade, and not appear as a mere variant of those shapes (§ 52).

The braiding (tressage) that is the subject of the trade mark applied for does not differ substantially from that used on the bottles of the PUJOL, RHUMERIE DU DOMAINE DE L'ACAJOU, BRUGAL ANEJO and Marqués de Cáceres trade marks (§ 53).

The mark applied for will only be perceived by the relevant public as a mere decorative or aesthetic finish to the goods concerned, and not as an indication of commercial origin (§ 57).

The fact that a trade mark simultaneously fulfils several functions, in particular technical, decorative or indicative of the commercial origin of the goods, has no bearing on its distinctive character when the relevant public perceives the mark applied for as a commercial indication of the goods (§ 59).

The overall complexity of the braiding (tressage) applied to the outside of the targeted products did not make it possible to remember specific details of

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the pattern, so the mark applied for could not be easily and immediately memorised by the relevant public as a distinctive sign (§ 60).

Furthermore, the impression left by the braiding (tressage) in question is not stable but is likely to be perceived differently depending on the angle of vision and on the very different shapes of the bottles (§ 61).

**13/05/2020, T 445/18, Peek & Cloppenburg / Peek & Cloppenburg, EU:T:2020:186**

**RESULT:** Action dismissed

**KEYWORDS:** Coexistence of trade marks, Company name, Sign of mere local significance, Suspension of the proceedings

### **FACTS:**

The applicant sought to register the word sign Peek & Cloppenburg as an EUTM for goods and services in Classes 18, 25 and 35. An opposition based on the commercial designation Peek & Cloppenburg, which is recognised as such in Germany and is used to manufacture and market clothing for men, women and children and accessories, such as belts and other leather items pursuant to Article 8(4) CTMR in conjunction with § 5(2), § 6(3) and § 15(2) and (3) of the German Trade Mark Act (MarkenG). The opposition division upheld the opposition.

On 8 August 2007, the applicant filed an appeal before the BoA. On 25 October 2011, the opposition proceedings were suspended as there were pilot proceedings before the Office relating to two opposition proceedings between the same parties ('the pilot proceedings'). In the pilot proceedings, the BoA upheld the oppositions based on Article 8(4) CTMR and rejected the applicant's applications. The GC rejected the applicant's actions in the pilot proceedings (18/04/2013, T 506/11 & T 507/11, Peek & Cloppenburg, EU:T:2013:197). The CJ dismissed the appeals (10/07/2014, C 325/13 P & C 326/13 P, Peek & Cloppenburg, EU:C:2014:2059). After the definitive closure of the pilot proceedings, the present opposition proceedings were resumed.

In other proceedings between the applicant and the opponent relating to the applicant's German trade marks (which also include three Peek & Cloppenburg trade marks), the Oberlandesgericht Düsseldorf, after the case was remitted to it by the Bundesgerichtshof by decision of 7 July 2015, ordered the applicant to give its consent to the cancellation of these trade marks. On 28 April 2016, the judgment of the 'Oberlandesgericht Düsseldorf' became final.

On 12 January 2017, the applicant requested that the Office suspend the proceedings ('the request for suspension') until a final decision had been taken in a counterclaim for a declaratory judgment which it had brought against the opponent on 30

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November 2006 ('the counterclaim for a declaratory judgment') before the Landgericht Düsseldorf. In the counterclaim for a declaratory judgment, it requested that the Landgericht Düsseldorf declare that it has the right to have marks derived from its commercial designation registered and to use them in the areas of Germany which have been allocated to it by a demarcation agreement concluded between the parties in 1990 and allegedly confirmed in 1992. The demarcation agreement consists solely of maps on each of which the parties' acronyms are shown, as well as lines to indicate the territories which are respectively allocated to them.

By decision of 24 January 2018 ('the contested decision'), the BoA – referring to the reasoning in the pilot proceedings – dismissed the appeal of 8 August 2007 and the request for suspension.

The applicant filed an action before the GC, relying on four pleas in law. The applicant submits, by its first three pleas, that the BoA misinterpreted Article 8(4) EUTMR, in conjunction with § 15(2) and (3) MarkenG, inasmuch as it took an incomplete account of the substantive conditions laid down by the German law. By its fourth plea, the applicant submits that the BoA infringed Article 70 EUTMR, in conjunction with Rule 20(7)(c) CTMIR, inasmuch as it made manifest errors of assessment when evaluating the applicant's request for suspension and therefore misused its powers. The GC dismissed the action.

### **SUBSTANCE:**

(i) MISINTERPRETATION OF ARTICLE 8(4) EUTMR IN CONJUNCTION WITH § 15(2) AND (3) MarkenG

By its first three pleas, the applicant claims that the BoA did not examine – despite its obligation – the material criterion arising from the expressions 'without authorisation' and 'without due cause' and from the term 'unfair', within the meaning of § 15(2) and (3) MarkenG and the new facts that the applicant put forward in that regard, in particular regarding the alleged rights arising from the demarcation agreement, aspects of the German law relating to undertakings that have the same name ('coexistence doctrine') and the opponent's allegedly inconsistent conduct (§ 56-63).

The GC confirms that the scope of examination that the Office is required to carry out, due to the full reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned, determine whether 'this sign gives its proprietor the right to prohibit the use of a more recent trade mark' (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 53, 66). The examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 69).

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In the present case, the ‘substantive exceptions’, arising from the expressions ‘without authorisation’ and ‘without due cause’ and from the term ‘unfair’, within the meaning of § 15(2) and (3) MarkenG, consequently include the interpretation of the demarcation agreement (§ 73, 74, 76-79) and the existence of abuse of rights (*venire contra factum proprium*) in the execution of the agreement (§ 91).

Nevertheless, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant’s duty to establish existence of the right to prohibit use (the legislation and its interpretation by the competent national courts) (§ 75, 80, 83). That duty exists regardless of the Office’s duty to check the correctness of the ‘legal facts’, if needs be, *ex officio* (§ 76-79, 82). The GC confirms that this duty also applies to the ‘substantive exceptions’ (§ 83, 85, 86) and that the burden of proof in this regard is on the EUTM applicant/proprietor; the existence of the national right is a matter of fact (07/05/2013, T 579/10, *makro*, EU:T:2013:232, § 62 (§ 83) and each party has to establish the rights upon which it relies (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 85, 86).

In the present case, it was therefore not for the BoA to apply German law in order to interpret the delimitation agreement, taking account of the later behaviour of the parties to this agreement. It was for the applicant to first show that such an interpretation is required under German law and, second, that the

result of that interpretation is such as to confer on it the right (as claimed by the applicant) supporting, where appropriate, its demonstration by reference to court judgments given in the Member State concerned (§ 88). The same applies to the alleged abusive behaviour in executing the agreement; it was up to the applicant to show that this is the correct interpretation under the German law (§ 91), as well as with the application of the ‘coexistence doctrine’ in German law – an issue that was already established in the final decisions at German and EU level (§ 95, 99). Therefore, the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 102).

### (ii) INFRINGEMENT OF ARTICLE 70 EUTMR IN CONJUNCTION WITH RULE 20(7)(c) CTMIR

The BoA has broad discretion when deciding whether or not to suspend proceedings (§ 112-113). However, this decision must result from a weighing of the competing interests (§ 114). The judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 113, 115).

The counterclaim for a declaratory judgment must be taken into account within Article 8(4) EUTMR in conjunction with § 15(2) and (3) MarkenG and, consequently, also in the context of the weighing of the competing interests with regard to the request

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for suspension (§ 116, 117). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 120, 121). It was therefore possible to conclude the prima facie analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 122). The BoA did not commit a manifest error of assessment in rejecting the request for suspension (§ 123).

**13/05/2020, T 446/18, Peek & Cloppenburg / Peek & Cloppenburg, EU:T:2020:187**

**RESULT:** Action dismissed

**KEYWORDS:** Coexistence of trade marks, Company name, Sign of mere local significance, Suspension of the proceedings

### **FACTS:**

The applicant sought to register the word sign Peek & Cloppenburg as an EUTM for goods and services in Classes 8, 9, 14, 16, 18, 20, 24, 25, 26, 28, 34, 35, 37, 39, 40 and 41. An opposition based on the commercial designation Peek & Cloppenburg, which

is recognised as such in Germany and is used to manufacture and market clothing for men, women and children and accessories, such as belts and other leather items pursuant to Article 8(4) CTMR, in conjunction with § 5(2), § 6(3) and § 15(2) and (3) of the German Trade Mark Act (MarkenG). The opposition division partially upheld the opposition.

On 5 October 2007, the applicant filed an appeal before the BoA. On 25 October 2011, the opposition proceedings were suspended as there were pilot proceedings before the Office relating to two opposition proceedings between the same parties ('the pilot proceedings'). In the pilot proceedings, the BoA upheld the oppositions based on Article 8(4) CTMR and rejected the applicant's applications. The GC rejected the applicant's actions in the pilot proceedings (18/04/2013, T 506/11 & T 507/11, Peek & Cloppenburg, EU:T:2013:197). The CJ dismissed the appeals (10/07/2014, C 325/13 P & C 326/13 P, Peek & Cloppenburg, EU:C:2014:2059). After the definitive closure of the pilot proceedings, the present opposition proceedings were resumed.

In other proceedings between the applicant and the opponent relating to the applicant's German trade marks (which also include three Peek & Cloppenburg trade marks), the Oberlandesgericht Düsseldorf, after the case was remitted to it by the Bundesgerichtshof by decision of 7 July 2015, ordered the applicant to give its consent to the cancellation of these trade marks. On 28 April 2016,

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the judgment of the 'Oberlandesgericht Düsseldorf' became final.

On 12 January 2017, the applicant requested that the Office suspend the proceedings ('the request for suspension') until a final decision had been taken in a counterclaim for a declaratory judgment which it had brought against the opponent on 30 November 2006 ('the counter-claim for a declaratory judgment') before the Landgericht Düsseldorf. In the counterclaim for a declaratory judgment, it requested that the Landgericht Düsseldorf declare that it has the right to have marks derived from its commercial designation registered and to use them in the areas of Germany which have been allocated to it by a demarcation agreement concluded between the parties in 1990 and allegedly confirmed in 1992. The demarcation agreement consists solely of maps on each of which the parties' acronyms are shown, as well as lines to indicate the territories which are respectively allocated to them.

By decision of 20 April 2018 ('the contested decision'), the BoA – referring to the reasoning in the pilot proceedings – dismissed the appeal, upheld the opposition and rejected the application for all the goods and services. It also rejected the request for suspension.

The applicant filed an action before the GC, relying on four pleas in law. The applicant submits, by its first three pleas, that the BoA misinterpreted Article 8(4)

EUTMR, in conjunction with § 15(2) and (3) MarkenG, inasmuch as it took an incomplete account of the substantive conditions laid down by the German law. By its fourth plea, the applicant submits that the BoA infringed Article 70 EUTMR, in conjunction with Rule 20(7)(c) CTMIR, inasmuch as it made manifest errors of assessment when evaluating the applicant's request for suspension and therefore misused its powers. The GC dismissed the action.

### **SUBSTANCE:**

(i) MISINTERPRETATION OF ARTICLE 8(4) EUTMR IN CONJUNCTION WITH § 15(2) AND (3) MarkenG

By its first three pleas, the applicant claims that the BoA did not examine – despite its obligation – the material criterion arising from the expressions 'without authorisation' and 'without due cause' and from the term 'unfair', within the meaning of § 15(2) and (3) MarkenG and the new facts that the applicant put forward in that regard, in particular regarding the alleged rights arising from the demarcation agreement, aspects of the German law relating to undertakings that have the same name ('coexistence doctrine') and the opponent's allegedly inconsistent conduct (§ 58-65).

The GC confirms that the scope of examination that the Office is required to carry out, due to the full reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned,

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determine whether ‘this sign gives its proprietor the right to prohibit the use of a more recent trade mark’ (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 55, 68). The examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 71).

In the present case, the ‘substantive exceptions’, arising from the expressions ‘without authorisation’ and ‘without due cause’ and from the term ‘unfair’, within the meaning of § 15(2) and (3) MarkenG, consequently include the interpretation of the demarcation agreement (§ 75, 76, 78-81) and the existence of abuse of rights (*venire contra factum proprium*) in the execution of the agreement (§ 93).

Nevertheless, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant’s duty to establish existence of the right to prohibit use (the legislation and its interpretation by the competent national courts) (§ 77, 82, 83, 85). That duty exists regardless of the Office’s duty to check the correctness of the ‘legal facts’, if needs be, *ex officio* (§ 78-81, 84). The GC confirms that this duty also applies to the ‘substantive exceptions’ (§ 85, 87, 88) and that the burden of proof in this regard is on the EUTM applicant/proprietor; the existence of the national right is a matter of fact (07/05/2013, T 579/10, *makro*, EU:T:2013:232, § 62 (§ 85) and each party has to establish the rights upon which it relies (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 87, 88).

In the present case, it was therefore not for the BoA to apply German law in order to interpret the delimitation agreement, taking account of the later behaviour of the parties to this agreement. It was for the applicant to first show that such an interpretation is required under German law and, second, that the result of that interpretation is such as to confer on it the right (as claimed by the applicant) supporting, where appropriate, its demonstration by reference to court judgments given in the Member State concerned (§ 85). The same applies to the alleged abusive behaviour in executing the agreement; it was up to the applicant to show that this is the correct interpretation under the German law (§ 88), as well as with the application of the ‘coexistence doctrine’ in German law – an issue that was already established in the final decisions at German and EU level (§ 92, 96). Therefore, the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 104).

(ii) INFRINGEMENT OF ARTICLE 70 EUTMR IN CONJUNCTION WITH RULE 20(7)(c) CTMIR

The BoA has broad discretion when deciding whether or not to suspend proceedings (§ 114-115). However, this decision must result from a weighing of the competing interests (§ 116). The judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 115, 117). The counterclaim

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for a declaratory judgment must be taken into account within Article 8(4) EUTMR, in conjunction with § 15(2) and (3) MarkenG and, consequently, also in the context of the weighing of the competing interests with regard to the request for suspension (§ 118, 119). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 122, 123). It was therefore possible to conclude the prima facie analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 124). The BoA did not commit a manifest error of assessment in rejecting the request for suspension (§ 125).

**13/05/2020, T 534/18, Peek / Peek & Cloppenburg, EU:T:2020:188**

**RESULT:** Action dismissed

**KEYWORDS:** Coexistence of trade marks, Company name, Sign of mere local significance, Suspension of the proceedings

### **FACTS:**

The applicant sought to register the word sign Peek as an EUTM for services in Class 42. An opposition based on the commercial designation Peek & Cloppenburg, which is recognised as such in Germany and is used to manufacture and market clothing for men, women and children and accessories, such as belts and other leather items pursuant to Article 8(4) CTMR, in conjunction with § 5(2), § 6(3) and § 15(2) and (3) of the German Trade Mark Act (MarkenG). The opposition division rejected the opposition.

On 28 January 2005, the opponent filed an appeal before the BoA. On 25 October 2011, the opposition proceedings were suspended as there were pilot proceedings before the Office relating to two opposition proceedings between the same parties ('the pilot proceedings'). In the pilot proceedings, the BoA upheld the oppositions based on Article 8(4) CTMR and rejected the applicant's applications. The GC rejected the applicant's actions in the pilot proceedings (18/04/2013, T 506/11 & T 507/11, Peek & Cloppenburg, EU:T:2013:197). The CJ dismissed the appeals (10/07/2014, C 325/13 P & C 326/13 P, Peek & Cloppenburg, EU:C:2014:2059). After the definitive closure of the pilot proceedings, the present opposition proceedings were resumed.

In other proceedings between the applicant and the opponent relating to the applicant's German trade marks (which also include three Peek &

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Cloppenburger trade marks), the Oberlandesgericht Düsseldorf, after the case was remitted to it by the Bundesgerichtshof by decision of 7 July 2015, ordered the applicant to give its consent to the cancellation of these trade marks. On 28 April 2016, the judgment of the 'Oberlandesgericht Düsseldorf' became final.

On 12 January 2017, the applicant requested that the Office suspend the proceedings ('the request for suspension') until a final decision had been taken in a counterclaim for a declaratory judgment which it had brought against the opponent on 30 November 2006 ('the counterclaim for a declaratory judgment') before the Landgericht Düsseldorf. In the counterclaim for a declaratory judgment, it requested that the Landgericht Düsseldorf declare that it has the right to have marks derived from its commercial designation registered and to use them in the areas of Germany which have been allocated to it by a demarcation agreement concluded between the parties in 1990 and allegedly confirmed in 1992. The demarcation agreement consists solely of maps on each of which the parties' acronyms are shown, as well as lines to indicate the territories which are respectively allocated to them.

By decision of 31 May 2018 ('the contested decision'), the BoA – referring to the reasoning in the pilot proceedings – upheld the appeal, refused the registration of the application and dismissed the request for suspension.

The applicant filed an action before the GC, relying on four pleas in law. The applicant submits, by its first three pleas, that the BoA misinterpreted Article 8(4) EUTMR, in conjunction with § 15(2) and (3) MarkenG, inasmuch as it took an incomplete account of the substantive conditions laid down by the German law. By its fourth plea, the applicant submits that the BoA infringed Article 70 EUTMR, in conjunction with Rule 20(7)(c) CTMIR, inasmuch as it made manifest errors of assessment when evaluating the applicant's request for suspension and therefore misused its powers. The GC dismissed the action.

### **SUBSTANCE:**

(i) MISINTERPRETATION OF ARTICLE 8(4) EUTMR IN CONJUNCTION WITH § 15(2) AND (3) MarkenG

By its first three pleas, the applicant claims that the BoA did not examine – despite its obligation – the material criterion arising from the expressions 'without authorisation' and 'without due cause' and from the term 'unfair', within the meaning of § 15(2) and (3) MarkenG and the new facts that the applicant put forward in that regard, in particular regarding the alleged rights arising from the demarcation agreement, aspects of the German law relating to undertakings that have the same name ('coexistence doctrine') and the opponent's allegedly inconsistent conduct (§ 55-63).

The GC confirms that the scope of examination that the Office is required to carry out, due to the full

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reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned, determine whether ‘this sign gives its proprietor the right to prohibit the use of a more recent trade mark’ (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 53, 85). The examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 88).

In the present case, the ‘substantive exceptions’, arising from the expressions ‘without authorisation’ and ‘without due cause’ and from the term ‘unfair’, within the meaning of § 15(2) and (3) MarkenG, consequently include the interpretation of the demarcation agreement (§ 67-70, 92, 93) and the existence of abuse of rights (*venire contra factum proprium*) in the execution of the agreement (§ 100).

Nevertheless, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant’s duty to establish existence of the right to prohibit use (the legislation and its interpretation by the competent national courts) (§ 66, 71, 72, 74). That duty exists regardless of the Office’s duty to check the correctness of the ‘legal facts’, if needs be, *ex officio* (§ 67-70, 73). The GC confirms that this duty also applies to the ‘substantive exceptions’ (§ 74, 94, 95) and that the burden of proof in this regard is on the EUTM applicant/proprietor; the existence of

the national right is a matter of fact (07/05/2013, T 579/10, *makro*, EU:T:2013:232, § 62 (§ 84) and each party has to establish the rights upon which it relies (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 94, 95).

In the present case, it was therefore not for the BoA to apply German law in order to interpret the delimitation agreement, taking account of the later behaviour of the parties to this agreement. It was for the applicant to first show that such an interpretation is required under German law and, second, that the result of that interpretation is such as to confer on it the right (as claimed by the applicant) supporting, where appropriate, its demonstration by reference to court judgments given in the Member State concerned (§ 97). The same applies to the alleged abusive behaviour in executing the agreement; it was up to the applicant to show that this is the correct interpretation under the German law (§ 100), as well as with the application of the ‘coexistence doctrine’ in German law – an issue that was already established in the final decisions at German and EU level (§ 104, 105). Therefore, the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 111).

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(ii) INFRINGEMENT OF ARTICLE 70 EUTMR IN CONJUNCTION WITH RULE 20(7)(c) CTMIR

The BoA has broad discretion when deciding whether or not to suspend proceedings (§ 122-123). However, this decision must result from a weighing of the competing interests (§ 123). The judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 122, 124).

The counterclaim for a declaratory judgment must be taken into account within Article 8(4) EUTMR, in conjunction with § 15(2) and (3) MarkenG and, consequently, also in the context of the weighing of the competing interests with regard to the request for suspension (§ 125, 126). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 129, 130). It was therefore possible to conclude the prima facie analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 131). The BoA did not commit a manifest error of assessment in rejecting the request for suspension (§ 132).

13/05/2020, T 535/18, Peek's / Peek & Cloppenburg, EU:T:2020:189

**RESULT:** Action dismissed

**KEYWORDS:** Coexistence of trade marks, Company name, Sign of mere local significance, Suspension of the proceedings

**FACTS:**

The applicant sought to register the word sign Peek's as an EUTM for goods and services in Classes 18, 25 and 35. An opposition based on the commercial designation Peek & Cloppenburg, which is recognised as such in Germany and is used to manufacture and market clothing for men, women and children and accessories, such as belts and other leather items pursuant to Article 8(4) CTMR, in conjunction with § 5(2), § 6(3) and § 15(2) and (3) of the German Trade Mark Act (MarkenG). The opposition division (OD) rejected the opposition.

On 29 December 2006, the opponent filed an appeal before the BoA. On 25 October 2011, the opposition proceedings were suspended as there were pilot proceedings before the Office relating to two opposition proceedings between the same parties ('the pilot proceedings'). In the pilot proceedings, the BoA upheld the oppositions based on Article 8(4) CTMR and rejected the applicant's applications. The GC rejected the applicant's actions in the pilot proceedings (18/04/2013, T 506/11 & T 507/11, Peek

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& Cloppenburg, EU:T:2013:197). The CJ dismissed the appeals (10/07/2014, C 325/13 P & C 326/13 P, Peek & Cloppenburg, EU:C:2014:2059). After the definitive closure of the pilot proceedings, the present opposition proceedings were resumed.

In other proceedings between the applicant and the opponent relating to the applicant's German trade marks (which also include three Peek & Cloppenburg trade marks), the Oberlandesgericht Düsseldorf, after the case was remitted to it by the Bundesgerichtshof by decision of 7 July 2015, ordered the applicant to give its consent to the cancellation of these trade marks. On 28 April 2016, the judgment of the 'Oberlandesgericht Düsseldorf' became final.

On 12 January 2017, the applicant requested that the Office suspend the proceedings ('the request for suspension') until a final decision had been taken in a counterclaim for a declaratory judgment which it had brought against the opponent on 30 November 2006 ('the counterclaim for a declaratory judgment') before the Landgericht Düsseldorf. In the counterclaim for a declaratory judgment, it requested that the Landgericht Düsseldorf declare that it has the right to have marks derived from its commercial designation registered and to use them in the areas of Germany which have been allocated to it by a demarcation agreement concluded between the parties in 1990 and allegedly confirmed in 1992. The demarcation agreement consists solely

of maps on each of which the parties' acronyms are shown, as well as lines to indicate the territories which are respectively allocated to them.

By decision of 31 May 2018 ('the contested decision'), the BoA – referring to the reasoning in the pilot proceedings – upheld the appeal, annulled the OD's decision, refused the registration of the application and dismissed the request for suspension.

The applicant filed an action before the GC, relying on four pleas in law. The applicant submits, by its first four pleas, that the BoA misinterpreted Article 8(4) EUTMR, in conjunction with § 15(2) and (3) MarkenG, inasmuch as it took an incomplete account of the substantive conditions laid down by the German law. By its fifth plea, the applicant submits that the BoA infringed Article 70 EUTMR, in conjunction with Rule 20(7)(c) CTMIR, inasmuch as it made manifest errors of assessment when evaluating the applicant's request for suspension and therefore misused its powers. The GC dismissed the action.

### **SUBSTANCE:**

(i) MISINTERPRETATION OF ARTICLE 8(4) EUTMR IN CONJUNCTION WITH § 15(2) AND (3) MarkenG

By its first four pleas, the applicant claims that the BoA did not examine – despite its obligation – the material criterion arising from the expressions 'without authorisation' and 'without due cause' and from the term 'unfair', within the meaning of §

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15(2) and (3) MarkenG and the new facts that the applicant put forward in that regard, in particular regarding the alleged rights arising from the demarcation agreement, aspects of the German law relating to undertakings that have the same name ('coexistence doctrine') and the opponent's allegedly inconsistent conduct (§ 50-64).

The GC confirms that the scope of examination that the Office is required to carry out, due to the full reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned, determine whether 'this sign gives its proprietor the right to prohibit the use of a more recent trade mark' (24/10/2018, T 435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 53, 87). The examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 90).

In the present case, the 'substantive exceptions', arising from the expressions 'without authorisation' and 'without due cause' and from the term 'unfair', within the meaning of § 15(2) and (3) MarkenG, consequently include the interpretation of the demarcation agreement (§ 68-71) and the existence of abuse of rights (*venire contra factum proprium*) in the execution of the agreement (§ 102).

Nevertheless, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant's duty to establish existence of the right to prohibit use (the legislation and its interpretation by the competent national courts) (§ 67, 72, 73, 75). That duty exists regardless of the Office's duty to check the correctness of the 'legal facts', if needs be, *ex officio* (§ 68-71, 74). The GC confirms that this duty also applies to the 'substantive exceptions' (§ 75, 96, 97) and that the burden of proof in this regard is on the EUTM applicant/proprietor; the existence of the national right is a matter of fact (07/05/2013, T 579/10, *makro*, EU:T:2013:232, § 62 (§ 75) and each party has to establish the rights upon which it relies (24/10/2018, T-435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 96, 97).

In the present case, it was therefore not for the BoA to apply German law in order to interpret the delimitation agreement, taking account of the later behaviour of the parties to this agreement. It was for the applicant to first show that such an interpretation is required under German law and, second, that the result of that interpretation is such as to confer on it the right (as claimed by the applicant) supporting, where appropriate, its demonstration by reference to court judgments given in the Member State concerned (§ 99). The same applies to the alleged abusive behaviour in executing the agreement; it was up to the applicant to show that this is the correct interpretation under the German law (§ 102), as well as with the application of the 'coexistence

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doctrine' in German law – an issue that was already established in the final decisions at German and EU level (§ 106, 110). Therefore, the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 113).

(ii) INFRINGEMENT OF ARTICLE 70 EUTMR IN CONJUNCTION WITH RULE 20(7)(c) CTMIR

The BoA has broad discretion when deciding whether or not to suspend proceedings (§ 124-125). However, this decision must result from a weighing of the competing interests (§ 125). The judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 124).

The counterclaim for a declaratory judgment must be taken into account within Article 8(4) EUTMR in conjunction with § 15(2) and (3) MarkenG and, consequently, also in the context of the weighing of the competing interests with regard to the request for suspension (§ 127, 128). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 131, 132). It was therefore possible to conclude the prima

facie analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 133). The BoA did not commit a manifest error of assessment in rejecting the request for suspension (§ 134).

**13/05/2020, T 5/19, PROFI CARE (fig.), EU:T:2020:191**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive, Lack of reasoning, Non-distinctive, Right of defence, Right to be heard

**FACTS:**

The applicant obtained international registration designating the EU for the figurative sign 'PROFI CARE' for goods in Classes 8, 9, 10, 11, 21 and 26, that was notified to the Office. The examiner refused the application pursuant to Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR in conjunction with Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal. It found that the mark applied for will, on account of the verbal element 'profi care', be understood as designating personal care products that constitute, or have the quality of, professional tools. It found that it was descriptive of all the goods, as they were directly related to personal care, including personal

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hygiene and to skin care, hair care, health care and hair styling, and that the figurative elements of the sign were merely decorative and banal. Moreover, it found that the relevant public would perceive the sign rather as a conventional laudatory indication encouraging purchase, and not as an indication of origin.

The applicant filed an action before the General Court (GC) relying on four pleas in law: (i) failure to state reasons and errors in the assessment of the descriptive character, Article 7(1)(c) EUTMR, (ii) failure to state reasons and errors in the assessment of the distinctive character, Article 7(1)(b) EUTMR, (iii) infringement of Article 94(1) EUTMR and (iv) infringement of the rights of defence and the right to be heard. The GC dismissed the action.

### EUTM Application

**PROFI CARE**

#### SUBSTANCE:

(i) FAILURE TO STATE REASONS AND ERRORS IN THE ASSESSMENT OF THE DESCRIPTIVE CHARACTER, ARTICLE 7(1)(c) EUTMR.

The relevant public is the German-speaking general public and the professional public with an average level of attention; it also includes English speakers (not disputed) (§ 22).

In agreement with consistent case-law, the BoA's reasoning is clear and unequivocal and appears sufficient to enable the interested parties to know the justifications for the measure taken so as to enable them to defend their rights and for the EU judicature to review the legality of the decision (21/10/2004, C 447/02 P, shade of orange, EU:C:2004:649, § 63-65) (§ 15, 34). This is observed in the BoA's disputed assessment of the figurative element (§ 27-41) and again in its assessment of the descriptive character of the sign in relation to the various goods (§ 54-68). A general reasoning may be used for goods that are linked in a sufficiently direct and specific way, to the point where they form a sufficiently homogeneous category or group of goods or services (§ 48-49). The BoA correctly applied the general reasoning that the sign, which refers to the concept of personal care of a professional quality, is descriptive insofar as all goods referred to are directly linked to personal care, including personal hygiene and to skin, hair and health care and to hair styling (§ 54). That general reasoning should be read in conjunction with the specific reasoning for the descriptive character of the sign for each of the identified categories of goods, namely Class 8 (§ 57), Classes 9 and 10 (§ 60), Class 11 (§ 66) and Classes 21 and 26 (§ 68).

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(ii) and (iii) FAILURE TO STATE REASONS AND ERRORS IN THE ASSESSMENT OF THE DISTINCTIVE CHARACTER, ARTICLE 7(1)(b) EUTMR AND INFRINGEMENT OF ARTICLE 94(1) EUTMR

The relevant public will perceive the sign as a conventional laudatory indication concerning the particular desirability and quality of the goods and therefore as an incitement to purchase and not as an indication of origin (not disputed) (§ 78). The BoA correctly found that the descriptive word element was dominant and that the figurative elements were banal and unable to confer any distinctive character on the sign (§ 81 97).

(iv) INFRINGEMENT OF THE RIGHTS OF DEFENCE AND THE RIGHT TO BE HEARD

The fourth plea is rejected since it results from a misreading of the contested decision or concerns findings that were solely made for the sake of completeness (§ 105-110).

**13/05/2020, T 49/19, Create delightful human environments, EU:T:2020:197**

**RESULT:** Action dismissed

**KEYWORDS:** Non-distinctive, Slogan mark

**FACTS:**

The applicant sought to register the word mark Create delightful human environments as an

EUTM for goods and services in Classes 9, 19 and 37, such as electronic controller for adjusting and controlling the tinting of insulated glass window units; installation, maintenance and repair services for glass units for windows.

The examiner refused the application pursuant to Article 7(1)(b) EUTMR in conjunction with Article 7(2) EUTMR as devoid of distinctive character.

The Board of Appeal (BoA) dismissed the appeal. It found that the expression ‘create delightful human environments’ had a clear, ordinary meaning in everyday language that did not conflict with the rules of English grammar and carried the overall message that by purchasing the goods and services the customer would enjoy the benefits promised. The relevant public would only perceive the sign as a laudatory and promotional statement. The BoA examined the sign specifically in relation to the goods in Classes 9 and 19 and the services in Class 37 and held that the sign merely highlighted the positive aspects of those goods and services, namely the creation of a balance between natural light, heat, fading and harmful radiation. It concluded that the sign was devoid of distinctive character.

The applicant filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 7(1)(b) EUTMR alleging, in particular, various errors in the interpretation and application of the Vorsprung durch Technik

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judgment (21/01/2010, C 398/08 P, Vorsprung durch Technik, EU:C:2010:29). The GC dismissed the action.

### SUBSTANCE:

INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR. The relevant public consists of the English-speaking public of the EU, comprising, in part, the general public, and, in part, a specialist public, both consumers with a high level of attention (not disputed) (§ 23).

The use of the word 'delightful' in this sign is not 'awkward'. This word does not primarily refer to an 'intense and highly pleasurable and emotional experience', as can be seen from the extract from the online Oxford dictionary. The expression 'human environments' in no way constitutes an 'unusual duplication' but merely emphasises that the goods and services have an application in a domestic setting. The expression 'create delightful human environments' has a clear, ordinary meaning in everyday language that does not conflict with the rules of English grammar. It carries the overall message that by purchasing these goods and services, the customer will enjoy the benefits promised by using them to create pleasant and comfortable conditions in which to live (§ 24-25).

The sign will simply be perceived as a laudatory and promotional message compatible with the goods and services in question, highlighting positive connotations. The slogan is a simple, direct and

common way to state that the goods and services aim to create a pleasant, indoor, human standard of comfort or to create a pleasant living space or living environment, given that these goods and services are all aimed at controlling and adjusting indoor lighting. The relevant public will immediately establish a link between the slogan and the qualities, nature or purpose of the goods and services, without any particular interpretation or treatment (§ 26).

The BoA correctly interpreted and applied the Vorsprung durch Technik judgment (21/01/2010, C 398/08 P, Vorsprung durch Technik, EU:C:2010:29). Although the case-law of the Court clarifies certain questions relating to the acceptability of slogans as trade marks, that case-law cannot and should not be read as suggesting that any promotional phrase can now be registered as a trade mark simply because it is presented in the form of an advertising slogan (§ 31-36). The BoA's assessment in the present case is free of errors (§ 39-44).

**13/05/2020, T 76/19, pontinova (fig.) / Ponti et al., EU:T:2020:198**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Likelihood of confusion

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### FACTS:

The applicant sought to register the figurative sign 'pontinova' for Legal services in Class 45. An opposition based on the earlier Spanish word mark Ponti for Industrial and Intellectual property consultancy services in Class 42, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division upheld the opposition.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal finding that, insofar as the services covered by the mark applied for included those covered by the earlier mark, they must be regarded as identical. It found that the signs were visually and phonetically similar to an average degree and that the conceptual comparison had no effect on the overall impression. It concluded that, as the services were identical, a lesser degree of similarity between the signs was sufficient to find a likelihood of confusion (LOC) between the marks.

The applicant filed 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 (fig.)

### Earlier trade mark

### SUBSTANCE:

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

The relevant public consists both of companies and individuals whose level of attention is higher than average, and the relevant territory is Spain (not disputed) (§ 19-20).

The industrial and intellectual property consultancy services covered by the earlier mark necessarily include advice on intellectual property rights, which are legal in nature. Those services are therefore part of legal services, which cover a very wide range of services and are covered by the mark applied for, without being specified or limited (§ 29). The services covered by the mark applied for are identical to those covered by the earlier mark (§ 33).

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The signs are visually similar to an average degree since both signs contain the verbal element 'ponti'. It is the only element of the earlier sign and is reproduced in its entirety in the sign applied for. The signs differ in the figurative element and suffix 'nova' of the sign applied for (§ 40-44).

The signs are phonetically similar to an average degree. Even though the signs have a distinct syllabic structure with a different number of syllables, they are similar. The element 'ponti', comprising the only syllables of the earlier sign and the initial syllables of the sign applied for, is included in both signs, although in the mark applied for, the emphasis is on the syllable 'no' (§ 48-52).

As neither of the two signs has a clear meaning, the conceptual comparison has no effect on the overall impression (not disputed) (§ 53-54).

In view of the average degree of visual and aural similarity of the signs and the normal degree of distinctiveness of the earlier mark, there is a LOC between the marks, even when the relevant public's higher level of attention is taken into account (§ 63).

**13/05/2020, T 284/19, Kenwell / Kenwood et al., EU:T:2020:192**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion

**FACTS:**

The applicant sought to register the word sign Kenwell for goods in Classes 7, 9, 11 and 21. An opposition was filed based on the earlier EU word mark Kenwood registered for goods in Classes 7, 9 and 11. It was filed against some of the goods in Classes 7 and 9 and all the goods applied for in Class 11 pursuant to Article 8(1)(b), Article 8(4) and Article 8(5) CTMR [now EUTMR]. The Opposition Division rejected the application for registration for some of the goods in Classes 7 and 9 and all the goods applied for in Class 11.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that the signs were visually and phonetically similar to at least an average degree, but that no conclusion could be drawn from their conceptual comparison. It concluded that there was a likelihood of confusion (LOC) between the signs.

The applicant filed 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.

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### **SUBSTANCE:**

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

The relevant public consists of the general public and business customers with specific professional knowledge or expertise in the EU; since the goods are partly specialist ones, the degree of attention of the relevant public varies from average to high (not disputed) (§ 25-27).

The goods covered by the marks are 'partly identical, partly similar and partly similar to a low degree' (not disputed) (§ 28-29).

The signs are visually similar at least to an average degree since each of the marks contains seven letters and therefore they are identical in length. Similarly, they share the same first four letters 'K', 'E', 'N', and 'W', which are in the same order, and both have a double letter among their remaining three letters, namely a double 'O' followed by a 'D' in the case of the earlier mark and an 'E' followed by a double 'L' in the case of the mark applied for (§ 39-40).

The signs are phonetically similar at least to an average degree since the earlier mark is pronounced 'KEN-WOOD', while the mark applied for is pronounced 'KEN-WELL'. Therefore, the first syllable of the marks is phonetically identical, the second syllable starts with the same consonant 'W', and the two marks have the same phonetic length (§ 41-42).

The signs have no meaning overall and therefore no conclusion can be drawn from their conceptual comparison. According to the Collins dictionary, in English the common element 'KEN' can mean 'range of knowledge or perception'(not disputed). The English-speaking part of the relevant public will therefore understand the meaning of that element, just as it will understand the difference between the respective meanings of the elements 'WOOD' and 'WELL', which are also part of English vocabulary, while the rest of the relevant public will not perceive the semantic content of those three elements. Nevertheless, for the English-speaking public, the verbal elements 'KENWOOD' and 'KENWELL', which are unusual in their structure, are not well-known expressions in English (§ 43-46).

Consequently, the marks are similar overall at least to an average degree (§ 47).

As the goods are 'partly identical, partly similar and partly similar to a low degree', in order to find that there is no LOC, the similarity and identity must be offset by a high degree of difference between the marks. However, the marks are similar overall to at least an average degree. Therefore, there is a LOC between the signs (§ 52).

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13/05/2020, T 381/19, City Mania / City Lights, EU:T:2020:190

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Dissimilarity of signs, Dominant element

### **FACTS:**

The applicant sought to register the word sign City Mania for goods in Classes 9 and 28. Pursuant to Article 8(1)(b) EUTMR, an opposition was filed based on the earlier EU word mark City Lights covering, inter alia, goods in Classes 9 and 28. The Opposition Division (OD) upheld the opposition.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA upheld the appeal and annulled the OD's decision. It found that the relevant public would have no difficulty in identifying the visual, phonetic and conceptual differences between the signs, since the common element 'city' is understood throughout the EU and has only a low degree of distinctiveness in relation to the goods. It concluded that there was no likelihood of confusion (LOC).

The opponent filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The opponent claimed in particular that the principle of interdependence within the global assessment of LOC had been misapplied. The GC dismissed the action.

### **SUBSTANCE:**

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

The relevant public consists of the general public of the EU displaying an average level of attention with regard to the goods (not disputed) (§ 20).

The goods are identical (not disputed) (§ 22).

The common element of the marks 'city' has a low degree of distinctiveness since it has a certain descriptive dimension for goods such as games software for video and computer games (§ 34). As the meaning of term 'mania' in the mark applied for is understood by a significant part of the general public of the EU, as a personal obsession, compulsion, obsessive need or excessive excitement and enthusiasm, that element is distinctive only to a normal degree (§ 35). The element 'lights' in the earlier mark is also distinctive only to a normal degree (§ 36).

The marks are visually and phonetically similar to a low degree in as much as they have the element 'city' in common, and it is not enhanced by any dominant or distinctive character. Of the marks differ in the words 'lights' and 'mania' (§ 43-47).

The two signs, taken as a whole, refer to different concepts, even though they share the word 'city'.

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The element 'lights' in the earlier mark will be perceived either as meaningless or as referring to the idea of 'lights'. As the semantic content of the word 'mania' will be immediately understood by a significant part of the relevant public, the mark applied for also refers to the idea of a personal obsession, compulsion, obsessive need or excessive excitement and enthusiasm. This is a very different concept from that evoked by the earlier mark. Therefore, the marks are conceptually similar only to a low degree (§ 51-52).

The similarities between the signs are not particularly significant. They are restricted to the presence of the element 'city', which has a weak distinctive character, and are offset to a large extent by the endings 'mania' and 'lights'. Although the elements 'mania' and 'lights' may also have a weak distinctive character for certain goods and for certain parts of the relevant public, they give rise to a difference between the signs, taken as a whole. The relevant public will therefore clearly distinguish the signs, even though they have a weak degree of similarity due to the common element 'city' (§ 60 61). Consequently, there is a LOC between the signs (§ 62).

**13/05/2020, T 503/19, Xoxo, EU:T:2020:183**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctiveness acquired through use, Laudatory mark, Non-distinctive, Principle of legality

**FACTS:**

The applicant sought to register the word mark Xoxo for goods and services in Classes 3, 9, 14, 18, 25 and 35.

The examiner refused to register the sign for goods in Classes 3, 9, 14, 18 and 25 on the basis of Article 7(1)(b) EUTMR and allowed it to proceed to registration for the services in Class 35.

The Board of Appeal (BoA) dismissed the appeal. The BoA found that the sequence of letters was understood by the English-speaking general public as meaning 'hugs and kisses'. It stated that the sign would be perceived as a banal and merely promotional statement to express love and affection and was devoid of distinctive character for the goods in Classes 3, 9, 14, 18 and 25 which were typically offered as gifts.

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

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### SUBSTANCE:

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

The relevant public consists of English-speaking general consumers in Ireland, Malta and the United Kingdom (not disputed) (§ 37-38).

The term 'xoxo' will be understood as meaning 'hugs and kisses' that is, in particular, shown by the online dictionaries Urban dictionary and Internetslang (not disputed) (§ 42). It is irrelevant that only teenagers and very young women might attribute that meaning to the sign Xoxo, since it is sufficient that a ground of refusal exists in relation to a non-negligible part of the target public (§ 43). With regard to goods that are capable of being offered as gifts, the sign will be perceived as a promotional message conveying feelings of love and affection. The sign is thus devoid of distinctive character (§ 45-49).

#### (ii) INFRINGEMENT OF THE PRINCIPLES OF EQUAL TREATMENT AND SOUND ADMINISTRATION.

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 the principle of legality (§ 57). The previous decisions at national level are irrelevant since the EU trade mark regime is an autonomous system (§ 62).

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

It is for the applicant to plead in the course of the proceedings before the Office that the mark applied for has acquired distinctive character through use and to provide evidence to support the claim (§ 69). The applicant's line of argument was not sufficiently clear and precise to be able to identify without difficulty a claim that the mark applied for has, for the purposes of Article 7(3) EUTMR, distinctive character acquired through use (§ 71, 74, 76).

**13/05/2020, T 532/19, Pantys (fig.), EU:T:2020:193**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctiveness acquired by use, Misspelled word mark, Non-distinctive

#### FACTS:

The applicant sought to register the figurative sign pantys for goods in Classes 5, 25 and 35, such as hygienic absorbents; sanitary napkins. The examiner refused the application pursuant to Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR in conjunction with Article 7(2) EUTMR on the ground that the sign applied for lacked distinctive character and was descriptive.

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The Board of Appeal (BoA) dismissed the appeal, finding that the link between the mark applied for (a misspelling of the English word 'panties') and the goods and services was sufficiently close for the sign to be regarded as descriptive. It rejected the applicant's arguments that that mark had acquired distinctive character through use since it was not possible to conclude, based on the evidence submitted, that the mark had become, in itself, distinctive from the perspective of the relevant public on the date on which the application for registration was filed.

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

### EUTM Application

pantys



#### SUBSTANCE:

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

The relevant public consists of the public at large, whose level of attention is average (not disputed). The descriptiveness of the trade mark is assessed by reference to how it is perceived by the average English-speaking consumer (§ 17).

The verbal element 'pantys' is a misspelling of the English word 'panties', which denotes a form of women's underwear. The word 'panties' is defined in various English dictionaries as 'women's or girls' underpants, especially short-legged or legless pants with an elasticated waist; tights, pantyhose' (§ 19-20).

The verbal element 'pantys' does not differ from everyday language in such a way that the relevant public would regard it as more than a mere misspelling of the English word 'panties' (§ 27). When used to designate the goods, which are all sanitary products, especially for women, that term will be immediately understood by the relevant public as describing the properties of those goods, namely, that they may be offered in the form of panties, or that they may be incorporated into that type of women's underwear (§ 21).

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

It is sufficient that one of the absolute grounds for refusal applies. Thus, it is not necessary to assess the merits of the second head of claim alleging infringement of Article 7(1)(b) EUTMR (§ 39-41).

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

The BoA did not err in finding that it was not possible to conclude that the mark applied for had acquired distinctive character through use based on the evidence submitted of use of that mark (§ 56-68).

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### New Decisions from the Boards of Appeal

05/06/2020, R 176/2020-2, KÖLNER DOM

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

The applicant sought to register the sign as a word mark consisting of two German words 'KÖLNER' and 'DOM', which in English means Cologne Cathedral, an UNESCO World Heritage Site. The examiner partially rejected the application on the basis of Article 7(1)(b) and (c), in connection with Article 7(2), EUTMR. The application was rejected, among others, for goods and services in Classes 16, 19, 35, 41 and 42.

The Board partially annuls the examiner's decision for some of the goods and services in Classes 19, 41 and 42. Firstly the Board notes that Cologne Cathedral is one of the five most visited tourist attractions in Germany. For this reason, the relevant public in Germany and Austria will create a direct link to Cologne Cathedral for most of the goods and services applied for. Nevertheless, goods applied for in Class 19 'Marble; Clay', which are considered to be mineral materials, the sign will not be perceived by the public as a source of origin of the goods, as well as for the following services applied for in Class 41 'Providing nurseries, schools, boarding schools,



and colleges' and in Class 42 'Land surveys; Urban planning'. For the services rejected in Class 42, the Board also notes that it is not obvious that the words 'KÖLNER DOM' will be perceived as a reference to an earlier project.

18/06/2020, R 21/2020-4, E (fig.)

#### EUTM application



**Figurative Mark – Article 7(1)(b) and (c) EUTMR – Decision partially annulled – EUTM application accepted**

The applicant sought to register the figurative mark consisting of the letter 'E' within a circle. The examiner rejected the application on the basis of Article 7(1)(b) and (c), in connection with Article 7(2), EUTMR. The application was rejected for the services in Class 35.

The Board disagrees with the examiner's opinion and confirms that the sign can proceed to registration for all goods and services in Classes: 8, 22, 24 and 35. There is no specific 'electronic' advertising. "Advertising" is aimed at companies

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that want to advertise their goods and services, not at the addressee of an advertising measure. The Board cannot see what characteristic the letter 'E' could describe in the sense that competing advertising services or business management services would not have that characteristic. If the letter "E" cannot be attributed a clear meaning relevant to the services in class 35, then the inherent distinctiveness even with a minimum degree can be retained. Furthermore, the sign applied for consists, in addition to the letter 'E', of another element, the circle in which the 'E' is located. Even if that circle is in itself a simple geometric representation which cannot be protected, the fact remains that the distinctive character of the sign applied for must be taken into account as a whole and may also result from the combination of the two elements.

Consequently, the application must also be allowed to proceed to publication pursuant to for the services applied for in Class 35.

19/06/2020, R 463/2020-2, CUCINA

### EUTM application



### **Figurative mark – Descriptive – Non-distinctive – Article 7(1)(b) and (c) EUTMR – Decision rejected – Application rejected**

The applicant sought to register the figurative mark above consisting of the verbal element 'CUCINA' on the image of a pot. The examiner rejected the application on the basis of Article 7(1)(b) and (c), in connection with Article 7(2), EUTMR. The application was rejected for the goods in Classes 29 and 30.

The Board agrees with the examiner's opinion and confirms the decision. The goods specified in Classes 29 and 30 deal with food products. The Board notes that the sign does not contain in itself any unusual or surprising elements that the average consumer will distinguish as differentiating the goods' source of origin. The pot has no figurative characteristic which the relevant public could memorise and the word 'CUCINA' is a key word in Italian. The Board concludes that the sign only contains information that serves to denote the consumption and preparation of food in a kitchen. For this reason, the sign cannot fulfil the main function of a trade mark.

Thus, the trade mark applied for is devoid of distinctive character pursuant to Article 7(1)(b) EUTMR.

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28/05/2020, R 2613/2019-5, Curamedical

### EUTM application

**CURAMEDICAL**

**Word Mark – Descriptive – Non-distinctive – Article 7(1)(b) EUTMR – Decision Confirmed – Application Rejected**

The applicant sought to register the word mark for goods and services in Classes 5, 35, 42 and 44 which were mainly connected to the pharmaceutical sector. However, in light of the fact that the relevant public would perceive the sign as providing information as regards the quality of the goods and that the elements making up the sign 'CURA' and 'MEDICAL' were descriptive, the examiner rejected the application on the basis of Article 7(1)(b) and (c) EUTMR.

The Board confirms that the sign does not contain the required level of distinctiveness in order for it to function as a trade mark. It is noted that in order for a combination of words to be regarded as descriptive under Article 7(1)(c) EUTMR, not only do each of the components have to be descriptive but also the combination itself. The Board confirms the examiner's conclusion that the word 'CURA' will be understood by Spanish, Italian and Portuguese consumers as having the meaning of 'cure' or



'therapy'. As far as word 'MEDICAL' is concerned, it will be understood as medical in the aforementioned countries of relevance. The Board confirms that as a combination the sign will be perceived as a sign providing information on the nature of the goods and services applied for. In other words, the relevant public will see it as a description of the characteristics of the goods and services applied for.

18/05/2020, R 2254/2019-1, KOROVKA (fig.)

### Contested mark



**Figurative Mark – Revocation Grounds – Article 58(1)(a) EUTMR – Decision Confirmed – EUTM Partially Revoked**

The application for a declaration of revocation was partially accepted for all the goods applied for, except for some goods in Class 30. After reviewing all the documents submitted by the EUTM proprietor, as regards the time of use, the place of use, the commercial volume and the nature of the use in relation to the registered goods, the Cancellation Division revoked the EUTM only partially.

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The Board confirms the decision. In relation to the time of use of the registered mark, the Board notes that the evidence submitted which deals with use outside of the relevant time period, confirms the use of the mark in the relevant time period. Secondly, since the mark is an EUTM, the use of it in Germany and Bulgaria as derives from the evidence is found sufficient by the Board. In relation to the extent of use, the Board indicates that the goods under the sign 'KOROVKA' have been continuously used in Germany and Bulgaria, where they were imported and offered for sale. Moreover, the volume of sales is sufficient to establish the fact that the EUTM proprietor tried to acquire a commercial position on the market. Thirdly, it is emphasised that even if the contested mark were used in two different ways on the market 'KOPOBKA' (in Cyrillic) and 'KOROVKA' (in Latin characters), five out of the seven letters coincide and are placed in the same order. As a result, the distinctiveness of the EUTM as registered is not altered as the variation in the mark is acceptable. From a global assessment of all the relevant factors, the Board therefore concludes that the use shown by the EUTM proprietor in relation to the contested goods is sufficient to maintain or create a market share on the specific market. The revocation applicant's approach of splitting up the evidence into individual items in order to find some missing information in relation to each requirement of use remains unsuccessful. Constant case-law, as that cited above, confirms that the evidence

must be assessed as a whole and that there is no obligation for the EUTM proprietor to produce individual pieces of evidence each complying with all the requirements of use. The proof of use does not require at all that each item of evidence must necessarily contain information on each of the four elements to which the proof of use must refer. In the present case, the evidence considered as a whole allows for the finding of genuine use of the mark in accordance with the requirements set out by the Regulations and the relevant case-law. Consequently, the contested decision correctly rejected the application for a declaration of revocation for all the contested goods at issue in the appeal.

[26/05/2020](#), [R 156/2020-2](#), [Plus screen](#) / [PLUSSCREEN \(fig.\) et al.](#)

### Earlier trade marks



**PLUSCREEN®**  
**PLUSCREEN**

### Contested sign

**Plus Screen**

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### **Descriptive – Non-distinctive – Article 31(2) EUTMR – Case suspended**

The applicant sought to register the word mark 'Plus Screen' for 'smartphones; display for smartphones; cellular phones, wearable smartphones' in Class 9. The Opposition Division rejected the opposition in its entirety.

The Boards of Appeal, in opposition proceedings, do not have the competence to examine absolute grounds for refusal. However, pursuant to Article 45(3) EUTMR, in conjunction with Article 30(2) EUTMDR, they may, by means of a reasoned interim decision, suspend the appeal proceedings and remit the contested application to the examiner competent for examining that application with a recommendation to reopen the examination, where it considers that an absolute ground for refusal should apply to some or all of the goods or services listed in the trade mark application.

In the present case, the Board indicates that it is appropriate to recommend a reopening of the examination of absolute grounds for refusal of the trade mark applied for. The mark applied for consists of the word 'Plus' followed by the word 'screen'. 'Plus' as an adjective means 'additional, extra; more than what is normally required or expected' or 'of a superior quality or class; excellent of its kind, elite' as also confirmed in various judgments of the General Court and decisions of the Boards that defined

'PLUS' as 'additional, extra, of superior quality, excellent of its kind'. The word 'PLUS' constitutes a laudatory statement and indicates that the goods are of a particularly good quality or have additional useful characteristics. It is a sign which, as a pure indication of quality, is both descriptive and also devoid of any distinctive character. A 'screen' is a flat vertical surface on which pictures or words are shown. It refers to any contrivance for 'affording an upright surface for display'. The goods covered by the mark applied for, that is 'smartphones; cellular phones, wearable smartphones' have a screen. In addition, a 'display for smartphones' is a screen. The sign 'Plus screen', as a whole, will be understood according to the natural meaning of its component parts, as referring to a screen which is of particularly good quality or has additional useful characteristics. For the English-speaking public, there is nothing unusual about the structure of the mark applied for. The combination of words simply indicates that the applicant's smartphones, etc., have a 'better screen'. No analysis or mental leap is required to ascertain the possible meaning of the expression, taken as a whole. Consequently, it seems that the mark applied for may fall within the scope of the grounds for refusal set out in Article 7(1)(b) and (c) EUTMR in relation to all of the goods for which registration is sought.

The appeal proceedings are suspended and the case is remitted to the examiner for further consideration regarding the registrability of the contested EUTM application.

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12/06/2020, R 2674/2019-5, [Arctic Wines / Artic \(fig.\) et al.](#)

### Earlier trade marks



### Contested sign

**Arctic Wines**

**Figurative mark - Deceptive element - Descriptive element - Non-distinctive - Article 31(2) EUTMR - Case Suspended**

The applicant sought to register the word mark 'Arctic Wines' for beverages in Classes 32 and 33. The Opposition Division partially upheld the opposition on the grounds that there was a likelihood of confusion, on the basis of the earlier rights, namely for beer in Class 32 and alcoholic beverages and cider in Class 33.

The Boards of Appeal, in opposition proceedings, do not have the competence to examine absolute grounds for refusal. However, pursuant to Article 45(3) EUTMR, in conjunction with Article 30(2) EUTMDR, they may, by means of a reasoned interim decision, suspend the appeal proceedings and remit the contested application to the examiner competent for examining that application with a recommendation to reopen the examination, where it considers that an absolute ground for refusal should apply to some or all of the goods or services listed in the trade mark application.

In the present case, the Board has serious doubts about the registrability of the contested word mark for all the goods that have been applied for. It is a well-known fact that there is no wine production in the Arctic area, however it is not excluded, as the scientific community has pointed out, that with climate change rapidly heating and bringing warm air to this region in the future there could be vineyards planted and producing wine in the Arctic regions. Therefore in relation to the goods in Class 33, 'Alcoholic beverages (except beer); Preparations for making alcoholic beverages', the mark could be considered descriptive of a geographical origin, and therefore could be prevented from being registered on the basis of Article 7(1)(c) EUTMR.

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Moreover, the word 'wines' for goods such as those in Class 32, 'Soft drinks; Preparations for making beverages; Beer and brewery products; Waters; Alcohol free wine'; or 'cider' in Class 33, could be considered misleading as it gives a wrong message about the type and nature of the product. The Board is of the opinion that the sign applied for could also be barred from registration on the basis of Article 7(1)(g) EUTMR.

The appeal proceedings are suspended and the case is remitted to the examiner for further consideration regarding the registrability of the contested EUTM application.

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