

Alicante News

Up to date information on IP and EUIPO-related matters

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EUIPO Strategic Plan 2025 approved by Management Board

On 20 November 2019 the new Strategic Plan 2025 (SP2025) of EUIPO was approved by the Management Board of the Office with the unanimous support of the member states and the Commission and will therefore begin its implementation period on 1 July 2020.

The SP2025 has as its core the delivery of 'IP value for businesses and citizens in Europe' through three Strategic Drivers that unite the Office and its stakeholders around a common purpose.

The three Strategic Drivers (SDs) will:

- further develop an interconnected, efficient and reliable IP System for the Internal Market (SD1);
- focus on more customer-centric services (SD2);
- move the Office towards a more innovative workplace while developing the organisational skillsets required to do so (SD3).

Within these Strategic Drivers, the EUIPO will also launch new projects to be rolled out through the Office's subsequent Annual Work Programmes, which implement the Strategic Plan. A new set of European Cooperation projects (ECPs) have also been approved to run alongside the SP2025.



SP2025 underwent [two consultations](#). The first consultation, which aimed at collecting feedback and ideas from stakeholders, ran from December 2018 to February 2019.

The second consultation was launched on 25 June 2019 and ran for a period of 12 weeks. The European Commission was consulted on the SP2025, and it was also presented to [the JURI committee of the European Parliament](#).

The SP2025 represents a new phase in the Office's work, and further highlights the dedication and efforts of all involved.

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Argentina joins TMclass, Peru joins DesignClass

As of 04 November 2019, the [National Institute of Industrial Property of Argentina](#) (INPI) joined [TMclass](#), and will use and accept the list of terms from the harmonised database (HDB) within the tool.

In addition, the [National Institute for the Defense of Free Competition and the Protection of Intellectual Property of Peru](#) (INDECOPI) has joined [DesignClass](#) and will use and accept the list of terms from the harmonised database of product indications (HDBPI).

Both become the seventh non-EU offices to use the harmonised databases for trade mark and design terms.

TMclass offers users the opportunity to search and translate goods and services to and from any of the 44 languages available. In DesignClass users can search and translate product indications in 27 languages.



European Cooperation: the Estonian Patent Office digitises 55,000 dossiers

The Estonian Patent Office ([EPA](#)) has implemented the European Cooperation project 'ECP5: Capture and Store Historical Files'.

The project, carried out with the support of the EUIPO's European Cooperation Projects, aims to digitise paper files across the EU's intellectual property offices to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

Over 55,000 dossiers have been digitised and information from more than 2,000 decisions captured. The Estonian implementation started in April 2019 and was completed on 11 November 2019, two months ahead of schedule.

The EPA is the fifth office to implement the project. With another three offices in progress, the total number of digitised dossiers has now reached 400,000.

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

In total, the EUIPO and its stakeholders are collaborating on five major [European Cooperation Projects](#), which aim to benefit users across the EU by providing modern, state-of-the-art tools and services for intellectual property offices.

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Check it out: quality control of absolute ground decisions is now even more efficient

The EUIPO has introduced a new approach to determine the quality assurance of EUTM decisions on absolute grounds. As from September 2019, the EUIPO's back-office systems have a new internal quality check (IQC) workflow for EUTM decisions on absolute grounds.

The quality assurance process has been improved so that all decisions where the IQC is triggered are now checked before the product is delivered to the user, namely, decisions to accept or refuse an EUTM on absolute grounds. The new workflow allows the EUIPO to identify and correct errors and to deliver a high quality product. It also serves to monitor absolute grounds examination and the application of the regulations and Guidelines. The implementation contributes to a more user-friendly process and to an efficiency gain in the area of IQC on absolute grounds.

Prior to September, decisions to accept EUTMs on absolute grounds were checked only after the EUTM had been accepted for publication. Decisions to refuse EUTMs on absolute grounds, however, have been checked before their notification to users since 2018.



Quality has always been a major priority for the EUIPO. It expresses the continuous commitment to improve and to provide better services to users. Implementing the new workflow will help close the gap between the users' and the Office's perception of quality.

This initiative is a result of user feedback. It was inspired by the outcome of discussions held at the stakeholder quality assurance panel (SQAP) audits and by general feedback from internal and external users on quality in this particular area.

Public consultation on the evaluation of GIs, PDOs, PGIs and TSGs

The European Union protects more than 3 000 names of specific products through its EU quality schemes: Geographical Indication (GI); Protected Designations of Origin (PDO); Protected Geographical Indication (PGI); and Traditional Specialty Guaranteed (TSG).

The European Commission has launched a public consultation aimed at receiving feedback on public understanding and opinion of these quality schemes. The consultation runs until **27 January 2020**, and is open to all interested parties, including consumers.

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The consultation contributes to the objectives of the evaluation of the overall functioning of the EU quality schemes, with a focus on the registered names from Member States and third countries sold in the EU internal market.

The questionnaire is available in all EU languages. It can be accessed via [the European Commission web page dedicated to the evaluation](#) or [directly through the consultation page](#).

Strengthening cooperation in the fight against IP crime

The EU's law enforcement agency [Europol](#) and the European Union Intellectual Property Office (EUIPO) have today formally signed an agreement to further increase their cooperation in fighting infringements of intellectual property rights, both online and offline.

Europol and the EUIPO have been collaborating since 2013 on a range of issues. In 2016, they stepped up their cooperation to create the [Intellectual Property Crime Coordinated Coalition](#) (IPC3), a specialist unit within Europol funded by the EUIPO.

Since its inception, the IPC3 unit has coordinated and supported cross-border operations aimed at tackling IP crime across the EU. The unit's operations have spanned sectors such as pharmaceuticals,



food and drinks, pesticides, counterfeit luxury goods, clothing, electronics, car parts, toys and illegal streaming. In total, counterfeit goods valued at over EUR 980 million have been seized.

In addition, over a hundred organised crime gangs have been identified and/or dismantled as a result of the unit's work. The investigations coordinated by the IPC3 unit have also linked IP crime to the health and safety of consumers, drug trafficking, tax evasion, fraud and terror financing.

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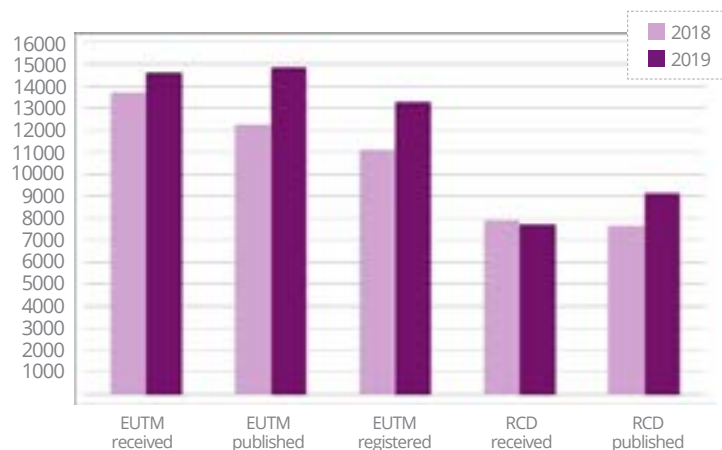


Statistical Highlights



Monthly statistical highlights October*	2018	2019
European Union Trade Mark applications received	13 711	14 607
European Union Trade Mark applications published	12 252	14 819
European Union Trade Marks registered (certificates issued)	11 107	13 253
Registered Community Designs received	7 880	7 685
Registered Community Designs published	7 680	9145

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



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

T 533/18; WANDA FILMS / WANDA; Wanda Films et al. v EUIPO; Judgment of 3 October 2019; EU:T:2019:727; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Likelihood of confusion

FACTS:

The applicant sought to register the word sign WANDA FILMS as an EUTM for goods and services in Classes 9 and 41.

An opposition based on the earlier EU word mark WANDA, registered for goods and services in Classes 9 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division upheld the opposition finding that there was a likelihood of confusion.

The applicant filed an appeal, which the Board of Appeal (BoA) dismissed. It found that the goods and services were identical, the relevant public would have a degree of attention ranging from



average to higher than average, the signs at issue were similar to at least an average degree and that, consequently, there was a likelihood of confusion between the signs.

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

SUBSTANCE:

ADMISSIBILITY — LOCUS STANDI.

The action introduced by two applicants is not inadmissible insofar as the second applicant was neither an applicant for the mark applied for nor a party to the administrative proceedings before the Office. Where admissibility must be established for one and the same application lodged by a number of applicants and the application is admissible in respect of one of them, there is no need to consider whether the other applicants are entitled to bring proceedings (24/03/1993, C 313/90, CIRFS and Others v Commission, EU:C:1993:111, § 31 and 21/04/2010, T 361/08, Thai silk, EU:T:2010:152, § 35 and 36) (paras 17-19).

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

The relevant public is composed of the general public and business clients with specific professional experience or knowledge (not disputed). The level of attention varies from average to higher than average (para. 30).

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The goods and services are identical (not disputed) (para. 37).

The signs are visually similar to an average degree since they contain the common word element 'wanda'. Although the signs differ in the word element 'films', present only in the mark applied for, where one mark consists exclusively of an earlier mark to which another word has been added, it is considered that the two trade marks are similar (para. 41).

The signs are phonetically similar to an average degree since they contain a common word element, which is pronounced identically. As the earlier mark is composed of two syllables, while the mark applied for is composed of three syllables, the similarities between the earlier mark and the initial part of the mark applied for outweigh the differences resulting from the presence of the element 'films' in the mark applied for (para. 42).

The signs are conceptually similar to an average degree. The common word element 'wanda' will be perceived, at least by part of the relevant public, as designating a female first name and is not devoid of distinctive character. As the word element 'films', present only in the sign applied for, may be descriptive for a large part of the relevant goods and services, it has weak distinctive character. It is thus not possible to establish a significant conceptual difference between the two signs (para. 43).

Thus, the signs are, on the whole, similar to at least an average degree (not disputed) (para. 44).

Given the high similarity between the goods and services and the at least average similarity between the signs, there is a likelihood of confusion on the part of the public, despite the fact that its level of attention may be higher than average, as it may believe that the goods and services designated by the marks come from the same undertaking or, at the very least, from affiliated undertakings (paras 47, 48 and 53).

T-542/18; WANDA FILMS (fig.) / WANDA; Wanda Films et al. v EUIPO; Judgment of 3 October 2019; EU:T:2019:728; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Likelihood of confusion

FACTS:

The applicant sought to register the figurative sign WANDA FILMS as an EUTM for goods and services in Classes 9 and 41.

An opposition based on the earlier EU word mark WANDA, registered for goods and services in Classes 9 and 41, was filed pursuant to Article 8(1)

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(b) EUTMR. The Opposition Division upheld the opposition finding that there was a likelihood of confusion.

The applicant filed an appeal, which the Board of Appeal (BoA) dismissed. It found that the goods and services were identical, the relevant public would have a degree of attention ranging from average to higher than average, the signs at issue were similar to at least an average degree and that, consequently, there was a likelihood of confusion between the signs.

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

EUTM application



Earlier trade mark



SUBSTANCE:

ADMISSIBILITY — LOCUS STANDI.

The action introduced by two applicants is not inadmissible insofar as the second applicant was



neither an applicant for the mark applied for nor a party to the administrative proceedings before the Office. Where admissibility must be established for one and the same application lodged by a number of applicants and the application is admissible in respect of one of them, there is no need to consider whether the other applicants are entitled to bring proceedings (24/03/1993, C 313/90, CIRFS and Others v Commission, EU:C:1993:111, § 31 and 21/04/2010, T 361/08, Thai silk, EU:T:2010:152, § 35 and 36) (paras 17-19).

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

The relevant public is composed of the general public and business clients with specific professional experience or knowledge (not disputed). The level of attention varies from average to higher than average (para. 30).

The goods and services are identical (not disputed) (para. 37).

The signs are visually similar to an average degree since they contain the common word element 'wanda'. Although the signs differ in the word element 'films' and in the figurative elements, which are present only in the mark applied for, where one mark consists exclusively of an earlier mark to which another word has been added, it is considered that the two trade marks are similar. Moreover, the figurative element of a dotted line, present only in

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the mark applied for, has weak distinctive character (para. 41).

The signs are phonetically similar to an average degree since they contain a common word element, which is pronounced identically. As the earlier mark is composed of two syllables, while the mark applied for is composed of three syllables, the similarities between the earlier mark and the initial part of the mark applied for outweigh the differences resulting from the presence of the element 'films' in the mark applied for (para. 42).

The signs are conceptually similar to an average degree. The common word element 'wanda' will be perceived, at least by part of the relevant public, as designating a female first name and is not devoid of distinctive character. As the word element 'films', present only in the sign applied for, may be descriptive for a large part of the relevant goods and services, it has weak distinctive character. It is thus not possible to establish a significant conceptual difference between the two signs (para. 43).

Thus, the signs are, on the whole, similar to at least an average degree (not disputed) (para. 44).

Given the high similarity between the goods and services and the at least average similarity between the signs, there is a likelihood of confusion on the part of the public, despite the fact that its level of attention may be higher than average, as it may



believe that the goods and services designated by the marks come from the same undertaking or, at the very least, from affiliated undertakings (paras 47, 48 and 53).

T-686/18; LEGALCAREERS (fig.); LegalCareers v EUIPO; Judgment of 3 October 2019; EU:T:2019:722; Language of the case: DE

RESULT:

Action dismissed

KEYWORDS:

Descriptive, Lack of reasoning

FACTS:

The applicant sought to register the figurative sign 'LEGALCAREERS' as an EUTM for goods and services in Classes 16, 35, 41 and 45.

The Office refused to register the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was descriptive and devoid of distinctive character.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. The sign was considered descriptive as it indicates that the goods and services are related to an employment placement in the legal field. The figurative element was considered too weak to counterbalance the overall impression of descriptiveness. The sign was also held to be devoid

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of distinctive character due to the combination of a purely descriptive indication and a non-distinctive figurative element.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 94(1) EUTMR. The GC dismissed the action.

EUTM application



SUBSTANCE:

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

The goods in Class 16 and some of the services in Class 41 target the general English-speaking public (not disputed). The other services from Class 41 and the services in Classes 35 and 45 target specialists in the legal and economic sectors (para. 16).

The sign is composed of two verbal elements, 'legal' and 'careers', and its meaning refers to 'a successful professional advancement in the legal field' (para. 19). Thus, the relevant public will perceive these



services as enabling a 'successful progression in the legal sector' (para. 30). The applicant did not provide concrete evidence proving that the sign is not descriptive (para. 32).

The sign is descriptive for all the goods and services applied for, which, in the absence of any specific limitation by the EUTM applicant, includes goods relating to the legal sector (para. 36). The figurative element does not add any original character that would call into question the descriptive nature of the mark (paras 38-44).

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

Since one of the absolute grounds of refusal is sufficient for the refusal of the application, the second plea in law is not examined (paras 50-53).

(iii) INFRINGEMENT OF ARTICLE 94(1) EUTMR

The BoA did not infringe the obligation under Article 94(1) EUTMR to state reasons and explained in detail the reasons that led it to consider the mark as descriptive.

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T-500/18; MG PUMA / GINMG (fig.) et al.; Puma v EUIPO; Judgment of 3 October 2019; EU:T:2019:721; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Likelihood of confusion

FACTS:

The applicant sought to register the word mark MG PUMA as an EUTM for goods and services in Classes 32 and 33.

An opposition based on the earlier EU figurative mark GINMG, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition.

The applicant appealed, which the Board of Appeal (BoA) dismissed. The BoA found that the goods were identical and that the marks had a low degree of visual and phonetic similarity and concluded likelihood of confusion.

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



EUTM Application

MG PUMA

Earlier trade mark

GINMG

SUBSTANCE:

The relevant public consists of the English-speaking general public of the European Union. The level of attention of the consumers is average (not disputed) (paras 23 and 44). The goods are identical (not disputed) (paras 11 and 44).

The letters 'mg' in the marks have an average degree of distinctiveness as it was not established that they had any meaning for the relevant public (paras 25-26). The word 'puma' has an average degree of distinctiveness (para. 27). Although that word contains more letters than the element 'mg', including vowels (which may influence the phonetic perception of the mark applied for) the letters 'mg' are the first element of the mark applied for and for that reason, the public will pay particular attention to them (para. 27). The applicant did not provide

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any evidence to support its claim that the word 'puma' has enhanced distinctive character, resulting from the reputation of the applicant and the 'PUMA trade marks' (para. 27). Thus, the letters 'mg' will be considered as important as the word 'puma' in the relevant public's perception of the mark applied for (para. 28).

As regards the earlier mark, the relevant public when perceiving the word sign will break it down into elements which, for that public, suggest a concrete meaning or which resemble words it is already familiar with (para. 29).

The word 'gin' is, in English, the name of an alcoholic beverage to which the description of the goods covered by the earlier mark expressly refers. The relevant public thus draws a distinction between the word 'gin' in the earlier mark and the letters 'mg' of that mark, despite there being no gap between that word and those letters. The word 'gin' also has descriptive character (para. 30).

The figurative elements are, in principle, more distinctive than the word elements of a trade mark, because the relevant public will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (para. 33). The applicant does not provide any arguments or evidence which call into question the BoA's conclusion that the figurative elements are purely decorative, with the result that the letters 'mg'



must therefore be regarded as the most distinctive element of the earlier mark (para. 35).

Consequently, the fact that the letters 'mg' are present in both marks is sufficient to establish the existence of phonetic and visual similarity between them, notwithstanding the fact that the position of these letters differs in the marks. There is thus likelihood of confusion (para. 44).

T-713/18; ESIM Chemicals / ESKIM; Esim Chemicals v EUIPO; Judgment of 9 October 2019; ECLI:EU:T:2019:744; Language of the case: EN

RESULT:
Action dismissed

KEYWORDS:
Substantial procedural violation

FACTS:
The applicant sought to register the word sign ESIM Chemicals for goods in Classes 1, 5, 31 and 42.

An opposition based on the earlier Italian word mark ESKIM registered for goods in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. On 3 May 2018, the Opposition Division upheld the opposition in part on account of a likelihood of confusion (LOC) with the earlier trade mark in respect of the goods in Class 5.

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On 2 July 2018, the applicant filed an appeal. On 20 July 2018, the Registry of the Board of Appeal (BoA) informed the applicant that the EUR 720 appeal fee had not been received by the Office until 13 July 2018, after the expiry (on 9 July 2018) of the 2 month appeal period during which that fee should have been paid according to Article 68(1) EUTMR.

Nevertheless, the Registry informed the applicant that the period for payment of the fee would be considered to have been observed if the applicant were to provide evidence by 20 August 2018 of having paid the fee or having given an order to a banking establishment to transfer the amount of the payment of the fee before the period for payment expired (Article 180(3) EUTMR). Moreover, the Registry informed the applicant that if it had made the payment within the last 10 days of the appeal period, it would also be required to pay a 10 % surcharge of the appeal fee and provide proof of that additional payment within 1 month (Article 180(4) EUTMR).

On 6 August 2018, the applicant provided proof of payment of the 10 % surcharge. On the same day, the applicant filed a statement setting out the grounds for its appeal. On 3 September 2018, the Office acknowledged receipt of the proof of payment of the 10 % surcharge and of the statement setting out the grounds of appeal.



By decision of 2 October 2018, the BoA found that the appeal was deemed not to have been filed and ordered that the appeal fee and the 10 % surcharge be refunded to the applicant.

The applicant filed an action before the General Court (GC) against the decision of 2 October 2018, relying on a single plea in law: infringement of Article 68 EUTMR. The GC dismissed the action.

SUBSTANCE:
INFRINGEMENT OF ARTICLE 68 EUTMR.

The notice of appeal to be filed in writing within 2 months of the date of notification of the contested decision is deemed to have been filed only when the fee for appeal has been paid (Article 68 EUTMR) (para. 25).

The date on which the payment is considered to have been made is the date on which the amount of the payment or transfer is actually credited to a bank account held by the Office (Article 180(1) EUTMR).

The time limit for filing the appeal and, consequently, for payment of the appeal fee was 9 July 2018. The Office did not receive payment of that fee until 13 July 2018 (not disputed). Consequently, the applicant did not comply with the period prescribed for payment of that fee (para. 28).

The applicant did not provide any evidence to

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substantiate its claim that an order to transfer the payment was given on 9 July 2018 (Article 180(3) EUTMR). Proof of payment of the 10 % surcharge of the appeal fee is, from that point of view, irrelevant, since payment of the appeal fee itself was not made within the prescribed period (para. 30).

The BoA was thus entitled to consider that the appeal fee had not been paid within the period provided for in Article 68 EUTMR and that the appeal was deemed not to have been filed (Article 23(3) EUTMR).

T-536/18; FITNESS; Société des produits Nestlé v EUIPO; Judgment of 10 October 2019; EU:T:2019:737; Language of the case: EN

RESULT:

Action upheld (decision annulled)

KEYWORDS: Belated evidence, Lack of reasoning, New submission on appeal, Remittal from GC/ECJ, Scope of proceedings

FACTS:

The proprietor registered the word sign FITNESS as an EUTM for goods Classes 29, 30 and 32.

An invalidity application was filed pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) CTMR and Article 7(1)(c) CTMR. The Cancellation



Division (CD) rejected the invalidity application.

The invalidity applicant filed an appeal. During the appeal proceedings before the Board of Appeal (BoA), the invalidity applicant submitted further evidence in support of its claim that the term 'fitness' had a descriptive content. The BoA dismissed the appeal. In particular, it rejected the evidence submitted for the first time before it as belated.

The invalidity applicant filed an action against this decision (earlier decision) before the General Court (GC). By judgment of 28 September 2016 ('the annulment judgment'), the GC annulled the earlier decision. It held, in particular, that Article 76 CTMR, did not imply that evidence submitted for the first time before the BoA had to be regarded as belated in invalidity proceedings based on an absolute ground for refusal. The GC held that the BoA had erred in law when it had decided not to take the evidence produced by the invalidity applicant for the first time before it into consideration because of its late submission (28/09/2016, T 476/15, FITNESS, EU:T:2016:568, §§ 58 and 66).

The judgment was confirmed by the Court of Justice (CJ) that held that evidence submitted for the first time before the BoA should not be considered out of time in all circumstances. The BoA was entitled to use its discretion under Article 76(2) CTMR, however, in considering that the evidence submitted by the invalidity applicant for the first time before it did

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not have to be taken into account because of its late submission, the BoA had made an error of law (24/01/2018, C 634/16 P, FITNESS, EU:C:2018:30, §§ 45 and 53).

Subsequently, by decision of 6 June 2018 ('the contested decision') the BoA annulled the CD's decision. The BoA followed from the judgment on appeal and the annulment judgment that it had to examine the appeal before it, taking into account the evidence that had been filed for the first time before it during the proceedings which led to the earlier decision (§ 25 of the contested decision). In the light, inter alia, of the evidence which had been submitted by the invalidity applicant before the BoA, the BoA declared the contested mark invalid pursuant to Article 7(1)(b) and (c) CTMR.

The proprietor filed an action before the GC, relying on four pleas in law: (i) infringement of Article 65(6) CTMR, (ii) infringement of Article 76(2) CTMR (iii) infringement of Article 7(1)(c) CTMR and (iv) infringement of Article 7(1)(b) CTMR.

In essence, it submits, first, that the Office did not take the necessary measures to comply with the judgment on appeal and the annulment judgment and that, by acting in that way, it failed to exercise its discretion and comply with its obligation to state reasons and, secondly, that the contested mark is not descriptive and has the requisite distinctive character. The GC upheld the action based on the first plea and annulled the contested decision.



SUBSTANCE:

(i) AND (ii) INFRINGEMENT OF ARTICLE 65(6) CTMR AND ARTICLE 76(2) CTMR

The Office's decisions must state the reasons on which they are based, Article 75 CTMR. The purpose of this obligation is, first, to inform those concerned of the reasons for the measure adopted, to enable them to defend their rights and, secondly, to enable the EU judicature to exercise its power to review the legality of the decision (para. 37)

Where an institution has discretion, it must exercise that discretion fully (14/07/2011, T 357/02 RENV, Freistaat Sachsen v Commission, EU:T:2011:376, § 45). Thus, the institution which has adopted the measure must be able to show that in adopting that measure it actually exercised its discretion, which presupposes the taking into consideration of all the relevant factors and circumstances of the situation the measure was intended to regulate (07/09/2006, C 310/04, Spain v Council, EU:C:2006:521, § 122) (para. 38).

In the present case, it is clear from paragraph 25 of the contested decision that the BoA took the view that it followed from the judgment on appeal and the annulment judgment that the evidence filed for the first time before the BoA had to be taken into account. However, it does not follow either from the judgment on appeal or the annulment judgment that the BoA was required to take the evidence into consideration (paras 39 and 41-43).

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The BoA had erred in law in finding that the evidence produced before it for the first time was not to be taken into consideration because of its late submission (para. 40). It was not inconceivable that the evidence that was wrongly refused might be such as to modify the substance of the earlier decision (para. 41).

Evidence submitted in due time for the first time before the BoA in invalidity proceedings, which is either evidence supplementary to that submitted in the proceedings before the CD, or evidence on a new matter which could not be raised during those proceedings, is not automatically admissible. It is for the party presenting that evidence to justify why the evidence has been submitted at that stage of the proceedings and to demonstrate that submission during the proceedings before the CD was impossible. Accordingly, it is for the BoA to assess the merits of the reasons put forward by the party which has submitted the evidence in order to exercise its discretion as to whether or not it should be taken into account (para. 44).

The BoA erroneously found that it followed from the judgment on appeal and the annulment judgment that it was required to take the evidence into account. Therefore, the BoA infringed Article 65(6) CTMR and failed to comply with its obligation to exercise its discretion and its obligation to state reasons on which its decision, as regards the taking into account of that evidence, was based (paras 47-48).



Consequently, the contested decision is therefore annulled, without it being necessary to rule on the third and fourth pleas in law (para. 50).

T-428/18; mc dreams hotels Träumen zum kleinen Preis! (fig.) / Mc DONALD'S et al.; McDreams Hotel v EUIPO; Judgment of 10 October 2019; EU:T:2019:738; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Reputation, Similarity of the goods and services, Similarity of the signs, Unfair advantage

FACTS:

The applicant sought to register the figurative sign mc dreams hotels Träumen zum kleinen Preis! for services in Class 43, notably 'providing temporary accommodation'.

An opposition based on several earlier EU word marks, such as McDONALD'S, McMISSION, McINTERNET, McCOMPASS, BIG MAC, McBITE, registered for goods and services in Classes 9, 25, 28 to 32, 35, 38, 41 to 43, was filed pursuant to Article 8(1)(b) CTMR and Article 8(5) CTMR. Reputation was claimed for the EU word mark

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McDONALD'S in respect of the goods in Classes 29, 30 and 32, as well as the services in Class 42, [now Class 43], corresponding to the following description: services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation and provision of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others. The Opposition Division (OD) rejected the opposition.

The opponent filed an appeal. The Board of Appeal (BoA) upheld the appeal. Although it concluded, as did the OD, that there was no likelihood of confusion between the marks within the meaning of Article 8(1)(b) EUTMR, it considered that all the conditions for the application of Article 8(5) EUTMR were fulfilled.

The BoA found that the earlier word mark McDONALD'S had a reputation, in particular, in respect of fast-food restaurant services in Class 43. It also noted that the opponent owned a family of marks in relation to fast-food establishments that



was defined by the prefix 'mc'. It added that that prefix had acquired a high degree of distinctive character through use on the fast-food market when combined with a generic term denoting food.

On the basis of the earlier mark's outstanding reputation, particularly for fast-food restaurant services, and the certain degree of similarity between the marks and the services, the BoA concluded that the unfair advantage taken by the mark applied for of the earlier mark's repute lay in the fact that the relevant public could be attracted by the mark applied for, which reproduces the structure of the earlier mark and the marks belonging to the intervener's family of marks, which would lead that public to purchase the services marketed by the applicant.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR (plea withdrawn at the oral hearing) and (ii) Article 8(5) EUTMR. The GC dismissed the action.

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EUTM application



Earlier trade mark

Mc DONALD'S, McMISSION,
McINTERNET, McCOMPASS, McFAMILY,
McCAFE, McWRAP, BIG MAC, McRIB,
McMUFFIN, McDOUBLE, McBITES,
McCOUNTRY, McTOAST, McFISH, Mc

SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(5) EUTMR

The relevant public consists of the public at large in the European Union with an average level of attention (not disputed) (para. 36).

SIMILARITY OF THE SIGNS

Despite the numerous elements that are specific to the mark applied for, there is a low degree of visual similarity between the two marks on account of the presence of the prefix 'mc' (paras 45-47, 49 and 54).



The signs are phonetically similar to an average degree (not disputed) (para. 60). The element 'mc' is perceived by the English-speaking part of the relevant public as the prefix of a Gaelic surname, which might further be identified as meaning 'son of', but that that element carried no particular meaning for the rest of the relevant public. Bearing in mind the dominance of the element 'mc dreams' in the mark applied for, there is a low degree of conceptual similarity between the marks (not disputed) (paras 48, 55 and 61-62). Thus, there is a low degree of overall similarity between the two marks (para. 63).

THE OPONENT'S FAMILY OF MARKS

The opponent holds a family of marks, linked to the fast-food sector, which share a structure composed of the prefix 'mc' followed by the generic name, in English, of a food or a descriptive characteristic of a foodstuff (not disputed) (para. 68). The fact that the prefix 'mc' is used in marks other than those held by the opponent does not serve to establish that that prefix is devoid of distinctive character (para. 70). The prefix 'mc' has acquired a high degree of distinctiveness through its use on the fast-food market (para. 71).

Although the word 'dreams' is not the generic name of a foodstuff product or a descriptive characteristic of a foodstuff product, the structure of the element 'mc dreams' — as the dominant element in the mark applied for — is, at least in part, similar to that of

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the opponents' family of marks, since it includes the prefix 'mc' followed by a name in English (para. 74). That common structure, which itself is not decisive for the purposes of determining the existence of a link between the marks, reinforces the likelihood of such a link in the mind of the relevant public (para. 75).

THE SIMILARITY OF THE SERVICES

The services of providing temporary accommodation in respect of which registration is sought may include services providing food and drink for guests (para. 78). All of the services may therefore coincide in the provider and target the same clientele (para. 79). Moreover, the services could be offered through the same distribution channels to the same public by the same undertakings (para. 80). There is thus, at the very least, a significant degree of closeness between those services (para. 82).

THE LINK BETWEEN THE MARKS

Having regard to the exceptional nature of the reputation of the earlier mark (not disputed), the average level of attention of the relevant public, the existence of a degree of similarity between the marks and the significant degree of closeness between the services, as well as the existence of a family of marks, the structure of which is reproduced, at least in part, by the mark applied for, the relevant public would establish a link between the marks, even though the opponent does not offer any form of accommodation or hotel services (para. 85).



UNFAIR ADVANTAGE TAKEN OF THE REPUTATION OF THE EARLIER MARK

The relevant public would associate the mark applied for with the image of reliability, efficiency, low-cost services and, on that account, choose it instead of the services provided by its competitors. The mark applied for would therefore ride on the coat-tails of the earlier mark to benefit from the power of attraction, the reputation and the prestige of that mark. The economic advantage would consist, for the applicant, of exploiting the effort expended by the opponent to establish the reputation and the image of its earlier mark, without paying any compensation in exchange (paras 90 and 98).

T-453/18; OOF (fig.) / OO (fig.) et al.; Alessandro Biasotto v EUIPO; Judgment of 10 October 2019; EU:T:2019:733; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Likelihood of confusion, Similarity of the signs, Visual similarity

FACTS:

The applicant sought to register the figurative mark OOF as an EUTM for goods in Class 25.

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An opposition based on the earlier EU word mark OOFOS registered for goods in Class 25 was filed based on Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal, finding that, in the light of the 'highly similar' nature of the goods and the average degree of visual and phonetic similarity between the marks, which share the sequence of letters 'O-O-F', and taking into account the principles of imperfect recollection and interdependence, there is a likelihood of confusion (LOC) on the part of the relevant public.

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

EUTM application



Earlier right

OOFOS



SUBSTANCE: INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

Relevant public. The relevant public is the general public in the European Union with an average level of attention (not disputed) (para. 17).

Comparison of the signs.

Distinctive and dominant elements of the signs. The verbal element 'OOF' of the mark applied for, which is easily recognisable and identifiable, is the distinctive and, compared with the figurative elements, the dominant element. The bar above each letter 'O' and the use of the colours red and white for the letters 'OO' and 'F' are perceived as secondary decorative elements (para. 26).

Visual similarity. There is an average degree of visual similarity between the signs. The signs share the three-letter sequence 'O-O-F', which appears at the beginning of them and forms the initial part on which the relevant public focus their attention. They differ only in the final part 'O-S' of the earlier sign — which has no equivalent in the sign applied for — and in the stylised aspect of the latter (paras 23, 29 and 36).

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Phonetic similarity. Phonetically the signs are similar to an average degree since their pronunciation coincides in the sequence of letters 'O-O-F', which forms the entirety of the word element of the mark applied for and the first part of the earlier mark. (not disputed) (paras 37 and 43).

Conceptual comparison. Conceptually, the signs have no meaning and will be perceived as fanciful terms by the relevant public. Therefore, a conceptual comparison is not possible and its impact on the comparison of the signs is consequently neutral (not disputed) (para. 45).

Comparison of the goods. The BoA's assessment that the goods are similar, at least to an average degree, is upheld, without it being necessary to rule on whether the goods are similar to a high degree (para. 52). The outcome of the comparison of the goods is by no means irrelevant to the examination of LOC, given that the marks are not different but similar to an average degree (paras 55-56).

Global assessment of LOC. Given the average degree of visual and phonetic similarity and the similarity of the goods, which is average at the very least, and in light of the principles of interdependence and imperfect recollection, there is a LOC on the part of the relevant public (para. 58).



T-454/18; OO (fig.) / OO (fig.); Alessandro Biasotto v EUIPO; Judgment of 10 October 2019; EU:T:2019:735; Language of the case: EN

RESULT:

Action dismissed

KEYWORDS:

Likelihood of confusion, Similarity of the signs, Visual similarity

FACTS:

The applicant sought to register the figurative mark 'OO' as an EUTM for goods in Class 25.

An opposition based on the earlier EU figurative mark 'OO' registered for goods in Class 25 was filed based on Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal, finding that, having regard to the 'highly similar' nature of the goods in question and the average degree of visual similarity and the phonetic identity of the marks, which share the letters 'OO', and taking the imperfect recollection and interdependence principles into account, there is a likelihood of confusion (LOC) on the part of the relevant public.

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

EUTM application



Earlier right



SUBSTANCE:

INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR

Relevant public. The relevant public is the general public in the European Union with an average level of attention (not disputed) (para. 17).

Comparison of the signs.

Distinctive and dominant elements of the signs. The verbal element 'OO' of the mark applied for, which is easily recognisable and identifiable is the distinctive



and, compared with the figurative elements, the dominant element. The bar above each letter 'O' and the use of the colour red for the letters 'OO' are perceived as secondary decorative elements (para. 26).

Visual similarity. There is an average degree of visual similarity between the signs. Both marks consist of the letters 'OO'. However, the shape of the letters 'OO' is not exactly the same, with the earlier mark having more 'almond-shaped or oval' letters than in the mark applied for, which are circular. Nevertheless, the relevant public will perceive both signs immediately and without further reflection as the letters 'OO'. The graphic features of the mark applied for, namely a line above each 'O', an almost standard typeface and the use of the colour red, whilst not insignificant, are not such as to divert the relevant public's attention away from the verbal element 'OO'. The public will more easily remember the verbal element and use it to identify the mark applied for (paras 23, 30-31 and 35).

Phonetic similarity. Phonetically, the pronunciation of the signs coincides, at least in those EU Member States where no diacritical signs are used in the alphabet, such as in the English-speaking ones. Consequently, the signs are phonetically identical (paras 36-37).

Conceptual comparison. Conceptually, the signs

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have no meaning and will be perceived as fanciful terms by the relevant public. Therefore, a conceptual comparison is not possible and its impact on the comparison of the signs is consequently neutral (not disputed) (para. 43).

Comparison of the goods. The BoA's assessment that the goods are similar, at least to an average degree, is upheld, without it being necessary to rule on whether the goods are similar to a high degree (para. 50). The outcome of the comparison of the goods is by no means irrelevant to the examination of LOC, given that the marks at issue are not different but similar to an average degree (paras 54-55).

Global assessment of the LOC. Given the average degree of visual and phonetic similarity and the similarity of the goods, which is average at the very least, and in light of the principles of interdependence and imperfect recollection, there is a LOC on the part of the relevant public (para. 57).

T-279/18; AXICORP ALLIANCE / ALLIANCE et al.; Alliance Pharmaceuticals v EUIPO; Judgment of 17 October 2019; EU:T:2019:752; Language of the case: EN

RESULT:

Action upheld (BoA decision partially annulled)



KEYWORDS:

Evidence of use, Proof of use

FACTS:

The proprietor obtained an international registration designating the European Union for the word mark AXICORP ALLIANCE for goods and services in Classes 3, 5, 10 and 35.

An opposition was filed pursuant to Article 8(1)(b) CTMR, Article 8(4) CTMR and Article 8(5) CTMR based on the earlier EU word mark ALLIANCE and the earlier EU figurative mark 'ALLIANCE', both covering goods in Class 5, as well as the earlier unregistered trade mark ALLIANCE, used in the course of trade for pharmaceutical preparations and substances in the United Kingdom. Upon request, proof of use of the earlier marks was submitted.

The Opposition Division (OD) rejected the opposition on the grounds of lack of evidence of genuine use of the earlier marks.

The opponent filed an appeal. The Board of Appeal (BoA) partially annulled the OD's decision and remitted the case to the OD. The BoA found that the opposition had rightly been rejected insofar as it was based on Article 8(1)(b) and (5) EUTMR.

In this connection, it observed that the specification of those marks, which refers to pharmaceutical preparations but not including infants' and invalids'

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foods and chemical preparations for pharmaceutical purposes was not clear. The BoA and OD interpreted the specification strictly, as excluding not only infants' and invalids' foods but also chemical preparations for pharmaceutical purposes, i.e. those containing chemical substances or synthetic components. The opposition was rejected because the evidence of use submitted referred exclusively to synthetic components.

The opponent filed an action before the General Court (GC), relying on a single plea in law alleging that the BoA construed the specification of the earlier EU trade marks incorrectly, and, thus, concluded that the evidence of use submitted did not show genuine use of the marks. The GC upheld the action.

International registration designating the EU

AXICORP ALLIANCE

Earlier trade marks

ALLIANCE

 **ALLIANCE**

ALLIANCE



SUBSTANCE:

THE INTERPRETATION OF THE SPECIFICATION OF THE EARLIER EU TRADE MARKS

The wording of the specification in English, the language in which the applications for registration of the earlier EU trade marks were filed, may give rise to two possible literal interpretations (para. 36):

(1) In the absence of punctuation, in particular of a semi-colon separating infants' and invalids' foods from chemical preparations for pharmaceutical purposes, or additional information, one possible literal meaning of the specification suggests that both infants' and invalids' foods and chemical preparations for pharmaceutical purposes are covered by the restriction but not including. It is that interpretation which was adopted by the OD and the BoA (para. 37).

(2) However, another possible literal interpretation, suggested by the opponent, does not exclude chemical preparations for pharmaceutical purposes from the specification (para. 38). That possibility was acknowledged by the Office at the hearing. Furthermore, the BoA admitted that interpretations other than that which it had adopted were possible (para. 39). It was only at the stage of the appeal before the BoA that the proprietor contended that the specification did not cover chemical preparations for pharmaceutical purposes and that the opponent had not provided proof of genuine

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use of its marks in connection with pharmaceutical or chemical preparations per se (para. 40).

Although the BoA's interpretation of the wording of the specification, according to which chemical preparations for pharmaceutical purposes are excluded, is possible, this interpretation did not duly take into consideration other factors that are essential for understanding the scope of that specification, namely the actual intention of the proprietor of the marks concerned and the need to give an appropriate scope to that wording, one that precludes a reading leading to an absurd result for the proprietor (para. 43).

If the approach adopted by the BoA were correct and the registrations of the earlier EU trade marks covered pharmaceutical goods except for those using pharmaceutical chemical preparations, that is to say they only covered 'natural' preparations or preparations 'of herbal origin' which do not contain chemical substances or synthetic components, those registrations would only cover goods which were not contemplated by the opponent and which were not expressly referred to in the specification of those marks. This situation is incompatible with the requirements of predictability and legal certainty (para. 45).

The OD, and, as the case may be, the BoA, must interpret the list of goods and services for which an earlier EU trade mark is registered and about which



proof of genuine use has been requested, in order to ascertain the extent of the protection of that mark and to settle the issue of its genuine use, before a ruling is given on the opposition proper. However, in so doing, they must interpret the wording of the list of goods and services covered in the most coherent manner, in the light not only of its literal meaning and its grammatical construction, but also, if there is a risk of an absurd result, of its context and the actual intention of the mark's proprietor as regards its scope (para. 50).

In the context of Article 47(2) EUTMR and of determining the extent of the protection of an earlier EU trade mark and assessing the evidence of genuine use of that mark, if two possible literal interpretations of the specification of that mark exist, but one of them would lead to an absurd result as regards the extent of the protection of the mark, the BoA must resolve the difficulty by opting for the most plausible and predictable interpretation of that specification. It would be absurd to adopt an interpretation of the specification which would have the effect of excluding all of the opponent's goods, leaving only goods for which it has not sought trade mark protection as goods protected by the earlier EU trade marks (para. 51).

Accordingly, the GC holds that it is only if both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are each equally plausible and predictable that, in

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determining the extent of the protection of that mark and assessing the evidence of genuine use that has been adduced, it is appropriate to apply the principle derived from the judgment of 06/04/2017, T 39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48, that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision (para. 60).

The GC annuls the contested decision, insofar as the BoA dismissed the appeal brought before it on the grounds for opposition set out in Article 8(1)(b) and (5) EUTMR.

T-559/18; Medizinische Pflaster; Atos Medical GmbH v EUIPO; Judgment of 24 October 2019; EU:T:2019:758; Language DE

RESULT:

Action dismissed

KEYWORDS:

Conflict of design with prior design, Disclosure within the EU, Freedom of designer, Individual character, Overall impression

FACTS:

The contested RCD was registered for medical plasters in Class 24 04.

An invalidity application was filed pursuant to Article 25(1)(b) in conjunction with Article 6 CDR.



The Cancellation Division (CD) found that the contested design lacked individual character.

Upon the proprietor's appeal, the Board of Appeal (BoA) annulled the CD's decision, finding that some of the earlier designs or models claimed by the invalidity applicant were not disclosed and that the disclosed earlier designs and models do not exclude the individual character of the contested CDR, given the differences in the overall impression.

The invalidity applicant filed an action before the General Court (GC), relying on an infringement of Articles 5 and 6 CDR and claiming that the BoA wrongly assessed the disclosure of the earlier designs and models and the individual character.

SUBSTANCE:

(i) DISCLOSURE.

The disclosure of an earlier design cannot be proved by means of probabilities or suppositions but must be demonstrated by precise and objective evidence of an effective disclosure in the market (para. 28). The BoA correctly acknowledged the divulcation of the earlier designs presented in documents AS4 and AS7 in the light of the documents submitted by the invalidity applicant. The disclosure of the design presented in AS7 is proven by the publication of a patent application by the German Patent Office (para. 30). The disclosure of the design presented in AS4 results from the overview of the technical

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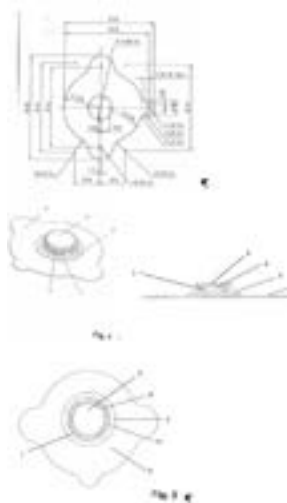
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Earlier designs



drawing, the affidavit and the catalogue submitted by the applicant. (para. 31). For the remaining designs, the BoA was correct to find that the technical drawings submitted, without completing documents, were not sufficient to prove their disclosure. Technical drawings are typically made for internal use. The affidavit related thereto is not sufficiently precise. The images of products in the catalogues do not match the designs or models depicted in the rejected technical drawings (paras 33-41).

(ii) INDIVIDUAL CHARACTER.

The freedom of the designer is limited in the case of medical plasters, as the round shape of the inner hole, as well as the size and the circular shape of the plaster, are dictated by its function (para. 48). The informed user is familiar with the function of the plasters used in a tracheotomy and knows the limitations on the freedom of the designer (para. 52). Whereas the earlier design in AS4 and the contested design share certain elements, they differ in several aspects. The overall shape of the contested design is more circular and the inner opening more to the left than in the earlier design. Also, the position of the badges on the sides differ. The overall impression made by the designs when compared is different (paras 64-65). The overall impression produced by the contested design is also different from that produced by the earlier design in AS7.

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The differences are the same as those in relation to the earlier design in AS4 and, moreover, the overall shape of the earlier design in AS7 is not asymmetric like that of the contested design (para. 68).

T-560/18; Medizinische Pflaster; Atos Medical GmbH v EUIPO; Judgment of 24 October 2019; EU:T:2019:758; Language DE

RESULT:

Action dismissed

KEYWORDS:

Conflict of design with prior design, Disclosure within the EU, Freedom of designer, Individual character, Overall impression

FACTS:

The contested RCD was registered for medical plasters in Class 24 04.

An invalidity application was filed pursuant to Article 25(1)(b) CDR in conjunction with Articles 6 CDR.

The Cancellation Division (CD) found that the contested design lacked individual character.

Upon the proprietor's appeal, the Board of Appeal (BoA) annulled the CD's decision, finding that some



of the earlier designs or models claimed by the invalidity applicant were not disclosed and that the disclosed earlier designs and models do not exclude the individual character of the contested CDR, given the differences in the overall impression.

The invalidity applicant filed an action before the General Court (GC), relying on an infringement of Articles 5 and 6 CDR and claiming that the BoA wrongly assessed the disclosure of the earlier designs and models and the individual character.

SUBSTANCE:

(i) DISCLOSURE.

The disclosure of an earlier design cannot be proved by means of probabilities or suppositions but must be demonstrated by precise and objective evidence of an effective disclosure in the market (para. 28). The BoA correctly acknowledged the divulgation of the earlier designs presented in documents AS4 and AS7 in the light of the documents submitted by the invalidity applicant. The disclosure of the design presented in AS7 is proven by the publication of a patent application by the German Patent Office (para. 30). The disclosure of the design presented in AS4 results from the overview of the technical drawing, the affidavit and the catalogue submitted by the applicant (para. 31). For the remaining designs, the BoA was correct to find that the technical drawings submitted, without completing

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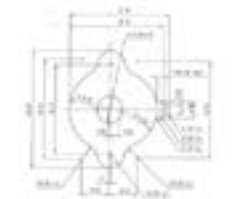
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(ii) INDIVIDUAL CHARACTER. The freedom of the designer is limited in the case of medical plasters, as the circular shape of the inner hole, as well as the size and the circular form of the plaster, are dictated by its function (para. 48). The informed user is familiar with the function of the plasters used in a tracheotomy and knows about the limitations on the freedom of the designer (para. 52). Whereas the earlier design in AS4 and the contested design share certain elements, they differ in several aspects. The overall shape of the contested design is more circular and the inner opening more to the left than in the earlier design. Also, the position of the badges on the sides differ. The overall impression made by the designs when compared is different (paras 64-65). The overall impression produced by the contested design is also different from that produced by the earlier design in AS7. The differences are the same as those in relation to the earlier design in AS4 and, moreover, the overall shape of the earlier design in AS7 is not asymmetric like that of the contested design (para. 68).

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19/09/2019, R 620/2019-4, KLANG EINER TONFOLGE (sonit.)

EUTM application



Download sound file [here](#)

Outcome:

Decision annulled.

Norms:

Article 7(1)(b) EUTMR; Article 94(1) EUTMR.

Keywords:

Lack of reasoning; Sound mark; Distinctive (yes).



Summary:

The applicant sought to register a sound mark consisting of an electronically produced (synthetic) sound sequence lasting approximately three seconds. The examiner refused it pursuant to Article 7(1)(b) EUTMR, because the sign contained no components which would enable the relevant public to remember it easily and instantly as a distinctive trade mark for the goods and services concerned in Classes 7, 9, 11, 35, 36, 37, 38, 39, 40 and 42.

However, the Board notes that the contested decision does not explain why the sound sequence lacks any distinctive character for the various goods and services. A general assumption regarding the behaviour of the relevant public in relation to the heterogeneous group of [goods and services](#), which are also aimed at different consumer groups and serve different purposes, is not sufficient reasoning. There is no evidence that the sequence of tones (jingle) is currently being used. It differs from other tone sequences. Individual tones, just as letters, can be combined infinitely. Even if some consumers have a low degree of perception with respect to jingles, this does not mean that this part has to be taken into account exclusively.

In addition, the jingle is not related to the goods and services applied for; it is neither an engine sound nor a natural sound. Whether the sound sequence is an 'inspirational or motivational noise' is open for discussion, but it is more than likely that this 'noisiness' will be consciously perceived and relevant

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consumers will also be able to remember the trade mark at a later point.

Consequently, the contested decision is annulled and the application is allowed to proceed to publication.

03/10/2019, R 2368/2018-1, PATTERN CONSISTING OF A VARIETY OF SHAPES, DESIGNS, COLOUR AND REPEATED LETTERS F, A, O

EUTM application



Outcome:
Application allowed.

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

Keywords:
Pattern mark; Distinctive (yes).



Summary:

The applicant sought to register a figurative mark containing the word element 'FAO FAO' for goods and services in Classes 16 and 28. The examiner partially refused the mark applied for on the grounds of Article 7(1)(b) and (c), in conjunction with Article 7(2), EUTMR. She stated that even if the pattern consisted of a variety of geometric shapes, designs and colours, it was not 'sufficiently complex' to provide it with distinctive character. The sign would give the impression of it being for a decorative purpose as regards the goods applied for, as a typical pattern that can be found on a variety of products for decorative purposes. Moreover, the repeated letters 'F', 'O', 'A' would not be perceived as a verbal element, but simply as random letters of the alphabet.

However, the Board recalls that recognition that a mark has distinctive character, within the meaning of Article 7(1)(b) EUTMR, is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark would enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings. First it notes that the sign's 'complexity' may not be a sufficient reason to decline the distinctiveness of the mark. Secondly, in relation to the fact that the sign gives the impression that it is primarily intended for a decorative purpose, the Board notes

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that a decorative function is not incompatible with a distinctive function. The Board underlines that as regards pattern marks there is no clear practice and that these kinds of marks should be assessed on a case-by-case basis.

The Board considers that the sign at hand does not have a 'special level of artistic creativity or imaginativeness', nevertheless it would be excessive to declare that it is 'devoid' of any distinctive character in relation to the goods specified.

Consequently, the contested decision is annulled and the application is allowed to proceed to publication.

08/10/2019, R 1124/2019-4, THE GOOD CIDER OF SAN SEBASTIAN Since 1918 (fig.)

EUTM application



Outcome:
Decision confirmed.

Norms:
Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 7(2) EUTMR.

Keywords:
Figurative trade mark; Function of trade mark; Quality of the goods and services; Descriptive (yes).

Summary:
The examiner refused the application for the figurative mark 'THE GOOD CIDER OF SAN SEBASTIÁN Since 1918' intended for ciders pursuant to Article 7(1)(b) and (c) EUTMR. She stated that the relevant English-speaking consumer would perceive that the sign provided information about the goods. Moreover, the different sizes and positions of the letters, the rhombus and the grey box, were fairly common and banal, as they were usually used on labels and did not add any distinctive element to the descriptive message of the word elements.

The Board agrees with the examiner. The combination of the terms complies with English grammar rules and is easy and immediately comprehensible and conveys obvious and direct information about the goods in question for the English-speaking public, namely a message indicating that the goods comprise good quality ciders originating from San Sebastián, which have

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been prepared and sold since 1918. The word 'from' accompanied by a year is a frequently used expression to designate the creation of an industrial or commercial establishment or of a specific product or service. As a marketing element it connotes an indication of quality that it is associated with a long existence or history, and therefore it is descriptive as regards the year in which the establishment was founded or the first time that the goods applied for were manufactured.

The figurative elements do not alter this conclusion. The type face for the letters used is not particularly striking or incorporate any characteristic requiring the relevant consumer to make an intellectual effort in order to identify the meaning of the word elements in relation to the goods applied for (28/6/2011, [T-487/09](#), ReValue, EU:T:2011:317, § 39, 44; 15/5/2014, [T-366/12](#), Yoghurt-Gums, EU:T:2014:256, § 31). The fact that the word elements appear on various levels and in different sizes does not change this assessment as they are stylistic elements which are commonly used on the market and therefore will not divert the public's attention away from the purely descriptive message of the sign (29/10/2018, R 2713/2017-4, FOODS & WINES from SPAIN (fig.), § 26).

In addition, the rhombus will not attract the relevant consumer's attention either, since such structures usually have the secondary function of being an image background and usually serve to highlight word elements (15/03/2006, [T-35/04](#),



Ferró, EU:T:2006:82, § 52, confirmed by [C-225/06 P](#); 15/12/2009, [T-476/08](#), Best Buy, EU:T:2009:508, § 27; 27/10/2016, [T-37/16](#), Caffè Nero, EU:T:2016:634, § 42).

Therefore the visual elements do not have sufficient weight in the overall impression for the public. As a whole the sign is descriptive and it also lacks distinctiveness.

Consequently, the appeal is dismissed and the application is rejected.

08/10/2019, R 1125/2019-4, THE GOOD CIDER OF SAN SEBASTIAN SINCE 1918 (fig.)

EUTM application



Outcome:

Decision annulled.

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Norms:

Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 7(2) EUTMR.

Keywords:

Figurative element; Function of trade mark; Quality of the goods and services; Descriptive (no); Minimum degree of distinctiveness (yes).

Summary:

The examiner refused the application for the figurative mark 'THE GOOD CIDER OF SAN SEBASTIÁN Since 1918' intended for ciders pursuant to Article 7(1)(b) and (c) EUTMR. She stated that the relevant English-speaking consumer would perceive that the sign provided information about the goods. Moreover, the figurative elements did not add any distinctive element to the descriptive message of the word elements and rather increased its descriptiveness.

As in case [R1124/2019-4](#), the Board agrees with the examiner that the combination of the terms is easy and immediately comprehensible and conveys obvious and direct information regarding the goods in question, further a rhombus usually serves to highlight the word elements.

Although it is true that nowadays ciders exist that taste of other fruits such as pears, limes, peaches, strawberries, etc., fruits other than apples do not



have a direct link with ciders, so the link that may eventually be established between other fruits and ciders is indirect and at best evocative of said goods. Furthermore, the configuration of the graphic element in the shape of a circle consisting of fruits with a very varied colour combination will not simply be perceived as a simple 'decoration' of the goods applied for, but as a drawing which consists of various elements with intrinsic distinctive character. Although the existence of a certain level of creativity is not indicative of distinctive character, the particular composition of the fruit in a circle is eye-catching and in the present case allows the relevant public to identify easily and immediately the origin of the goods in question as the fruit circle design will create an immediate, lasting impression. Taking into account the wide variety of fruit represented, the consumer will not analyse what kind of fruit is involved.

The figurative element in the overall impression of the sign is therefore sufficient to divert the relevant public's attention away from the descriptive nature of the word combination.

Consequently, the contested decision is annulled and the application is allowed to proceed to publication.

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19/09/2019, R 1223/2019-5, [Mappa di Imola](#)

Outcome:

Decision confirmed.

Norms:

Article 7(1)(j) EUTMR.

Keywords:

Word mark; Geographical origin.

Summary:

The applicant sought to register the sign 'MAPPA DI IMOLA' for wines. The examiner raised a provisional refusal of the trade mark registration on the ground of Article 7(1)(j) EUTMR, indicating that this could be overcome by limiting the abovementioned goods affected by the designation of origin in Class 33 as followed: wines complying with the specifications of the protected designation of origin (PDO) 'Colli d'Imola'. The applicant did not withdraw its application for registration, nor did it propose a restriction as regards the list of goods and the examiner considered that the sign 'MAPPA DI IMOLA' for 'wine' evoked the PDO 'Colli d'Imola'.

The Board indicates that the applicant's approach concerning its reasoning based on the concept of a likelihood of confusion is incorrect and cannot be followed. For geographical indications the relevant

legal concept is 'evocation' which, according to the Court of Justice, refers to 'the fact that the word used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his or her mind is that of the product whose designation is protected'. Therefore there is no obligation to establish a degree of similarity. The Board notes that in the present case, the applicant's sign incorporates the most significant part of the protected designation of origin and indicates the same geographical origin. The consumer will therefore establish a link between the trade mark applied for and the PDO in question. In any case, for the absolute ground for refusal set out in Article 7(j) EUTMR to apply, it suffices that a trade mark contains or consists of elements which enable the geographical indication in question to be identified with certainty.

Consequently, the appeal must be dismissed.

[PDO-IT-A0290 - Colli d'Imola](#)

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10/10/2019, R 1143/2019-5, FÉLIX de Múrtiga JABUGO (fig.)

EUTM application



Outcome:

Decision confirmed.

Norms:

Article 7(1)(j) EUTMR.

Keywords: Right to be heard; Word mark; Geographical origin.

Summary: The applicant sought to register the figurative sign 'FÉLIX de Múrtiga JABUGO' for goods and services in Classes 29, 35 and 43. The examiner proposed, as a limitation to circumvent the ground for refusal, the wording: 'Ham de Jabugo conforming to the specifications of the Protected Designation of Origin Jabugo; Jabugo palettes conforming with the specifications of the Protected Designation of Origin Jabugo'. However, the applicant did not submit observations in respect of the examiner's provisional partial refusal and, therefore, did not



limit its specification in Class 29 to the suggestion in its first submission. Finally, the examiner partially refused the trade mark applied for pursuant to Article 7(1)(j) EUTMR in respect of all the goods in Class 29, namely: Jabugo Ham granted under the Protected Designation of Origin 'Jamón de Huelva'/ 'Jabugo'; Jabugo palettes granted under the Protected Designation of Origin 'Jamón de Huelva'/'Jabugo'.

The Board notes that 'JABUGO' is a Protected Designation of Origin in the European Union under Regulation No 1151/2012 of the European Parliament and of the Council of 21/11/2012 on quality schemes for agricultural products and foodstuffs. The objections made pursuant to Article 7(1)(j) EUTMR may be rejected if the relevant goods are restricted in order to comply with the specification for the PDO in question. In the case of agricultural products and foodstuffs, as in the present case, the category of goods that includes those covered by the PDO must be restricted to designating exactly the goods covered by the PDO that comply with the specification. The application must be rejected since there is a direct use of the PDO 'Jabugo' through its reproduction together with other elements in the sign applied for (see also 03/10/2019, R1142/2019-5, Romeral de jabugo).

Consequently, the appeal must be dismissed.

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03/10/2019, R 1952/2018-1, ESPAÑISIMO (fig.) / La Española (fig.) et al.

Contested EUTM



Earlier Trade Mark



Outcome:
Opposition allowed.

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

Keywords:
Enhanced distinctiveness; Identity of the goods and services; Similarity of the signs; Likelihood of confusion (yes).



Summary:

The Opposition Division upheld the opposition for all the contested goods in Class 29 because it found that there was a likelihood of confusion under Article 8(1)(b) EUTMR with earlier EUTM No 5 773 957 which was not yet subject to the use obligation.

The Board, confirming the Opposition's Division findings, notes that the goods covered by the contested mark are identical to those of the earlier mark since they are all 'edible oils and fats', which are precisely the goods covered by the earlier mark. Regarding the comparison of the two signs, the Board indicates that where a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element of the mark (18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 35). Consumers will therefore in both marks, note the word elements 'La Española' and 'ESPAÑISIMO', respectively. Firstly, from a visual perspective, the contested mark's word element has the same beginning as the earlier mark's verbal element 'Espanola', which is the part to which consumers attach more attention. Secondly, in regard to the aural comparison of the signs, the two signs produce a similar sound, since their respective first five letters are the same. Lastly, from a conceptual comparison the consumer will, in both signs, recognise a connotation in relation to Spain.

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Therefore, there is also a degree of conceptual similarity between the marks. Overall, the signs are similar to a certain degree.

Moreover, the opponent claimed the enhanced distinctiveness of its earlier mark. The Board, after assessing the documents submitted as a whole, notes that the use of the earlier mark is substantiated, geographically widespread and long-standing for a wide proportion of the relevant public – notably in Spain and Germany.

The conflicting goods are identical and the two signs have at least a low level of similarity. Taking into account the fact that the public will more easily refer to the signs in question by their words than by describing their figurative elements and the earlier mark's enhanced distinctiveness, the Boards confirms the likelihood of confusion between the two signs. Last, but not least, the Board emphasises that consumers may assume that the products that originate from the same or economically-linked enterprises as consumers may see in the later mark a new line of oil or edible fat products from 'La Española'.

Consequently, the appeal is dismissed and the opposition is allowed.

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