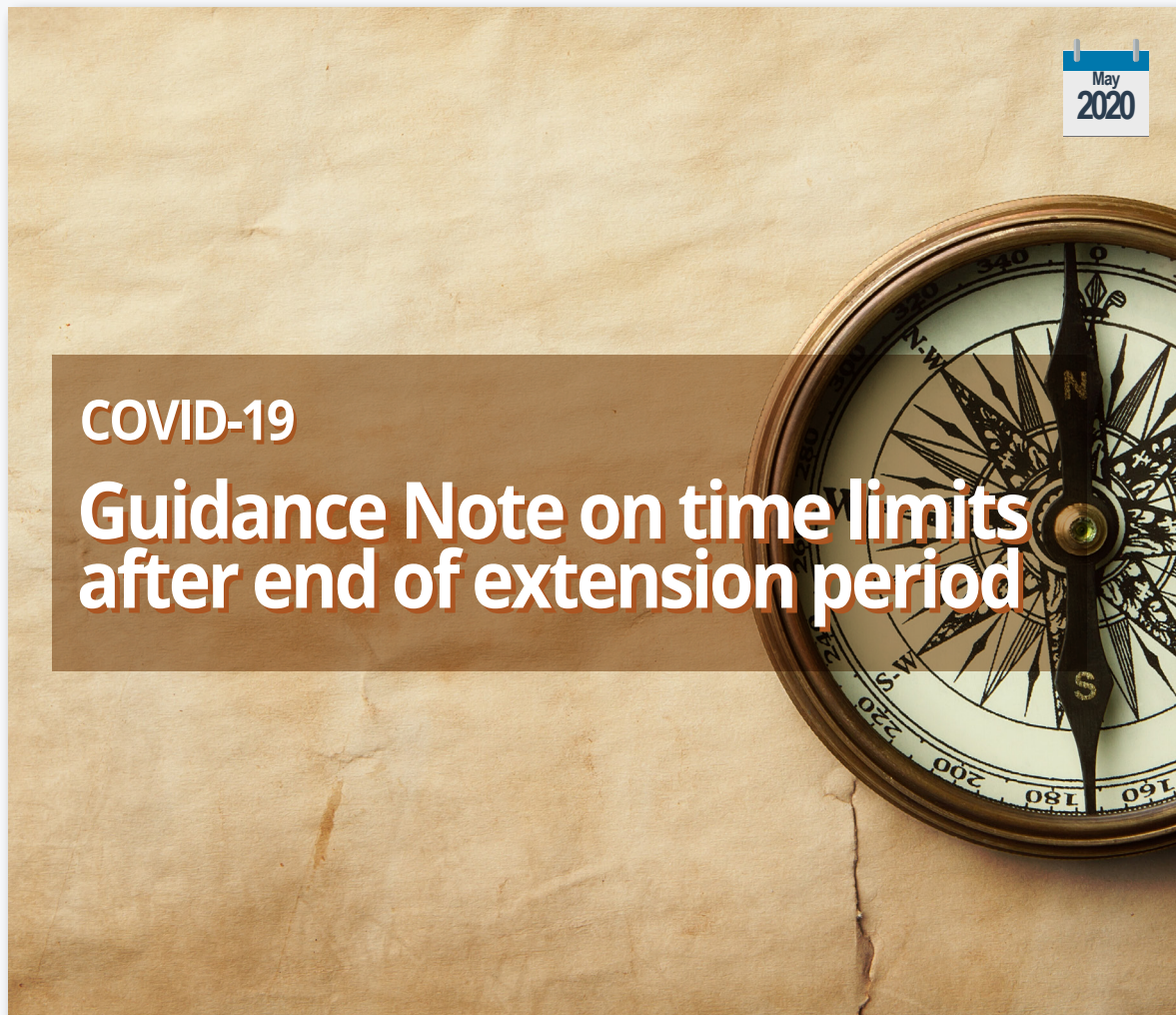


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COVID-19 – Guidance Note on time limits after end of extension period

As a response to the exceptional circumstances created by the COVID-19 outbreak, the Executive Director of the EUIPO issued [Decision No EX-20-3](#) and the consequent [Decision No EX-20-4](#), both of which concern extension of time limits in proceedings before the Office.

As of 18 May 2020, those extensions come to an end. It is possible that some users may still face difficulties due to the COVID-19 outbreak. To provide them with further guidance on the usual means of dealing with time limits provided for in the applicable Regulations (EUTMR, EUTMDR, EUTMIR, CDR, CDIR), the following clarifications are issued.

AVAILABLE REMEDIES

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. Compliance with them is necessary to ensure clarity and legal certainty. The procedural instruments listed below mitigate the rigorous application of the principle of strict observance of time limits and are available upon request by the parties of proceedings before the Office.



I. EXTENSION OF TIME LIMITS (Article 68 EUTMDR and Article 57 CDIR)

The time limits laid down directly by the Regulations are mandatory and cannot be extended at the request of the parties (although for some exceptions to this rule, please see section IV Restitutio In Integrum below). However, time limits determined by the Office in ongoing proceedings can be extended under certain circumstances. Upon receipt of a reasoned request, the Office may grant an extension of a time limit it has set. The request must be submitted by a party to the proceedings and before the time limit in question expires. An extension can be granted in:

- ex parte proceedings (i.e. where one party is involved, such as in the examination of the classification or absolute grounds for refusal of a European Union trade mark application). An extension may be granted upon request of the party, depending on the circumstances of the case. The extension cannot exceed six months for any given request. The first request for an extension will be considered appropriate without a detailed justification. However, this does not prevent parties from asking for an additional extension if exceptional circumstances warrant it.
- inter partes proceedings (i.e. where there are two or more parties involved, such as in opposition, invalidity and revocation

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proceedings). In these types of proceedings the first request for an extension will be considered appropriate without a detailed justification and will be granted for a period one to up to six months. Second and subsequent extensions of the same time limit, for a period of up to six months for each extension, can be granted if the party requesting it can explain the presence of exceptional circumstances that prevent it from observing the time limit. The Office may subject the extension of a time limit to the agreement of the other party.

Difficulties arising from measures taken by public authorities against the pandemic caused by the COVID-19 outbreak or instances of sickness of the party or its representative for the same reason do constitute exceptional circumstances that will be considered appropriate by the Office for granting second and subsequent extensions of the same time limit.

II. SUSPENSION OF PROCEEDINGS (Article 71 EUTMR)

Where inter partes proceedings have been suspended, the proceedings are stayed, and no procedural steps are taken (except, where applicable, for the payment of fees). A suspension can be granted:

- **At the reasoned request of one of the parties**, where the suspension is appropriate under the circumstances of the case. Before



granting the suspension, the Office will take into account the interest of all the parties and the stage of the proceedings.

• **By joint request of the parties in:**

- Trade mark proceedings, for periods which will not exceed six months. That suspension may be extended upon a request of both parties up to a total maximum of two years.
- Design invalidity proceedings, for periods of six months regardless of the period requested by the parties.

Furthermore, difficulties arising from measures taken by public authorities against the pandemic or instances of sickness of the party or its representative may constitute appropriate circumstances for requesting a suspension. In addition, financial difficulties preventing the party from obtaining or securing continued professional representation before the Office (within the meaning of Articles 119 and 120 EUTMR, and Articles 77 and 78 CDR) that are caused by the pandemic situation may also constitute a proper reason for granting a suspension.

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III. CONTINUATION OF PROCEEDINGS (Article 105 EUTMR)

Any party in **trade mark proceedings** before the Office that has **missed a time limit** can seek continuation of proceedings, even without giving an explanation or justification. This is however not available in design proceedings. In order to exercise the right to continuation of proceedings, the party must:

- submit a **request within two months** of the expiry of the unobserved time limit;
- carry out **the omitted act** by the time the request is made; and
- pay a **fee of (EUR 400)**.

Once a request for continuation of proceedings has been granted, the time limit is deemed to be observed and the consequences of having failed to meet the time limit will be deemed not to have occurred.

Continuation of proceedings may be requested, for instance, for all the time limits in opposition proceedings, other than the ones for filing an opposition and paying the applicable fee, such as the time limits under Article 146(7) EUTMR to translate the notice of opposition and under Article 10(2) EUTMDR for submitting proof of use, as well as all the time limits that apply in proceedings for revocation or declaration of invalidity.

Continuation of proceedings is not applicable to certain time limits, specified in Article 105(2) EUTMR, namely:

- the time limits for requesting restitutio in integrum and paying the fee (Article 104 EUTMR) and the time limits for continuation of proceedings itself (Article 105(1) EUTMR);
- the period of three months within which conversion must be requested and the conversion fee paid (Article 139 EUTMR);
- the time limit for filing an opposition and paying the fee (Article 46(1) and (3) EUTMR);
- the time limits laid down in Article 32 EUTMR (payment of the application fee), Article 34(1) EUTMR (right of priority), Article 38(1) EUTMR (right of exhibition priority), Article 41(2) EUTMR (period to remedy filing deficiencies), Article 53(3) EUTMR (period for renewal), Article 68 EUTMR (appeal) and Article 72(5) EUTMR (appeal before the Court of Justice); and
- the time limits for claiming, after the application has been filed, seniority within the meaning of Article 39 EUTMR.

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IV. RESTITUTIO IN INTEGRUM (Article 104 EUTMR and Article 67 CDR)

The remedy of reinstatement of rights, also called restitutio in integrum, allows a party to proceedings before the Office to be reinstated in its rights, when:

- it has **missed a time limit** to perform a procedural act;
- the time limit was missed despite it **taking all due care** required by the circumstances; and
- the non-observance (of the time limit) by the party has the direct consequence of causing the **loss of a right or means of redress**.

In order to exercise the right to restitutio in integrum, the party must:

- submit a **request within two months of the removal of the cause of non-compliance** and no later than **one year** after expiry of the missed time limit. In this context:
- The date when the cause of non-compliance is removed is the first date on which the party knew or should have known about the facts that led to the non-observance of the time limit. If the ground for non-compliance was the absence or illness of the party or the professional representative dealing with the case, the date on which the



cause of non-compliance is removed is the date on which the representative returns to work.

- However, if the omitted act is a request for renewal of an EU trade mark registration or a Community design, or payment of the renewal fees (Article 53(3) EUTMR and Article 13(3) CDR), the one-year time limit, specified above, starts on the day on which the protection ends (date of expiry), and not on the date the further six-month time limit (grace period) expires. Once the grace period expires the Office will inform the party about the expiry and the loss of rights.
- **set out the facts** justifying that they have taken **all due care** (required by the circumstances) to perform the omitted act and provide appropriate and proportionate evidence. The circumstances must be exceptional, namely circumstances that cannot be predicted from experience and are therefore unforeseeable and involuntary, such as natural disasters and general strikes. In this regard, failures to comply with time limits caused by operational difficulties arising from measures taken by public authorities against the pandemic or due to instances of sickness of the party or its representative may constitute exceptional circumstances in the above sense. Financial difficulties preventing

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the party from obtaining or securing continued professional representation before the Office or from paying fees payable to the Office when they were originally due that are caused by the pandemic situation (i.e. are due to objective circumstances that are beyond the sphere of influence of the party) and have resulted in the loss of right or means of redress may also constitute exceptional circumstances (unless otherwise provided for in the Regulations);

- carry out the **omitted act** within the abovementioned period (e.g. submit the observations for which the time limit was missed, pay the missing renewal fee and any surcharges); and
- pay a **fee (EUR 200)**.

Granting restitutio in integrum has the retroactive legal effect that the time limit that was not met will be considered to have been observed, and that any loss of rights in the interim will be deemed never to have occurred.

Restitutio in integrum is available, for instance, when the party has missed one of the time limits, laid down in: Article 32 EUTMR (payment of the application fee), Article 34(1) EUTMR (right of priority), Article 38(1) EUTMR (right of exhibition priority), Article 41(2) EUTMR (period to remedy filing deficiencies), Article 53(3) EUTMR (the period

for renewal) subject to the specific provision in Article 104(2) EUTMR, Article 68 EUTMR (appeal), Article 139 EUTMR (request for conversion into a national trade mark) and Article 39 EUTMR (the time limit for claiming seniority after the application has been filed).

Restitutio in integrum is not applicable to certain time limits specified in Article 104(5) EUTMR and Article 67(5) CDR, namely:

- the priority period, which is the six-month time limit for filing an application claiming the priority of a previous design or utility model application (Article 41(1) CDR);
- the time limit for filing an opposition and paying the opposition fee (Article 46(1) and (3) EUTMR);
- the time limits for restitutio in integrum itself (Article 104(2) EUTMR and Article 67(2) CDR);
- the time limit for requesting continuation of proceedings and paying the fee (Article 105(1) EUTMR);
- the two-month time limit to file an appeal against a decision of the Boards of Appeal before the General Court (Article 72(5) EUTMR).

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As a general rule, a fee must be paid for each application for restitutio in integrum (i.e. one fee per individual right). Nevertheless, in certain cases exceptions may apply. The minimum conditions (all of which must be met) for applying these exceptions are the following:

- all the rights should relate to the same rights holder;
- all the rights should be of the same type (e.g. EUTMs, RCDs);
- the unobserved time limit should be the same for all rights (e.g. missed time limit for renewal);
- the loss of all rights concerned should be the result of the same circumstances.

If the abovementioned conditions are met, the application for restitutio in integrum relating to multiple rights can be subject to a single fee. For instance, when a party has missed renewing multiple EU trade mark registrations, it can file a single request for restitutio in integrum for the renewal of all of its marks and pay a single restitutio in integrum fee. Otherwise, an individual fee must be paid for each right concerned.

CONDITIONS FOR APPLICATION

The Office's Guidelines for examination of European Union trade marks (Trade Mark Guidelines) and the Guidelines for examination of registered Community

designs (Design Guidelines) are applicable to all the above listed time limit instruments. They will be interpreted in the light of this communication insofar as they relate to exceptional circumstances caused by the ongoing pandemic. The same applies to the Rules of Procedure of the Office's Boards of Appeal. Further information is available for:

- extension of time limits at: [Trade mark and Design guidelines, Means of communication, time limits](#); [Trade mark and Design guidelines, Extension of time limits](#); [Trade mark guidelines, Extension of time limits in opposition proceedings](#); [Trade mark guidelines, Extension of the cooling-off period and Design guidelines, Extension of time limits](#).
- suspension of proceedings at: [Trade mark guidelines, Opposition proceedings, Suspension](#); [Trade mark guidelines, Friendly settlement](#); [Trade mark guidelines, Cancellation, Proceedings, Suspensions and Design guidelines, Suspension](#).
- continuation of proceedings at: [Trade mark and Design guidelines, Continuation of proceedings](#).
- *restitutio in integrum* at: [Trade mark and Design guidelines, Restitutio in integrum](#).
- Rules of Procedure of the Boards of Appeal at: [Decision 2020-1 of 27 February 2020 of the Presidium of the Boards of Appeal](#).



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Georgian IP Office now aligned with CP3, CP4 and CP5

The National Intellectual Property Center of Georgia ([Sakpatenti](#)) has published three Practice Papers: Distinctiveness - figurative marks containing descriptive/non-distinctive words, Scope of protection of black and white marks, and Likelihood of confusion (impact of non-distinctive/weak components) relative grounds of refusal.

Sakpatenti is the first non-EU IP office to find common grounds with the criteria listed under the *Common Communications on the following three Common Practices (CP) — Distinctiveness - figurative marks containing descriptive/non-distinctive words (CP3); Scope of protection of black and white marks (CP4) and likelihood of confusion (impact of non-distinctive/weak components) relative grounds of refusal (CP5)*.

The practice papers provide a clear and comprehensive explanation of the principles on which the practices are based, which will be generally applied by Sakpatenti and the IP offices of the European Union Intellectual Property Network ([EUIPN](#)). They also aim to cover a majority of cases.

Uruguayan IP Office aligned with CP3

The National Directorate of Industrial Property under the Ministry of Industry, Energy and Mining of Uruguay ([DNPI](#)) has published a Practice Paper concerning the examination of absolute grounds for refusal as regards figurative trade marks with purely descriptive words/expressions.

This publication is the result of the joint collaboration efforts of the DNPI, the EUIPO and the EU-funded project [IP Key Latin America](#).

The DNPI is the **first Latin American IP office** to analyse and find common ground with the criteria developed under the Common Communication on the *Common Practice of Distinctiveness - Figurative marks containing descriptive/non-distinctive words, referred to as *marcas mixtas* (mixed marks) in Uruguayan terminology*.

New online services in the Benelux

The Benelux Office for Intellectual Property ([BOIP](#)), with the support of the EUIPO's European Cooperation Service, has improved the services it provides to trade mark and design applicants through the launch of new online services.

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The BOIP platform now provides four additional online services: Change of Representative and Transfer of Rights for trade marks and for designs, which will **help modernise IP-related operations in the Benelux**. These new digital services, available since 12 May 2020, complement BOIP's existing services (Change of Name, Change of Address, Change of Name and Address, Renewal Trade Mark, Renewal Design, Opposition and e-Filing Trade Mark/Design).

The new BOIP services are the result of the work carried out by the EUIPO and its partners under the [European Cooperation Projects \(ECP1\)](#). The release marks another successful implementation of the Software Package Front Office tools developed by the EUIPO and offered to the national and regional intellectual property offices of the EU.

The European Cooperation Projects support the intellectual property offices in the European Union Intellectual Property Network (EUIPN) to develop more efficient, reliable and user-friendly tools and services for trade marks and designs.

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Closer collaboration between the EUIPO and EURid to benefit SMEs

The EUIPO and [EURid](#), the domain name registry for the .eu, .euo and .eu top-level domains, are set to intensify collaboration to support trade mark and domain name applicants and owners, particularly small and medium enterprises (SMEs).

This collaboration will support users of the EU IP system, particularly startups, by helping them to obtain trade mark and domain name protection in a joined-up manner, so they can secure their brands from the very beginning of their business journey.

At present, EU trade mark applicants are advised whether their trade mark is available as a .eu domain name at the end of the online application process at EUIPO. Applicants and holders can also set up alerts to be informed once a .eu domain name that matches their trade mark is registered.

Under a new work programme agreed jointly by the two organisations, the EUIPO and EURid will explore the possibility of implementing a reciprocal process when a .eu domain name is registered, allowing holders to see if a trade mark with a similar name is available at the EUIPO.

Additionally, both organisations will work on a common study on application behaviour, to see whether trade marks or domain names are

registered first. The study will assist in tackling fraudulent domain names and registrations done in bad faith. Work will also begin on a feasibility study to create a tool to inform users of the availability of the terms they are searching for both as a trade mark and as a domain name.

With outreach to SMEs at the heart of the EUIPO's Strategic Plan 2025, information from EURid on domain names will be integrated into a planned chatbot for SMEs, as well as into discovery guides and webinars, to further guide smaller companies towards an integrated brand protection scheme.

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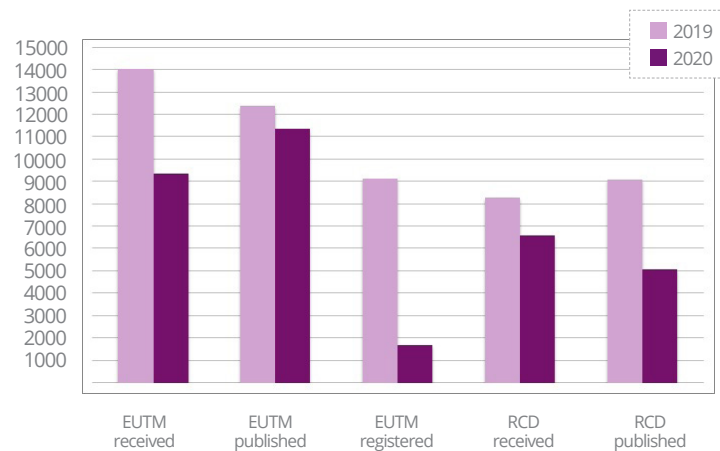
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Statistical Highlights

Monthly statistical highlights April*	2019	2020
European Union Trade Mark applications received	14 004	12 990
European Union Trade Mark applications published	12 372	9 349
European Union Trade Marks registered (certificates issued)	9 099	1 652
Registered Community Designs received	8 255	6 576
Registered Community Designs published	9 062	5 048

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



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EUIPO's Service Charter shows positive results in the first quarter 2020

Despite the impact of the COVID-19 pandemic, the Office has been able to comply with its timeliness, quality and accessibility commitments during the first quarter of 2020. Certain timeliness indicators have also improved during this period, namely the EU trade mark direct filings and registered Community designs registration. Only the timeliness in cancellation decisions still remains in 'Actions Needed.'

The new EU trade mark and registered Community design timeliness indicator for recordals measures several types of recordals, like Change of name/ Representative, Transfers (EUTM/RCD), Corrections (EUTM/RCD) and Seniority (EUTM). These recordals represent approximately 85 % of all the recordals the Office receives. As this indicator has been included in the Service Charter as from 2020, the previous figures have been calculated using 2020 parameters to illustrate the evolution.

The Service Charter underpins all the Office's quality activities and represents the EUIPO commitment to its users. The Service Charter sets out what users can expect from the Office in three core areas:

- Timeliness, or how long it takes to deliver a service;
- Accessibility, or how well and quickly the Office makes services available to users by phone, email and through e-business applications;
- Quality of decisions, or how EUIPO decisions measure up against agreed quality criteria.

HDB: over half of applicants have EUTM classification pre-accepted

Approximately half of all direct EUTM applications at EUIPO are now fully classified automatically via the Harmonised Database (HDB) system.

The HDB contains goods and services terminology that has already been pre-approved by all national and regional intellectual property offices in the EU. Terms chosen from the HDB are automatically accepted at EUIPO.

This increases predictability for applicants, who can select terms from the HDB with the security of knowing that those terms will be accepted. For even greater predictability, applicants can check the [Similarity tool](#), which uses terms from the HDB, and which allows EUIPO customers to know how the

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Office will assess the degree of similarity between goods and/or services in inter partes proceedings. The HDB is integrated into EUIPO's own e-filing system and into [TMclass](#).

Third edition of the ETMD Education Programme

Following the success of the first two editions, which saw the participation of more than 100 IP practitioners from 26 EU Member States, the EUIPO has launched the third edition of its tailor-made Trade Mark and Design Education Programme (ETMD EP).

The ETMD EP is held annually and focuses on interaction between the EUIPO and IP practitioners in trade mark and design registration and protection. The programme is delivered by leading IP professionals, academics and EUIPO staff.

The programme will be held in English only and will run from September 2020 to June 2021, with approximately 150 hours of tuition, combining e-learning, webinars and two three-day workshop sessions at the EUIPO in Alicante, Spain. It concludes with a final examination consisting of both a written and an oral exam; the latter will take place at the EUIPO in Alicante. Successful candidates will be awarded an EUIPO certificate.



For more information about the programme, provisional dates and the tuition fees, visit the [programme's website](#).

Registration will be open from 18/05/2020 until 30/06/2020, unless the maximum number of 60 places is filled before the closing date.

ACADEMY webinars

You can find all our [latest webinars](#) in the Academy Learning Portal, including:

Belated evidence

The EUTMR Legal Reform introduced explicit provisions on belated evidence. Our webinar gives a better understanding of belated evidence and how the Office deals with it in proceedings and subsequent decisions.

IPTV crime in the European Union

Television broadcasting is big business for legal media providers but there is a criminal underbelly that exploits opportunities provided by the internet to illegally share television broadcast signals. This latest webinar, based on the EUIPO report 'Illegal IPTV in the European Union' published in October 2019, presents the legal landscape, the illegal business models and existing countermeasures.

New functionalities for the EUIPO's Guidelines in electronic format

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Following feedback from users, the [Guidelines for Examination of EUTMs and RCDs](#) have been enhanced with an advanced search function and the option to download a PDF at both Part and Section level. This webinar will give you a virtual demo of the new functionalities, followed by a Q&A session. For an overview of all functionalities of our online Guidelines, see the [Guidelines tutorial](#).

Requests for the further extension of time limits in response to the COVID-19 pandemic

Following Decision No EX-20-4 of the Executive Director of the Office of 29 April 2020 on the extension of time limits, this webinar explains the conditions under which parties to proceedings before the Office can obtain a further extension of their time limits.

Distinctiveness of shape marks – Convergence Programme 9

The Common Practices are common guidelines drafted by all EU intellectual property offices together with the user associations. CP9 deals with the challenge of registering a shape mark when the shape itself is non-distinctive. It examines whether and how such an obstacle can be overcome and how to meet the threshold of distinctiveness. This webinar summarises to what extent other elements contained in the shape can render the sign as a whole distinctive.

Upcoming webinars

Webinar: **Disclosure of designs on the internet – Convergence Programme 10** [Tuesday, 2 June](#), 10.00-11.00

Webinar: **Boundaries of IP exclusive rights in entertainment content** [Tuesday, 9 June](#), 10.00-11.00

Interactive webinar: **Artificial Intelligence** [Tuesday, 16 June](#), 10.00-11.00

Webinar: **Design decisions of the EUIPO Boards of Appeal** [Tuesday, 23 June](#), 10.00-11.00

Webinar: **Decisions of the trimester of the GC and CJEU** [Tuesday, 30 June](#), 10.00-11.00

On current case-law

In Case C-240/18 P, the Court of Justice concluded that the EUIPO and the General Court, which had both found the sign Fack Ju Göhte to be contrary to accepted principles of morality, had failed to take sufficient account of the fact that the title of a comedy film did not appear to have been perceived as morally unacceptable by the German-speaking public at large.

As stated by the legislator, offensive trade marks should never be registered. Is this right? And what does it mean in practice? A discourse on marks that may offend 'public order or accepted principles of

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morality'. Or not. Follow the webinar: [Public order and morality](#) Warning! Contains bad language.

The most viewed one: tips on how to present arguments

[Arguments of the parties: Most frequent arguments presented by parties and how to deal with them](#)

In opposition and cancellation proceedings, parties very often repeat the same arguments, which are dismissed for a variety of reasons. This webinar looks at the recurring arguments and gives tips on how to present them in a better light. It also provides an insight into how the Office deals with the parties' arguments and the impact of arguments on the decision-taking process.

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Luxembourg trade mark and design news

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

26/03/2020, C 622/18, Cooper International Spirits and Others, EU:C:2020:241

KEYWORDS: Counterclaim

FACTS:

On 5 December 2005, the appellant in the main proceedings ('the appellant') applied for the French semi-figurative trade mark Saint Germain for alcoholic beverages. It was registered on 12 May 2006. On 8 June 2012, having learned about the distribution of a liqueur under the name 'St-Germain', the appellant brought proceedings against three companies before the Tribunal de grande instance de Paris for trade mark infringement by reproduction or, in the alternative, by imitation.

In parallel proceedings, by its judgment of 28 February 2013, the Tribunal de grande instance de Nanterre revoked the appellant's trade mark with effect from 13 May 2011. On 11 February 2014, the Cour d'appel de Versailles upheld that judgment, which became irrevocable.

The appellant maintained its claims before the Tribunal de grande instance de Paris, alleging infringement during the period prior to revocation, from 8 June 2009 to 13 May 2011. Those claims were dismissed on the ground that the trade mark had not been used since it was filed.

The Cour d'appel de Paris upheld that judgment, finding that the evidence was insufficient to demonstrate that the mark Saint Germain had actually been used. It concluded that the appellant could not successfully argue that the trade mark's function as a guarantee of origin, nor the monopoly of use conferred by it, nor its investment function, had been adversely affected since, in the absence of any use of that mark, a competitor's use of a sign identical to it did not substantially impede its use.

In the appeal proceedings, the Cour de cassation referred the following question to the Court of Justice (CJ).

'Must Article 5(1)(b) and Articles 10 and 12 of Directive [2008/95] be interpreted as meaning that a proprietor who has never [used his or her] trade mark and whose rights in it were revoked on expiry of the period of 5 years following publication of its registration obtain compensation for injury caused by infringement, claiming an adverse effect on the essential function of [his or her] trade mark, caused by use by a third party, before the date on which the revocation took effect, of a sign similar to that

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trade mark to designate goods or services identical or similar to those for which that trade mark was registered?

SUBSTANCE:

The CJ has previously held that Article 15(1) and Article 51(1)(a) CTMR confer on the proprietor of a trade mark a grace period within which to begin making genuine use of that mark. During this period, they may rely on the exclusive rights which the mark confers, pursuant to Article 9(1) CTMR, in respect of all the goods or services for which that mark is registered, without having to demonstrate its use. In determining, under Article 9(1)(b) CTMR, whether the goods or services of the alleged infringer are identical or similar to the goods or services covered by the EU trade mark, the extent of the exclusive right conferred should be assessed, during the 5-year period following the EU trade mark's registration, by having regard to the goods and services covered by it, and not in relation to the use made by the proprietor (21/12/2016, C 654/15, Länsförsäkringar, EU:C:2016:998, § 26-27) (§ 37-23).

This case is different in that it concerns the question of the scope of that exclusive right on expiry of the grace period where the trade mark has already been revoked (§ 41). It is therefore necessary to examine if, under Directive 2008/95/EC, the revocation of the rights conferred by that mark may have an effect on whether it is possible for the proprietor to rely, after expiry of the grace period, on infringements of the

exclusive rights conferred by that mark within that period (§ 42).

The French legislature decided that the revocation of a trade mark for non-use would take effect on expiry of a 5-year period following the mark's registration. Moreover, it did not make use of the option provided for in Article 11(3) of Directive 2008/95/EC (§ 44). It follows that French legislation maintains the possibility for the proprietor of the trade mark to rely, after expiry of the grace period, on infringements of the exclusive rights conferred by that mark within that period, even if the proprietor's rights in the mark have been revoked (§ 45).

The fact that a trade mark has not been used remains an important factor to be taken into account in determining the existence and extent of the damage sustained by the proprietor, and the amount of damages that they might claim (§ 47).

THE CJ'S ANSWER

Article 5(1)(b), the first subparagraph of Article 10(1) and the first subparagraph of Article 12(1) of Directive 2008/95/EC must be interpreted as leaving Member States the option of allowing the proprietor of a trade mark, whose rights in that mark have been revoked on expiry of the 5-year period from its registration due to lack of genuine use of the mark in the Member State concerned in connection with the goods or services for which it was registered, to retain the right to claim compensation for damage

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resulting from the use by a third party of a similar sign, in connection with identical or similar goods or services, that is liable to be confused with the proprietor's trade mark, before the date on which the revocation took effect (§ 49).

02/04/2020, C 567/18, Coty Germany, EU:C:2020:267

KEYWORDS: Use by another undertaking

FACTS:

The case involved Coty Germany, a distributor of perfumes, holding a licence for the EU trade mark DAVIDOFF (which enjoyed protection for perfumes, essential oils, cosmetics) and four companies linked to the 'Amazon group', which, collectively, offered an integrated service in an online marketplace. The Amazon group operated an online marketplace listing goods offered for sale by persons who had registered and created a seller's account. The Amazon group charged a percentage fee on completed transactions.

Sellers could use the 'Fulfilment by Amazon' scheme, under which goods were stored by Amazon group companies and dispatched by external service providers, once sales were made online via the Amazon websites. In this case, products bearing the 'Davidoff' trade mark and originating from a third country were offered for sale on the Amazon.de website.

Coty Germany claims that two Amazon group companies infringed its rights in that mark by storing and dispatching bottles of 'Davidoff Hot Water' perfume, offered for sale by third-party sellers on Amazon-Marketplace (www.amazon.de), although those bottles had not been put on the EU market with its consent. Coty Germany requested the German courts to order the two Amazon companies concerned to desist from this storage and dispatch.

The Landgericht (Regional Court, Germany) dismissed the action brought by Coty. The Court of Appeal dismissed the appeal brought by Coty, considering that Amazon Services Europe and Amazon FC Graben were not accountable for any act of infringement to the extent that they acted on behalf of the seller and that they were unaware of any trade mark infringement.

An appeal was filed before the Bundesgerichtshof (Federal Court of Justice). The referring court observed that a successful action would depend on the interpretation to be given to Article 9(2)(b) CTMR and Article 9(3)(b) EUTMR. The Federal Court of Justice referred a question to the Court of Justice (CJ) for a preliminary ruling:

'Does a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of that infringement, stock those goods for the purpose of offering them or putting them on the market, if it is not that person himself

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but rather the third party alone which intends to offer the goods or put them on the market?

SUBSTANCE:

It is clear from the proceedings that the respondents merely stored the goods concerned, without themselves offering them for sale or putting them on the market. Nor did they intend to offer those goods for sale or put them on the market. It must therefore be determined whether such a storage operation may be regarded as ‘using’ the trade mark. Neither the CTMR nor the EUTMR defines the concept of ‘using’ referred to in Article 9 of those regulations (§ 33-36).

According to its ordinary meaning, the expression ‘using’ involves active behaviour and direct or indirect control of the act constituting the use (§ 37). Moreover, only a third party who has direct or indirect control of the act constituting the use is effectively able to stop that use and therefore comply with that prohibition. The use, by a third party, of a sign identical or similar to the proprietor’s trade mark implies, at the very least, that that third party uses the sign in its own commercial communication (§ 38-39). Creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses the sign (§ 43).

Under the provisions at issue, to be classified as ‘using’, it is necessary for the economic operator providing the storage itself to pursue the aim referred to by those provisions, which is offering the goods or putting them on the market (§ 45).

The respondents have not themselves offered the goods concerned for sale or put them on the market. Therefore, they do not themselves use the sign in their own commercial communication (§ 47). Where an economic operator has enabled another operator to make use of the trade mark, its role must, as necessary, be examined from the point of view of rules of law other than Article 9 of Regulation CTMR or Article 9 EUTMR (§ 49).

Article 9(2)(b) CTMR and Article 9(3)(b) EUTMR must be interpreted as meaning that a person who, on behalf of a third party, stores goods which infringe trade mark rights, without being aware of that infringement, must be regarded as not stocking those goods in order to offer them or put them on the market for the purposes of those provisions, if that person does not itself pursue those aims (§ 53).

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02/04/2020, **C 753/18, Stim and SAMI**,
EU:C:2020:268

KEYWORDS: Copyright

FACTS:

The request for a preliminary ruling was made in connection with two disputes, one between Stim (the Swedish organisation that collectively manages copyright in music) and Fleetmanager, and the other between SAMI (the Swedish organisation managing the related rights of performers) and NB, concerning the classification, from the copyright perspective, of the hiring out of motor vehicles equipped with radio receivers.

Fleetmanager and NB were motor vehicle rental companies established in Sweden. They offered, directly or through intermediaries, hired vehicles equipped with radio receivers, in particular for periods not exceeding 29 days, which was regarded under national law as a short-term hire.

In the dispute between Stim and Fleetmanager, Stim sought an order that Fleetmanager pay it the sum of SEK 369 450 (approximately EUR 34 500), in respect of copyright infringement. Stim claimed that Fleetmanager, by making vehicles equipped with radio receivers available to third parties, namely motor vehicle rental companies for short-term hires to private clients, they contributed to the copyright infringements committed by those companies, who

had made musical works available to the public without authorisation.

In the dispute between SAMI and NB, NB brought an action seeking a declaration that NB was not required, on the basis of the fact that the vehicles which it hired to individuals and entrepreneurs were equipped with radio receivers and CD readers, to pay fees to SAMI for the use of sound recordings.

The Swedish Supreme Court referred the following questions to the Court of Justice (CJ) for a preliminary ruling:

(1) Does the hiring out of cars which are equipped as standard with radio receivers mean that the person who hires the cars out is a user who makes a 'communication to the public' within the meaning of Article 3(1) of Directive 2001/29/EC and within the meaning of Article 8(2) of Directive 2006/115/EC?

(2) What is the significance, if any, of the volume of the car hire activities and the duration of the hires?

SUBSTANCE:

The expression 'communication to the public' used in the two abovementioned provisions must be interpreted as having the same meaning (§ 28). The concept of 'communication to the public' includes two cumulative criteria, namely an 'act of communication' of a work and the communication of that work to a 'public' (§ 30).

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To determine whether the hiring out of vehicles equipped with radio receivers constitutes an act of communication within the meaning of Directives 2001/29/EC and 2006/115/EC, it is necessary to carry out an individual assessment, in the light of a number of complementary criteria, which are not autonomous and are interdependent. Those criteria must be applied both individually and in their interaction with each other, insofar as they may, in different situations, be present to widely varying degrees (§ 31).

It is apparent from Recital 27 of Directive 2001/29/EC, which reproduces, in essence, the joint declaration concerning Article 8 of the WIPO Copyright Treaty, that 'the mere provision of physical facilities for enabling or making a communication does not in itself amount to communication within the meaning of this directive' (§ 33).

This is the case in the supply of a radio receiver that forms an integral part of a hired motor vehicle, which makes it possible to receive, without any additional intervention by the leasing company, the terrestrial radio broadcasts available in the area in which the vehicle is located (§ 34). Such a supply differs from acts of communication by which service providers intentionally broadcast protected works to their clientele, by distributing a signal by means of receivers that they have installed in their establishment (§ 35).

Consequently, by making available to the public vehicles equipped with radio receivers, vehicle rental companies are not carrying out an 'act of communication' to the public of protected works (§ 36).

In light of the answer given to the first question, there is no need to answer the second question (§ 40).

23/04/2020, C 736/18 P, GUGLER (fig.) / GUGLER FRANCE, EU:C:2020:308

RESULT: Appeal dismissed

KEYWORDS: Company name, Use by another undertaking

FACTS:

Gugler GmbH, Mr Gugler's predecessor in title, registered the figurative mark as an EUTM for goods and services in Classes 6, 17, 19, 22, 37, 39 and 42. Gugler France filed an invalidity application based on, first, bad faith on the part of the proprietor when filing the application for registration of that mark, within the meaning of Article 52(1)(b) CTMR, and, second, its company name, which entitles it, under French law, to prohibit the use of that mark, for the purposes of Article 8(4) CTMR and Article 53(1)(c) CTMR.

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The Cancellation Division (CD) upheld the invalidity application. On appeal by Mr Gugler, the Board of Appeal (BoA) annulled the CD's decision and dismissed the application for a declaration of invalidity. Gugler France filed an action before the General Court (GC). The GC annulled the BoA's decision (28/01/2016, T 674/13, GUGLER, EU:T:2016:44) and referred the case back to the BoA.

After remittal, the BoA dismissed the appeal against the CD's decision, finding that the invalidity application should be upheld on the basis of Article 53(1)(c) CTMR, read in conjunction with Article 8(4) CTMR.

Mr Gugler filed an action before the General Court (GC) against this decision. The GC dismissed the action. It held that the BoA erred in finding that there was a likelihood of confusion (LOC), since the economic link between Gugler France and Gugler GmbH on the filing date of the application for registration of the contested mark precluded any finding of a LOC. Consequently, the GC annulled the BoA's decision (25/09/2018, T 238/17, GUGLER (fig.) / GUGLER FRANCE, EU:T:2018:598).

Gugler France appealed to the Court of Justice (CJ), relying on a single ground of appeal: infringement of Article 8(1)(b) CTMR and Article 8(4) CTMR and of Article L. 711 4 of the French Intellectual Property Code. The CJ dismissed the appeal.

EUTM



Earlier trade mark

GUGLER

SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(4) CTMR AND OF ARTICLE L. 711 4 OF THE FRENCH INTELLECTUAL PROPERTY CODE.

According to Gugler France, the GC erred in assessing the economic link between itself and Gugler GmbH and, therefore, erred in finding that there was no LOC (§ 22-27).

However, the methodological approach adopted by the GC (§ 29-30) complies with the requirement that the examination of whether an economic link exists must be conducted globally, taking into account all the relevant circumstances (20/12/2017, C 291/16, Schweppes, EU:C:2017:990, § 51) (§ 33-38).

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23/04/2020, C 237/19, Gömböc Kutató,
EU:C:2020:296

KEYWORDS: Functional element, Shape of the product, Substantial value, Technical result, Three dimensional mark

FACTS:

The request for a preliminary ruling was made in proceedings between Gömböc Kft. and the Hungarian IP Office relating to an application for a three-dimensional mark as a national mark for decorative items in Class 14 and decorative crystalware and chinaware and toys in Classes 21 and 28.

The Hungarian IP Office rejected that application since it found that the sign represented a three-dimensional object which, due to its external design and the homogeneous material used, always returns to its position of balance, and that the shape of the object serves, overall, to achieve its technical objective of always righting itself. When assessing the registrability of the sign, the Hungarian IP Office relied on the knowledge of the characteristics and the function of the shape of the product that the average consumer was able to obtain from the applicant's website and from the considerable publicity the product had enjoyed in the press, as well on the relevant public's knowledge to establish that the shape gives the goods substantive value.

The Hungarian Supreme Court asked the Court of Justice (CJ) in essence:

- i. whether Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of the goods which is necessary to obtain a technical result, assessment must be limited to the graphic representation of the sign, or whether other information, such as the perception of the relevant public, should also be taken into account;
- ii. whether the ground of refusal of Article 3(1)(e)(iii) Directive 2008/95/EC is applicable to a sign which consists exclusively of the shape of the goods and in respect of which it is only on the basis of the perception or knowledge of the relevant public as regards the product graphically represented that the competent authority reaches the view that the shape gives substantial value to that product;
- iii. whether the ground of refusal of Article 3(1)(e)(iii) Directive 2008/95/EC must be applied systematically to a sign which consists exclusively of the shape of the product where the appearance of that product enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item.

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TM application



SUBSTANCE:

(i) FIRST QUESTION FOR PRELIMINARY RULING

The correct application of the ground for refusal of Article 3(e)(ii) Directive 2008/95/EC requires that the authority deciding on the application for registration of the sign first, properly identify the essential characteristics of the three-dimensional sign and, second, establish whether they perform a technical function of the product concerned (see, by analogy, 14/09/2010, C 48/09 P, Lego brick, EU:C:2010:516 § 68, 72, 84; 10/11/2016, C 30/15 P, CUBES (3D), EU:C:2016:849, § 40, 42, 45, 52) (§ 25-28).

As regards the first step, the competent authority may either base its assessment directly on the overall impression produced by the sign or examine each of the components of the sign in turn. Consequently, the identification of the essential characteristics of a three-dimensional sign may be carried out by means of a simple visual analysis of the sign or be based on a detailed examination, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously

in respect of the goods concerned (14/09/2010, C 48/09 P, Lego brick, EU:C:2010:516, § 70-71) (§ 29-30). The presumed perception by the relevant public is not a decisive factor when applying that ground for refusal, and may, at most, be a relevant criterion of assessment for the competent authority when identifying the essential characteristics of the sign (14/09/2010, C 48/09 P, Lego brick, EU:C:2010:516, § 76) (§ 31).

As regards the second step of the analysis, the ground for refusal – pursuant to its objective to prevent any monopoly on technical solutions or functional features of a product – may be applied when the graphic representation of the shape of the product only allows part of the shape to be seen, provided that the visible part of the shape is necessary to obtain the technical result sought by that product, even if it is not sufficient, on its own, to obtain that result (§ 32). The determination (by the competent authority) of the technical functions of the product must be based on objective and reliable information such as that given in the description of the product submitted at the time of filing the application for registration, in data relating to intellectual property rights conferred previously in respect of that product, by looking at surveys or expert opinions on the functions of the product, or in any relevant documentation, such as scientific publications, catalogues and websites, which describes the technical features of the product (§ 34). Information concerning any knowledge the relevant public may have of the technical functions

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of the product would involve subjective factors, and potentially give rise to uncertainty as to the extent and accuracy of that public's knowledge (§ 35). Moreover, the relevant public does not necessarily have the required expertise to enable it to determine with accuracy what the technical features of the product in question are and the extent to which the shape of that product forming the sign contributes to the technical result sought (§ 36).

(ii) SECOND QUESTION FOR PRELIMINARY RULING

The application of the ground for refusal of Article 3(1)(e)(iii) Directive 2008/95/EC is based on an objective analysis, intended to demonstrate that, owing to its characteristics, shape has such a great influence on the attractiveness of the product that restricting the benefit of the shape to a single undertaking would distort the conditions of competition on the market concerned (§ 40). Therefore, it must be apparent from objective and reliable evidence that a consumer's decision to purchase the goods in question is, to a very great extent, determined by one or more features of the shape that alone forms the sign (§ 41). On the other hand, characteristics of the product not connected to its shape, such as technical qualities or the reputation of the product, are irrelevant (§ 42). Although the presumed perception of the sign by the average consumer is not, in itself, a decisive element when applying the ground for refusal set out in Article 3(1)(e)(iii)

of Directive 2008/95/EC, it may, nevertheless, be a useful criterion of assessment for the competent authority in identifying the essential characteristics of that sign (18/09/2014, C 205/13, Tripp Trapp, EU:C:2014:2233, § 34).

In a situation such as that in the main proceedings, in light of the relevant public's perception of the sign and the knowledge of that public, the competent authority was allowed to find that the shape, which alone forms the sign, is the tangible symbol of a mathematic discovery. Since it took the view that that fact makes the shape special and striking, it was entitled to conclude that it is an essential characteristic and that it was necessary to assess whether, as a result of that fact, the shape, which alone forms the sign, gives substantial value to the goods (§ 45). The fact that such a characteristic does not, in itself, concern the aesthetic merits of the shape does not exclude the application of Article 3(1)(e)(iii) of Directive 2008/95/EC (§ 47).

(iii) THIRD QUESTION FOR PRELIMINARY RULING

The objective of the ground for refusal in Article 3(1)(e)(iii) of Directive 2008/95/EC does not mean that EU intellectual property law prevents the coexistence of several forms of legal protection (for the protection of designs Article 16 of Directive 98/71/EC) (§ 50-52). The fact that the appearance of a product is protected as a design does not prevent a sign consisting of the shape of that product from

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benefiting from protection under trade mark law, provided that the conditions for registration of that sign as a trade mark are satisfied (§ 53). Article 3(1) (e)(iii) of Directive 2008/95/EC may, inter alia, apply to a sign consisting exclusively of the shape of a product with an artistic or ornamental value where it is apparent from objective and reliable evidence that the consumer's decision to purchase the product is based to a very large extent on one or more characteristics of that shape (§ 58-59).

30/04/2020, C 772/18, Korkein oikeus, EU:C:2020:341

FACTS:

A, the plaintiff in the main proceedings is proprietor of an international registration for the word mark INA, which designates Finland and covers inter alia bearings in Class 7. The defendant, B, is a natural person resident in Finland. In 2011, B received a consignment of 150 bearings arriving in Finland from China and collected the goods from a depot. The bearings were in B's possession for some weeks and were subsequently sent to a trader in Russia. B received a carton of cigarettes and a bottle of brandy as remuneration for this transaction.

In criminal proceedings for trade mark infringement brought against B before the Court of first instance of Helsinki, to which A was joined with respect to his civil interest, the court acquitted B on the ground that it could not be proved that he had deliberately

committed an offence. However, the court ordered B not to continue or repeat this conduct, ordering him to pay compensation and damages to A for the harm suffered by the latter.

B appealed to the Court of Appeal of Helsinki, who upheld the appeal. Relying on the judgment of 16/07/2015, C 379/14, BACARDI, EU:C:2015:497, it considered, in essence, that B's actions could be equated with storage and forwarding activities. Therefore, 'use in the course of trade' within the meaning of Article 5 of Directive 2008/95/EC was not established. Consequently, it held that A's claim for compensation and damages was unfounded.

A brought an appeal against that judgment before Finland's Supreme Court. The Supreme Court asked the Court of Justice (CJ) for a preliminary ruling on four questions.

In these questions the Supreme Court sought, in essence, to ascertain whether Article 5(1) of Directive 2008/95/EC, read in conjunction with Article 5(3) (b) and (c) of that directive, must be interpreted as meaning that a person who does not engage in trade as an occupation, but who takes delivery of, releases for free circulation in a Member State and retains goods that are manifestly not intended for private use, where those goods were sent to that person's address from a third country and where a trade mark, without the consent of the proprietor of that trade mark, is affixed to those goods, must be regarded as using that trade mark in the course

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of trade, within the meaning of Article 5(1) of that directive.

SUBSTANCE:

The question whether the conditions laid down in Article 5(1) of Directive 2008/95/EC are satisfied must be determined solely on the basis of objective factors (§ 22).

In that regard, the expression ‘use in the course of trade’ entails that the exclusive rights conferred by a trade mark may, as a rule, ‘be relied on by the proprietor of that trade mark only as against economic operators and, consequently, only in the context of a trading business’ (12/07/2011, L’Oréal-eBay, C 324/09, EU:C:2011:474, § 54). Further, if the transactions carried out, by reason of their volume, their frequency or other characteristics, go beyond the scope of a private activity, whoever carries out those transactions will be acting in the course of trade (12/07/2011, C 324/09, L’Oréal-eBay, EU:C:2011:474 § 55).

The goods in the main proceedings are ball bearings weighing 710 kg, generally used in heavy industry (§ 24). Since these goods, bearing in mind their nature and their volume, are manifestly not intended for private use, the relevant transactions must be considered to fall within the scope of a trading business, though that is a matter to be determined by the referring court (§ 25).

Further, a person who makes known their address as the place to which the goods concerned are to be shipped, who completes or has an agent complete the customs clearance of those goods and who releases them for free circulation is importing those goods within the meaning of Article 5(3)(c) of Directive 2008/95/EC (§ 26).

In order to identify use in the course of trade, ownership of the goods on which the trade mark is affixed is of no relevance. The fact that an economic operator uses a sign corresponding to a trade mark in relation to goods that are not their own — in the sense that they do not have title to them — does not in itself prevent that use from falling within the scope of Article 5(1) of Directive 2008/95/EC (12/07/2011, C 324/09, L’Oréal-eBay, EU:C:2011:474, § 91) (§ 27).

The fact that a person has imported and released such goods for free circulation justifies in itself a finding that that person has acted in the course of trade, there being no need to examine subsequent dealings with those goods, whether, for example, they have been stored by the importer or put on the market within the European Union or exported to non-Member States (§ 28).

Finally, the significance of the remuneration that the importer received is also irrelevant (§ 29).

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ANSWER OF THE CJ

Article 5(1) of Directive 2008/95/EC, read in conjunction with Article 5(3)(b) and (c) of that directive, must be interpreted as meaning that a person who does not engage in trade as an occupation, who takes delivery of, releases for free circulation in a Member State and retains goods that are manifestly not intended for private use, where those goods were sent to their address from a third country and where a trade mark, without the consent of the proprietor of that trade mark, is affixed to those goods, must be regarded as using that trade mark in the course of trade, within the meaning of Article 5(1) of that directive.

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

29/04/2020, T 37/19, cimpress / p impress (fig.) et al., EU:T:2020:164

RESULT: Action dismissed

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

FACTS:

The applicant sought to register the figurative mark cimpress as an EUTM for goods and services in Classes 16, 35, 38 and 42.

An opposition was filed based on the earlier EU figurative mark, registered for goods in Class 16, and the German word mark Impress-Media, registered for goods and services in Classes 16, 35 and 38, pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) found that the opponent had not provided sufficient proof of use of the earlier national trade mark Impress-Media and examined the opposition only in relation to the opponent's earlier EU figurative mark. The OD found a likelihood of confusion (LOC) for part of the contested goods and services and therefore partially upheld the opposition.

Both parties filed an appeal. The Board of Appeal (BoA) dismissed the applicant's appeal and partially upheld the opponent's appeal. It found proof of use also for the German mark and annulled the OD's decision insofar as it rejected the opposition in respect of certain services. The BoA allowed the opposition on the basis of the earlier EU figurative mark for certain goods and services covered by the trade mark applied for and rejected the opposition for the remaining goods and services on the basis of the earlier EU figurative mark and insofar as its use had been proved, on the basis of the earlier German mark.

The applicant filed an action before the General Court (GC) seeking annulment of the BoA's decision and annulment of the OD's decision, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

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EUTM Application

cimpress

Earlier trade marks

impress

Impress-Media

SUBSTANCE:

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

The relevant public consists of the general public and professionals (small and medium enterprises who require printed matter and advertising services) in the EU that display an average to high level of attention (§ 31, 35-40). Considering the unitary character of the EU trade mark, the BoA was not wrong in limiting its assessment to the Polish-speaking part of the EU public (§ 44-49).

The goods and services covered by the mark applied for are partially identical and partially similar to the goods covered by the earlier figurative mark (not disputed) (§ 50 51).

Distinctive character of the elements of the earlier EU figurative mark. The understanding of a word sign may be assumed for a territory in which the language of the sign is the native language of that territory's population. It must be proved in territories in which the relevant language is not the population's native language, unless a sufficient knowledge of the language of the sign on the part of the target public in those territories is a well-known fact (26/11/2008, T 435/07, New Look, EU:T:2008:534, § 22 (§ 63). In this case there is no need to decide whether the Polish-speaking public's knowledge of basic English vocabulary is a well-known fact since the term 'impress' is not basic English vocabulary. This public cannot be presumed to have an understanding of this term and it must therefore be proved (§ 64, 70). It has not been proved that the public in Poland has a sufficient level of English to understand 'impress' (§ 66-69). The BoA correctly found that the verbal element 'impress' has no meaning for the relevant Polish-speaking public and therefore has an average degree of distinctive character (§ 75). The distinctive character of the figurative element of the earlier figurative mark is not disputed. Therefore, the elements of the earlier EU figurative mark have an average degree of distinctiveness (§ 76 77).

The signs are visually and phonetically similar to a high degree because the term 'impress' of the earlier EU figurative mark is contained in full in the trade mark applied for. The conceptual comparison is neutral (§ 84).

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There is a LOC on account of the high degree of visual and phonetic similarity between the signs and, considering the principle of imperfect recollection, despite the letter 'c' at the beginning of the trade mark applied for and the figurative element of the earlier EU figurative mark (§ 89-96).

(ii) FORM OF ORDER SOUGHT SEEKING ANNULMENT OF THE OD'S DECISION.

It falls within the GC's jurisdiction to annul or to alter decisions, as provided for in Article 72(3) EUTMR, and, therefore, to annul the OD's decision and to adopt the decision that the BoA should have taken. However, the claim is rejected as the applicant's single plea in law is unfounded (§ 97-98).

29/04/2020, T 73/19, Wood splitting tools, EU:T:2020:157

RESULT: Action dismissed

KEYWORDS: Conflict of design with prior design, Individual character, Overall impression, Right to be heard

FACTS:

The RCD proprietor registered the design for wood splitting tools in Class 08 03 of the Locarno Classification.

An invalidity application was filed pursuant to Article 52 CDR and Article 6 CDR. The Invalidity Division (ID) declared the contested design invalid on the ground that it had no individual character.

The Board of Appeal (BoA) dismissed the appeal filed by the RCD proprietor. The BoA considered that the contested design produced an impression of déjà vu with regard to the earlier design, inasmuch as it reproduced the characteristics of that earlier design that immediately strike an informed user – namely a base comprising a piece of solid material with several protruding teeth and a lever in the form of a steel rod with a blade on one side and a handle on the other. In particular, it specified that the fact that the tool was represented in a closed position (in the contested design) and in an open position (in the earlier design) was not decisive either in the comparison of the designs or in the assessment of individual character. The BoA confirmed that the contested design was devoid of individual character.

The invalidity applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 62 CDR and (ii) infringement of Article 6(1) CDR. The GC dismissed the action.

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RCD



Earlier design



SUBSTANCE:

(i) INFRINGEMENT OF ARTICLE 62 CDR

The right to be heard, as enshrined in Article 62 CDR, extends to all the matters of fact or of law which form the basis of the decision, but not to the final position which the authority intends to adopt (09/02/2017, T 16/16, BECHER, EU:T:2017:68, § 57), or to each well-known fact on which it relies in

order to arrive at that position (01/06/2016, T 34/15, CHEMPIOIL / CHAMPION et al., EU:T:2016:330, § 83) (§ 15). The mere fact that the final position of the BoA, as regards the lack of individual character of the contested design, does not correspond to that expressed by the applicant before the Office, in no way constitutes an infringement of the applicant's right to be heard (24/09/2008, T 179/07, Aprile, EU:T:2008:401, § 24).

(ii) INFRINGEMENT OF ARTICLE 6(1) CDR

The informed user is a person who is familiar with wood-splitting tools, including people who use these tools to split logs that can be burned in a fireplace into smaller pieces (not disputed) (§ 27).

The freedom of the designer in developing a wood-splitting tool is not severely limited inasmuch as, even though the tool has a functional purpose (splitting pieces of wood), thus requiring a blade and a body, the designer could choose a particular shape for the body, the lever arm, and the handle, or the way in which the tool could be mounted on a surface (not disputed) (§ 28).

The earlier design represents a wood-splitting tool comprising a base and a lever connected by a hinge, the purpose of which is to move the lever and take a closed or open position in order to cut the wood. The assessment of the design's overall impression on the informed user must include the way in

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which the product represented by that design is used (07/11/2013, T 666/11, Gatto domestico, EU:T:2013:584, § 31). In view of the characteristics of the wood-splitting tool represented, which is specifically designed to cut wood by moving the lever, the BoA correctly took into account the impression produced by the design on the informed user when the tool is in a closed position (21/11/2013, T 337/12, Sacacorchos, EU:T:2013:601, § 46) (§ 40).

The fact that the representation of the earlier design is limited to a single view, representing the tool in question in an open position, does not exclude the possibility of carrying out a comparison with the contested design insofar as the visual representation of the tool in question in a closed position may be deduced from the representation of the earlier design (21/05/2015, T 22/13 & T 23/13, UMBRELLAS, EU:T:2015:310, § 80) (§ 41).

The graphic representation of the earlier design, consisting of a single view, is clear and unambiguous. Accordingly, the closed visual appearance of the tool in question can be deduced with sufficient clarity and precision from its representation in an open position (§ 43-44).

As to the assessment of the overall impression produced by the designs, the BoA was correct to take account of the basic elements of the product incorporated into the designs and to state that what was striking to the informed user was the overall

design of the base (with teeth) and the lever (with a blade and a handle), which were very similar and which produced an impression of déjà vu on that user (§ 56).

The differences in the shape of the body and the shape of the lever of the wood-splitting tool cannot dispel the impression of déjà vu which emerges from the designs, in view of their common elements, which are among their most visible and important elements. These differences are insufficiently marked to produce, by themselves, a dissimilar overall impression on the informed user, taking the low degree of restriction of the freedom of the designer in developing the design into account. Therefore, they do not confer individual character on the contested design (§ 60, 73). The safety device has a functional aspect and does not play an important role in the overall impression produced by the designs (§ 74-76). Accordingly, the differences between the designs have a relatively low weighting in the overall impression produced by them, which is dominated by the very similar appearance of a base with several teeth and a lever with a blade and a handle (§ 77).

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29/04/2020, T 106/19; ABARCA SEGUROS (fig.) / Abanca, EU:T:2020:158

RESULT: Action dismissed

KEYWORDS: Dominant element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS:

The applicant sought to register the figurative mark ABARCA SEGUROS with a colour claim as an EUTM for services in Class 36 such as insurance agencies; insurance underwriting.

Pursuant to Article 8(1)(b) CTMR, an opposition was filed. It was based on the earlier EU word mark ABANCA, registered for insurance services; finance services; monetary affairs; credit leasing; debt collection agencies: banking, information (financial -); credit & debit card services in Class 36. The Opposition Division upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the services in question were identical and the signs visually and aurally similar to an average degree. It considered that it was not possible to make a conceptual comparison of the marks because they had no meaning for the Swedish and Danish-speaking parts of the relevant public. It concluded that there was a likelihood of confusion (LOC).



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

EUTM Application



Earlier trade mark

ABANCA

SUBSTANCE:

(i) PRELIMINARY ADMISSIBILITY ISSUES

As to the applicant's head of claim seeking to alter the contested decision, it is clear from its pleadings, that the applicant necessarily seeks not only the alteration of the contested decision, but also the annulment thereof, which, moreover, can be inferred from the presentation of the applicant's single plea in law, alleging infringement of Article 8(1)(b) EUTMR (27/02/2014, T 509/12, TEEN VOGUE, EU:T:2014:89, § 16) (§ 16).

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

The relevant public consists of the general public and professionals of the European Union, whose degree of attention varies from average to high. The LOC was assessed with regard to the Swedish- and Danish-speaking parts of the relevant public for which the earlier mark ABANCA and the verbal element 'abarca' of the mark applied for have no meaning (not disputed) (§ 27).

The services are identical (not disputed) (§ 29).

The mark applied for is made up of a visually dominant verbal element, namely the word 'abarca', an element which takes up a negligible portion of the mark, the word 'seguros', and a figurative element in the form of a bird, which has a secondary position within the sign and could be perceived as a decorative background element by the Swedish- and Danish-speaking parts of the relevant public. The verbal elements 'abarca' and 'seguros' have no meaning for the relevant Swedish- and Danish-speaking parts of the relevant public (not disputed) and therefore are distinctive. (§ 38-39, 42, 52).

The marks are visually similar to an average degree because the earlier mark appears almost identically in the first verbal element of the mark applied for, which is also the visually dominant element of the latter. That conclusion regarding similarity is not called into question by the differences between



the marks, namely the fourth letter of the verbal elements 'abarca' and 'abanca', the verbal element 'seguros' and the figurative element of the mark applied for (§ 56, 59-65). There is an average degree of phonetic similarity between the marks (§ 66, 70-72). The conceptual comparison of the marks is neutral as they have no meaning for the Swedish- and Danish-speaking parts of the relevant public (§ 73, 77-78).

LOC. In view of the normal degree of distinctiveness of the earlier mark and the average degree of visual and phonetic similarity between the marks and the identical services, there is a LOC even for the section of the relevant public who would have a high level of attention. The average consumers of the services, even if they are specialists, only rarely have the chance to make a direct comparison between the marks and must place their trust in the imperfect picture of them that they have kept in their mind (§ 91).

29/04/2020, T 108/19, TasteSense By Kerry (fig.) / Multisense et al., EU:T:2020:161

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs

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FACTS:

The applicant sought to register the figurative mark TasteSense By Kerry as an EUTM for goods in Classes 1, 29 and 30.

An opposition was filed pursuant to Article 8(1) (b) CTMR on the basis of the earlier EU word mark MultiSense, registered for goods in Classes 1, 3 and 30, and the earlier EU word mark Tastecraft for goods and services in Classes 1, 2, 3, 5, 7, 29, 30, 32, 33, 35 and 42. The Opposition Division (OD) examined the opposition with regard only to the earlier mark MultiSense and upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. It limited its assessment to the first earlier mark and to the non-English-speaking part of the EU public, namely to the Polish- and Spanish-speaking parts. The BoA found that the goods were identical or similar to a high degree. As regards the inherent distinctiveness of the verbal elements, the BoA observed that it could not be assumed that English was understood by all average consumers in the EU and, with respect to Polish or Spanish consumers in particular, it could not be presumed that, in general, English words had a meaning for them, unless equivalent words existed in Polish and Spanish. However, the term 'multi' would be understood by both Polish and Spanish consumers, with the result that that element lacked distinctiveness. The BoA stated that the first earlier mark had a normal degree of distinctiveness, despite the presence of



the weak or descriptive element 'multi'. As there was an average degree of visual and phonetic similarity, the BoA concluded that there was a likelihood of confusion (LOC).

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. At the oral hearing the applicant put forward a new plea in law, alleging infringement of the obligation to state reasons (Article 94 EUTMR). The GC dismissed the action.

EUTM Application

TasteSense
By Kerry

Earlier trade marks

MultiSense
Tastecraft

SUBSTANCE:

(i) PRELIMINARY ADMISSIBILITY ISSUES

For the GC's review of the legality of the decision, the applicant's evidence (provided for the first time in the proceedings before the GC) regarding

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the Polish and Spanish public's level of knowledge of English, in particular their understanding of the words 'taste' and 'sense', was declared inadmissible as it should have been produced in the course of the proceedings before the BoA (§ 32-37).

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

The relevant public and its level of attention. The relevant public consists of the general public and professionals with a level of attention that varies from average to high. The goods are specialised goods directed at both the general public (for example, additives and flavourings in Classes 29 and 30) and a specialist public, particularly as they could be used in the manufacturing process (§ 49-50, 54-58).

The relevant public's knowledge of English. Since knowledge of English on the part of the Polish and Spanish public is not a well-known fact (in contrast to the knowledge of English on the part of, inter alia, the Swedish public) and since the sector in question is not one of those in which English is frequently or normally used (in contrast to the technology or computing sectors), it was for the applicant to provide, in the course of the administrative proceedings, evidence to highlight the relevant public's knowledge of a language other than its mother tongue (§ 63). Although the BoA erred in finding that the Polish public would not understand the meaning of the English term 'sense' (§ 69-70), the

Spanish public would not establish a link between the English term 'sense' and one of the Spanish equivalents, 'sentido' (§ 71). The BoA's findings regarding the Spanish public's perception of the English terms 'taste' and 'sense' must be upheld, with the result that the subsequent analysis was carried out solely with regard to the Spanish public (§ 72).

Comparison of the signs and global assessment of LOC. The signs are visually and phonetically similar to an average degree, despite the difference between the prefixes 'multi' and 'taste' at the beginning of the marks, because they have the word 'sense' in common, which is meaningless, at least for the Spanish public (§ 81). For that public, a conceptual comparison of the marks is irrelevant (§ 83). The BoA correctly concluded that as the goods were identical or highly similar there was a LOC between the signs (§ 84).

(iii) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS

A plea alleging a failure to state reasons is a plea involving a matter of public policy, which may be put forward at any stage of the procedure (§ 87-89).

However, the plea is unfounded since the BoA stated why the relevant public could be considered not to have a knowledge of English: it pointed out that knowledge of a foreign language, unless it was a well-known fact, could not be presumed (§ 93).

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29/04/2020, T 109/19; **TasteSense (fig.) / Multisense et al.**, EU:T:2020:162

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs

FACTS:

The applicant sought to register the figurative mark TasteSense as an EUTM for goods in Classes 1, 29 and 30.

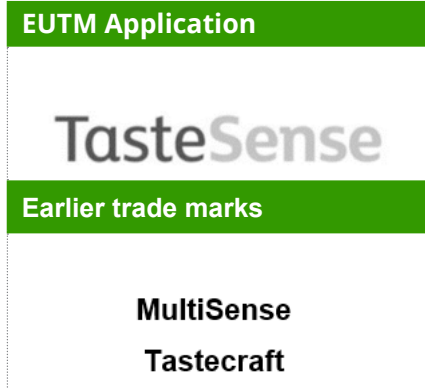
An opposition was filed pursuant to Article 8(1) (b) CTMR on the basis of the earlier EU word mark MultiSense, registered for goods in Classes 1, 3 and 30 and the earlier EU word mark Tastecraft for goods and services in Classes 1, 2, 3, 5, 7, 29, 30, 32, 33, 35 and 42. The Opposition Division (OD) examined the opposition with regard only to the earlier mark MultiSense and upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. It limited its assessment to the first earlier mark and to the non-English-speaking part of the EU public, namely to the Polish- and Spanish-speaking parts. The BoA found that the goods were identical or similar to a high degree. As regards the inherent distinctiveness of the verbal elements, the BoA observed that it could not be assumed that English was understood by all average consumers in the EU and, with respect to Polish or Spanish consumers in



particular, it could not be presumed that, in general, English words had a meaning for them, unless equivalent words existed in Polish and Spanish. However, the term 'multi' would be understood both by Polish and Spanish consumers, with the result that that element lacked distinctiveness. The BoA stated that the first earlier mark had a normal degree of distinctiveness, despite the presence of the weak or descriptive element 'multi. As there was an average degree of visual and phonetic similarity, the BoA concluded that there was a likelihood of confusion (LOC).

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. At the oral hearing the applicant put forward a new plea in law alleging infringement of the obligation to state reasons (Article 94 EUTMR). The GC dismissed the action.



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SUBSTANCE:

(i) PRELIMINARY ADMISSIBILITY ISSUES

For the GC's review of the legality of the decision, the applicant's evidence provided for the first time in the proceedings before the GC regarding the Polish and Spanish public's level of knowledge of English, in particular their understanding of the words 'taste' and 'sense', was declared inadmissible as it should have been produced in the course of the proceedings before the BoA (§ 32-37).

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

The relevant public and its level of attention. The relevant public consists of the general public and professionals with a level of attention that varies from average to high. The goods are specialised goods directed at both the general public (for example, additives and flavourings in Classes 29 and 30) and a specialist public, particularly as they could be used in the manufacturing process (§ 49-50, 54-58).

The relevant public's knowledge of English. Since knowledge of English on the part of the Polish and Spanish public is not a well-known fact (in contrast to the knowledge of English on the part of, inter alia, the Swedish public) and since the sector in question is not one of those in which English is frequently or normally used (in contrast to the technology

or computing sectors), it was for the applicant to provide, in the course of the administrative proceedings, evidence to highlight the relevant public's knowledge of a language other than its mother tongue (§ 63). Although the BoA erred in finding that the Polish public would not understand the meaning of the English term 'sense' (§ 69-70), the Spanish public would not establish a link between the English term 'sense' and one of the Spanish equivalents, 'sentido' (§ 71). The BoA's findings regarding the Spanish public's perception of the English terms 'taste' and 'sense' must be upheld, with the result that the subsequent analysis was carried out solely with regard to the Spanish public (§ 72).

Comparison of the signs and global assessment of LOC. The signs are visually and phonetically similar to an average degree, despite the difference between the prefixes 'multi' and 'taste' at the beginning of the marks, because they have the word 'sense' in common, which is meaningless, at least for the Spanish public (§ 81). For that public, a conceptual comparison of the marks is irrelevant (§ 82). The BoA correctly concluded that as the goods were identical or highly similar there was a LOC between the signs (§ 83-84).

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(iii) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS

A plea alleging a failure to state reasons is a plea involving a matter of public policy, which may be put forward at any stage of the procedure (§ 86-88).

However, the plea is unfounded since the BoA stated why the relevant public could be considered not to have a knowledge of English: it pointed out that knowledge of a foreign language, unless it was a well-known fact, could not be presumed (§ 92).

29/04/2020, T 78/19, green cycles (fig.), EU:T:2020:166

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Catalogue, Evidence of use, Extent of use, Nature of use, Press articles, Promotional material, Proof of use

FACTS:

The EUTM proprietor registered the figurative EU mark (EUTM No 8 807 265) for goods and services in Classes 17, 20 (including articles made of plastic), 40 (including treatment of materials; in particular treatment, processing of plastic and decoration of plastic surfaces) and 42.

A revocation of the abovementioned EUTM was filed for all of the goods and services covered. The Cancellation Division partially upheld the application for revocation for certain services in Class 40, namely treatment of materials with the exception of plastics.

The revocation applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It considered that the evidence adduced by the EUTM proprietor, considered as a whole, was sufficient to prove the genuine use of the contested mark during the relevant period for Classes 17, 20, 42, and partially for Class 40.

The revocation applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article^o18(1) EUTMR read in conjunction with Article^o10(3) EUTMDR and Rule 22(4) CTMIR.

EUTM No 8 807 265



SUBSTANCE:

On the assessment of the use of the contested mark in connection with all of the designated goods and

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services. Regarding the extent of the use: the BoA was right in assessing the evidence and considering that it was sufficient to show the extent of the use of the sign (§ 35).

The EUTM proprietor submitted evidence that shows the extent of sales not only of plastic bags and plastic films but also of other goods and services, such as bin bags, laundry bags, urns, pellets, plastic films, wads for cartridges, film tubes and resins, and design, development and testing services (§ 36).

The evidence submitted is objective even though it was issued by the EUTM proprietor itself. In particular, the invoices show that goods bearing the contested mark were sold both inside and outside the EU, and the documents are intended for third parties. Consequently, these documents are capable of serving as evidence of genuine use of a mark without the need for authentication (§ 37).

The evidence provided in the context of revocation proceedings is valid insofar as it allows clear inferences to be drawn as to the criteria provided for in Article 10(3) EUTMDR, including the extent of use. The advertising and sponsorship material, and the advertisements which appeared in two of the major national newspapers suffice for the purpose of corroborating that the goods covered by the

contested mark were placed on the market and sufficiently marketed (§ 40).

The analysis carried out by the BoA of the extent of genuine use of the contested mark does not concern, individually, each class of goods and services designated by that mark. However, the BoA was solely required to assess whether the mark at issue had been put to effective and sufficient use in connection with the goods and services identified in the evidence submitted. Therefore, the BoA was free, in the context of the analysis relating to the nature of the use, to carry out an assessment of the specific classification of such goods and services in accordance with the Nice Agreement, and the correspondence thereof with the goods and services covered by the contested mark (§ 41-42).

Regarding the nature of the use: the large number of invoices issued by the EUTM proprietor to different clients shows that the use of the contested mark took place publicly and outwardly (§ 45).

As regards the Class 17 goods covered by the contested mark, Class 17 includes a range of goods defined and identified on the basis, first, of their basic material, in particular plastic, and, secondly, their semi-processed state (§ 50-51). Therefore, according to the evidence submitted, the BoA was

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right to conclude that genuine use had been duly shown for the goods in Class 17 (§ 52).

As regards the Class 20 goods, the BoA was wrong in considering that genuine use of the contested mark had been shown (§ 59). In fact, most of the goods that were proven to have been marketed are not classified in Class 20, bearing in mind that the explanatory note to the Nice Agreement clarifies that Class 20 'includes mainly ... plastic goods, not included in other classes' (§ 55).

With respect to the plastic goods which are not included in other classes, as is the case with urns, the sale of these goods cannot constitute proof of genuine use with respect to a category as broad as articles made of plastics or goods of water-soluble, biodegradable and compostable plastic (§ 56). The requirement for proof of genuine use seeks to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services (§ 57).

In the present case, since there are almost no articles which cannot be made out of plastic, the BoA should have divided the goods in Class 20 designated by the contested mark into subcategories and carried

out a separate analysis of the evidence provided in relation to each of those subcategories (§ 58).

As regards the services in Classes 40 and 42, the complaint must be rejected as inadmissible (§ 60).

On the assessment of the use of the contested mark in the form in which it was registered. The BoA was right in considering that the contested mark was used in a form which did not alter its distinctive character (§ 70).

The contested mark was used in a form including further elements, such as 'solutions and products', 'plásticos Hidrosolubles s.l.', sometimes preceded by the preposition 'by', and the inversion of the colours of the figurative mark. However, such elements are only minor additions to the dominant element 'green cycles', for which the distinctive character is not affected in any way. The variations, such as the size of the figurative element and the inversion of the colours of the contested mark, are merely decorative considering their position within the configuration of the contested mark (§ 68-69).

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On the assessment of the use of the contested mark as a trade mark. The BoA was right to consider that the evidence submitted proved the use of the contested sign as a trade mark and not only as a company name (§ 80).

The presence of the contested mark on the invoices, articles and advertisements relating to the EUTM proprietor's goods and services is capable of establishing that connection. Even if, in principle, a mark may not be affixed to goods and services, it is apparent from the evidence of use provided that the consumers of the categories of goods or services concerned would easily understand that the contested mark indicates the origin of the services provided and invoiced (§ 77-78).

Moreover, the EUTM proprietor's company name is 'Plásticos Hidrosolubles SL', whereas the contested mark is green cycles (§ 79).

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28/04/2020, R 1636/2019-2, MOTION OF A FLOWING CIRCULAR BLUE RING (Motion Mark)
Motion mark – Distinctive element – Article 7(1)(b) EUTMR – Decision confirmed –Application rejected.

The applicant sought to register the sign as a motion mark consisting of a flowing circular blue ring element, claiming the colour blue. However, in light of the fact that the movement represented by the mark was unremarkable and of a banal nature, the examiner rejected the application on the basis of Article 7(1)(b) EUTMR.

The Board confirms that the sign does not contain the required level of distinctiveness in order for it to function as a trade mark. The sign applied for consists of two colours ascending synchronously, both clockwise and counter clockwise, from the 6 o'clock position up to a full circle. Firstly, the Board notes that the motion mark is treated with the same principles as a figurative mark, as basically it is a fluent sequence of two-dimensional pictures. Also, the sign is not a mere circle, since its nature refers to the flowing motion. From this perspective, the Board indicates that the motion itself, in comparison to the resulting shape, impacts only to a limited degree on the perception of the public and, at any



rate, cannot be considered distinctive. Moreover, in light of the fact that most of the goods and services applied for, relate to electronic devices or software, the flowing motion of the sign does not provide the mark with distinctiveness, as similar motions in marks are immediately perceived by the public as being associated with such a function.

21/05/2020, R 2721/2019-4, SONIDO

Sound mark – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed –Application rejected

EUTM application



The applicant sought to register a sound mark by submitting an MP3 file to the Office. Its sound was found to be too short and non-distinctive by the examiner who rejected the application on the basis of Article 7(1)(b) EUTMR.

[Download sound file](#)

The Board agrees with the examiner's opinion and confirms the decision. The goods specified in Classes 9, 16, 35, 41 deal with education and

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training. The sign applied for consists of a sequence of electronically generated (synthetic) sounds that last 2-3 seconds. It is a sequence of different tones merged within a chord, that starts with several short tones which change into a longer and louder one. The Board notes that the sound is short, has no recognisable structure and, as such, cannot be perceived by the public as an identification of origin. Moreover, regarding the scientific and technical report submitted by the applicant, the Board notes that the small number, and the young age, of the participants on whom the report is based, cannot represent the EU's population. However, there is little scientific evidence to support the idea that the sound mark at hand when continuously associated with goods and services of the applicant (a university), such as teaching videos, could acquire distinctiveness; in other words, acquire distinctiveness through use. However, a claim based on Article 7(3) EUTMR was not submitted by the applicant, and as a result the decision is confirmed and the application is rejected.

08/04/2020, R 2409/2019-5, black FOREST

EUTM application

black FOREST



Word Mark – Geographical Origin – Article 7(1)(c) EUTMR – Decision Confirmed – EUTM Cancelled

The application for a declaration of invalidity was accepted for all the goods applied for in Class 25 (clothing). The Cancellation Division found that the relevant public would establish a link between the goods in Class 25 and the term 'black FOREST' which would be perceived as a descriptive indication of geographical origin.

The Board confirms the decision. The contested mark consists of the words 'black FOREST', which are associated with the popular region of the Black Forest in south-west Germany. Based on the documents submitted, it is a large German mountain range which extends over a wide area. The Board notes that Article 7(1)(c)EUTMR does not, in principle, preclude the registration of geographical names that are not known in the trade circles involved and that not every geographical indication acts as an indication of origin. However, it is emphasised that the relevant English-speaking public will associate the mark with the region of the Black Forest. In light of the above, after examining if the specific geographical indication could be associated with the goods applied for (clothing), the Board concludes that there is a sufficient connection between the geographical region of the Black Forest and the goods, based on the fact that the relevant public will perceive the term 'black FOREST' as a descriptive indication of geographical origin, the decision is confirmed and the EUTM is cancelled.

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12/05/2020, R 2210/2019-5, XI FENG (fig.) / DEVICE OF THREE CHINESE CHARACTERS (fig.)

Figurative Mark – Dominant Element – Article 8(1)(b) EUTMR – Decision Annulled – EUTM Cancelled

The application for a declaration of invalidity, based on Article 60(1)(a) EUTMR, was rejected, namely for goods in Class 33 (alcoholic beverages etc.), because

Earlier protected sign



Contested sign



beverages'. As far as the signs are concerned, they are both figurative. The Chinese elements in both marks possess a lower than average level of distinctive character, since the relevant public will not be able to verbalise them. Hence, the Board focuses on the circular element, comprising a highly stylised phoenix, depicted in both signs. Visually, the marks are considered similar to an average degree as the circular element differs only in colour, while the first two Chinese characters of the contested sign are also present in the earlier mark. A phonetic comparison cannot be carried out since the earlier mark does not contain any word elements. The Board also notes that considering the many visual similarities, the two marks should be considered similar at least to an averagedegree. As such, due to the fact that the circular figurative element of the earlier mark is clearly depicted in the contested sign, only differing in colour, the Board cannot exclude the possibility of the relevant public perceiving the two marks as originating from the same undertaking. As a result, the decision is annulled and the EUTM is cancelled.

no likelihood of confusion was found between the two marks.

The Board notes that the contested goods must be considered identical to the earlier goods, as both lists contain similar goods such as 'alcoholic

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