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From food and wine to... textiles and crafts: a short history of GIs

By **Eleonora Rosati**

When you buy some *Prosciutto di Parma* at your local deli or order a glass of *Alentejo* at your favourite restaurant, you probably know that you are getting a product that reflects a longstanding tradition of expertise, quality, and craftsmanship.

But did you also know that the use of terms like 'Prosciutto di Parma' and 'Alentejo' is reserved to producers that are based and operate in specific territories and in accordance with a detailed set of rules and standards?

Indeed, these names are protected by a specific type of intellectual property ('IP') right: geographical indications ('GIs'). GIs are not just IP. They are also tools aimed at supporting the objectives of traditional and rural development and address consumers' growing demand for authenticity and sustainability.

How it all started

Throughout history, IP has sought to ensure the protection of trade names and distinctive signs associated with a specific region. Just think that, as

early as 1411, France regulated the production of blue *Roquefort* cheese by parliamentary decree!

However, it was throughout the 1800s that trade names and trade marks started also being used to safeguard the geographical origin and reputation of a product, stemming, for example, from certain qualities that can be attributed to the characteristics of their territories and the know-how of the people living there. Similarly, regimes have been used to protect against false trade descriptions, passing off, and unfair competition. These regimes protect against undue suggestions that a product has a geographic origin or quality that it does not in fact have.

Throughout the early 1900s, specific laws were passed to protect geographic origin and quality standards: the first French law on appellation d'origine contrôlée was adopted in 1905, and Italy regulated its denominazione di origine controllata for the first time in 1963.

The international dimension: treaties and trade agreements

Over time, attempts have also been made to harmonise the protection available to GIs on an international scale. Just think of the [Paris Convention](#), which spells out the requirement of

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protection of indications of source or appellations of origin, the [Madrid Agreement](#), which lays down standards meant to protect consumers against false indications of source, and the [Lisbon Agreement](#), which introduces an international system for the protection of appellations of origin. In all this, the most important international treaty remains the [TRIPS Agreement](#), which provides a definition of GIs and requires its member states to ensure protection against any use of the designation or presentation of an item that misleads the public as regards the geographic origin of such an item.

GIs have been also increasingly protected through the adoption of trade agreements, both on a bilateral and multilateral basis. For example, the EU has [concluded several agreements](#) with third countries to ensure protection of third-country GIs, for example Swiss [Bernbieter Kirsch](#), in the EU and vice versa.

GIs in Europe

A system of protection for GIs is also provided [at the EU level](#) to protect agricultural products and foodstuffs, spirit drinks, and wines as registered names against misuse or imitation of such names.

With nearly 900 registrations, Italy is currently the EU country with the [highest number](#) of registered GIs, ranging from [Agnello di Sardegna](#) (lamb) to [Pane di](#)

[Altamura](#) (bread), from [Miele delle Dolomiti Bellunesi](#) (honey) to [Toscana/Toscana](#) (wine), and many other delicious things!

Over time, courts have also been asked to provide guidance on the interpretation and application of the GI framework. For example, the Court of Justice of the European Union has decided cases concerning cheeses such as French [Morbier](#) and Spanish [Queso Manchego](#), UK [Scotch whiskey](#), and Italian [Aceto Balsamico di Modena](#).

Thanks to the efforts of the EUIPO, today it is also possible to see all GIs registered in Europe and beyond using Glview. Launched in 2020, Glview is a database which is currently regarded as the most complete and reliable GI data worldwide. As of today, Glview contains more than 5 200 GIs protected in the EU and has more than 40 000 entries showing the protection of EU GIs worldwide.

The future of GIs in Europe

The importance and success of the GI framework has grown over time. Should the EU system, however, be only concerned with agricultural products?

Since 2011, the European Commission has been considering [whether the EU GI framework should be extended to craft and industrial products](#), this being a possibility that already exists in some EU

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countries. Over the past couple of years, such a reflection has intensified. As a result, a [legislative proposal](#) was [unveiled in spring 2022](#).

From food and wine to textiles and crafts, the EU GI framework may soon be covering all these things. Stay tuned!

Eleonora Rosati is an Italian-qualified lawyer with experience in copyright, trade marks, fashion and internet laws. Dr Rosati is a Full Professor of Intellectual Property (IP) Law, Director of the Institute for Intellectual Property and Market Law (IFIM), and Co-Director of the LLM in European IP Law at Stockholm University. She is also Of Counsel at Bird & Bird and is the author of several articles and books on IP issues.

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IP KEY: new drive to support IP in Latin America



On 27 April, the official launch of the second phase of the [IP Key Latin America](#) project, funded by the EU and managed by the EUIPO, took place in Mexico City. The project aims to increase **intellectual property protection and enforcement throughout Latin America**.

Following the success of the first phase of the project (2018-2021), IP Key Latin America will run for 3 years and will focus on Chile, Mexico, the Andean Community (Colombia, Ecuador, Peru), Central America (Costa Rica, El Salvador, Guatemala, Honduras, Nicaragua, Panama) and Mercosur (Argentina, Brazil, Paraguay, Uruguay). It will:

- work in areas related to **trade agreements** between the EU and Latin America.
 - support the protection of **trade marks, designs, geographical indications, plant varieties, patents and copyright** throughout the region.
- support studies that confirm the economic benefits of intellectual property rights (IPR) for local economies.

In terms of **IP enforcement**, the project also aims to work in this area. The illegal circulation of counterfeit products remains a serious problem in Latin America. Some countries in the region encounter difficulties in implementing effective customs and online sales controls.

IP Contribution to the economy in Latin America: According to [studies carried out in the first phase of IP Key](#), IPR-intensive industries contribute to the local economies (employment, GDP and exports) of Mexico, Argentina, Peru, Chile and Uruguay, thus confirming the economic benefits of intellectual property rights.

More information

EU and India: IP cooperation at a glance



In May 2022, the EUIPO and the Department for Promotion of Industry and Internal Trade of India (DPIIT) signed a bilateral agreement or Memorandum of Understanding, which will set the ground for future relations and cooperation between the two organisations.

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The IP cooperation between the EU and India dates back to 2015 when the EU-funded cooperation project, EU-India Intellectual Property Cooperation ([IPC-EUI](#)), was launched. The project kicked off the negotiations between the EUIPO and the Indian authorities, namely the Controller General of Patents, Designs and Trade Marks (CGPDTM) and the DPIIT, and ultimately led to the signing of a bilateral agreement.

India is also already part of some of the largest and most international EUIPO online tools, such as TMview, DESIGNview and TMclass. More than 2 million Indian national trade marks are available on the [TMview platform](#).

What's the agreement about?

The agreement establishes a cooperation framework under which biennial work plans will be drawn up. These will detail the collaboration activities to be undertaken, including:

- exchange and dissemination of best practices, as well as knowledge on IP awareness among public, businesses and educational institutions;
- collaboration in training programs, exchange of experts, technical exchanges and outreach activities;
- exchange of information and best practices on processes related to applications for trade marks and designs, as well as for the protection, enforcement and use of IP rights;
- cooperation in the development of automation and modernisation projects, new documentation

and information systems in IP, such as search and classification tools.

EU trade relations with India

In May 2021, the EU and Indian leaders agreed to resume negotiations for a [trade agreement](#) and to launch separate negotiations on an investment protection agreement and another agreement on geographical indications.

Another strategic coordination mechanism between the EU and India is the **EU-India Trade and Technology Council (TTC)**. The Council is set up to tackle trade, technological and security challenges, and to strengthen the partnership between the two blocks. It is also India's first TTC and the second for the EU, after the one set up in the US.

New study on Community Plant Variety Rights



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A joint publication of the EUIPO and the Community Plant Variety Office (CPVO) highlights the very significant contributions made by the Community Plant Variety Rights system to the economy and to the environment during the past 25 years, thereby supporting the EU's economic and environmental goals.

CO2 emissions from agriculture must be reduced in the coming years to help achieve the goals of the European Green Deal. Other environmental considerations call for less intensive use of pesticides, fertiliser and other chemicals, while at the same time maintaining and increasing food production to cope with the demands of the European and global markets.

This challenge can only be met by creating new varieties of crops that use fewer resources while enhancing productivity of European agriculture. These new varieties must also be able to cope with the changing climate. A great deal of innovation in breeding of plant varieties is therefore required. Such innovation is underpinned by the Community Plant Variety Rights (CPVR) on the EU level, managed by the [Community Plant Variety Office \(CPVO\)](#).

The main findings of the study were presented via a [dedicated online policy seminar](#):

- **In the absence of the CPVR system, in 2020:**
 - production of arable crops in the EU would be 6.4% lower,
 - production of fruit would be 2.6% lower,
 - that of vegetables 4.7% lower,
 - the output of ornamentals would be 15.1% lower.
- **Without the added production attributable to CPVR-protected crops,** the EU's trade position with the rest of the world would worsen (for some crops, the EU might even switch from being a net exporter to a net importer), and EU consumers would face higher food prices.
- **The annual greenhouse gas (GHG) emissions from agriculture and horticulture are reduced by 62 million tons per year.** This corresponds to the total GHG footprint of Hungary, Ireland or Portugal.
- **Many of the companies protecting their innovations with CPVRs are small and medium-sized enterprises (SMEs).** These small companies account for more than 90% of the registrants of CPVRs and hold 60% of all CPVRs currently in force.

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History of trade marks



Further to the previous articles ranging from the Ancient Age to the current challenges of technology, the series of articles that delves into the history of Intellectual Property (IP) comes to an end by taking a closer look at the history of trade marks.

A trade mark is commonly defined as a sign, for example a word or a logo, that functions as an indicator of commercial origin. So, if I am in the business of making cakes and biscuits, attaching my trade mark to boxes containing such products serves to inform consumers that they come from me.

Standing this essential function of trade marks, it is probably not surprising to learn that their history dates back several hundreds of centuries. Let's find out more!

Trade marks from the Middle Ages to the 20th century

Traders and merchants have marked their goods

since the early days of agriculture and commerce, whether to indicate ownership (for example, earmarked cattle) or to guarantee quality. The latter was, for example, one of the main functions performed by guilds during the Middle Ages and throughout the 1700s. Still during the Middle Ages, the Vikings produced uniquely sharp and resistant swords, all carrying the 'trade mark' "Ulfberht" framed by two crosses.

In the United Kingdom, the first ever trade mark statute (the **Trade Mark Registration Act**) was adopted in 1875. It is believed that the night before 1 January 1876, which is when trade mark applications could finally be filed, an employee of Bass Brewery, originally founded in 1777, was sent to wait outside the Patent Office to be able to file the first trade mark application the following morning. Not only is the Bass trade mark represented in the iconic painting "Un bar aux Folies Bergère" by Edouard Manet but, to celebrate its trade mark history and the fact that it is regarded as the oldest trade mark registration of modern age, in 2013 **Bass Pale Ale** was also rebranded "Bass Trademark No.1".

Over time, several developments have occurred, which have contributed to shaping trade mark law as we know it today. Trade marks become objects of property and have come to encompass different functions; not just origin and quality, but also investment and indication of a certain lifestyle and values. In this sense, a trade mark reflects our current understanding of brands as being indicators of something more than just commercial origin.

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Furthermore, trade mark law has been profoundly affected by progressive harmonisation at both the international and regional level. For example, in the European Union (EU), not only is it possible to register EU-wide trade marks, but also the requirements for and scope of protection of national trade marks are very similar across all EU Member States. The first ever EU directive harmonising national trade mark law was adopted in 1988, while in 1994, an **EU-wide trade mark system**, administered by what is today the [European Union Intellectual Property Office \(EUIPO\)](#) was also introduced. Achieving a single trade mark registration valid across the whole EU has been a success of the EU integration process.

Iconic and less conventional trade marks

Following the [latest reform](#) of the EU trade mark system, trade mark protection today is in principle available to any sign that is capable of indicating origin (in technical terms, a sign displaying distinctive character) and being appropriately represented.

This means that **not only words and logos can be trade marks**, but also colours, shapes, sounds, and patterns – just to mention a few examples – may be registered.

This said, each case is decided on its own merit. For example, did you know that [the shape of a Coca-Cola bottle](#) is protected as a trade mark in the EU, but that is not the case of the [shape of Voss water bottle](#)? Or did you know that [Dior's iconic Cannage pattern](#) is an EU trade mark but that [Birkenstock's own pattern](#) mark has been refused registration?

Or, as another example, that the [hiss of a drink can opening](#) has been refused trade mark registration while [the yell of Tarzan](#) has been registered? Or that neither the shape of the [LEGO toy bricks](#) nor the [shape of a KitKat chocolate bar](#) are registered trade marks?

In addition, sometimes being too 'famous' may be a problem for a trade mark, as the risk of 'genocide' – that is the fact that a registered trade mark comes to be intended as the common name of a certain product – is often around the corner. Take "linoleum" as an example. Today we use this term to indicate a certain type of flooring, but did you know that it was once a registered trade mark?

Trade marks into the future

Trade mark law has come a long way since its early days and securing registration of a trade mark may serve an undertaking's own strategic goals, including to enjoy broader protection in valuable 'objects', such as books and characters. For example, [you can register the title of a book or the name of a character as trade marks](#).

In all this, like any other intellectual property (IP) right, protection under trade mark law is only possible when all relevant requirements for registration are fulfilled. A careful interpretation and application of trade mark principles, including the conditions under which a sign can be protected, is necessary for this area of IP to continue to serve its purposes to protect traders and consumers alike – now and in the future.

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Latest cooperation updates

Here is a rundown of other events and milestones in the EUIPO's European and international cooperation projects:

- **Tools:** Turkey has joined [DESIGNclass](#), and Albania now uses and accepts the terms from the [harmonised database of goods and services \(HDB\)](#) in TMclass.
- A set of [new online services](#) related to designs is now available in Greece (OBI).
- **Extension of Common Practices:** Colombia aligned its practice with [CP3](#) (figurative marks containing descriptive/non-distinctive words), Albania with [CP6](#) (graphic representations of designs), and Moldova with [CP10](#) (criteria for assessing the disclosure of designs on the internet).
- **Webinars:** Discover how the [EU Trade Mark Directive](#) is being implemented in the Member States.
- The [Icelandic IP Office and the EUIPO](#) renewed their cooperation.

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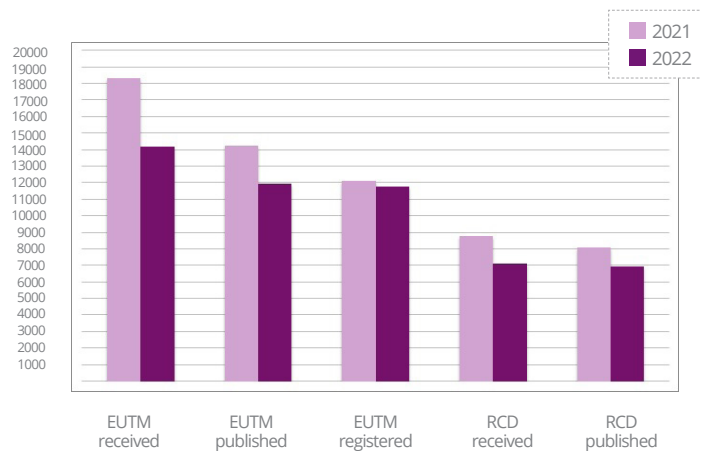
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| Monthly statistical highlights April* | 2021 | 2022 |
|---|--------|--------|
| European Union Trade Mark applications received | 18 343 | 14 142 |
| European Union Trade Mark applications published | 14 234 | 11 912 |
| European Union Trade Marks registered (certificates issued) | 12 110 | 11 740 |
| Registered Community Designs received | 8 766 | 7 116 |
| Registered Community Designs published | 8 065 | 6 955 |



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Customer Satisfaction Survey results



The results of the EUIPO's Customer Satisfaction Survey are out now. And they are good: overall, customers indicate **a high rate of satisfaction with the EUIPO's services, at 90%**.

The Office's core services related to EU trade marks and Community designs are also highly valued, both at 91%.

The EUIPO launched its 2022 Customer Satisfaction Survey as part of its ongoing commitment to provide the highest quality service to its customers, and to learn from their feedback.

The EUIPO would like to thank its customers for participating in the survey. The feedback provided allows us to capture the customers' needs, highlight problem areas and continuously strive for excellence in the framework of the quality management system.

[More details on the results of the survey.](#)

Quality continues to be the heart of the EUIPO's priorities. The Office is committed to improving, and facilitating, its interaction with customers. To find out more about how we manage quality, keep on reading!

Registration process: how we ensure quality

When you apply for an EU trade mark or a design, you will receive a communication from the EUIPO. This communication may be a notification, a decision or the registration certificate for your IP right (an IP product). It is the result of many steps taken to ensure our communications with you are of the best quality.

The [EUIPO Guidelines](#) explain our examination practice. Before raising an objection or issuing a decision, we carry out different types of quality controls that follow auditing techniques and apply defined quality criteria. These quality controls not only ensure compliance with legal and linguistic requirements, but also that the product that reaches you is of the highest quality. We monitor our performance because timeliness is important. We build tools and create working methods to continually enhance quality.

Additional checks are carried out internally on the proceedings after they have been completed. The aim of these checks is to measure the quality in statistical terms and to identify areas for improvement. A sample of our decisions are

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also checked by user associations following the [Stakeholder Quality Assurance Panel \(SQAP\)](#) methodology. In addition, our processes are audited annually by third party auditors based on internationally recognised standards. Last but not least, we always take into account your feedback for improving the quality of our products and services collected through different types of surveys.

We have prepared brief descriptions of 15 quality enablers and controls that affect the registration process. Have a look!

Quality Enablers Fiches:

- [Tools: Front & Back Office](#)
- [Quality criteria](#)
- [Interactive Collaborative Examination \(ICE\) initiatives](#)
- [IP Knowledge Circles](#)
- [EUIPO Guidelines](#)

Quality Controls Fiches:

- [Process audits](#)
- [IP Product audits](#)
- [Operations Department Ex Ante](#)
- [Internal Quality Checks](#)
- [Stakeholders Quality Assurance Panels \(SQAP\)](#)
- [Performance monitoring](#)
- [Style audits \(proofreading of decisions\)](#)
- [Customer Satisfaction Survey](#)
- [Pulse Surveys](#)
- [Immediate Feedback Surveys](#)

Background

The [Integral Quality Framework at the EUIPO](#) structures and emphasises the interrelations of the different elements that ensure the registration process is handled effectively.

A new Customer Service Charter

The [Customer Service Charter \(CSC\)](#) describes the level of service excellence the EUIPO aims to deliver. Through the CSC, the Office manages customer expectations concerning the delivery of products, quality standards, and conflict resolution.

The CSC has been updated to strike a balance between targets and users' expectations while preserving the Office's commitments: quality, timeliness, and accessibility.

For each indicator, three levels are defined:

- **'Excellence'** (the level for which we strive),
- **'Compliance'** (the level considered acceptable),
- **'Actions needed'** (the Office needs to act to raise the performance standard to 'Compliance').

When an indicator is in 'Actions needed', the EUIPO analyses the situation and publishes an explanation – on its website – regarding the actions taken to restore the 'Compliance' level.

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Timeliness

The EUIPO's priority to maintain its CSC **timeliness commitment** particularly focuses on Fast Track cases, given the sustained growth in EUTM direct filings.

- **Fast Track universes have been adjusted to 99 %** of total cases to reflect the true impact of minor and/or temporary issues.
- **Four new indicators** have been included to measure second actions for EUTMs, International Registrations, [Registered Community Designs](#) (RCDs), and [Recordals](#) to help accelerate the notification of decisions, as well as one new indicator to measure non-straightforward first action for Recordals.
- The **timeliness level for cancellation decisions has been increased by 1 month**, requiring more than 6 months for a cancellation decision to be reported as 'actions needed'. This additional month gives the Office flexibility to move cancellation decision-takers to the opposition decisions area to maintain timeliness under control, while the cases compliant with quality criteria for cancellation decisions remain within 'excellence' level.
- The **scope for 'timeliness to answer to proceedings customer's communications'** was **increased to 15 working days** to be reported as 'actions needed'.

Accessibility

A new indicator for Accessibility measures 'chats answered by the Information Centre' as a new channel of communication with users and other relevant stakeholders, to ensure that the proposed improvements provide benefits and value-added for the targeted businesses or users.

Quality

By the end of the first quarter of 2022, the Office had attained a 97.1 % level of achievement in its Quality Service Charter objectives, with a level of commitment successfully met in all cases for quality of decisions.

Positive performance results

Achieving positive performance results in all EUTM and RCD operations over an extended period has allowed the Office to add new KPIs to the CSC on timeliness while defining several actions to reduce the max time to respond to customers' communications for all inter partes proceedings (EUTM opposition and cancellation as well as RCD invalidities). Starting the 2021 with 19 working days and ending with 12 working days.

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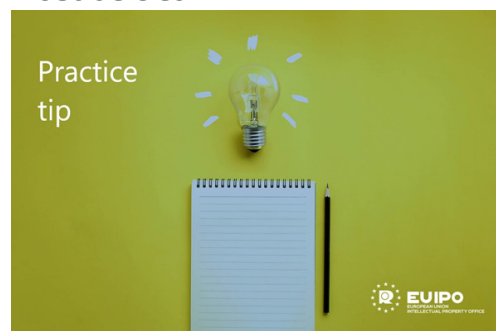
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In a year characterised by an unprecedented increase in the number of filings, the Office has not only met its objectives, but strived for excellence.

For more details, visit our [Customer Service Charter](#)

Practice tip: Visual disclaimers must be clear



In design applications, visual disclaimers such as broken lines and colour shading must clearly indicate that certain features are not intended for protection.

Colour shading and broken lines are types of visual disclaimers used to indicate that certain aspects of the visual depiction of a design do not form part of the design for which protection is sought.

Colour shading is the use of contrasting colours, tones and shades to conceal the elements of the views accompanying a design that are not intended for protection. However, it is sometimes done improperly by simply displaying the parts intended for exclusion in a different colour from the features intended for protection. **Colour shading must obscure the features intended to be excluded by blurring them or making them imperceptible.**

Broken lines (made up of dots and/or dashes) are also used to show that protection is not sought for the features they designate. **A clear contrast is necessary between the broken lines and the continuous lines** that are used to demark the features intended for protection.

It should be **clear that the features depicted using broken lines or colour shading are intended to be excluded** and that they do not simply appear that way in the design. In short, clarity is key when it comes to using visual disclaimers to exclude features from protection.

For more information, please see the Guidelines: [5.4 Use of visual disclaimers to exclude features from protection](#), [5.4.1 Broken lines](#), [5.4.3 Colour shading](#).

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IP Case Law Conference: Don't miss it!



The **IP Case Law Conference** will take place in Alicante on 7-8 July. Have you registered yet? As the date is fast approaching, below is an overview of the interesting programme planned for this edition.

1. General Court Proceedings: This session will address current procedural and substantive questions of the EU courts' case law in trade mark and design matters. Speakers include judges and référendaires of the EU courts in Luxembourg.

2. Sustainability and the Greening of Intellectual Property: Climate change and environmental concerns are at the forefront of government and corporate agendas in a lot of fields of economic activity, including IP. This session will look at how the sustainability and greening of IP are being addressed by EU policy, their impact on trade mark and design jurisprudence and what eco-friendliness means for protection of plant varieties at EU level.

Set against the backdrop of working with nature and sustainable products, consideration will also be given to the treatment of cannabis trade marks at the EUIPO as well as an insider view of how companies must go beyond mere 'greenwashing' of their IP.

3. Intersecting Intellectual Property Rights in Culture, Fashion and Entertainment: This session will deal with the interesting issue about intersecting IP rights in these fields. The topics cover different aspects of culture and entertainment including press and book titles, gaming and sport, music and film, art and also fashion law, which has become a hot topic during the past years.

4. Nurturing the Value of Healthcare and Wellness: The last two years have put health concerns at the centre of our lives. IP was challenged by the pandemic, many new issues were raised in the world of health and new concepts of wellness emerged. The panel will lead the journey into the changes that have altered our lives in recent months.

5. Challenges in the digital age: The digital world plays a crucial role in all aspects and is changing rapidly. International experts will address the upcoming challenges for IP, including how AI can be used in public administration and in trade mark law, if technology created by machines can be protected and how the use of trade marks can be proven by Internet evidence.

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6. Rolling Out Automotive Intellectual Property:

With innovation and technology evolving at an ever-increasing pace, and competition among car manufacturers and suppliers being as fierce and cutthroat as ever before, IP protection is more important now than ever. In this session, we will be discussing the impact of IP issues and challenges for automotive industry, primarily in the field of trade marks, patents and design in light of the Design Reform.

7. Boosting the Attractiveness of Intellectual Property Rights in Food and Beverages:

The food and beverage industries are not only the largest in the world, but in recent years they have also become one of the most competitive in terms of companies and markets. It is not surprising that companies devote considerable resources to creating and promoting distinctive brands, and are increasingly looking to intellectual property protection as a tool to establish or maintain their dominance in the field. The last session will cover these various aspects in the realm of trade marks and geographical indications, with an emphasis on the interactions and challenges between these IP rights and the GI Reform.

[Register now](#)

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EUIPO, gold at the Global Business Tech Awards



The EUIPO won the first prize at the [Global Business Tech Awards](#), in the category of **best application of tech in the public sector**, with its project entitled [IP register in Blockchain](#). This award recognises technologies with tangible benefits.

This is what the jury said about the project:

This winning entry really stood out to us all on the jury panel as it was well written, and clearly described a complex implementation of blockchain technology. The international scale that the EUIPO implemented is really impressive and we have confidence that it will clearly deliver significant efficiencies and value to companies globally.

About IP register in blockchain

The EUIPO modernised the two largest databases of trade marks and designs in the world, [TMview](#) and [DESIGNview](#), using blockchain technology.



The technology was implemented in 2021 to help provide a super-fast, reliable and secure delivery of information on IP rights.

This is the first time this technology has been used to connect IP offices. TMview and DESIGNview now function at speeds that had never been seen before, updated with the data that reflects all the changes a trade mark or design undergoes over time.

Find out more about [IP register in blockchain](#).

Becoming a better data-driven organisation



A decade ago, big data was brought to the attention of corporate boardrooms. Since then, many large enterprises have started their big data journey as part of their digital transformation to become a data-driven organisation.

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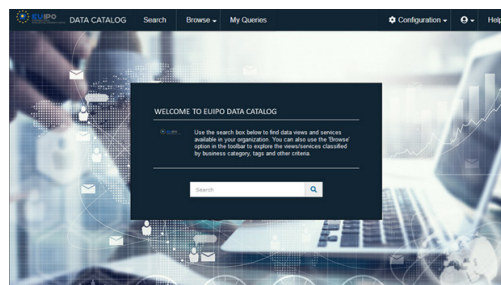
Today, virtually every business process is run on an IT system that generates data. This data can be analysed and used to optimise the process; it can be combined with other data sources to enable further optimisation across the organisation, or it can be combined with external data sources to help generate even more new opportunities.

There are multiple benefits of using a big data initiative, including better strategic decision making, improved control of operational processes, and gaining a better understanding of customers. However, becoming data-driven is not an easy task.

What is the EUIPO doing in this field?

Within the EUIPO's Digital Evolution Programme, the Office has initiated the [Data Governance and Literacy project](#) with the intention of shifting from a business intelligence model to a self-service model where users are able to identify, access and gather operational and corporate data to build their own data analytics.

A **data catalogue** informs users about the data sets and metadata available on a topic and assists users to locate it. It includes information such as data owners' details, classification, and certification status.



Users **can search for business entities** and find datasets related to them. The data catalogue also includes a **business glossary** of terms which provides every individual with the same understanding of the terms used in reports. The catalogue also facilitates data exploitation through the elaboration of reports.

What's next?

A **set of data policies** is being written, providing rules to help safeguard data and establish standards for how this data is accessed, used, and maintained in an accurate and consistent way over its entire life cycle. These documents identify, for instance, who checks data quality, who can access existing datasets, and how long the data should be stored. The **Data Governance Network** will play a key role in elaborating and adopting these policies.

Business cases will be developed over the course of the year, increasing the overall data maturity of the organisation.

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Finally, **increasing the level of data literacy** – the ability to read, write and communicate data in context – is another key objective that the project will address by providing appropriate training.

First prize at the LENS Awards with IPdental



The EUIPO won first prize for **best use of video from the public sector** at the Lens Awards 2022 with its first short movie [IPdental](#).

The Lens Awards brings together agencies and organisations to celebrate corporate film and video, and recognise innovation in a range of categories and objectives. This is what the jury said about IPdental:

[...] The simple, dramatic landscape provides a good primer into the value of intellectual property



protections, a topic which young audiences understand less. Bringing it home for digital natives, the film uses concepts like isolation, monotony and drudgery as a foil to the modern world's creative nature.

The memorable concept is shareable and impactful. It provides a clear motivation for understanding and respecting IP while also celebrating the joys of creativity and indicating more subtly the role the EUIPO plays in supporting creativity.

If you haven't seen it yet, you can find the film on our [YouTube channel](#).

Follow us on social media

Do you follow our social media accounts? Keep up to date with all the EUIPO news and fun facts from the world of IP through our accounts below. Share, like, and keep your comments coming! Our aim is to engage and to bring intellectual property closer to you.

You will find all kinds of IP-related content about art, tech, food, fashion, sports, gaming, the stories behind famous brands and trade marks, great designs and a bit of news and history of IP in the European Union and beyond.

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Check them out!



[Twitter](#)



[LinkedIn](#)



[Facebook](#)



[YouTube](#)



[Instagram](#)

The tool tip: Insights that matter

How to get statistical insights on searches made in [TMview](#) and [DESIGNview](#).

Whether searching for trade marks or designs, for each search that you perform you can further analyse the results with the help of statistical information. Access the statistics area through the search results page by clicking the 'Statistics view' button.



In the statistics area you can see at a glance all the results of your search, grouped by relevant metrics such as Status, Goods and Services, Trade Mark Type, Territories and Applicant Names. In DESIGNview, the metrics are: Status, Locarno classification, Territories and Applicant Names.



When visualising different types of charts you can also make use of the tool tip information, just by hovering over any section on which you would like to get more details. For instance, on the Territories tab you can hover over a particular area to see the number of trade marks / designs that are protected in that country.

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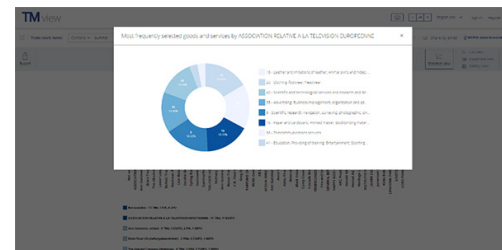
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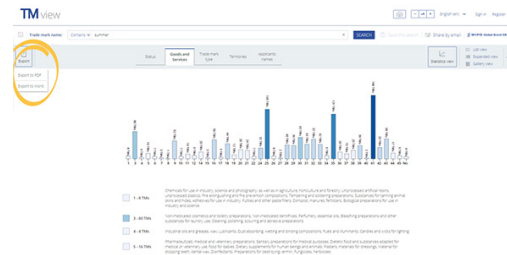
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If you access the 'Applicant's names' tab you can take your research even further. You can find the total number of trade marks / designs grouped by owner, as well as a list with the number of trade marks that have been filed at each of the offices. By clicking on an applicant's name, you can see which goods and services that particular applicant selects most frequently.



On all of the tabs you can find an 'Export' button. So, if you want to consult the statistics offline or save them for future reference, you can export them either as a PDF or as Word document. The exported document will contain information from all the tabs, so you don't need to export each tab individually.



ACADEMY webinars

Latest webinars

Webinar: Drugs and the accepted principles of morality under Article 7(1)(f) EUTMR

Cocaine, heroin, LSD, cannabis, alcohol, pharmaceuticals, tobacco... all of these are drugs. Some are hard drugs, some soft drugs, some are legal and some are not. Some of them can be accepted for registration as European Union trade marks and some cannot, depending on several factors.

Thanks to this webinar you can:

- learn about the EUIPO practice related to the acceptance or refusal of marks that include any reference to drugs (words and/or pictures);
- understand the application of Article 7(1)(f) EUTMR depending on the different types of drug names, their combination with other elements of

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the mark, and the goods and services for which the trade mark is protected.

We presented several examples of these trade marks, and participants were asked to give their opinion on acceptable or non-acceptable trade marks according to the EUIPO guidelines.

[Watch the webinar](#)

Webinar: Beware of misleading invoices: Act smart against scammers!

Scammers make millions through misleading invoice scams. Learn from Europol and the EUIPO experts and avoid being the next victim.

[Watch the webinar](#)

Upcoming webinars

Webinar: Power your business with the SME Fund, Tuesday, 7 June 2022, 10.00 AM – 11.00 AM (CEST)

Webinar: Track Case-Law: GC/CJEU judgments and decisions of the EUIPO Boards of Appeal (Q2), Tuesday, 21 June 2022, 10.00 AM – 12.00 AM (CEST)

On recent case-law

In [Case C-401/19](#), the Court of Justice dismissed the action brought by Poland against Article 17 of the directive on copyright and related rights in the Digital Single Market. The Court stated that the obligation of online content-sharing service providers to review, prior to its dissemination to the public, the content that users wish to upload to their platforms, is accompanied by the necessary safeguards to ensure that such an obligation is compatible with freedom of expression and information.

If you are interested in the Digital Single Market and how to rebalance the rights and responsibilities of users, intermediary platforms, and public authorities, find all the answers to your questions in the recorded webinar on [Digital Services Act: new rules of the game](#).

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

Case law

Case-law comment: Reliability of surveys

By **Christoph Bartos**, Member of the First Board of Appeal of the EUIPO

This article reflects the views and opinions of the 02/03/2022, T-125/21, EUROBIC, EU:T:2022:102

Insights from the General Court on surveys as a means of evidence.

Background

On 26 May 2017, the applicant, a Portuguese bank, sought to register the sign 'EUROBIC' as an EUTM for, among others, goods in Class 9, namely credit cards for banking operations, and services in Class 36, namely insurance, real estate affairs and any kind of financial services.

In September 2017, the opponent, another Portuguese bank, filed an opposition based on several trade marks, including Portuguese trade mark 512 902

BANCO BiG

claiming likelihood of confusion. While the Opposition Division granted the opposition based on the Portuguese trade mark, the Board of Appeal rejected it. The Board held that even if the earlier



Portuguese trade mark were to have enhanced distinctive character acquired through intensive use, there would still be no likelihood of confusion, not even for identical goods and services.

The opponent filed an action before the General Court, claiming infringement of Article 8(1)(b) EUTMR.

Analysis

Confusion on the market

The opponent claimed that a likelihood of confusion exists on the market, since the leading Portuguese payment services provider confused the banks. The General Court dismissed this claim by indicating that the 'confusion' was based on different trade marks that were not part of the proceedings, and does not illustrate a case of relevant likelihood of confusion on the part of the relevant public, but refers rather to the conduct of third parties or service providers.

The opponent further submitted a survey to prove likelihood of confusion on the market. This survey was dismissed on several grounds. The General Court held that the persons questioned had not been selected in such a way as to represent part of the relevant public and that the questions were leading and thus led to unusual speculations.

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The relevant public and its level of attention

In accordance with consistent case-law, the General Court confirmed that the goods and services at issue targeted the general public, which was deemed to be highly attentive.

Comparison of the signs

The General Court confirmed that the element 'banco', meaning 'bank' in English, must be considered weak with respect to the goods and services. However, this does not mean that the element could be considered negligible. Concerning the sign applied for, the Court held that signs consisting of a single word, such as 'EuroBic', do not have any dominant (visual) element.

Despite the high degree of visual and phonetic similarities between the elements 'Bic' and 'BIG', there is only lower than average degrees of visual and phonetic similarities between the signs. This is because of the differences between 'euro' and 'banco'. Conceptually, the General Court held that neither of the signs, as a whole, had any meaning, and that 'euro' and 'banco' evoked different concepts, even if 'euro' were considered as referring to the currency and not a geographical area.

Global Assessment

Due to the high level of attention of the relevant public, the below average degree of visual and phonetic similarities, the conceptual differences, and despite the similarity and identity of the goods and services at issue and the possible enhanced distinctiveness of the earlier Portuguese trade mark acquired through use, the General Court confirmed that there was no likelihood of confusion between the EUTM applied for and the earlier Portuguese trade mark.

Practical significance

The General Court confirmed once again (13/05/2020, T 288/19, IPANEMA (fig.) / iPANEMA (fig.) et al., EU:T:2020:201, § 41) that the principle of the unfettered evaluation of evidence prevails in EU law, from which it follows, in particular, **that the only relevant criterion for the purpose of assessing the probative value of evidence lawfully adduced relates to its credibility.** To assess the probative value of a document, it is necessary to take into account, in particular, the person from whom the document originates, the circumstances in which it came into being, the person to whom it is addressed and whether, on its face, the document appears sound and reliable (06/11/2014, T-463/12, MB, EU:T:2014:935, § 53).



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The probative value of a survey depends therefore on whether the persons questioned represent part of the relevant public (02/03/2022, T 125/21, Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 38) as well as on the way in which the questions are formulated (02/03/2022, T 125/21, Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL (fig.) et al., EU:T:2022:102, § 41; 24/10/2018, T 261/17, SALOSPIR 500 mg (fig.) / Aspirin et al., EU:T:2018:710, § 68).

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Luxembourg trade mark and design news

06/04/2022, T-516/20, Quest 9 / Quex, EU:T:2022:227

| |
|---------------------------|
| EUTM Application |
| QUEST 9 |
| Earlier trade mark |
| QUEX |

Likelihood of confusion — Comparison of the signs — Knowledge of a foreign language — Basic English words — Professional public — Marketing strategies for the goods concerned — Obligation to state reasons on which the decision is based

The applicant sought to register the word sign 'QUEST 9' as a European Union trade mark for goods in Class 10, namely 'bioresonance-based instruments and diagnostic apparatus; medical biofeedback apparatus and instruments', following the restriction made in the course of the proceedings before the EUIPO. An opposition was filed according to Article 8(1)(b) EUTMR based on the EU word mark 'QUEX', covering, inter alia, goods in Class 10 corresponding to the following description: 'Biofeedback devices and bioresonance devices that

generate microcurrents, electro-magnetic impulses, biophotons and bio-energy information for analysis and therapeutic use and for de-stressing and wellness enhancement'. The Opposition Division (OD) upheld the opposition. The applicant filed an appeal.

The Board of Appeal (BoA) dismissed the appeal and confirmed the OD's decision. In essence, the BoA, taking into account the identity of the goods at issue, the average degree of visual and phonetic similarity between the signs at issue and the average degree of distinctiveness of the earlier mark, found that, in spite of the high level of attention of the relevant public, there was a likelihood of confusion within the meaning of Article 8 (1)(b) EUTMR. The applicant filed an action before the General Court (GC). The GC dismissed the action.

The GC confirms that, the relevant public consisted of professionals as regards 'bioresonance instruments and apparatus' and of professionals and the general public as regards 'medical biofeedback apparatus and instruments'. In addition, it states that the relevant public displayed a high level of attention, given that the goods at issue were capable of affecting health (§ 31). The term 'professional', notes the GC, refers to the idea of a restricted and specialist category of public, which is likely to have specific knowledge relating to the goods at issue and generally to display a high level of attention. It is not apparent either from the EUTMR or from the case-



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law that the BoA is required to state the qualifications of the persons who are specifically concerned by the identification of a category of relevant public, whether what is concerned is the general public or the professional public. A distinction is drawn solely between the general public and the professional or specialist public, since the global assessment of the likelihood of confusion must be carried out having regard to the average consumer who has the lowest level of attention. The likelihood of confusion, states the GC, is assessed by reference to the consumers' perception of the goods at issue and not on the basis of particular marketing strategies for those goods, which may vary over time and depend on the wishes of the proprietor of the mark (§ 33-35).

The GC addresses the issue of understanding of a foreign language. It points out that knowledge of a foreign language cannot, in general, be assumed (§ 49, 60, 94). However, it is apparent from the case-law that many consumers in the European Union know basic English vocabulary, but not other terms or one of their meanings which cannot be considered to be part of that basic vocabulary. It is not obvious in the present case that the word 'quest' is part of basic English vocabulary. Moreover, the applicant has not provided any evidence to establish that this is the case (§ 49). The GC finds that even if the term 'quest' were part of basic English vocabulary and it were therefore, as such, capable of being understood by the general public, including the Italian general public, or that public understood

the term 'biofeedback', as the applicant claims, that does not, however, mean that, when purchasing the goods concerned, it would spontaneously associate the element 'quest' in the mark applied for with the English word 'quest' (§ 50). In addition, the GC points out that it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his or her own language, especially in the present case, when the element does not have any specific meaning for the relevant public with regard to the goods at issue (§ 94).

The GC also notes that, in so far as the applicant claims that the sequence of letters 'q', 'u' and 'e' will be given less attention by the relevant public, on account of its presence in a large number of trade marks which have been registered in the European Union and in a large number of words in Italian, it must be pointed out that that claim is unfounded, since those letters do not, in the light of the goods at issue, have any specific meaning. For the purposes of assessing the distinctive character of an element of a mark, it is necessary to take into account, in particular, the inherent characteristics of that element and to ask whether it is at all descriptive of the goods for which the mark has been registered (§ 75).

Finally, in addressing the applicant's claims, the GC notes the first sentence of Article 94(1) EUTMR provides that decisions of the EUIPO must state the reasons on which they are based. That obligation

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to state reasons has the same scope as that under Article 296 TFEU, pursuant to which the reasoning of the author of the act must be shown clearly and unequivocally (§ 135). The obligation to state reasons does not require the BoA to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. It is sufficient if it sets out the facts and the legal considerations having decisive importance in the context of the decision (§ 136). In addition, the reasoning may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its review (§ 137). Lastly, the obligation to state reasons is an essential procedural requirement which must be distinguished from the question whether the reasons given are correct, which goes to the substantive legality of the contested measure. The reasoning of a decision consists in a formal statement of the grounds on which that decision is based. If those grounds are vitiated by errors, the latter will vitiate the substantive legality of the decision, but not the statement of reasons in it, which may be adequate even though it sets out reasons which are incorrect (§ 138). In the case at hand, the BoA set out in a clear and unequivocal manner the reasons which led to the definition of the relevant public. Furthermore, the BoA enabled the applicant to understand the contested decision and to bring an action disputing its merits and then enabled the Court to exercise its power of review (§ 139).



06/04/2022, [T-118/21](#), **Halix records** / **HALIX RECORDS** Edition of **CILEM RECORDS INTERNATIONAL** et al., EU:T:2022:214

EUTM application

HALIX Records

Earlier trade mark

HALIX Records



Substantiation of an earlier right — No infringement of Rules 19(2) and 20(1) CTMIR (now Article 7(2) and Article 8(1) and (7) EUTMDR) — Earlier right according to Article 8(4) EUTMR

The applicant sought to register the word sign 'HALIX Records' as a European Union trade mark for goods and services in Classes 9, 38 and 41. An opposition, based on a German word mark 'HALIX Records' and a German figurative mark



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invoking Article 8 (1)(a) and (b) and Article 8(5) EUTMR was filed. In addition, in the section 'statement of grounds' of the opposition notice, the opponent explained, inter alia, that the contested trade mark had been applied for in bad faith, that the opponent had held rights under company names in Germany and in the European Union since the 1980s pursuant to Section 5 of the Law on the Protection of Trade Marks and Other Signs (Trade Mark Law) of 25 October 1994 (BGBl. 1994 I, p. 3082) and that it had been exposed to unfair competition. The Opposition Division (OD) gave a time limit to the opponent until 11 February 2018 in order to submit further arguments, facts and evidence to substantiate the earlier rights. Within the given time limit, the opponent sent a letter stating that the relevant point in the present case was the date of registration of the earlier marks and not the identity of their proprietor. That letter was accompanied by a number of items of evidence, such as photographs of audio cassettes and various certificates, seeking in particular to prove use of the marks and of their element 'Halix', inter alia, as a designation or logo, since the 1980s. On 14 February 2018, the OD informed the opponent that the earlier marks had not been sufficiently substantiated and that a decision on the opposition would be taken on the basis of the evidence available. The opponent informed the OD on 16 February 2018 that the earlier marks had been transferred to the opponent. Attached to this letter was a fax dated 10 February 2018, to the German Patent and Trade mark Office

(DPMA) requesting the immediate correction of the ownership of the earlier marks in favour of the opponent in its database. On 7 January 2020, the opponent submitted register excerpts from the DPMA evidencing the transfer of the earlier marks published on 6 April and 13 April 2018, respectively, following a request from the previous owner to the opponent. The OD rejected the opposition in its entirety. First, it held that the objection of bad faith was not a ground for opposition and would not be taken into account. Second, it considered that the opponent was not the proprietor of the earlier marks either at the time of filing the opposition or at the time of expiry of the time-limit set for it to substantiate the opposition, nor had it claimed to be a licensee. Thus, the opponent was not entitled to base the opposition on those marks and the opposition should be rejected as unsubstantiated in that respect. Third, the OD considered that the opposition was also unfounded in so far as it was based on Article 8(4) EUTMR, since the opponent had not provided any information on the relevant national legislation and its content but had only referred to Section 5 of the German Trade Marks Act, but without any specific information on its legal consequences. The opponent filed an appeal.

The Board of Appeal (BoA) dismissed the appeal and confirmed the OD's decision. In particular, it considered that the opponent did not provide evidence in due time that it was entitled to file a notice of opposition as proprietor or licensee of the

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earlier marks. Moreover, the ground of opposition based on Article 8(4) EUTMR was not raised either in the notice of opposition or subsequently, and thus, should not be taken into account. In any event, the opponent also failed to identify precisely the national provision to which it referred when it claimed to be entitled, under Article 8(4)(b) EUTMR, to prohibit the use of the mark applied for under national law, and to set out and prove its content. The opponent filed an action before the General Court (GC). The GC dismissed the action.

The GC confirms that the opponent was not the proprietor of the marks on which the opposition was based at the time when the opposition was filed. Moreover, within the time limit set by the OD, which expired, after extension, on 11 February 2018, the opponent did not produce any documents which would have demonstrated any development of that situation whatsoever, in particular the fact that the opponent — and not the original proprietor — was the proprietor of the two earlier national marks. The GC notes that although the opponent informed the OD on 16 February 2018, of a request filed with the DPMA on 10 February 2018, for the transfer of the two earlier national marks, there was no evidence whatsoever, before the expiry of the time limit set for 11 February 2018, that any transfer had taken place and that the opponent was the proprietor of the marks in question (§ 41, 42). The acquisition of the earlier national marks is a circumstance which occurred later, so that the opponent's proof of that

late acquisition does not affect the condition of ownership of the earlier national marks at the time the opposition was filed (§ 44).

As regards Article 8(4) EUTMR, the GC points out that apart from the fact that the opponent did not submit the wording of § 5 German Trade Mark Law, it did not provide any further details as to its content, or as to the precise nature of the basis of the claim or earlier right on which it wished to rely, or as to the grounds which would have entitled it to prohibit the use of the mark applied for, whereas, according to the BoA, § 5 German Trade Mark Law governs four different types of earlier right (§ 63).

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01/04/2022, R 1268/2021-1, Hacker space / Hacker-Pschorr et al.

EUTM application

HACKER SPACE

Earlier trade mark



Relation between Article 8(1)(a) EUTMR and Article 8(1)(b) EUTMR — Substantial procedural violation — Decision annulled

The applicant sought to register the trade mark 'HACKER SPACE' (word) in respect of Classes 3, 5, 29, 32 and 33. An opposition was filed with respect to some of these goods based on four earlier rights, two German trade marks 'HACKERBRÄU' and 'Hacker' and two EUTMs, 'HACKER PSCHORR' and



The ground of Article 8(1)(a) EUTMR (the contested sign is identical to the earlier trade mark and covers identical goods and/or services) was indicated in the opposition notice. When submitting the further facts, arguments and evidence, after the expiry of the opposition period, the opponent claimed that the EUTM applied for should be rejected due to a likelihood of confusion pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) upheld the opposition partially and rejected the EUTM applied for with respect to part of the goods. It found that since none of the signs in dispute were identical Article 8(1)(a) EUTMR cannot be applied. However, the OD stated that even though the opponent only invoked Article 8(1)(a) EUTMR in the notice of opposition, the specific conditions under Article 8(1)(a) and (b) EUTMR are related, despite some differences. Consequently, in oppositions dealing with Article 8(1) EUTMR, if Article 8(1)(a) EUTMR was the only ground claimed but identity between the signs and/or the goods/services could not be established, the Office would still examine the case under Article 8(1)(b) EUTMR, which required at least similarity between the signs and the goods/services and a likelihood of confusion. The applicant filed an appeal.

The Board of Appeal (BoA) annuls the contested decision insofar as it upheld the opposition since it ruled on a ground (Article 8(1)(b) EUTMR) which was not invoked by the opponent in the notice of

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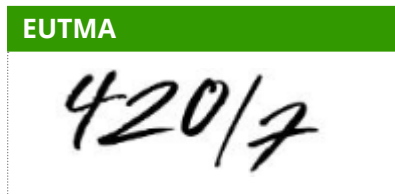
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opposition. It also finds that Article 8(1)(a) EUTMR does not apply in this case. According to the BoA, the scope of proceedings is totally in the hands of the opponent. By choosing a specific ground of opposition, it sets the framework for the proceedings. Adding any grounds of opposition, as well as any other earlier trade mark, after the opposition period, three months after the publication of the EUTM applied for, would broaden the scope of the opposition initiated by the opponent and is not permissible. While it is true that Article 8(1)(a) and (b) EUTMR are closely related, they also differ on some important points. Article 8(1)(b) EUTMR is applicable, if the goods and services as well as the signs are either similar or identical and a likelihood of confusion exists. Article 8(1)(a) EUTMR is only applicable if the goods and services as well as the signs are identical. There is no doubt that Article 8(1)(b) EUTMR also includes the situation regarding Article 8(1)(a) EUTMR. However, the same cannot be said with respect to the reverse situation. To reach the conclusion concerning identity, one must go beyond the concept of 'similarity'. The pure wording used by the legislator is clear. The legislator created two different legal norms, even within the same paragraph, one concerning similarity or identity between the goods and services, which leads to a likelihood of confusion and one concerning identity between the goods and services, which applies without any other further requirement. There is also no room for interpretation. Where the wording of a norm is clear, the verbal interpretation always

prevails over any possible teleological interpretation (15/09/2021, T-207/20, Palladium, EU:T:2021:587, § 47). Consequently, the BoA can only conclude that when Article 8(1)(a) EUTMR is claimed by the opponent as the sole ground of the opposition, the Office is prevented from checking the applicability of Article 8(1)(b) EUTMR. By applying Article 8(1)(b) EUTMR, the OD went beyond the scope of proceedings, which was limited to the application of Article 8(1)(a) EUTMR. By referring to Article 8(1)(b) EUTMR in its submissions concerning further facts, arguments and evidence, which was filed after the expiry of the opposition period, the opponent broadened the scope of the proceedings.

01/04/2022, R 1847/2021-1, 420/7 (fig.)



Trade mark contrary to the accepted principles of morality pursuant to Article 7(1)(f) EUTMR — Decision annulled — Remitted to the examiner for continuation of the examination proceedings

The applicant sought to register the above depicted figurative trade mark in respect of 'cannabis for

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medical purposes; pharmaceutical preparations and substances with analgesic properties; pharmaceutical preparations for treating arthritis; pharmaceutical preparations for the prevention of diabetes; pharmaceutical preparations and substances with anti-inflammatory properties' in Class 5, 'unprocessed cannabis; cannabis plants; grass seeds; seeds for growing herbs' in Class 31 and 'tobacco; Japanese shredded tobacco (kizami tobacco); flavoured tobacco; cigars for use as an alternative to tobacco cigarettes; raw tobacco; inhalers for use as an alternative to tobacco cigarettes; tobacco and tobacco substitutes; roll-your-own tobacco; tobacco pouches; manufactured tobacco; humidifiers for tobacco; flavourings for tobacco; tobacco and tobacco products, including substitutes for tobacco; smokeless tobacco; hand held machines for injecting tobacco into paper tubes' in Class 34. The examiner rejected the trade mark application stating that it is contrary to the accepted principles of morality pursuant to Article 7(1)(f) EUTMR in conjunction with Article 7(2) EUTMR mainly arguing that the element '420' (pronunciation: four-twenty) is related to cannabis and closely related products since it is a common code word in US slang for the regular consumption of cannabis, especially smoking around the time 4:20pm. It also refers to cannabis-oriented celebrations that take place annually on April 20 (4/20 in US form). The relevant public would perceive the sign as being contrary to accepted principles of morality, as it promotes drug consumption. The laws of several EU Member

States prohibit the purchase or consumption of products containing cannabis. The EU has also taken measures in the field of drug policy to combat illegal drugs. The applicant filed an appeal.

Firstly, the Board of Appeal (BoA) finds that the examiner failed to carry out an examination of the absolute ground for refusal pursuant to Article 7(1)(f) EUTMR with regard to homogeneous groups of the goods. The goods applied for are, on the one hand, pharmaceutical products in Class 5 and, on the other hand, plants and seeds in Class 31 and tobacco and tobacco related products in Class 34. Even if all the goods may contain cannabis, it is not a homogeneous group of goods. Pharmaceutical products are marketed and sold differently from tobacco products, for example. Although the assessment of Article 7(1)(f) EUTMR is not to be based on the public that consumes these goods, but rather on the general public, the goods must nevertheless be taken into account. Furthermore, account must be taken of the context in which the mark is likely to be found. Secondly, the BoA finds that the examiner has not examined the sign applied for, but only one of its components since he analysed only the possible meanings of the number '420' and did not mention at all the other elements (a forward slash '/' and the number '7'). These elements, all written in very legible handwriting, are neither so small nor insignificant not to be perceived by the average consumer. Finally, the BoA affirms that the examiner did not sufficiently explain why the term '420' would

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be understood as a code word for 'cannabis' or as a reference to '4:20pm' or 'April 20'. The cited meaning might be known only by a part of the public in the United States of America. Even though terms from American English are generally part of British English which is primarily taught, understood and spoken in Europe, this requires particular evidence in the case of slang words, abbreviations and specialist terms. That evidence has not been provided by the examiner. Neither has evidence that the number sequence '420' will be understood immediately and without further consideration either as '4:20 p.m.' or 'April 20' been provided in the contested decision. In the BoA's view, the sign in its entirety will be perceived as four hundred and twenty slash seven or as a division (420 divided by 7) or, in some circumstances, as a reference to an event that recurs daily at 4:20 pm. Neither of these meanings has any clearly discernible connection to the goods in question. If the element '420' is understood as a reference to 'cannabis' this would at best be known to those members of the general public who are familiar with the code word '420', i.e., the public interested in cannabis and its derivatives. The sensitivity and tolerance threshold of consumers who consume cannabis themselves differs from the sensitivity and tolerance threshold of consumers who do not consume it and fundamentally reject it. It can be assumed that consumers of cannabis are at least neutral towards a reference to cannabis; such a reference will not disturb them and will not be perceived by these consumers as a violation of

the recognised principles of morality. However, by recognising the said meaning, the sign applied for could be non-distinctive or descriptive for this part of the public. This requires separate proof, in particular as to whether this group is large enough to justify a refusal under Article 7(1)(b) or (c) EUTMR. The interpretation of the number 7 seems meaningless if '420' is understood as a reference to 'April 20'.

04/04/2022, R 1523/2020-1, **Economic parfemi / ECONOMIC (fig.)**

Invalidity — Article 60(1)(b) EUTMR — Article 8(3) EUTMR — Agent's trade mark — Bad faith — Article 59(1)(b) EUTMR

The applicant sought to register the trade mark 'ECONOMIC PARFEMI' (word) in respect of goods and services in Classes 3, 16 and 35, which, after limitation, are the following 'toiletries, except perfumes' in Class 3, 'printed matter' in Class 16 and 'advertising, advertising, marketing and promotional services for market and promotional research, other than advertising, advertising, marketing and promotional services for market research and promotional services relating to perfumes' in Class 35. On 9 February 2017, a third party which later filed a cancellation action against this trade mark (hereinafter 'the cancellation applicant') submitted a request to transfer the

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ownership of the registration to it and also to one of the proprietors. The cancellation applicant attached a copy of a contract of assignment. On 21 February 2017, the Office confirmed that the request for transfer of ownership of the registration was granted. On 29 March 2017, the proprietors filed a notice of appeal against the Office's decision. On 10 October 2017, the cancellation applicant filed an application for a declaration of invalidity in respect of all the goods and services. The application was based on the grounds set out in Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR and on Article 59(1)(b) EUTMR (bad faith). On 23 August 2018, the Board of Appeal (BoA) issued a decision on appeal R 718/2017-1, followed by a corrigendum dated 7 January 2019. In its decision of 7 January 2019, the BoA allowed the appeal and annulled the assignment of the trade mark.

By a decision of 26 May 2020 (the contested decision), the Cancellation Division (CD) declared the trade mark invalid on the grounds of Article 59(1)(b) EUTMR ('bad faith') and refused the application for a declaration of invalidity on the grounds of Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR. The cancellation applicant filed an appeal against the contested decision, requesting that it be annulled insofar as the application for a declaration of invalidity pursuant to Article 60(1)(b) EUTMR in conjunction with Article 8(3) EUTMR and the corresponding assignment of the contested EUTM had been rejected.

The BoA upholds the appeal in part. It firstly states that given that the cancellation applicant's principal application was to obtain assignment of the trade mark in its favour and given that the CD only upheld its subsidiary application, and declared the registration invalid, the cancellation applicant is entitled to appeal. Furthermore, it notes that there is no doubt that the cancellation applicant owns earlier national trade mark registrations



in Serbia, the Republic of North Macedonia and Montenegro in respect of goods in Class 3. The BoA finds that the provision of Article 8(3) EUTMR must be interpreted broadly and, in that regard, that the evidence submitted, taken as a whole, leads it to conclude that the relationship between the EUTM proprietors and the cancellation applicant was that of a non-written agreement for the distribution of perfumes, under an identical mark, in Croatia and Slovenia. As regards the signs and the goods and services in question, the BoA observes that there is no identity between them; nevertheless, it confirms the similarity of the signs and the similarity between the cancellation applicant's goods and the contested goods and services in Classes 3 and 35. In that regard it refers to the judgment of 11/11/2020, C-809/18 P, Mineral Magic, EU:C:2020:902, § 73,

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pointing out that the removal of a trade mark filed by an agent or representative cannot be deemed to occur only in cases where the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical but it also has to occur also in cases where the marks at issue are similar. Thus, the BoA concludes that the condition for the application of Article 8(3) EUTMR applies to the goods and services which have been found similar. As regards the remaining goods, 'printed matter' in Class 16, the BoA notes that the CD had found that the contested trade mark had been filed in bad faith within the meaning of Article 21(2)(a) EUTMR and Article 59(1)(b) EUTMR in respect of those goods of the proprietors. Since the proprietors did not submit any arguments in response to the CD's conclusion concerning the existence of bad faith in respect of these goods, the contested decision must be upheld insofar as the contested trade mark was declared invalid.

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New cancellation decisions

Each edition of Alicante News includes a new summary in the series of interesting decisions from the EUIPO's cancellation division.

17/02/2022, C 47 548 (Invalidity), BALATON GIN (figurative)

Contested EUTM



**Invalidity - Article 59(1)(a) EUTMR -
Descriptiveness and non-distinctiveness -
Deceptiveness - Application rejected**

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Article 59 (1)(a) EUTMR, in conjunction with Article 7(1)(b), (c) and (g), against all the goods covered by the EUTM in Class 33.

The applicant argued that the mark is descriptive and lacks distinctive character. The sign provided



information about the kind and geographical origin of the products. The term 'Balaton' refers to a Hungarian lake, which is a popular tourist destination and is also known for many distilleries. The term 'gin' refers to an alcoholic beverage. The fish would be associated with the verbal element 'Balaton' and the relevant public would associate it with Lake Balaton. Therefore, the depiction of a fish would not add any distinctive character to the sign.

The proprietor indicated that Lake Balaton cannot be considered sufficiently well known to the relevant public as a particular geographical location. Moreover, the geographical term 'Balaton' does not designate a place that is currently associated with the goods at issue. The proprietor also found no link between the depiction of the fish, the element 'Balaton' and the goods at issue, since the goods are gin and not fish products. The proprietor noted that as a whole, the mark, a combination of verbal and figurative elements, does have distinctive character and can function as a trade mark.

The applicant further maintained that the sign could deceive consumers, as they would wrongly assume that the goods are manufactured in the area of the Balaton Lake. In response, the proprietor pointed out that this area is not known as designating certain characteristics of gin.

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After the appropriate assessment, the Cancellation Division noted that while the expression is grammatically correct and meaningful, it would not inform the consumer about the kind and geographical origin of the goods. The figurative element contained in the mark also gives the sign distinctive character. Finally, the Cancellation division concluded that it could not be established that Balaton, as a geographical area, designates certain characteristics or the quality of the goods. Therefore, there was no risk that the trade mark would deceive the public, and the application was rejected.

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New decisions from the Grand Board

3/04/2022, R 0964/2020-G, Zoraya / Viña zoraya

Phonetic similarity – Similarity of the goods and services – Similarity of the signs – Visual similarity – Well known facts need no evidence – Article 8(1)(b) EUTMR – Article 165(3) EUTMR – Decision partially annulled – Opposition partially rejected

On the basis of the arguments, facts and evidence presented before it, generally known facts as well as the practical experience and knowledge of its members, the Grand Board decided that ‘non-alcoholic beverages’ and ‘flavoured carbonated beverages’ are at least slightly similar to ‘wines, spirits and liqueurs’ for the relevant public in Spain. For these goods, there is also a likelihood of confusion due to the high degree of similarity of the signs.

The remaining goods applied for, namely ‘waters; vitamin enriched sparkling water [beverages]’ are dissimilar with the goods covered by the earlier mark, there can therefore be no likelihood of confusion.

In view of the above considerations, the Grand Board partially upheld the opposition that was based on Article 8(1)(b) EUTMR.

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Case-law on IPR Infringement and Enforcement

A new update of the [Recent European Case-law on the Infringement and Enforcement of Intellectual Property Rights](#) (IPR) is out now.

The 'recent case-law update' reports on the latest significant European decisions related to infringing and enforcing IP rights. The document contains **234 summaries of key judgments** from national courts and preliminary rulings from the Court of Justice of the European Union (CJEU).

The first part features the most recent cases.

- On 26 April, the CJEU delivered its long-awaited ruling in case [C 401/19](#). It confirmed that **Article 17** of Directive (EU) 2019/790 on copyright and related rights in the Digital Single Market (C-DSM Directive) **is compatible** with the EU Charter of Fundamental Rights. Therefore, it dismissed the action for annulment brought by the Republic of Poland. The Court essentially reasoned that the liability regime established under Article 17(4) of the C-DSM Directive **entails a limitation** of the freedom of expression and information by the preventive control it de facto requires from online content-sharing services providers on the content posted by their users. However, the Court ruled that the limitation is justified as it is accompanied by **internal safeguards** within Article 17 that



are sufficient to protect those freedoms and rights and ensure a fair balance between them.

- The CJEU also issued three preliminary rulings on the interpretation of Directive 2004/48/EC (Enforcement Directive - 'IPRED').

- In case [C-559/20 \(Koch Media\)](#), the CJEU first clarified that lawyers' fees incurred in the pre-litigation phase for sending warning notices of copyright infringements are reimbursable by the unsuccessful party as 'other expenses' under Article 14 IPRED. The Court assessed if, and under which circumstances, reimbursement claims can be limited where a natural person has carried out an infringement without a commercial purpose. In such a case, the Court confirmed that the reimbursement of 'other expenses' can be calculated on a flat-rate basis, on the basis of a value of the dispute limited by a legislation, unless the national court considers that the application of such a limitation is inequitable or disproportionate with regard to the specific characteristics of the case.

- In case [C-531/20 \(NovaText\)](#), the CJEU interpreted Article 3(1) and 14 IPRED, specifically the concept of 'reasonable and proportionate legal costs' in relation to patent lawyers' costs. The Court ruled

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that in the proceedings under IPRED, the courts must be able to take due account of the specific characteristics of each case brought before them for the purposes of assessing whether the legal costs incurred by the successful party are reasonable and proportionate. National legislation or an interpretation thereof which goes so far as to subtract a category of court costs or other expenses from judicial review of their reasonableness and proportionality is not compliant with EU law.

- In case [C-44/21 \(Phoenix Contact\)](#), the CJEU interpreted Article 9(1) IPRED in a patent dispute. The CJEU ruled that competent judicial authorities can grant an interlocutory injunction in infringement proceedings even if the validity of the patent has not been confirmed. That ruling challenges established case-law in Germany which stresses the importance of securing validity of a patent prior to the granting of a preliminary injunction.

- In [Holland](#), the Dutch Supreme Court examined whether the use of a lookalike in a commercial video could constitute a violation of an **image right**. The person displayed resembled a professional racing driver (Max Verstappen) and was wearing the same racing outfit and cap as the famous driver. The Court answered in the

affirmative. It stated that a person has to be recognisable by the image of the lookalike, and that this possibility of recognition is increased when there are additional similarities, such as the manner of presentation of the lookalike.

- In [France](#), the Tribunal judiciaire de Paris issued another so called '**dynamic blocking injunction**' in the sport sector, under the new accelerated judicial procedure provided for by Article 333-10 of the Sports Code, in a proceeding brought by Canal Plus publishing company against several French internet services providers. [ARCOM](#) (Autorité de régulation de la Communication audiovisuelle et numérique) is tasked with updating the blocking order together with the rights holders.

- In [Spain](#), the Madrid Commercial Court interpreted the now abolished article 32(2) of the Spanish Intellectual Property Law, enabling **news publishers** to receive compensation for the use of their content by online platforms, including news aggregators. The Court did so in a dispute between the Spanish Center for Reprographic Rights (CEDRO) and Google, in relation to its Google DISCOVER service.

- In the [United Kingdom](#), the High Court of Justice found in favour of **Ed Sheeran** in a proceeding in which his song 'Shape of You' was alleged to infringe upon Sami Chokri's song 'Oh Why'.

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The update includes other national developments, in particular those on the interface between copyright and design protection, such as:

- in [Denmark](#), where the Danish Eastern High Court recognised copyright protection and subsequent infringement in a work of applied art (i.e. a **plant box design**).
- in [Belgium](#), where the Tribunal de l'Entreprise de Liège similarly confirmed the copyright protection and subsequent infringement of the model 'Le pliage' (a **Longchamp handbag**).

The second part covers decisions issued between 2018 and April 2022.

The [case-law update](#) aims to provide practitioners, judges and lawmakers with a meaningful overview of the latest developments and trends in jurisprudence in this field.

[More information about this activity and other Observatory initiatives in the field of case-law.](#)

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