

# Alicante News

Up to date information on IP and EUIPO-related matters

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### Extension of time limits COVID-19

In order to provide users with further guidance on [Decision No EX-20-3](#) extending time limits expiring between 9 March 2020 and 30 April 2020 in the context of the coronavirus outbreak, the following clarification has been issued about the time limits affected by the extension, the nature of the extension and the measures to adapt communications sent to users.

#### I. TIME LIMITS AFFECTED BY THE EXTENSION

Article 1 of [Decision No EX-20-3 of the Executive Director of the Office of 16 March 2020](#) extends until 1 May (in practice 4 May, since 1 May is a public holiday, followed by a weekend) **'all time limits** expiring between 9 March and 30 April 2020 inclusive that affect all **parties in proceedings before the Office'**.

Article 101 (4) EUTMR, which empowers the Executive Director to extend time limits in the case of exceptional occurrences uses a similar language, by also referring to 'all time limits' and 'all parties to the proceedings'.

The reference to **'all time limits'** is to be read literally and encompasses **all procedural deadlines**, irrespective of whether they have been set by the Office or are statutory in nature (i.e. are stipulated directly in the Regulations).

For the sake of clarity, this expression covers:

- Time limits set by any instance of the Office, in any proceeding before the EUIPO, including its Boards of Appeal
- Time limits imposed directly by the EUTMR, the EUTMIR or the EUTMDR as well as CDR and CDIR
  - including those originating from the Paris Convention or other International Treaties, and
  - regardless of whether they are excluded from restitutio in integrum within the meaning of Article 104 (5) EUTMR and Article 67(5) CDR
- In particular, the following statutory time limits **are covered** by the extension:
  - Payment of the Application Fee (Article 32 EUTMR)
  - Right of Priority (Article 34(1) EUTMR and Article 41 CDR)
  - Exhibition Priority (Article 38(1) EUTMR and Article 44 CDR)
  - Opposition Period (Article 46(1) EUTMR)
  - Payment of the Opposition Fee (Article 46(3) EUTMR)
  - Request for Renewal (Article 53(3) EUTMR and Article 13 CDR)
  - Filing of an Appeal and of the Statement of Grounds, payment of the Appeal Fee (Article 68 (1) EUTMR and Article 57 CDR),
  - Conversion (Article 139 EUTMR)
  - Deferment of publication of design (Article 50 CDR).

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However, the reference in the Decision to **'proceedings before the Office'** means that time limits that relate to proceedings **before other authorities** are **not covered** by the extension, even if mentioned in the Regulations. This is in particular the case with regard to the time limit for:

- Bringing an action before the General Court against decisions of the Boards of Appeal (Article 72(5) EUTMR and Article 61 CDR).

Finally, it should be pointed out that the expression **'proceedings before the Office'** **only relates to trade mark and design matters**, which means that time limits related to subjects not dealt with by the EUTMR or the CDR (such as employment or procurement) or which relate to other matters (e.g. the governance of the Office) are also **not covered** by the Decision of the Executive Director.

### II. NATURE OF THE EXTENSION

The extension of time limits granted by the Executive Director has the immediate effect of preventing the deadlines concerned from lapsing when they were originally due, and of setting a new expiry date applicable to all, namely the 1 May 2020 (in practice, 4 May).

This effect is automatic and derives directly from the Decision of the Executive Director. Accordingly, affected parties are **not required** to file a request to the Office for the extension of the time limit to take effect.

Parties to ongoing proceedings are therefore advised not to lodge unnecessary requests for extension.

It should be noted, however, that in case the parties are in a position to meet either the original or the extended deadline, and choose to discharge their procedural obligations during that period, the procedure will take its usual course and any documents filed will be examined in the regular manner.

### III. COMMUNICATIONS SENT TO USERS

The immediate effect of the extension also implies that users whose time limits are concerned **will not be informed** about the grant of the extension by means of individual communications.

The Office has done its utmost to adapt its IT systems in such a way as to guarantee a seamless treatment of the time limits that were due to expire before the extension date. However, in the unlikely event that a communication from the Office does not adhere to the given extension, the Office will address the case immediately by issuing a rectification either of its own motion or following a written request from the user indicating the file number concerned.

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## Visual search for TMview extended to Poland

TMview's visual search facility, which allows users to search for trade mark images in the world's largest online trade mark database continues to grow.

**The Polish Patent Office** made its trade mark images available to the **visual search tool in TMview** on 23 March 2020.

The visual search facility, implemented on a pilot basis in 2017, enables to search for trade marks using images, further enriching TMview as a whole. This functionality is also available in the new **TMview beta**.

The extension of the TMview visual search to the Polish Patent Office follows its extension to the IP offices of Austria, Benelux, Bulgaria, Croatia, Cyprus, the Czech Republic, Estonia, Finland, France, Greece, Hungary, Ireland, Italy, Lithuania, Malta, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, the United Kingdom and the EUIPO, bringing the total number of **participating offices to 24**.

## Consultation on CP11 – New Types of Trade Marks

The draft Common Practice documents of the work-streams 1 and 2 of the project **CP11 'New Types of Trade Mark – Examination of formal requirements and grounds for refusal and invalidity'** have been made available in English for comments.

The documents can be accessed via the following links:

- [Work-stream 1: Examination of formal requirements and absolute grounds for refusal and invalidity](#)
- [Work-stream 2: Examination of relative grounds for refusal and invalidity](#)

The Working Groups of CP11 work-stream 1 (WS1) and work-stream 2 (WS2), composed of representatives from nine and eight intellectual property offices of the EU, respectively, four user associations and the EUIPO, made significant progress on developing the Common Practice documents during the course of four Working Group meetings and two (one for work-stream 2) drafting workshop meetings in which the representatives shared their best practices and expertise to **establish the common principles of the CP11 project**.

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As a result, the second draft of the CP11-WS1 Common Practice and the first draft of the CP11-WS2 Common Practice are now available for review by all stakeholders.

The Working Group members have included **various examples in both documents that are still under discussion**, where it would be very appreciated to receive feedback.

**The EUIPO welcomes your comments** on both draft Common Practices, which should be addressed to [CommonPractices@euipo.europa.eu](mailto:CommonPractices@euipo.europa.eu) by Monday, **13 April 2020**.

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## #EUIPO Innovation



### International registrations back office released

The EUIPO has released a new back office function for international registrations. The upgrade is designed to increase the efficiency, operational effectiveness and security of all the processes related to international registrations.

#### What's new?

- One integrated platform for all trade mark processes
- Low added value tasks are now automated
- New functionalities

The international registration back office release is part of the IP Tool project — the EUIPO's renovation of all the back office systems — and completes the trade mark cycle. Today, all the back office systems of the core trade mark activities have been successfully revamped with IP Tool.

For the first time in the Office's history, nearly all examiners are working with the same tool, covering different processes of the entire lifecycle of an EUTM, from filing and publication to final registration, as well as dealing with the examination procedures for international applications and subsequent designations.

The release has been supported by a multidisciplinary and multi-departmental team and has involved the close coordination of activities with the [World Intellectual Property Organization](#).

With the new back office, the Office expects to process approximately 29 500 trade marks in 2020. In 2019, international registrations represented 17.8 % of filings received by the Office. Filing volumes increased significantly last year (by 13.5 % compared to 2018).

#### What is IP TOOL?

The IP Tool project started in 2014 with the aim of integrating all the Office's back office systems, which existed as separate modules, into one single tool. The ultimate aim is to have one integrated platform to support all IP processes in the Office.

Timeline:

- Apr 2015 Inspection of files
- Sep 2016 Recordals (I)
- Apr 2017 eAppeal, Recordals (II)
- Jul 2017 Recordals (III), Inter partes (Cancellations)
- Feb 2018 Inter partes (Oppositions, Invalidities), Ex parte trade marks (EUTMs)
- Jun 2019 Register, Litigation
- Aug 2019 Ex parte trade marks (international applications, subsequent designations)
- Feb 2020 Ex parte trade marks (international registrations)

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### Next steps

The next major improvements anticipated in the back office systems include the integration of the Community design examination tools and expanding this to other Office areas including publication, the Boards of Appeal and litigation.

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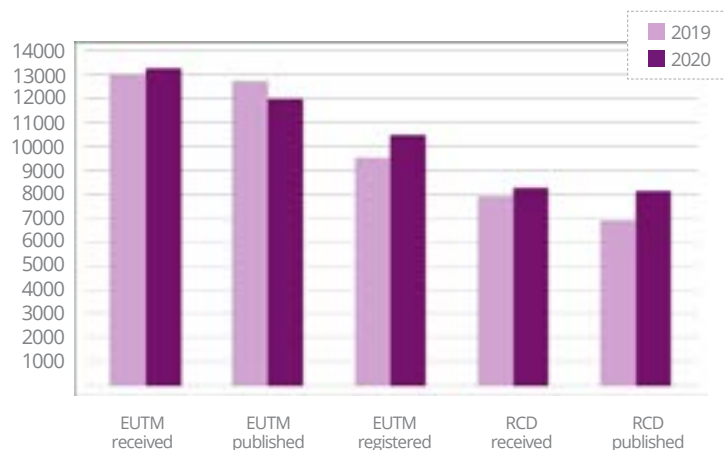


## # EUIPO Excellence



### Statistical Highlights

Monthly statistical highlights February*	2019	2020
European Union Trade Mark applications received	12 981	13 267
European Union Trade Mark applications published	12 725	11 977
European Union Trade Marks registered (certificates issued)	9 510	10 476
Registered Community Designs received	7 906	8 270
Registered Community Designs published	6 892	8 153



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## # EUIPO Excellence



### External audit 2020: conformity with the highest standards

The EUIPO has successfully passed the external audit of its six certified management systems.

This year's external audit concluded with the renewal of the EUIPO's environmental certification (EMAS). The auditors also confirmed that the EUIPO's processes remain in full alignment with international standards in the field of quality (ISO 9001), information security (ISO 27001), complaints management (ISO 10002), occupational health and safety (OHSAS 18001) and universal accessibility (UNE 170001).

The auditors praised the EUIPO for its drive towards continuous improvement. The maturity of the management systems implemented at the Office as well as the robustness of its processes were also mentioned, among other noteworthy efforts.

The auditors underlined the consultation with stakeholders that was launched to develop the SP2025, highlighting in particular the EUIPO's customer-focused approach. In addition, the auditors drew special attention to the Office's continuous development in the field of information security and new technologies, its outstanding environmental performance and the effectiveness of its health and safety and accessibility measures considering the extraordinarily low accident rate

Overall, no non-conformities were identified and a few observations and opportunities for improvement were indicated. The EUIPO took note of these findings and will start working to address them soon.

This successful outcome is without doubt the result of the invaluable work of all EUIPO staff.

For more information about the Office's certified management systems, please visit the [EUIPO's quality page](#).

### This month's webinars from the EUIPO Academy

#### Latest webinars:

#### **Arguments of the parties: most frequent arguments presented by the parties and how to deal with them**

In opposition and cancellation proceedings parties very often repeat the same arguments which are dismissed for a variety of reasons. This webinar goes over these recurrent arguments and provide tips on how to present them in a better light, as well as giving insight on how the Office deals with the parties' arguments and their impact on the decision-taking process.

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## # EUIPO Excellence



### Nail your list of goods and services: avoiding the traps

Are you drafting a list of goods and services in your own words? Beware the pitfalls of classification! Watch this webinar for tips on how to choose the right scope of protection; to learn about the effect of the classes selected; to understand which terms are not clear or sufficiently precise, why they're not clear or sufficiently precise and how to fix them; to find out how to juggle scope-determining punctuation correctly; and for a variety of helpful insights and relevant examples.

### Introduction to the registered Community design system

This webinar provides a synthetic overview of the registered Community design (RCD) system. The main topics covered include legal definitions, conditions for protection, the filing and examination process, prerogatives of the design rights owners and also the cancellation actions that can be filed against RCDs.

### Decision of the trimester of the EUIPO Board of Appeal

### Priorities for decision takers: practical aspects

### Upcoming webinars

**Tuesday, 7 April**, 10.00 AM » 11.00 AM **Decisions of the trimester of the GC and the CJEU**

**Tuesday, 21 April**, 10.00 AM » 11.00 AM **Cancellation: the basics of invalidity and revocation proceedings**

**Tuesday, 21 April**, 11.30 AM » 12.00 PM **Notification of detentions using the IP Enforcement Portal and introduction to the Detention Report 2013-2017**

**Tuesday, 28 April**, 10.00 AM » 11.00 AM **Enforcement of IPR change after the signing of EU trade agreements**

### On current case-law

In [C-766/18 P](#), the Court of Justice set aside the judgment of the General Court according to which the *collective mark* HALLOUMI, reserved for Cypriot cheesemakers, does not preclude the sign 'BBQLOUMI' from being registered as a European Union trade mark for cheese of a Bulgarian producer. To find out more about *collective trade marks*, watch our [webinar on collective trade marks](#).

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The most popular webinar this month: **New types of trade marks: what has been their reception by the Office and the Boards of Appeal?**

One of the most important aspects brought by the legislative reform of the EUTM is the deletion of the graphical representation requirement. This has a direct and important impact on the so-called non-traditional trade marks, which have now new ways to be represented in a clearer, more precise and easier way. Virginia Melgar's presentation guides us through the many examples of new types of marks and how they have been accepted or refused by the Office.

You can find out more about the EUIPO webinars and see what's on offer at [www.euipo.europa.eu/knowledge](http://www.euipo.europa.eu/knowledge)

### New e-learning modules in cooperation with MARQUES

The EUIPO, together with [MARQUES](#), has developed two new e-learning modules on intellectual property within the framework of the 'ECP3 Academy Learning Portal' cooperation project.

The EUIPO Academy Learning Portal now offers a module on [Intellectual Property \(IP\) as Valuable Business Assets](#), in which Shane Smyth (FRKelly) explains the meaning of IP, its main forms and characteristics, and how to protect and use it. A second module on [Commercial Exploitation of IP Rights: Trade Mark Licensing](#) is presented by Sandra Mueller (Squire Patton Boggs).

Following completion of the modules, the user will be able to:

- Identify and consider an IP strategy linked with a business strategy;
- Understand what a licensing agreement is and what types of licence exist;
- Understand how to create an additional income through licensing;
- Identify the pitfalls;
- Negotiate a license agreement.

The new modules include videos and quizzes and they target users with a **basic to intermediate level of intellectual property knowledge**. After successfully completing the final quiz, a certificate of completion can be downloaded.

As part of the EUIPO's [European Cooperation](#) activities, this project provides a common network for developing tailor-made tutorials and e-learning content in the field of IP in cooperation with intellectual property offices of the EU and user associations.

Following a call for speakers in August 2019, [MARQUES](#) forwarded two nominations and, together with the EUIPO project team, they developed the content of the new e-learning modules. An implementation workshop took place in November 2019 and both modules were recorded at the EUIPO.

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## # EUIPO Excellence



### Rules of Procedure of the Boards of Appeal published

With the adoption of Decision 2020-1 the Presidium of the Boards of Appeal has created heightened transparency in appeal processes.

The Decision, which was conceived in close cooperation with stakeholders and User associations, entered into force on 27th February 2020 and creates a complete set of rules for the Boards of Appeal to govern appeal proceedings for both EU Trade Marks and Designs.

**For the first time in more than twenty years of the history of the Boards, both parties and decision-takers will benefit from a single comprehensive set of rules applied to all proceedings before the Boards of Appeal.**

These Rules of Procedure are the result of the Boards dedication to increasing transparency, consistency and legal certainty for users of the appeal system and streamline the decision-taking processes throughout the Boards.

They compile and codify existing procedural practice of the Boards of Appeal as governed by the EUTMR, EUTMDR and EUTMIR as well as the CDR and CDIR, and general principles of EU law, including the principles of equal treatment and sound administration as interpreted by the General Court and the Court of Justice.

One of the main purposes of the Rules is to clarify the extent to which the procedural rules on trade mark proceedings are applied by analogy to design appeals after the legal reform of 2017. Consequently, the Rules specify the adjustments and adaptations needed for design appeal proceedings, with a view to increasing legal certainty. Moreover, while the applicable regulations leave room for diverging interpretations in other areas as well, these Rules aim to provide clarification and greater alignment of practice on procedural issues.

By crystallizing the Rules into a single document, parties to appeal proceedings at the EUIPO will have a much clearer and more detailed picture of the process, thereby increasing predictability.

The EUIPO Boards of Appeal would like to extend their gratitude to the User Associations for their involvement. The comments and feedback received from the associations during the drafting stage has truly been paramount in the codification of the Rules of Procedure. The end result would not have been possible without our stakeholders.

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### Luxembourg trade mark and design news

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

27/02/2020, C 240/18 P, Fack Ju Göhte, EU:C:2020:118

**RESULT:** Appeal well founded (GC judgment entirely annulled and case settled by the CJ)

**KEYWORDS:** Contrary to public policy or principles of morality

#### FACTS:

The General Court (GC) found that the word mark applied for, Fack Ju Göhte, was contrary to accepted principles of morality. It considered that the German-speaking public will assimilate the mark applied for to the English phrase 'Fuck you' which has a sexual connotation and is vulgar. The additional element 'Göhte' does not attenuate its vulgarity.

The fact that the mark applied for is the same as the name of successful films popular among the German-speaking public does not exclude that that public can be shocked by the mark.

The EUTM applicant appealed to the Court of Justice of the European Union (CJ) relying on three pleas in law: (i) infringement of Article 7(1)(f) EUTMR, (ii)

infringement of the principle of equal treatment, and (iii) infringement of the principle of legal certainty and sound administration.

#### SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE 7(1)(f) EUTMR. The concept of 'accepted principles of morality' is determined by taking into account the fundamental moral values and standards that society adheres to at a given time. These are likely to change over time and should be assessed objectively according to the social consensus prevailing in that society at the time, taking the social context into account (including cultural, religious or philosophical diversities) (§ 39).

The examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance considering the context in which the mark may be encountered and the particular circumstances of the part of the EU concerned (that is, legislation, administrative practices, public opinion) (§ 42). The examination cannot be confined to an abstract assessment of the mark applied for. It must be established that the use of that mark in the concrete and current social context would be perceived by that public as being contrary to the fundamental moral values and standards of society (§ 43). Contextual elements capable of shedding light on how the relevant public perceives the mark cannot be disregarded (§ 51).

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The examination carried out by the GC does not meet the standards required by Article 7(1)(f) EUTMR (§ 49).

Despite the social context and factors relied on by the applicant ('Fack Ju Göhte', a German cinematic comedy produced by them, having been one of the greatest film successes of 2013 in Germany and also used for educational purposes in schools and by the Goethe Institute), the GC confined itself to an abstract assessment of the mark and of the English expression to which the first part is assimilated by the German-speaking public, without examining all the relevant factors and conclusively reasoning the refusal (§ 50-54).

Freedom of expression, laid down in Article 11 of the Charter of Fundamental Rights of the European Union, must be taken into account when applying Article 7(1)(f) EUTMR (§ 56).

The relevance of the use of the sign and its perception by the relevant public must be taken into account to establish if the absolute ground for refusal under Article 7(1)(f) EUTMR precludes registration, and not with a view to disregarding that ground once its applicability to the case has been established (§ 70).

(ii) INFRINGEMENT OF THE PRINCIPLE OF EQUAL TREATMENT, (iii) INFRINGEMENT OF LEGAL CERTAINTY AND SOUND ADMINISTRATION. The

judgment must be set aside without any need to examine the other grounds of appeal (§ 58).

### FINAL JUDGMENT OF THE CJ

The Board of Appeal (BoA) decision contains largely the same errors in its interpretation and application of Article 7(1)(f) EUTMR as those that vitiate the GC judgment (§ 62-63).

All of the contextual factors consistently indicate that, despite the assimilation of the terms 'Fack ju' to the English phrase 'Fuck you', and taking into account that sensitivity in the mother tongue may be greater than in a foreign language, the title of the comedies was not perceived as morally unacceptable by the German-speaking public (§ 68).

No concrete evidence has been put forward to explain plausibly why the German-speaking public will perceive the word sign 'Fack Ju Göhte' as going against the fundamental moral values and standards of society when it is used as a trade mark (§ 69).

The relevance of the success of the eponymous comedies with the relevant public and the absence of controversy as regards their title must be taken into account to establish if the absolute ground for refusal under Article 7(1)(f) EUTMR precludes registration, and not with a view to disregarding that ground once its applicability has been established (§ 70).

The BoA decision must be annulled (§ 71).

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**04/03/2020, C 155/18 P to C 158/18 P, BURLINGTON /BURLINGTON ARCADE ET AL., EU:C:2020:151**

**RESULT:** Appeal well founded (GC decision entirely annulled and case settled by the CJ)

**KEYWORDS:** Detriment to earlier mark, Similarity of the goods and services

### FACTS:

The General Court (GC) rejected the appeal brought against the Board of Appeal's (BoA) decision.

As to the application of Article 8(5) EUTMR, the GC found that neither the repute of the earlier marks for retail services nor the risk of unfair advantage that the contested sign could take from the distinctive character or the repute of the earlier marks had been proven.

Regarding the opposition based on Article 8(4) EUTMR, the GC considered that the opponent had not provided any factual or legal material needed to prove that the conditions of that provision had been met.

Finally, as to the application of Article 8(1)(b) EUTMR, the GC found that the BoA was right in finding that the contested goods and services in Classes 3, 14 and 18 were dissimilar to the services in Class 35 covered by the earlier marks. If there was no statement that the goods could be sold in

the shops in the shopping arcade, no similarity or complementarity could be established between the goods and services covered by the marks.

The opponent appealed to the Court of Justice of the European Union (CJ), relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, (ii) infringement of Article 8(4) EUTMR, and (iii) infringement of Article 8(1)(b) EUTMR.

### Contested TMs



### Earlier TMs



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### SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE<sup>o</sup>8(5) EUTMR. Assuming that consumers will establish a link between the marks applied for and the earlier trade marks, the GC was right in examining first if there was a risk that the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. In finding no risk, the GC did not need to examine the existence of a link between the signs because the failure to meet one of the three conditions in Article 8(5) EUTMR precludes the application of that provision (§ 70).

The GC did not assess the evidence provided by the opponent for the criteria laid down in Article 8(5) EUTMR and therefore erred in law (§ 84).

The GC held that the opponent had not proved that the use of the marks applied for takes unfair advantage of the distinctive character or reputation of the earlier trade marks due to the lack of evidence showing that the use of the marks applied for would make the earlier marks less attractive (§ 79-80). However, the GC's reference to the possible reduction in the 'attractiveness' of the earlier mark cannot guarantee that the GC assessed if there was a risk of detriment. Furthermore, the finding that there was no risk of reduction of attractiveness cannot prove that there is no risk of unfair advantage (§ 81).

The GC's finding that the fact that other economic agents may be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the opponent's London arcade will not necessarily affect, in the eyes of the average consumer, the 'commercial attractiveness of that place' is not directly related to any of the types of detriment referred to in Article 8(5) EUTMR (§ 82-83).

(ii) INFRINGEMENT OF ARTICLE<sup>o</sup>8(4) EUTMR.

Right to be heard

The GC was right in considering that the BoA was correct not to request the parties to submit additional observations regarding this ground for opposition, since the opponent could submit any additional arguments or observations throughout the proceedings before the Office (§ 96-98).

Assessment of evidence

The opponent did not prove that the GC had distorted the facts or evidence submitted in support of the opposition based on Article 8(4) EUTMR (§ 103).

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

Application of the Praktiker judgment

The concept of 'retail services' covers services aimed at the consumer consisting, on behalf of the businesses occupying a shopping arcade's stores, in bringing together a variety of goods in a range of stores enabling the consumer to conveniently view and purchase those goods and in offering a variety of services separate from the act of sale, that seek to ensure that that consumer purchases the goods sold in those stores (§ 127).

The GC correctly considered that the CJ's interpretation of the Praktiker judgment does not support the assertion that the services provided by shopping arcades or shopping centres are, by definition, excluded from the scope of the concept of 'retail services' defined in Class 35 (§ 128) and that shopping arcade services are essentially limited to rental and real estate management services (§ 129).

Consequently, the GC was fully entitled to find that the concept of 'retail services' includes a shopping arcade's services aimed at the consumer with a view to enabling them to conveniently view and purchase those goods (§ 130).

The line of authority derived from the Praktiker judgment only concerns applications for registration and does not concern trade marks registered at the

date of that judgment's delivery. Since the earlier marks were registered before that date, they were not concerned by the obligation, arising from that judgment, to specify the goods or types of goods to which the retail services relate (§ 132-133).

It cannot be inferred from the considerations in the Praktiker judgment that, when an earlier trade mark covering retail services, registered after that judgment's delivery, is relied on in support of an opposition based on Article 8(1)(b) EUTMR, that ground may be rejected simply because of the absence of any precise statement of the goods to which the retail services relate (§ 134).

Therefore, the GC was wrong in considering that the lack of precise statements of the goods that may be sold in the shops in the shopping arcade precluded any association between those shops and the goods of the mark applied for (§ 137).

### FINAL JUDGMENT OF CJ.

The CJ can give the final judgment in this case according to Article 61 Statute CJEU (§ 138).

The BoA erred in law in adopting a restrictive definition of 'retail services' and in not taking into account the fact that the opponent provided such services and failed to characterise the facts correctly (§ 143-144).

The BoA decisions must be annulled (§ 145).

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

**05/02/2020, T 331/19, Représentation d'une tête de lion encerclée par des anneaux formant une chaîne (fig.), EU:T:2020:33**

**RESULT:** Action dismissed

**KEYWORDS:** Function of trade mark, Non-distinctive, Principle of legality, Shape of the product, Three dimensional mark

#### **FACTS:**

The applicant sought to register the figurative sign as an EUTM for goods in Classes 9, 14, 18, 25 and 26.

The Office refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR and Article 7(2) EUTMR in respect of goods in Class 14: boxes for cufflinks; cufflinks; silver and silver pleated cufflinks; gold cufflinks; precious metal cufflinks; precious stones encrusted precious stones; precious metals inlaid with precious metals; imitation gold cufflinks; porcelain cufflinks;.etc., and in Class 26: buttons; pressure buttons for duvets (fasteners);pressure buttons for footwear (fasteners); riveting buttons; blazer buttons of precious metal; shirt buttons; collar buttons; fashion badges (badges) for clothing; decorative buttons; fanciful buttons, of precious metal; clothes buttons; pressure buttons; pressure



buttons for clothing ;buttons; pressure buttons; clothing accessories.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the mark is purely figurative and devoid of any word element, as it corresponded to the representation of a lion's head surrounded by rings forming a chain. The image of a lion's head is not immediately memorable to the relevant public and the sign does not depart significantly from the norms and practices of either the buttons or the jewellery sector. Therefore, the mark could not serve to identify the origin of the product.

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

### EUTM Registrations



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### SUBSTANCE:

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

The GC recalls that the criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. Nevertheless, as consumers are not in the habit of making assumptions about the origin of goods based on their shape, it might be more difficult to establish distinctiveness (§ 21-22).

According to the case-law, only a mark which departs significantly from the norm or customs of the sector, and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character. This case-law, developed regarding 3D marks consisting of the appearance of the product itself, also applies to a figurative mark consisting of the two-dimensional representation of that product (§ 24-25).

The level of attention of the relevant public and the fact that the relevant public is specialised are not decisive factors for the assessment of the distinctive character of a sign. The sole fact that the relevant public is specialised would not necessarily lead to the acceptance of a weaker distinctive character of the sign (§ 31).

A large number of buttons, cufflinks and jewellery that bear the head of a lion are indisputably available on the market. The pattern, as well as its position surrounded by a chain, are not sufficiently far departed from the patterns frequently used for the production of buttons, cufflinks and jewellery. Therefore, the mark naturally comes to mind as a typical form of production of those goods (§ 35-36).

The GC concludes that the mark does not depart significantly from the norm or customs of the sector of the buttons in Classes 14 and 26 (§ 38).

The applicant claims that the mark is a fanciful and original graphic representation and is therefore distinctive. The GC states that the distinctive character of the sign does not derive from its alleged novelty or originality (§ 40). In this instance, the mark does not depart from the norm or customs of the sector, thus, it is not capable of indicating the origin of the goods (§ 41).

The applicant argues that the BoA erred in relying on the case-law relating to 3D marks when the mark at issue is a figurative mark whose pattern cannot be confused with the product. The GC rules that the mere possibility that a trade mark constitutes the whole or a part of the shape of the goods for which protection is claimed is sufficient to apply the case-law relating to signs, which are indissociable from the appearance of the goods, to figurative marks (§ 44-45).

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The applicant's argument claiming that the distinctive character of the mark has been acquired through use (the buttons bearing the mark are used on all Balmain clothing enabling consumers to identify the buttons with the Balmain mark) is rejected, since no plea based on Article 7(3) EUTMR was put forward (§ 50).

The Office's obligation to take previous decisions concerning similar applications into consideration when examining the application must be reconciled with respect for the principle of legality (§ 52-53). The examination of any application must be stringent and full, and conducted individually in each case. The question of the registration of the sign must be assessed solely based on the EUTMR and the case-law and not on previous BoA decisions (§ 54-55). Consequently, as the examination of the mark in light of that provision could not, in itself, lead to a different conclusion, the applicant's claims relating to the failure to take the registration of other marks into consideration cannot be upheld (§ 56).

**05/02/2020, T 332/19, Représentation d'une tête de lion encerclée par des anneaux formant une chaîne (fig.), EU:T:2020:34**

**RESULT:** Action dismissed

**KEYWORDS:** Function of trade mark, Non-distinctive, Principle of legality, Shape of the product, Three dimensional mark

**FACTS:**

The applicant sought to register the figurative sign as an EUTM for goods in Classes 9, 14, 18, 25 and 26.

The Office refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR and Article 7(2) EUTMR in respect of goods in Class 14: boxes for cufflinks; cufflinks; silver and silver pleated cufflinks; gold cufflinks; precious metal cufflinks; precious stones encrusted precious stones; precious metals inlaid with precious metals; imitation gold cufflinks; porcelain cufflinks;.etc., and in Class 26: buttons; pressure buttons for duvets (fasteners);pressure buttons for footwear (fasteners); riveting buttons; blazer buttons of precious metal; shirt buttons; collar buttons; fashion badges (badges) for clothing; decorative buttons; fanciful buttons, of precious metal; clothes buttons; pressure buttons; pressure buttons for clothing ;buttons; pressure buttons; clothing accessories.

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The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that the mark is purely figurative and devoid of any word element, as it corresponded to the representation of a lion's head surrounded by rings forming a chain. The image of a lion's head is not immediately memorable to the relevant public and the sign does not depart significantly from the norms and practices of either the buttons or the jewellery sector. Therefore, the mark could not serve to identify the origin of the product.

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

### EUTM Registrations



### SUBSTANCE:

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

The GC recalls that the criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. Nevertheless, as consumers are not in the habit of making assumptions about the origin of goods based on their shape, it might be more difficult to establish distinctiveness (§ 21-22).

According to the case-law, only a mark which departs significantly from the norms or customs of the sector, and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character. This case-law, developed for 3D marks consisting of the appearance of the product itself, also applies to a figurative mark consisting of the two-dimensional representation of that product (§ 24-25).

The level of attention of the relevant public and the fact that the relevant public is specialised are not decisive factors for the assessment of the distinctive character of a sign. The sole fact that the relevant public is specialised would not necessarily lead to the acceptance of a weaker distinctive character of the sign (§ 31).

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A large number of buttons, cufflinks and jewellery that bear the head of a lion are indisputably available on the market. The pattern, as well as its position surrounded by a chain, are not sufficiently far departed from the patterns frequently used for the production of buttons, cufflinks and jewellery. Therefore, the mark naturally comes to mind as a typical form of production of those goods (§ 35-36).

The GC concludes that the mark does not depart significantly from the norm or customs of the sector of the buttons in Classes 14 and 26 (§ 38).

The applicant claims that the mark is a fanciful and original graphic representation and is therefore distinctive. The GC states that the distinctive character of the sign does not derive from its alleged novelty or originality (§ 40). In this instance, the mark does not depart from the norm or customs of the sector, thus, it is not capable of indicating the origin of the goods (§ 41).

The applicant argues that the BoA erred in relying on the case-law relating to 3D marks when the mark at issue is a figurative mark whose pattern does not confuse with the product. The GC rules that the mere possibility that a trade mark constitutes the whole or a part of the shape of the goods for which protection is claimed is sufficient to apply the case-law relating to signs which are indissociable from the appearance of the goods to figurative marks (§

44-45).

The applicant's argument claiming that the distinctive character of the mark has been acquired through use (the buttons bearing the mark are used on all Balmain clothing enabling consumers to identify the buttons with the Balmain mark) is rejected since no plea based on Article 7(3) EUTMR was put forward (§ 50).

The Office's obligation to take previous decisions concerning similar applications into consideration when examining the application must be reconciled with respect for the principle of legality (§ 52-53). The examination of any application must be stringent and full, and conducted individually in each case. The question of the registration of the sign must be assessed solely based on the EUTMR and the case-law and not on previous BoA decisions (§ 54-55). Consequently, as the examination of the mark in light of that provision could not, in itself, lead to a different conclusion, the applicant's claims relating to the failure to take the registration of other marks into consideration cannot be upheld (§ 56).

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## Case law

05/02/2019, T 44/19; TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion

### FACTS:

The applicant sought to register the figurative sign TC Touring Club for services in Class 39. An opposition based on the earlier EU word mark TOURING CLUB ITALIANO, registered for services in Classes 16, 35, 39 and 41, namely tourist offices and travel agencies, including tourist information and assistance, escorting of travellers, arranging of cruises, arranging of tours, travel arrangement, sightseeing [tourism], was filed pursuant to Article 8(1)(b) EUTMR. At the applicant's request, the opponent furnished proof of genuine use of the earlier mark.

The Opposition Division (OD) rejected the opposition, finding that, inter alia, the opponent had failed to prove genuine use of the earlier mark.

The opponent appealed before the BoA and submitted additional evidence for proof of genuine use. The BoA annulled the OD's decision. It allowed some of the supplementary evidence and found that the evidence had proved genuine use of the earlier mark, at least for the following services: tourist offices and travel agencies, namely tourist



information and assistance, arranging of tours, travel arrangement, sightseeing [tourism]. It found that the services were identical, that the signs were visually similar to an average degree, phonetically similar to at least an average degree and very similar, if not identical, conceptually, and that the degree of distinctive character of the earlier mark was lower than average. It concluded that there was a likelihood of confusion (LOC) by the Italian public in the European Union.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 95(1) and (2) EUTMR, (ii) infringement of Article 47(2) EUTMR and (iii) infringement of Article 8(1)(b) EUTMR. The opponent filed a cross-claim that the GC rejected as inadmissible. The GC dismissed the action.

### EUTM application



### Earlier trade mark

TOURING CLUB ITALIANO

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### SUBSTANCE:

**INADMISSIBILITY OF THE CROSS-CLAIM.** If a BoA decision upholds the opponent's claims in their entirety, the opponent does not have standing to bring an action before the Court (14/07/2009, T 300/08, Golden Elephant Brand, EU:T:2009:275, § 27).

A BoA decision must be regarded as having upheld a party's claims when it has granted that party's application on the basis of one of the grounds for refusal or for invalidity of a mark or, more generally, of only part of that party's arguments, even if it did not examine, or if it rejected, the other grounds or arguments (25/09/2015, T 684/13, BLUECO / BLUECAR, EU:T:2015:699, § 28; 17/01/2019, T 671/17, TURBO-K / TURBO-K (fig.), EU:T:2019:13, § 91).

(i) INFRINGEMENT OF ARTICLE 95(1) AND (2) EUTMR. When evidence of use is produced within the time limit set by the Office, the production of supplementary evidence remains possible (21/07/2016, C 597/14 P, Bugui va (fig.) / BUGUI (fig.) et al., EU:C:2016:579, § 24-26) (§ 40). Article 95(2) EUTMR grants the Office broad discretion to decide, while giving reasons for its decision, whether or not to take such evidence into account (28/02/2018, C 418/16 P, mobile.de (fig.), EU:C:2018:128, § 49) (§ 38). The BoA correctly exercised its discretion (§ 45).

(ii) INFRINGEMENT OF ARTICLE 47(2) EUTMR. The BoA correctly found that the opponent had provided sufficient and conclusive evidence about the time, place, extent and nature of use of the earlier mark during the relevant period in the relevant territory, at least in connection with the services tourist offices and travel agencies, namely tourist information and assistance, arranging of tours, travel arrangement, sightseeing [tourism]. The addition of the figurative element does not alter the distinctive character of the earlier mark (§ 58, 62).

When a word mark is also a company name, it is possible for the company name to be used as a trade mark. However, there is use in relation to goods or services only where a third party affixes the sign constituting its company name to the goods that it markets, or where, even if the sign is not affixed, the third party uses that sign in such a way that a link is established between the sign that is the company name and the goods marketed or the services provided by the third party (§ 63). That condition was satisfied (§ 64-74).

(iii) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR. The relevant public consists both of the general public and of professionals in the European Union that display an average level of attention with regard to services connected with travel arrangements (§ 82, 87-88, 89). The BoA was justified in focusing its assessment on the Italian part of the relevant public (§ 84-85).

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The services are identical: the travel agency services covered by the mark applied for include all the services covered by the earlier mark for which use had been proved, namely tourist information and assistance, arranging of tours, travel arrangement [and] sightseeing [tourism] (not disputed) (§ 92-93).

The element 'touring club' is dominant in the signs despite its weak distinctive character. The element 'italiano' in the earlier mark is devoid of any distinctive character because it is purely descriptive. The figurative element of the mark applied for is small in size and difficult to remember or decipher (§ 97, 104).

The signs are visually similar to an average degree. The signs coincided in the word element 'touring club', but differed in the word element 'italiano' in the earlier mark and the figurative element in the mark applied for. In the BoA's view, the figurative element played a secondary role (§ 105).

The signs are phonetically similar to at least an average degree, since they coincide in the element 'touring club' and differ in the pronunciation of the element 'italiano' in the earlier mark and, if perceived by the relevant public, in the figurative element of two letters of the mark applied for (§ 109, 111-112).

Conceptually, both signs have the idea of a 'club for tours' in common, which arises from the common element 'touring club', that will be understood by at least part of the Italian-speaking public. Consequently, the degree of conceptual similarity is high, even though that similarity is the result of a weakly distinctive element (§ 114-115).

Global assessment of LOC. It had not been established that the earlier mark was particularly distinctive due to its intensive use or reputation. Its distinctiveness therefore rested on its distinctiveness per se (§ 118). As the earlier mark consists of the element 'touring club', which is weakly distinctive with regard to the services, and of the element 'italiano', which is directly descriptive, the distinctive character of the earlier mark is weak. However, there is LOC, even in a case involving an earlier mark with a weak distinctive character, since the services are identical and the signs are visually similar to an average degree, phonetically similar to at least an average degree, and conceptually similar to a high degree (§ 119-121).

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07/02/20, T 214/19, Fleximed / mediFlex, EU:T:2020:40

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion

### FACTS:

The EUTM proprietor registered the word mark Fleximed for goods in Class 10, namely orthopaedic articles, namely orthopaedic footwear, orthopaedic insoles and orthopaedic soles. An invalidity application was filed pursuant to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR, based on the earlier EU word mark mediFlex, registered for goods in Class 10, namely orthopaedic footwear; orthopaedic soles; supports for flat feet; boots for medical purposes; orthopaedic bandages.

The Cancellation Division (CD) upheld the invalidity application.

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that, due to the high degree of visual, phonetic and conceptual similarity of the signs, the average distinctive character of the earlier mark and the identity between the goods, there was a likelihood of confusion (LOC).

The EUTM proprietor filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 8(1)(b) EUTMR. The GC



dismissed the action as manifestly lacking any foundation in law.

### SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR. The relevant public is the German-speaking public in the European Union (§ 25).

The goods are identical (not disputed) (§ 27).

The signs are visually highly similar since they are composed of the identical elements, 'flex' and 'med', placed in reverse order around the common letter 'i' (§ 41-44). There is a high degree of phonetic similarity (§ 45-48). The signs are conceptually similar as a whole, as the common elements will be understood by the German-speaking public as an indication of the medical sector, on the one hand, with the concept of flexibility, on the other (§ 49).

Taking the identity between the goods into account and the high degree of visual and phonetical similarity between the signs, there is a LOC, at least for the relevant German-speaking public, despite the low inherent distinctive character of the earlier mark and the high level of attention of that public (§ 60).

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11/02/2020, T 487/18, ViruProtect,  
ECLI:EU:T:2020:44

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive, Lack of reasoning, Laudatory mark

### **FACTS:**

The applicant sought to register the word mark ViruProtect for goods in Class 5 such as pharmaceutical preparations, medical and veterinary preparations.

The examiner refused the application pursuant to Article 7(1)(b) and (c) CTMR, in conjunction with Article 7(2) CTMR, as descriptive and devoid of distinctive character.

The Board of Appeal (BoA) dismissed the appeal. The BoA found that the sign was purely descriptive in respect of the goods and devoid of distinctive character as the consumer would understand it as a simple advertising message that humans, animals or plants would be protected against viruses.

The applicant filed an action before the General Court, relying on three pleas in law: (i) infringement of the duty to state reasons, (ii) infringement of Article 7(1)(c) CTMR, infringement of Article 7(1)(b) CTMR, and (iii) infringement of Article 7(1)(b) and Article 7(2) CTMR.

### **SUBSTANCE:**

(i) INFRINGEMENT OF THE DUTY TO STATE REASONS. The statements of reasons for the contested decision are adequate. The BoA did not disregard its duty to state reasons (§ 15-20).

(ii) INFRINGEMENT OF ARTICLE 7(1)(c) AND (2) CTMR. The relevant public consists of the English-speaking public in the European Union, composed both of medical specialists and average consumers, who display an increased level of attention to Class 5 goods (not disputed) (§ 31).

The juxtaposition of the words 'Viru' and 'Protect' follows the grammar rules of the English language, despite the absence of the letter 's' (§ 7, 32-34). Furthermore, as all of the goods covered by the trade mark applied for are associated with the maintenance, strengthening or restoration of the health of humans, animals or plants, the sign directly describes the kind, nature and intended purpose of the goods. Therefore, the relevant public would attribute the meaning 'virus protection' to the trade mark applied for. Consequently, the sign is descriptive (§ 7, 37).

(iii) INFRINGEMENT OF ARTICLE 7(1)(b) AND (2) CTMR. Since one of the absolute grounds for refusal listed in Article 7(1) CTMR is sufficient to refuse an application, the second plea in law is not examined (§ 49-50).

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11/02/2020, T 732/18, charantea / CHARITÉ,  
EU:T:2020:43

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

**KEYWORDS:** Dissimilarity of signs, Identity of the goods and services, Likelihood of confusion, Scope of proceedings

### FACTS:

The EUTM applicant sought to register the word mark charantea for dietary supplements and dietetic preparations in Class 5.

An opposition, based on the earlier figurative EUTM for dietetic substances adapted for medical use in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division dismissed the opposition, not finding any likelihood of confusion (LOC).

The opponent appealed. The Board of Appeal (BoA) upheld the appeal. It found a LOC due to the identity of the goods, the average degree of visual similarity, the above-average degree of phonetic similarity, and the average degree of distinctiveness of the earlier mark.

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



### EUTM application (word)

charantea

### Earlier EUTM (fig.)

CHARITÉ

### SUBSTANCE:

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

Relevant public

The BoA may take only part of the relevant public in the EU into account insofar as it is sufficient to refuse a trade mark registration on a relative ground under Article 8(1)(b) EUTMR (§ 21).

Comparison of the goods

The contested goods and the opponent's goods are identical, even if the goods in Class 5 covered by the contested sign are not mentioned in the list of goods in Class 5 of the earlier mark. The former constitute a broad category including the latter (§ 29).

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### Visual similarity

The BoA was wrong in finding the signs visually similar to an average degree. The different dimension and position of the figurative elements in the signs, their stylisation, and the different length, due to two additional letters in the contested sign, determine a low degree of similarity, in spite of the common letter combinations 'CHAR' and 'TE' (§ 48).

### Phonetic similarity

The BoA was wrong in finding the signs phonetically similar to an above-average degree (§ 62). The number of syllables of the signs and the pronunciation of the second and last syllables are different (§ 59-60). Depending on how the combination 'CHAR' of the contested mark is pronounced, the phonetic similarity is non-existent or low (§ 61-62).

### Conceptual similarity

The BoA was right in finding a neutral conceptual similarity between the signs. The signs have no meaning for the majority of the German-speaking public (§ 69).

### LOC

The BoA was wrong in finding that there was a LOC (§ 82). Due to its high level of attention to health-



related goods, even though such products are not consumed regularly, the relevant public cannot believe that a commercial link exists between the two signs (§ 81).

### Power to issue directions and to alter decisions

The Court cannot issue instructions to the Office (§ 85) nor exercise the power to alter the decisions in this case since the BoA did not assess the claimed enhanced distinctiveness of the earlier mark (§ 88).

**11/02/2020, T 733/18, charantea / CHARITÉ, EU:T:2020:42**

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

**KEYWORDS:** Dissimilarity of signs, Identity of the goods and services, Likelihood of confusion, Scope of proceedings

### FACTS:

The EUTM applicant sought to register the figurative mark for food supplements in Class 5.

An opposition, based on the earlier figurative EUTM for dietetic substances adapted for medical use in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division dismissed the opposition, not finding any likelihood of confusion (LOC).

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The opponent appealed. The Board of Appeal (BoA) upheld the appeal. It found a LOC for the German-speaking public due to the identity of the goods, the average degree of visual similarity, the above-average degree of phonetic similarity, and the average degree of distinctiveness of the earlier mark.

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

### EUTM application (fig.)



### Earlier EUTM (fig.)



#### SUBSTANCE:

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

Relevant public

The BoA may take only part of the relevant public in the EU into account insofar as it is sufficient to



refuse a trade mark registration on a relative ground under Article 8(1)(b) EUTMR (§ 21).

Comparison of the goods

The contested goods and the opponent's goods are identical, even if the goods in Class 5 covered by the contested sign are not mentioned in the list of goods in Class 5 of the earlier mark. The former constitute a broad category including the latter (§ 29).

Visual similarity

The BoA was wrong in finding the signs visually similar to an average degree. The different figurative elements in the signs, their stylisation, and their different lengths, due to two additional letters in the contested sign, determine a low degree of similarity, in spite of the common letter combinations 'CHAR' and 'TE' (§ 51).

Phonetic similarity

The BoA was wrong in finding the signs phonetically similar to an above-average degree (§ 65). The number of syllables of the signs and the pronunciation of the second and last syllables are different (§§ 62-63). Depending on how the combination 'CHAR' of the contested mark is pronounced, the phonetic similarity is non-existent or low (§ 64-65).

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### Conceptual similarity

The BoA was right in finding a neutral conceptual similarity between the signs. The signs have no meaning for the majority of the German-speaking public (§ 72).

### LOC

The BoA was wrong in finding that there was a LOC (§ 85). Due to its high level of attention to health-related goods, even though such products are not consumed regularly, the relevant public cannot believe that a commercial link exists between the two signs (§ 84).

### Power to issue directions and to alter decisions

The Court cannot issue instructions to the Office (§ 88) nor exercise the power to alter the decisions in this case since the BoA did not assess the claimed enhanced distinctiveness of the earlier mark (§ 90).

**11/02/2020, T 262/19, FORM EINER TASSE (3D), EU:T:2020:41**

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

**KEYWORDS:** Admissibility, Entitlement to appeal, Ownership of IP right, Right of defence

### FACTS:

An EUTM application for the three-dimensional sign for goods in Classes 21, 30 and 32 was filed, indicating as applicant type 'society', name 'Jakober Rechtsanwälte', and legal form 'liberal profession'.

The applicant's information in the EUTM Register was later amended. The applicant's name became 'Philip M. Jakober, acting on behalf of Jakober Rechtsanwälte', and 'liberal profession' was replaced by 'natural person'.

The examiner rejected the registration pursuant to Article 7(1)(b) and Article 7(3) EUTMR.

An appeal was filed. The Board of Appeal (BoA) sent a communication stating, inter alia, that it had no information about the actual legal form of Jakober Rechtsanwälte and requiring Jakober Rechtsanwälte to submit evidence of its legal form. Jakober Rechtsanwälte replied that Jakober Rechtsanwälte was not a legal person but a self-employed freelancer, and, subsidiarily, asked the BoA to consider 'the natural person Mr. Philip Jakober' as the appellant.

The BoA considered the appeal inadmissible as the notice of appeal lacked the essential information required by Article 21(1)(a) EUTMDR and Article 2(1)(b) EUTMIR (official designation and legal form of the entity). Due to the denomination 'Jakober Rechtsanwälte', the appellant was considered as a

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legal person and not a 'self-employed freelancer', and the subsidiary request to consider 'the natural person Mr. Philip Jakober' as the appellant was rejected as inadmissible.

Philip Jakober filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 21(1)(a) EUTMDR in combination with Article 2(1)(b) EUTMIR. The GC upheld the action and annulled the BoA's decision.

### EUTM Application



#### SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE<sup>o</sup>21(1)(a) EUTMDR AND ARTICLE<sup>o</sup>2(1)(b) EUTMIR. The BoA had to take the appellant's status in the EUTM Register into account on the date on which the contested decision was delivered (§ 23).

The BoA was wrong in declaring the appeal inadmissible due to the appellant's failure to provide the information required by Article 21(1)(a) EUTMDR and Article 2(1)(b) EUTMIR. The appellant, as a natural person, provided his name and surname and remedied the deficiency raised by the BoA (§ 24-25).



By not granting the subsidiary request to consider 'the natural person Mr Philip Jakober' as the appellant, the BoA deprived the appellant of his right to appeal. The examiner's decision was addressed to the natural person 'Philip M. Jakober, acting on behalf of Jakober Rechtsanwälte' and the appellant declared himself to be a natural person (§ 27).

**27/02/2020, T 159/19, Furniture, EU:T:2020:77**

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

**KEYWORDS:** Disclosure within the EU, Promotional material

#### FACTS:

An application for a declaration of invalidity of the Community design (CD) was filed pursuant to Article 52 CDR in combination with Article 25(1)(b) CDR. The Invalidity Division upheld the application, finding that the contested design lacked the individual character required by Article 6 CDR.

The CD applicant appealed. The Board of Appeal (BoA) upheld the appeal, finding that the earlier design had not been made available to the public.

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

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### CD application



### Earlier CD



The disclosure of an earlier design cannot be proven by means of probabilities or presumptions, it must be demonstrated by solid and objective evidence of actual disclosure of the earlier design on the market. In addition, the items of evidence provided by the applicant for a declaration of invalidity must be assessed in relation to each other. Although some of these items of evidence might be insufficient on their own, when combined or read in conjunction with other documents or information, they may contribute to establishing disclosure (§ 22).

The evidence submitted by the applicant (that is, a catalogue extract, an invoice for the printing of 25 000 catalogues, and three invoices related to sales of furniture with the confirmations of receipt), assessed in relation to each other, proves the disclosure of the earlier design before the date of filing of the contested design (§ 39).

The invoice referring to the product code for the item of furniture to which the earlier design had been applied shows, in particular, that the earlier design was used in trade, that is, an event constituting disclosure (§ 35-36). The extract from the catalogue is insufficient on its own but, in conjunction with the other items of evidence, contributes to establishing disclosure (§ 33).

Since the invalidity applicant had proved the veracity of those events, the BoA should have presumed that the earlier design had been made available to the

#### SUBSTANCE:

(i) ADMISSIBILITY. The action is admissible since it is brought by a party to proceedings before the BoA (§ 15).

(ii) INFRINGEMENT OF ARTICLE 7(1) CDR.

Disclosure of the earlier design

The BoA erred in finding that the earlier design had not been made available to the public (§ 42).

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public and assessed if the events constituting the disclosure were not known to the specialised circles of the sector concerned, as alleged by the CD holder (§ 39-41).

### Power to alter decisions

The Court cannot alter the BoA decision, as the BoA failed to assess the plausibility of the knowledge of the events constituting disclosure among the specialised circles of the sector concerned or the CD's individual character (§ 46).

**27/02/2020, T 202/19, Caratour / Carado et al., EU:T:2020:75**

**RESULT:** Action dismissed

**KEYWORDS:** Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

### FACTS:

The applicant sought to register the word mark CaraTour for goods in Classes 12 and 39. An opposition, based on the earlier EU word mark and the earlier German mark Carado, registered for goods and services in Classes 12, 22 and 39, was filed pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) partially upheld the opposition. It found that there was a likelihood of confusion (LOC) for the following goods in Class 12: camper vans, mobile homes and motor caravans, caravans, spare parts and fittings therefor (included in Class 12); car accessories, namely trailer couplings, luggage racks, ski racks, mudguards, snow chains, wind deflectors, head rests, safety belts; bicycle accessories, namely dress guards for bicycles, luggage carriers for bicycles, bells, air pumps; vehicle trailers, including multipurpose crossover leisure trailers.

The applicant appealed. The Board of Appeal (BoA) dismissed the appeal, confirming that use was proven for motor caravans, caravans, and spare parts therefor in Class 12 and the LOC with the earlier EUTM.

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.

### SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR. The relevant public consists of both the general public and a specialist public of the European Union, namely owners and retailers with an increased level of attention (not disputed) (§ 27-30).

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The goods are partly identical and partly similar (§ 36-42). In particular, accessories are parts intended to supplement a main object and fall under the broader category of parts. The accessories covered by the trade mark applied for are intended for vehicles, including motor caravans, caravans and spare parts therefor, for which the earlier trade mark was registered (§ 37).

The opposing signs have a high degree of visual similarity since they both consist of a single word and coincide in the first four letters (§ 46-56). The signs also have a high degree of phonetic similarity because of their identical syllabic structure and rhythm (§ 57-64).

As the signs as a whole have no meaning in any EU language, the conceptual comparison is neutral (§ 65, 69-70, 73).

Taking into account the average distinctive character of the earlier trade mark (not disputed) and the high degree of visual and phonetic similarity of the opposing signs, there is a LOC despite the increased level of attention of the relevant public (§ 78, 80, 87).

**27/02/2020, T 203/19; Caratwo / Carado et al., EU:T:2020:76**

**RESULT:** Action dismissed

**KEYWORDS:** Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

**FACTS:**

The applicant sought to register the word mark CaraTwo for goods in Classes 12, 37 and 39. An opposition based on the earlier EU word mark and the earlier German mark Carado, registered for goods and services in Classes 12, 22 and 39, was filed pursuant to Article 8(1)(b) EUTMR.

The Opposition Division (OD) partially upheld the opposition. It found that there was a likelihood of confusion (LOC) for vehicles; camper vans, mobile homes and motor caravans, caravans, spare parts and fittings therefor (included in Class 12); apparatus for locomotion by land, air or water; car accessories, namely trailer couplings, luggage racks, ski racks, mudguards, snow chains, wind deflectors, head rests, safety belts; safety seats for infants; bicycle accessories, namely dress guards for bicycles, luggage carriers for bicycles, bells, air pumps; vehicle trailers, including multipurpose crossover leisure trailers in Class 12, and vehicle repair, in particular for caravans and motor caravans; repair, maintenance, serving, installation,

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namely of caravans and motor homes; washing of vehicles, in particular caravans and motor caravans in Class 37.

The applicant appealed. The Board of Appeal (BoA) dismissed the appeal, confirming that use was proven for motor caravans, caravans, and spare parts therefor in Class 12 and the LOC with the earlier EUTM.

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.

### **SUBSTANCE:**

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR. The relevant public consists of both the general public and a specialist public of the European Union, namely owners and retailers with an increased level of attention (not disputed) (§ 27-30).

The goods are partly identical and partly similar (§ 36-44). In particular, accessories are parts intended to supplement a main object and fall under the broader category of parts. The accessories covered by the trade mark applied for are intended for vehicles, including motor caravans and caravans, and spare parts therefor, for which the earlier trade mark was registered (§ 37).

The opposing signs have a high degree of visual similarity since they both consist of a single word, almost identical in length, and coincide in the first four letters and their last letter (§ 56-62). The signs also have a high degree of phonetic similarity because of their identical syllabic structure and rhythm (§ 63-70).

As the signs as a whole have no meaning in any EU language, the conceptual comparison is neutral (§ 75, 79).

Taking into account the average distinctive character of the earlier trade mark (not disputed) and the high degree of visual and phonetic similarity of the opposing signs, there is a LOC despite the increased level of attention of the relevant public (§ 84, 88-89).

**05/03/2020, T 688/18, CORNEREYE / BACKEYE et al., EU:T:2020:80**

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

**KEYWORDS:** Conceptual dissimilarity, Descriptive element, Dissimilarity of signs, Likelihood of confusion

### **FACTS:**

The EUTM applicant sought to register the word mark CORNEREYE for cameras; monitors; apparatus for the recording and reproduction of images; data processing apparatus in Class 9.

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An opposition, based on the earlier EUTM word mark **BACKEYE**, for closed circuit television apparatus including television cameras and television monitors, all for mounting on vehicles or mobile apparatus in Class 9, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division upheld the opposition, finding a likelihood of confusion (LOC).

The EUTM applicant appealed. The Board of Appeal (BoA) dismissed the appeal finding that the elements 'eye' and 'corner' alluded to the goods. It also found a LOC. The goods were identical and the degree of visual and phonetic similarity between the signs was considered to be low to average. The signs were conceptually similar to an average degree, while the earlier mark had a high degree of distinctiveness due to its extensive use, in particular in the United Kingdom.

The EUTM applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 95(1) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR.

### **SUBSTANCE:**

(i) **INFRINGEMENT OF ARTICLE<sup>o</sup>95(1) EUTMR.** The applicant's arguments seek solely to establish that the BoA did not correctly assess the evidence of use of the earlier mark. Therefore, they are ineffective in the context of the first plea, the purpose of which is to establish infringement of the principle, laid down

in Article 95(1) EUTMR, that the Office is to examine the facts of its own motion (§ 26).

The BoA referred to the reputation of other marks belonging to the opponent that are different from the earlier mark, only for the sake of completeness. This fact does not affect the BoA finding relating to the high degree of distinctiveness of the earlier mark and the existence of a LOC (§ 27-28).

(ii) **INFRINGEMENT OF ARTICLE<sup>o</sup>8(1)(b) EUTMR.**

Comparison of signs

The relevant public, composed of the general public in the EU and professionals with an average to high degree of attention (§ 11), will perceive the signs as the juxtaposition in one word of two inherently weak elements, each of which is descriptive, or at least evocative, of the essential characteristics of the goods concerned (§ 54).

Visually and phonetically, the signs coincide in the final element 'eye', but differ in the first element, 'back' and 'corner' respectively (§ 55), which normally has a greater visual impact (§ 56). The terms 'back' and 'corner' do not convey the same concept, even though they can both refer to the position of a camera on a vehicle or to the concept of field of vision (§ 57).

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The element 'eye' will be perceived as referring directly and specifically to the function and, therefore, as being descriptive of an essential characteristic, of the goods (§ 66). Therefore, the mere presence of the descriptive element 'eye' in both signs cannot automatically imply that the signs are visually, phonetically, or conceptually similar (§ 67).

The BoA was wrong in its assessment. It should have found that the signs were visually, phonetically, and conceptually dissimilar, and that each element of the signs, considered separately, and as a whole, was descriptive of the goods or of their characteristics (§ 69).

### Overall assessment

The BoA was wrong in finding a LOC in view of the descriptiveness of the common element 'eye', its position at the end of the signs and the lack of visual and phonetic similarity between the signs (which cannot be offset by any degree of conceptual similarity since the elements 'back' and 'corner' have different meanings), even if the earlier mark was considered to have enhanced distinctiveness acquired through use (§ 82-83).

**05/03/2020, T 80/19, DECOPAC, EU:T:2020:81**

**RESULT:** Action dismissed

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

### **FACTS:**

The proprietor registered the word mark DECOPAC as an EUTM for goods and services in Classes 29, 30 and 35.

An application for revocation was filed pursuant to Article 51(1)(a) CTMR. The proprietor provided evidence seeking to prove genuine use of the contested mark. The Cancellation Division (CD) upheld the revocation application and declared the trade mark to be revoked on the ground of lack of genuine use.

The proprietor appealed and submitted further evidence for proof of genuine use. At the BoA's request, the proprietor provided, by letter dated 20 September 2018, a correlation table showing the link between the goods on invoices, catalogue excerpts, samples of instruction cards and photographs of packaging, inter alia.

The BoA partially upheld the appeal, annulling the CD's decision insofar as it revoked the contested EUTM in respect of goods in Class 30, namely edible and inedible decorations for cakes and pastries. It found that the proprietor had furnished proof

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of genuine use in respect of those goods for the relevant period.

The applicant for revocation filed an action before the General Court (GC), relying on two pleas: (i) infringement of the right to be heard, and (ii) lack of genuine use of the contested mark. The GC dismissed the action.

### **SUBSTANCE:**

(i) ALLEGED INFRINGEMENT OF THE RIGHT TO BE HEARD. Article 88(4) CTMR, read in conjunction with Rule 88(c) CTMIR, concerns the non-disclosure of certain documents or items of business information considered to be confidential vis-à-vis third parties and not vis-à-vis parties to proceedings before the Office. As all the documents were notified to the other parties, there is no infringement of the right to be heard (§ 27-28).

The Office's decisions are to be based only on reasons or evidence upon which the parties concerned have had an opportunity to present their comments (Article 75 CTMR and Article 63(2) CTMR) (§ 33-34). However, the proprietor's letter of 20 September 2018 and the attached table, on which the other party did not have the possibility to present its observations, do not contain any new items of evidence. They only contain explanations to show the link between the items of evidence already in the file (§ 37). Furthermore, the BoA

itself could have established the links between the various items of evidence (§ 38). Consequently, the applicant for revocation could present its comments on all the matters of fact and of law that form the basis of the contested decision, including all the evidence in the Office's case file. The observations of 20 September 2018 are not decisive for the outcome of the proceedings (§ 39).

(ii) ALLEGED LACK OF GENUINE USE OF THE CONTESTED MARK. The invoices and other evidence prove use of the contested mark, which is objectively such as to create or preserve an outlet. The commercial volume, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark (§ 51-56).

As regards use of the sign both as a company name and as a trade mark, the visual arrangement of the invoices highlights the contested mark. It consistently appears in the middle of the heading in the form of a logo in bold white upper-case letters on a black band with the symbol ® at the bottom on the right-hand side, as the first element, next to a reference to the company name 'DECOPAC, INC.' in normal letters. The other marks, inter alia, DecoPic, DecoPics and DecoSet, that cover some of the goods marketed under the contested mark and reflect the details of those goods, appear opposite the invoiced price. This arrangement confirms that

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the use made of the sign DECOPAC goes beyond the mere identification of the company. It also indicates, as a trade mark, the commercial origin of the goods supplied. The arrangement of the invoices therefore enables a close link to be established between the sign DECOPAC and the invoiced goods (§ 64).

Genuine use of an EUTM does not relate solely to its use vis-à-vis end consumers, but also to its use vis-à-vis professionals or intermediaries. Outward genuine use has been proved to the requisite legal standard (§ 70, 71, 74).

The evidence provided shows genuine use of the contested mark in the European Union in connection with the goods edible and inedible decorations for cakes and pastries in Class 30 (§ 81).

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### New Decisions from the Grand Board

02/03/2020, R 1499/16-G, LA IRLANDESA 1943 (fig.)

EUTM



**Bad faith - Complementary evidence - Deceptive element - Dominant element - Figurative trade mark - New submission on appeal - Article 7(1)(g) EUTMR - Article 59(1)(a) EUTMR - Article 59(1)(b) EUTMR - Article 71(1) EUTMR - Article 27(4) EUTMR - Decision annulled - EUTM cancelled**

The decision concerns an application for a declaration of invalidity as regards the trade mark 'LA IRLANDESA' because of its deceptiveness and bad faith.

Firstly, the EUTM is declared invalid on the grounds of it being deceptive within the meaning of Article 7(1)(g) EUTMR. The dominant word elements 'LA IRLANDESA' establish a geographical link to Ireland. Used on the goods at issue in Class 29, 'LA IRLANDESA' will be understood by relevant Spanish-speaking consumers as an indication that



these products are of Irish origin. It has however been proven by the invalidity applicants that the goods are not of Irish origin. The serious risk that consumers would believe that the goods bearing the mark were of Irish origin, when in fact they were not, was already present at the time of filing the EUTM application.

Secondly, the EUTM is declared invalid on the grounds that it was filed in bad faith. The objective circumstances of the case lead to this conclusion, namely, the use, in a deceptive manner, of the contested mark by its proprietor, the many previous EUIPO and Spanish Court decisions establishing other 'LA IRLANDESA' marks as being deceptive, and the previous business relationship with one of the (Irish) invalidity applicants. These factors lead to the conclusion that it was the EUTM proprietor's intention to take advantage of the image of Irish products, even though its products were not of Irish origin.

11/02/2020, R 2445/17-G, Sandra Pabst

**Bad faith - Legal certainty - Proof of use - Article 58(1)(a) EUTMR - Article 107 EUTMR - Decision confirmed - Cancellation rejected**

The Grand Board confirmed the decision of the Cancellation Division, namely that the revocation request had been filed as an abuse of rights and process.

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These findings were reached taking into account the number of revocation requests (37) filed against the same company practically simultaneously, together with the attempt to acquire one of those trade marks (exerting disproportionate pressure on the EUTM proprietor which was done in a retaliatory manner), the nature of the company which filed the revocation request and the number of other cases launched by the same or economically linked companies, concerning their hundreds of revocation actions and thousands of trade mark filings and trade name registrations.

### New Decisions from the Boards of Appeal

[11/03/2020, R 1364/2019-2, Ism ATEX INERIS EX Installation Service Maintenance \(fig.\)](#)

#### EUTM application



**Certification mark - Decision confirmed - Application rejected.**

The Board confirms the refusal of the EU certification mark since the deficiencies in the

regulations governing the use of the mark have not been remedied. The information, mentioned in the regulations of use required by Article 17 EUTMIR, is compulsory.

Unlike the examiner, the Board finds that the representation of the mark in colour and in black and white in the annex of the regulation of use, indicating how the mark should be used in commerce, is not contrary to Article 17(c) EUTMIR. However, the Board confirms that the conditions required by Article 17(d), (e), (f), (g) EUTMIR have not been fulfilled. In particular, as to the characteristics of the services to be certified, the fact that the applicant certifies that the services offered in Class 37 are carried out by persons trained and certified by the applicant itself does not guarantee an objective quality to the services. As to the evaluation, training and audit services applied for, the certification mark is contrary to Article 83(2) EUTMR.

[02/03/2020, R 1161/2019-4, POSITION OF A GREEN BAND ON SPRAY PAINT GUN](#)

**Position mark - Non-distinctive - Decision confirmed - Application rejected.**

The examiner refused the sign intended for 'paint spray guns' because it would be perceived either as a banal decorative element or as functioning as a connector ring rather than as an indication of commercial origin. The position mark applied for lacked distinctive character and was refused in

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accordance with Article 7(1)(b) EUTMR.

### EUTM application



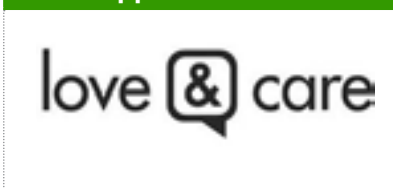
The Board considers that the sign merely combines a basic geometric shape corresponding to a band with a green colour. There are no eye-catching features which may allow the relevant public to immediately perceive the contested sign as an indicator of the commercial origin of the claimed goods, even assuming a higher degree of attention paid by part of relevant consumers.

In addition the 'particular' position of the sign applied for, which is located at the rear part of the air cap ring in a paint spray gun, that extends around the circumference, does not endow the contested sign with any distinctive character either. In fact, it could have been positioned in any other place on the spray gun with the same result, namely, that even an attentive consumer would perceive this element as being purely decorative or even as having a certain functionality.



11/03/2020, R 1096/2019-1, love & care (fig.)

### EUTM application



**Slogan mark - Non-distinctive - Decision confirmed - Application rejected.**

The sign applied for is to be rejected because it is a banal slogan which merely aims to promote the specified goods in Class 5 'food for infants; infants formula' by appealing to the relevant consumer's strongest innate feelings towards infants.

The Board finds that both of the word elements 'love' and 'care' are basic English terms commonly used in trade for goods and services addressed to parents of infants, in particular in the field of infant nutrition. Indeed, they refer to the more powerful and innate feelings of a parent towards his or her infant. In this sense, the sign 'Love and care' conveys the idea that these goods were prepared by the producer with love and care, in accordance with highest quality standards and with all the elements that loving and caring parents would wish to provide to their infants.

Moreover, in the context of commercial communications, the banal framing of the

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ampersand symbol '&' in a dialogue box, would, at most, be perceived as a means to stress the importance of the second element 'care' of the merely promotional expression 'love AND care' coupled with an indication that the applicant would provide further help and advice through an online chat application.

[24/02/2020, R 1991/2019-4, Neo](#)

### **Word mark - Laudatory mark - Non-distinctive - Decision Confirmed - Application rejected.**

The registration of the sign 'NEO' for goods and services in Classes 9 and 38 is refused pursuant to Article 7(1)(b) and (c), combined with Article 7(1)(c), EUTMR on the premise that the sign was descriptive and would be perceived by Greek and Cypriot consumers as a descriptive message for the goods and services at hand such as 'communication equipment' and 'telecommunications'.

The Boards confirms that the sign applied for is the Latin transcription of the Greek word 'neo', in modern Greek written as νεο or νεος. 'NEO' would be understood by the aforementioned consumers as something new or innovative. Furthermore, the Board notes that although the word 'NEO' derives from Greek, nowadays it is understood with the meaning of 'new' in many more languages. Regarding the goods in Class 9, namely 'communications equipment, communication devices etc.' the



mark applied for indicates that the goods are either new or innovative in terms of technology. As such, the sign is considered descriptive. The same reasoning applies to the services in Class 38 namely 'telecommunications, telephone and telecommunications services'. Furthermore, the Board indicates that the promotional character of the mark applied for is devoid of any distinctive character based on Article 7(1)(b) EUTMR. As a result, on the basis that the sign 'NEO' will be perceived by the relevant consumer as advertising information on the positive qualities of the goods and services applied for, the trade mark applied for acts as a promotional message and not as an indication of commercial origin.

[24/02/2020, R 2392/2018-1, ORANGE \(fig.\)](#)

### **EUTM application**



### **Figurative mark - Colour Mark - Right of Defence - Article 49(2) EUTMR - Decision Annulled - No Decision on Cancellation.**

The applicant sought to register the figurative mark for several goods in Classes 32 and 33 while claiming the colour orange per se. Even after limiting

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the goods to 'champagne wines' in Class 33, the examiner refused the trade mark application on the basis of Article 7(1)(b) EUTMR. However, the Board annulled the examiner's decision, while remitting the case back to the examiner for further prosecution. After the publication of the sign as a figurative mark, a third party filed an application for a declaration of invalidity based on Article 52(1)(a) and Article 7(1)(b) EUTMR which was rejected by the Cancellation Division referring to the previous decision of the Second Board (20/11/2002, R 246/2000-2, (colour orange) (fig.)), where both parties had agreed that the mark applied for was a colour per se mark which was also recognised in the decision.

The Board notes that the type of mark cannot be agreed upon by the two parties nor is the present Board bound by the previous Board's or the Cancellation Division's decisions. Firstly, the indication of the type of mark by the applicant should be clear and precise in the application. In the case at hand, the mark was applied for as a figurative mark while claiming the colour orange. Moreover, the applicant repeatedly referred to the mark as a figurative one and never tried to amend the application on the basis of Article 49(2) EUTMR. Hence, the mark remains registered as being figurative and not as a colour mark. Furthermore, according to case-law, the reclassification of a mark would substantially affect the mark itself, in relation to the analysis of its distinctive character. In order to allow the parties to defend their arguments on

the present interpretation, the Board notes that it is appropriate for the case to be remitted to the Cancellation Division for further examination. As such, the contested decision is annulled and remitted to the Cancellation Division.

**03/03/2020, R 1115/2019-4, Bucocalma / Mucocalm**

**Word Mark - Conceptual Similarity - Likelihood of Confusion - Decision Confirmed -Opposition Allowed.**

The opposition based on Article 8(1)(b) EUTMR was upheld in its entirety, namely for goods in Class 5, specifically pharmaceuticals, hence the applicant's trade mark applied for was rejected. With the exception of their first letters, the contested sign identically reproduced the earlier sign, resulting in a likelihood of confusion between the two marks.

The Board confirms the contested decision. The comparison between the two marks and the overall impression given by them, is considered from the perception of the Dutch-speaking public. Visually, the marks are similar to an average degree since the contested sign reproduces seven out of the eight letters composing the earlier mark. The different initial letters and the additional last letter 'A' of the contested mark are not sufficient to outweigh the marks' visual similarities. Phonetically, their similar lengths and the identical pronunciation

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of 'UCOCALM', result in an average degree of similarity. The Board notes that the differences in the initial and last letters cannot change their aural similarities. Conceptually, neither of the signs has a clear meaning.

The Dutch public will only perceive the sequence 'CALM(A)' in both word marks as something to 'reduce pain' while 'BUCO' or 'MUCO' will only be perceived, by the professional public in the medical sector, as something relating to the mouth cavity. As such, the conceptual similarity between the marks is neutral. In light of the above, the Board confirms that based on the similar overall impressions produced by the two signs and bearing in mind the earlier mark's normal level of inherent distinctiveness, there is likelihood of confusion.

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