

Alicante News

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Up to date information on IP and EUIPO-related matters



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Looking at a list of Europe's geographical indications is like taking a deep dive into the history and heritage of our continent. The ancient Romans were the first to plant vines in the region that now gives us Champagne, for example, and the sweet smell of Bulgarian rose oil has been delighting us since the 16th century. Every geographical indication is freighted with the stories and traditions of the people and regions that produce it, and speaks to the strength and diversity of our European way of life.

Like all intellectual property rights, geographical indications support economic growth and jobs. Industries intensive in geographical indication rights contribute approximately EUR 20 billion to the EU's GDP, and support nearly 400 000 jobs, many of them in rural areas. Geographical indications are key to the EU's trade; of the nearly EUR 74 billion annually they generate in value, a full fifth comes from outside the EU.

Together with the European Commission, the EUIPO has launched a single entry point for data on GIs registered in the EU, for consumers, producers and intellectual property professionals. GView has been created as a one-stop-shop for information on geographical indications, and also contains detailed information on non-EU GIs protected at EU level through bilateral and multilateral agreements, and on EU GIs protected in non-EU countries.

GView contains data such as GI type (PDO, PGI, GI), priority date, legal status, basis of protection in relation to all GIs covering wines, spirit drinks and aromatised wines, agricultural products and foodstuffs protected at EU level.

A special feature of GView is that it is made open to national authorities and to producer groups to upload extended data, such as the contact data of the GI producer groups and control bodies, maps, photographs of the product, product description, the geographical area, sustainability statements, and other information. This is designed both to maximize information about GIs, and to directly assist anti-fraud authorities who can easily see the descriptions and photos of genuine product and who can then directly contact the relevant authorities and the producer group of the genuine product, in case of an investigation.

Trade mark applicants in particular can use GView to check the GI status and registered name – and include a statement in their application that the trade mark will only be used in relation to products qualifying for the GI, if this is the case. GView can also be used by potential trade mark applicants, to prevent conflicts arising with existing GIs.

GIs may form the basis for an ex officio objection against a registration of the trade mark by the relevant trade mark office (Article 4(1)(i) of Directive (EU) 2015/2436 of the European Parliament and of

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the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Article 7(1)(j) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark). GIs may also be invoked as earlier rights in opposition proceedings (Article 5(3)(c) of the Directive, Article 8(6) of Regulation (EU) 2017/1001).

It is therefore important for trade mark applicants to ensure that the mark they intend to apply for, especially where it covers agricultural products, foodstuffs, wines or spirits, is not in conflict with any earlier GIs protected in the EU. Glview can help trade mark applicants to identify any earlier GIs, which may potentially be an obstacle to a smooth trade mark registration process.

Open to everyone, free and continually updated, Glview is an important tool for IP professionals. With its intuitive interface and detailed information, it is also an asset for producers. It has been created to be as easy to use as possible, and can help to raise awareness among consumers about the incredible range and variety of geographical indications that form such an important part of our European heritage.

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First GI registration in ARIPO supported by EUIPO

On 23 November, Mozambique officially launched the newly created geographical indication (GI) Cabrito de Tete, which is the first GI registered in ARIPO (African Regional Intellectual Property Organization).

Cabrito de Tete is a local goat breed, from Tete province in Mozambique. The province of Tete has a goat population of about 300 000 animals, which has increased over recent years, and the area is regarded as the leading goat producer in the country.

Thanks to the registered geographical indication, Cabrito de Tete will be commercialised under strict standards, which include breeding and processing rules. It will also ease access to national and international markets, highlight its GI reputation, and protect local goat meat producers.

The GI registration of Cabrito de Tete was supported by the EUIPO and the AfriPI (Intellectual Property Rights & Innovation) initiative, an EU-funded project for which the EUIPO is the implementing agency. In particular, AfriPI provided technical and logistical assistance for the commercial testing, including two training sessions for local producers.

European cooperation: online improvements in Romania

On 28 October, the Romanian State Office for Inventions and Trademarks (OSIM), with the support of the EUIPO's European cooperation projects, enhanced its back and front office applications.

New reporting and improved smart PDF online forms introduced in the back office have further enhanced the capabilities available to OSIM users. The front office application will also now include six new e-services for designs.

The new reporting capability consists of 70 different reports available within the back office. OSIM users benefit from an improved user-friendly interface and more powerful and faster search results.

European Cooperation: new online services in Portugal

The Portuguese Institute of Industrial Property (INPI), with the support of the EUIPO's European Cooperation Service, has improved the service it provides to its users with the launch of a new set of modern online features for trade mark and design applications. These digital service improvements became available on 11 November 2020.

The INPI platform now includes additional features such as an improved Goods&Services search

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and similarity report document for TM e-filing, or multiple files upload and DS Class integration into DS e-filing, which will help modernise the IP-related operations in Portugal.

Additionally, the implementation of the Transposition of Directive was completed in accordance with Directive (EU) 2015/2436, allowing users to register the following new types of trade marks using INPI TM e-filing: position mark, pattern mark, motion mark, multimedia mark, colour mark and hologram mark.

Monaco and San Marino join Designclass

As of 09 November 2020, the Industrial Property Office of the Business Development Agency of the Principality of Monaco (MCIPO) and the Patents and Trademarks Office of the Republic of San Marino (USBM) became part of Designclass, and will use and accept the list of terms from the harmonised database of product indications (HDBPI) in the tool.

Following the decision of MCIPO and USBM to use HDBPI, there are now 13 non-EU IP offices in Designclass that use and accept terms from this harmonised database.

The addition of MCIPO and USBM in DESIGNclass brings the total number of participating IP offices to 40.

European Cooperation: Slovenia completes the digitisation of its trade mark and design dossiers

On 30 October 2020, the Slovenian Intellectual Property Office (SIPO) successfully completed the digitisation of its paper dossiers relating to trade marks and designs under the ECP5 project: Capture and Store Historical Files (CSHF).

The CSHF project, carried out within the framework of European Cooperation Projects, aims at digitising paper dossiers across EU national Intellectual Property Offices to enable easy and rapid access to documentation and data related to trade mark and design dossiers.

The digitisation process began in June 2019 with collaboration of different teams from the EUIPO and SIPO. Despite challenges in recent months due to COVID-19, the dedication and cooperation of SIPO, the EUIPO and the service providers allowed the project to continue and more than 46 000 trade mark and design dossiers have now been digitised.

The ultimate goal of the CSHF project is to support the participating offices in creating a paperless working environment and to help users interact digitally with all EU national Intellectual Property Offices.

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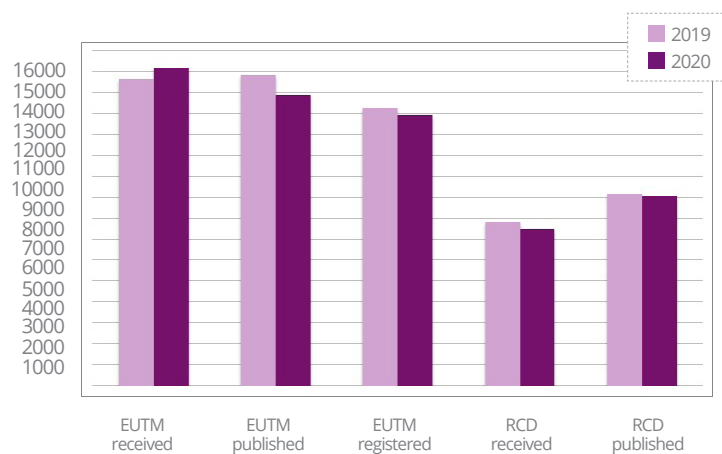
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Statistical Highlights

Monthly statistical highlights October*	2019	2020
European Union Trade Mark applications received	14 639	15 144
European Union Trade Mark applications published	14 825	13 893
European Union Trade Marks registered (certificates issued)	13 249	12 919
Registered Community Designs received	7 811	7 487
Registered Community Designs published	9 145	9 041

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



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Fax Phase Out

The entry into force of the Decision of the Executive Director [No EX 20 9](#) will bring an important change to the Office's official means of communication.

Fax will no longer be a means to communicate with the EUIPO from 1 March 2021.

The decision has been driven by the fact that fax is no longer reliable from a technical point of view, and the aim is to provide state-of-the-art communication tools to our users.

We will be in touch with our customers that still use fax to make sure they are aware of this change and to help them get used to the alternative means of communication available to them, if necessary. **If you would like personalised support, please call us on +34 965 139 100.**

Did you know that from your User Area you can already communicate with the Office **100% electronically**?

- The **e-Reply button** is available in all e-communications sent by the Office where a reply is permitted.
- The **Fax Alternative** option, set up to help our customers during the [COVID-19 lockdown](#), is available in the Communication tab of the User Area for cases of technical difficulty with the e-Reply buttons.

In addition, we are working on a **file-sharing** option as a fall-back solution in case of a lack of connection with the Office systems. Technical details on these back-up solutions (fax alternative and file-sharing) will be available in the 'conditions of use' of each option.

Finally, **postal mail** will continue to be an accepted means of communication with the Office.

Please remember that you should only use Fax Alternative in case of technical difficulty with the established e-communication options, if those options are unsuitable for your request or if the e-communication that you received from the Office has no e-Reply button.

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Webinars from the EUIPO Academy

Latest webinars

Use of a trade mark in a form differing from the one registered - Convergence Programme 8

The European Union Intellectual Property Network (EUIPN) has agreed on a Common Practice with regard to the use of a trade mark in a form differing from the one registered. The Common Practice document aims to identify general principles for assessing when the use of a trade mark in a form differing from the one registered alters its distinctive character and to provide guidance in this respect. More specifically, it assesses the impact of changes, namely of additions, omissions, modifications of characteristics, and combinations of these changes, on the distinctive character of registered word marks, purely figurative marks and composite marks. The Common Practice aspires to harmonise the practices of the intellectual property offices that already assess proof of use, as well as of those that have to introduce this assessment for the first time as a result of the transposition of the Trade Mark Directive. The document reflects the results of the combined efforts of EU and non-EU intellectual property offices, as well as of User Associations, and aims to increase transparency, legal certainty, consistency and predictability for examiners and users alike. The details of the Common Practice can be found in the CP8 Common Communication document.

Watch the webinar [here](#).

eSearch Case Law Database and Automatic Translation

This webinar demonstrates the multilingual functionalities of the eSearch Case Law search tool and how best to take advantage of it to overcome language barriers. Thanks to the integrated automatic translation service, EUIPO first-instance decisions, Boards of Appeal decisions, and GC and CJEU judgments are available in multiple languages. The tool saves customers time and money by allowing them to understand the key content of relevant case-law without needing to understand the language of the source document (i.e. the language of the proceedings).

Watch the webinar [here](#).

Crowdfunding and IP

This webinar, especially created for SMEs and start-ups, explores the potential of crowdfunding and aims to help you learn how to make your crowdfunding campaign successful. Speakers from the European Crowdfunding Network and EIT Health Crowdfunding Accelerator will list aspects to be considered and give practical examples of crowdfunding. An IP expert from the EUIPO will help you use IP to reinforce your business.

Watch the webinar [here](#).

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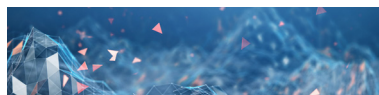
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IP Tech Watch

IP Tech Watch looks to the future but with a firm understanding of the past and present, and an awareness of the impact of technology in society, on businesses and in our lives. In this webinar we present the discussion paper prepared with support from the Observatory's Impact of Technology Expert Group. This paper provides a more comprehensive understanding of the complexity of emerging and disruptive technologies and considers their impact on the future protection, infringement and enforcement of intellectual property. The discussion paper is available on the Observatory website at [this link](#).

Watch the webinar [here](#).

Refiling of trade marks and bad faith

This webinar will analyse the area of refiling of trade marks. It will focus on the case-law that allows trade marks to be refiled, as well as on case-law relating to the refiling of trade marks considered to have been carried out in bad faith.

Watch the webinar [here](#).

The right to be heard, the right of defence and the obligation to state reasons, exercising discretion and the notion of misuse of powers

This webinar aims to provide an overview of the EUIPO's practice and the latest case-law of the General Court and the Court of Justice on the

obligation to state reasons and the right to be heard (Articles 94 and 95 EUTMR).

Watch the webinar [here](#).

Upcoming webinars

Webinar: **Leading digital transformation Tuesday, 1 December**, 10.00 AM – 11.00 AM

Webinar: **Decisions of the Trimester of the GC and the CJEU Tuesday, 8 December**, 10.00 AM – 11.00 AM

Webinar: **Digits and numbers: When do they COUNT as trade marks? Tuesday, 8 December**, 11.30 AM – 12.30 AM

Webinar: **The new services offered by alternative dispute resolution Tuesday, 15 December**, 10.00 AM – 10.30 AM

Webinar: **Decisions of the Trimester of the EUIPO Boards of Appeal Tuesday, 15 December**, 11.00 AM – 12.00 AM

On current case-law

In case T 187/19, the GC confirmed that the colour mark 'Purple – Pantone: 2587C' was devoid of any distinctive character and that acquired distinctive character through use of a mark 'must be demonstrated throughout the territory of the

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European Union, and not only for a substantial part or the majority thereof. In this sense, the court confirmed the Board's finding that the evidence (surveys) filed by the applicant was not sufficient to demonstrate acquired distinctiveness throughout the European Union.

For a closer look at colour marks and the assessment of their distinctiveness, watch the webinar '[Distinctiveness of colour marks](#)'. This webinar presents several cases relating to the registration as a trade mark of combinations of colours or a single colour and some clues for assessing distinctiveness.

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

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Overview of CJ/GC Case-law (Status: 01/01/2019 – 31/08/2020)



The last updated version (to 31.08.2020) is now available on the e-Search Database (Overview of CJ/GC Case-law).

The Overview of CJ/GC Case-law contains a systematic compilation of the key points of judgments and of orders rendered by the Court of Justice and the General Court of the European Union on actions brought against decisions taken by the Office's Boards of Appeal (BoA) in trade mark and design matters. It also contains key points of judgments rendered by the Court of Justice in preliminary rulings on IP rights and their enforcement. The key points consist of new or infrequent statements or statements that, while not new, are relevant in confirming established case-law.

The hyperlinks in the case reference lead to the Office's eSearch Case Law database, giving the user easy access to the full text of the judgment or order



and any relevant information and documentation (translations, summaries, first instance and BoA decisions, link to the InfoCuria Database of the CJEU).

Luxembourg trade mark and design news

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

11/11/2020, [C 809/18 P](#), **MINERAL MAGIC / MAGIC MINERALS BY JEROME ALEXANDER et al.**, [EU:C:2020:902](#)

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

KEYWORDS: Agent, Identity of the goods and services, Representative, Similarity of the goods and services, Similarity of the signs

NORMS: Article 8(3) CTMR [now Article 8(3) EUTMR]

KEYPOINTS: Article 8(3) CTMR applies to applications for registration by the agent or representative of the proprietor of the earlier mark, both where the mark applied for is identical to that earlier mark and where it is similar to it (§ 54-74, 91). For the purposes of applying Article 8(3) CTMR, similarity between

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the marks is not determined on the basis of the existence of a likelihood of confusion (§ 92).

The application of Article 8(3) CTMR is not precluded where the goods or services covered by the mark applied for and those covered by the earlier mark are similar, and not identical (§ 99).

FACTS: The applicant John Mills Ltd (‘John Mills’) sought to register, in its own name, the word mark MINERAL MAGIC as an EUTM for cosmetics and other products in Class 3, such as hair lotions; soaps; perfumery. An opposition was filed by Jerome Alexander Consulting (the proprietor), pursuant to Article 8(3) CTMR. The opposition was based on the earlier American word mark Magic minerals by Jerome Alexander, registered for face powder featuring mineral enhancements. According to that Article ‘a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor’s consent’.

The Opposition Division (OD) rejected the opposition. The proprietor filed an appeal before the Board of Appeal (BoA). The BoA upheld the appeal, annulled the OD’s decision and refused registration of the contested mark. It found that the mark had been applied for by John Mills in its capacity as an ‘agent’ and without the proprietor’s consent. It also noted that the goods covered by the marks were identical or similar and that the signs were similar.

The applicant filed an action before the General Court (GC), relying on a single plea in law: infringement of Article 8(3) CTMR. The GC annulled the BoA’s decision on the ground that Article 8(3) CTMR applies only where marks are identical (15/10/2018, T 7/17, MINERAL MAGIC / MAGIC MINERALS BY JEROME ALEXANDER et al., EU:T:2018:679).

The Office appealed to the Court of Justice (CJ). The CJ set aside the GC’s decision and gave a final ruling on the action.

SUBSTANCE:
INFRINGEMENT OF ARTICLE 8(3) EUTMR

The CJ rules that the application of Article 8(3) CTMR is not limited solely to the situation in which the earlier mark and the mark applied for (by the agent or representative of the proprietor of the earlier mark) are identical (§ 74) for the following reasons.

First, the provision of Article 8(3) CTMR does not explicitly state whether it applies only in the case where the mark applied for by an agent or representative is identical to the earlier mark (§ 55-57).

Second, the examination of the ‘travaux préparatoires’ reveals that it cannot be inferred from these that the scope of that provision is limited solely to cases in which the marks are identical (§ 58-61). By contrast, it is apparent from the ‘travaux

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préparatoires' that Article 8(3) CTMR reflects the choice of the EU legislature to reproduce, in essence, Article 6 septies of the Paris Convention (§ 62). The GC should have considered the 'travaux préparatoires' relating to that convention, from which it is apparent that the mark applied for by the agent or representative of the proprietor of the earlier mark may also be covered by the Paris Convention where the mark applied for is similar to that earlier mark (§ 63-69).

Third, a different interpretation would have the effect of calling into question the general scheme of the CTMR, in that it would result in the proprietor of a mark being deprived of the possibility of opposing the registration of a similar mark by his agent or representative, even though the latter would be entitled to file a notice of opposition to the application for subsequent registration of the initial mark by that proprietor on the ground of its similarity to the mark registered by the agent or representative of that proprietor (§ 70).

Fourth, the objective of Article 8(3) CTMR is to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark, as those persons may improperly benefit from the effort and investment which the proprietor himself has made. Such misuse is also likely to occur where the marks are similar (§ 71).

As the action brought before the GC is in a state ready to be adjudicated, the CJ gives a final ruling on it (§ 76-77).

John Mills criticised the BoA for finding that it was an 'agent' of the proprietor (§ 83). According to the objective pursued by Article 8(3) CTMR (to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark), the concepts of 'agent' and 'representative' must be interpreted broadly so as to cover all forms of relationship based on a contractual agreement under which there is some agreement or commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark (§ 83-85). In that regard, the CJ finds that the applicant was a preferred distributor of the proprietor's goods, and that there was a non-competition clause and provisions relating to the intellectual property rights with respect to those goods (§ 86). The BoA was therefore right to find that John Mills was an 'agent' of the proprietor (§ 87).

With regard to the assessment of similarity of the marks, the CJ emphasises that, for the purposes of applying Article 8(3) CTMR, similarity is not determined on the basis of the existence of a likelihood of confusion (§ 92). So far as the goods are concerned, the CJ recalls that the essential function

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of a trade mark is to indicate the commercial origin of the goods or services covered (§ 98). Consequently, the application of Article 8(3) CTMR cannot be precluded where the goods or services covered by the mark applied for and those covered by the earlier mark are similar, and not identical (§ 99).

In the present case, the CJ holds that the signs are similar and that the goods are, in part, identical and, in part, similar. Accordingly, the action brought by John Mills is dismissed in its entirety (§ 100-103).

The Court of Justice sides with the Boards of Appeal and clarifies the scope of application of Article 8(3) EUTMR

With its landmark judgment recently given on 11 November 2020 (11/11/2020, C-809/18 P, MINERAL MAGIC / MAGIC MINERALS BY JEROME ALEXANDER et al., EU:C:2020:902), the CJEU provides clear guidance on the application of Article 8(3) EUTMR.

Article 8(3) EUTMR allows a proprietor to oppose the registration sought by an agent or representative without the proprietors consent. The main question before the CJEU was whether the scope of application of Article 8(3) CTMR (which is identical to Article 8(3) EUTMR) is limited to identical signs, as the GC had concluded, or if similarity is sufficient. In this regard, the wording of the Article does not include mention of either a requirement of similarity or identity.

The CJEU set aside the judgment of the GC and sided with the Boards of Appeal. It found that the application of the provision is not limited to identical marks, and that a likelihood of confusion is not required either. Similarity of signs is therefore sufficient for the application of Article 8(3) EUTMR.

The CJEU reached its conclusion taking into account not only of its wording, but also of its context, and the objectives and purpose pursued by the trade mark regulation. Moreover, the CJEU took note the legislative history relating to the CTMR as well as to Article 6 septies (1) of the Paris Convention, which Article 8(3) EUTMR seeks to reproduce.

The CJEU also upheld the Board's analysis that the terms 'agent' and 'representative' of Article 8(3) CTMR must be interpreted broadly and found that the applicant was to be regarded as an 'agent' on account of the business relationship between the parties, which included an agreement comprising inter alia a non-competition and clauses as well as clauses indicating the applicant as, at the very least, a preferred distributor of the goods.

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

05/10/2020, T 53/19, apiheal (fig.) / APIRETAL, EU:T:2020:469

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Admissibility, Conceptual similarity, Dissimilarity of the goods and services, Figurative element, Likelihood of confusion, Phonetic similarity, Purpose of the goods and services, Similarity of the goods and services, Similarity of the signs, Visual similarity, Weak element

NORMS: Article 8(1)(b) EUTMR

KEY POINTS: Chemical reagents for pharmaceutical and veterinary purposes in Class 5 are similar to antipyretics in the same class (§ 71).

Dietary supplements for pharmaceutical and veterinary purposes; dietary supplements; nutritional supplements; medical preparations for slimming purposes; food for babies; herbs and herbal beverages adapted for medicinal purposes; herbal supplements; herbal creams for medical purposes; herbal creams for medical use; herbal teas for medicinal purposes; liquid herbal supplements in Class 5 have a lower-than-average

degree of similarity to antipyretics, also included in Class 5 (§ 56).

Sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles; fungicides, disinfectants; antiseptics; detergents for medical purposes in Class 5 have a lower-than-average degree of similarity to the antipyretics (§ 72).

Bee glue for human consumption, propolis, propolis for human consumption in Class 30 have a slightly lower-than-average degree of similarity to antipyretics in Class 5 (§ 55).

Teeth filling material, dental impression material, dental adhesives and material for repairing teeth in Class 5 are dissimilar to antipyretics (§ 70).

FACTS: The applicant sought to register the figurative mark 'apiheal' as an EUTM for goods in Classes 3, 5 and 30.

An opposition was filed based on the earlier Spanish word mark APIRETAL, registered for goods in Class 5, pursuant to Article 8(1)(b) and Article 8(5) CTMR. The Opposition Division (OD) partially upheld the opposition and rejected the EUTM for goods in Classes 3 and 5. It found that the earlier mark had been put to genuine use pursuant to Article 42(2) CTMR for antipyretics in Class 5 and had reputation in the sense of Article 8(5) CTMR.

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The opponent filed an appeal before the Board of Appeal (BoA), concerning the opposition rejected for part of the goods in Class 30, namely bee glue for human consumption, propolis, propolis for human consumption. The applicant in its response sought the annulment of the contested decision pursuant to Article 68(2) EUTMR. It alleged that there were differences between the signs, that the reputation of the earlier sign was not proven and that no unfair advantage of it had been taken.

The BoA upheld the opponent's appeal and annulled the OD decision. It found a likelihood of confusion (LOC) for the relevant goods in Class 30. The BoA also confirmed the OD decision, finding a LOC in relation to all the other goods in Class 5 apart from preparations for destroying vermin; herbicides. On the other hand, the BoA annulled the OD decision insofar as it had upheld the opposition against some goods in Class 3, such as perfumery and cosmetics and preparations for destroying vermin; herbicides in Class 5. It found these goods dissimilar to antipyretics.

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 partially upheld the action.



EUTM Application



Earlier trade mark

APIRETAL

SUBSTANCE: The relevant public

The relevant public is the public living in Spain, particularly the general public for goods in Class 30 and the general and professional publics for goods in Class 5, all of which display a high level of attention (§ 38).

The comparison of goods

The contested bee glue for human consumption, propolis, propolis for human consumption in Class 30 and antipyretics in Class 5 have a slightly lower-than-average degree of similarity on account of their common healing purpose, and because they can be marketed through the same distribution channels (§ 55).

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The contested dietary supplements for pharmaceutical and veterinary purposes; dietary supplements; nutritional supplements; medical preparations for slimming purposes; food for babies; herbs and herbal beverages adapted for medicinal purposes; herbal supplements; herbal creams for medical purposes; herbal creams for medical use; herbal teas for medicinal purposes; liquid herbal supplements in Class 5 and antipyretics in Class 5 have a lower-than-average degree of similarity because of their nature, purpose, method of use and distribution channels (§ 64).

The contested teeth filling material, dental impression material, dental adhesives and material for repairing teeth in Class 5 are dissimilar to antipyretics in Class 5, in particular because of their intended purpose, and are not similar to a slightly lower-than-average degree, as the BoA found (§ 70).

The contested pharmaceutical and veterinary preparations for medical purposes; chemical preparations for medical and veterinary purposes in Class 5 are identical to antipyretics, while the contested chemical reagents for pharmaceutical and veterinary purposes are similar to the same (not disputed) (§ 71).

The contested sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles; fungicides, disinfectants;

antiseptics; detergents for medical purposes in Class 5 have a lower-than-average degree of similarity to antipyretics (not disputed) (§ 72).

The comparison of signs

The signs are visually similar to a low degree, and not similar to an average degree, as the BoA found (§ 90). They present visual similarities (both have a word element of similar length and three letters in common ('API'), placed in the same order at the beginning of each sign), but the use of colours and the depiction of a bee are notable differences.

The signs are phonetically similar to an average degree, and not similar to a high degree, as the BoA found (§ 98). The pronunciation of the first part of the signs ('API') is identical. Since the element 'HEAL' of the EUTM may be pronounced as two syllables in Spanish ('HE'-'AL'), the signs may have the same number of syllables and the same vowel sounds (§ 96). The differences in the letter 'H', which may have guttural sound (close to a letter 'J'), in the EUTM, and in the letters 'T' and 'R' of the earlier mark are clear phonetic differences.

The signs are conceptually different for the specialised public. It will associate 'API' with the medical concept of 'apyrexia' (absence of a fever) in the earlier mark, and with the beekeeping in the EUTM (due to the picture of a bee) (§ 102-105).

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Conceptually, the signs are at most slightly similar for the general public (§ 106-109). It may associate both signs with beekeeping due to the common and weakly-distinctive element 'API'.

The LOC must be assessed for the general public for whom the risk of confusion is greater, as the signs present similarities for that public in all three aspects of perception (§ 119).

Following a global assessment, there is no LOC between the signs (even for identical goods and considering the average degree of distinctiveness of the earlier mark). This is because, firstly, the degree of similarity between the signs is based on a weakly-distinctive element, and secondly, the general public will display a high level of attention in relation to the goods (§ 120).

05/10/2020, T 602/19, Naturanove / Naturalium, EU:T:2020:463

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Common element, Conceptual similarity, Minimum degree of distinctiveness, Phonetic similarity, Visual similarity, Weak trade mark

NORMS: Article 8(1)(b) EUTMR

KEY POINTS: Where the endings of word marks composed of two elements possess no visual, phonetic or even conceptual similarity, they are able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the weakly-distinctive beginning component, 'natura', common to both signs (§ 43, 44 and 50). Since the inherent distinctiveness of the earlier mark in the light of the two components of the word sign is weak (§ 75), the signs are globally different in the overall impression they produce in the mind of the relevant public (§ 76). There is no likelihood of confusion (LOC), notwithstanding the identity of the goods (§ 77).

For a trade mark of weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

FACTS: The applicant sought to register the word sign Naturanove for goods and services in Class 3, including Cosmetics and Cosmetic preparations for maintaining and caring for the hair.

An opposition was filed pursuant to Article 8(1)(b) EUTMR, based on the earlier Spanish word mark Naturalium and the earlier international registration designating the EU of the word mark Naturalium, both registered for goods in Class 3 including

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cosmetics, hair lotions. The Opposition Division upheld the opposition.

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal on the basis of the earlier international registration. It found that the signs were visually and phonetically similar to an average degree, and that conceptually both signs had no meaning. It added that the common element 'natura' had a weakly distinctive semantic significance and could not be given too much weight. It further stated that the earlier trade mark as a whole, despite the presence of the weakly distinctive component 'natura', had a normal degree of inherent distinctiveness. Due to the overall similarity of the signs, the identical goods, and the earlier trade mark's normal degree of distinctiveness, the BoA concluded that there was a likelihood of confusion (LOC) for a significant part of the public at large in the EU, with a level of attention that varies from average to higher.

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 upheld the action and annulled the BoA's decision.

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

The relevant public consists of the public at large in the EU as a whole and in Spain, with an average-

to-high level of attention, in particular for goods applied to the skin (not disputed). The goods under comparison are identical (not disputed) (§ 21 23).

COMPARISON OF THE SIGNS

The visual and phonetic similarities are strictly limited to the first component 'natura' which is common to both signs. The endings 'lium' and 'nove', despite containing the same number of letters, are completely different, so that they differ radically, both visually and phonetically (§ 42).

The BoA was wrong to consider that the first word component 'natura', common to both signs, was likely to attract more attention than the second word component of the signs. The relevant public will only distinguish two word components in the word signs (not disputed). Moreover, the first component 'natura' is weakly distinctive, which was explicitly stated by the BoA (not disputed) (§ 43). Therefore, notwithstanding the length and position of the component 'natura' in the signs, the endings of those signs have a significant distinctive role for the purposes of determining the commercial origin of the goods concerned (23/10/2013, T 114/12, Sterilina (fig.) / STERILLIUM et al., EU:T:2013:551, § 31). The endings of each of the signs, namely 'lium' and 'nove', do not share any degree of visual or phonetic similarity (§ 44).

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Therefore, the degree of visual and phonetic similarity of the signs is low and not average, as the BoA erroneously held (§ 45). Due to the weakly distinctive character of the common component 'natura', the conceptual similarity between the signs, taken as a whole, is low and not average as the BoA concluded (§ 51). Accordingly, the degree of similarity between the signs is visually, phonetically and conceptually low (§ 52).

LIKELIHOOD OF CONFUSION

For a trade mark of weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

THE INHERENT DISTINCTIVENESS OF THE EARLIER MARK

The earlier mark necessarily has, by virtue of its mere registration, a minimum degree of inherent distinctiveness. However, taken as a whole, the distinctiveness of the earlier mark is low (§ 65-66). The component 'natura' of the earlier mark is weakly distinctive, even though it accounts for 60 % of the length of the sign and appears at the beginning, since it will be perceived by the relevant public as suggestive of the natural origin of the goods. As for the second word component, the ending 'lium', although it has a significant distinctive role in

relation to the word component 'natura', neither its shorter length, nor its visual, phonetic or conceptual characteristics are capable of strengthening the distinctiveness of the earlier mark, taken as a whole (§ 67-69).

THE OVERALL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

The signs are globally different in the overall impression they produce in the mind of the relevant public (§ 76). The degree of similarity between the signs is visually, phonetically and conceptually low because of the weakly distinctive component 'natura' and the endings of the signs which have a significant distinctive role for the purposes of determining the commercial origin of the goods in question. The endings share no element of visual, phonetic or even conceptual similarity and are, therefore, able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the component 'natura', at the beginning, common to both signs (§ 43-44, 50, 52, 67, 73-74). In the light of the two components of the word sign, the inherent distinctiveness of the earlier mark is weak (§ 66-69, 75). There is no LOC between the signs, notwithstanding the identity of the goods (§ 76-77).

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05/10/2020, T 847/19, Pax / SPAX (fig.) et al, EU:T:2020:472

RESULT: Action dismissed

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

NORMS: Article 8(1)(b) EUTMR

KEY POINTS: If an earlier mark is registered for one of the general indications of the class heading, for example hand tools (hand operated) in Class 8, it is then protected for all products included in the literal meaning of that indication (07/04/2016, T 613/14, Polycart A Whole Cart Full of Benefits / POLICAR, EU:T:2016:198, § 23) (§ 43, 59)

FACTS: The applicant sought to register the verbal sign Pax for goods in Classes 8 (including knives; knife bags; knife holders; table forks; cutlery of precious metals; spoons; spoons for tea), 16, 21 (including cups; cups and mugs; glass mugs; cups of precious metal; mugs; cup holders; tumblers; porcelain mugs; cocktail glasses; glasses [drinking vessels]; pint glasses; margarita glasses; glasses [receptacles]; table plates; holders for carving boards; bottle stands; bottle coolers; bottle cradles; knife boards; bottles; bottle openers, electric and non-electric; bottle openers incorporating knives; cookie jars) and Classes 29, 30, 32 and 33. An opposition was

filed, pursuant to Article 8(1)(b) CTMR, based on the earlier figurative EU trade mark SPAX registered for goods in Class 21, namely glassware, porcelain and earthenware (included in Class 21). It was also based on an international registration for the figurative mark SPAX designating the EU, registered for goods in Class 6, namely goods of metal, as far as included in this class, as mechanical fastening elements, screws, nuts as well as threaded inserts of metal; Class 7, namely Motor driven tools; inserts and insert tools for motor driven tools; adapted cases for the aforesaid goods; and Class 8, namely hand tools (hand-operated), inserts and insert tools for hand-operated tools; cases adapted for the aforesaid goods. The Opposition Division (OD) rejected the opposition.

The opponent filed an appeal before the Board of Appeal (BoA). The BoA allowed the appeal and annulled the OD's decision. It found that the conflicting goods were in part identical and in part highly similar. It further found that the signs were visually and phonetically similar to at least an average degree, and that they had no conceptual meaning for part of the relevant public. The BoA held that the earlier marks were distinctive to an average degree and 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.

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EUTM application

Pax

Earlier marks



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

The relevant public consists of the general public and the professional public within the EU, with a level of attention that varies from average to high (not disputed (§ 31 32)).

As to the goods in Class 8, one of the earlier rights is registered for one of the general indications of the class heading, namely hand tools (hand operated), and it is therefore protected for all products included in the literal meaning of that indication (07/04/2016, T 613/14, Polycart A Whole Cart Full of Benefits / POLICAR, EU:T:2016:198, § 23) (§ 43). Accordingly, knives covered by the sign applied for are identical to hand tools (hand-operated) (§ 41-47). Knife bags and knife holders are included in cases adapted for

hand-operated tools and are therefore also identical (§ 50-54). Table forks; cutlery of precious metals; spoons; spoons for tea in Class 8 are highly similar to glassware, porcelain and earthenware in Class 21 (§ 56-61). The goods in Class 21, cups of precious metal, are highly similar to glassware, porcelain and earthenware (§ 63-64). Cups; cups and mugs; glass mugs; mugs; cocktail glasses; glasses [drinking vessels]; pint glasses; margarita glasses; glasses [receptacles]; bottle coolers; bottles; cookie jars are identical to glassware in Class 21 (§ 65-69). Cup holders, porcelain mugs, table plates; holders for carving boards; bottle stands; bottle coolers; bottle cradles; knife boards; bottle openers, electric and non-electric; bottle openers incorporating knives are identical to porcelain and earthenware in Class 21 (§ 71-74).

The verbal elements are the dominant elements of the earlier trade marks and their figurative elements are negligible (§ 89-90).

The signs under comparison have at least an average degree of visual similarity, as the sign applied for is entirely contained in the earlier trade marks. Additionally, although the consumer generally pays greater attention to the beginning of a mark containing verbal elements than to the end, in respect of word marks which are relatively short the central elements are as important as the elements at the beginning and end of the sign (§ 100-105).

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The signs have at least an average degree of phonetic similarity, since the sign applied for is entirely contained in the earlier trade marks and the signs are identical in their syllable structure and phonetic rhythm (§ 108-114).

None of the signs under comparison have a clear and specific meaning for the majority of the relevant public. Consequently, there is no conceptual difference which may counteract the visual and phonetic similarity of the signs (not disputed) (§ 91-93, 117).

Considering the identity/similarity of the goods, the average degree of similarity of the signs, and the average degree of distinctive character of the earlier trade marks, there is a LOC for a non-negligible part of the relevant public, which is sufficient to uphold an opposition, despite the relevant public's partially higher level of attention (§ 120-129).

05/10/2020, T 264/19, viscover (fig.) / VISCOVER et al., EU:T:2020:470

RESULT: Action dismissed

KEYWORDS: Bad faith, Burden of proof, Copyright

NORMS: Article 52(1)(b) CTMR [now Article 59(1)(b) EUTMR], Article 53(1)(c) CTMR [now Article 60(1)(c) EUTMR], Article 53(2)(c) CTMR [now Article 60(2)(c) EUTMR]

FACTS: The proprietor registered the figurative mark 'viscover' as an EUTM for goods and services in Classes 1, 2, 5, 9, 10, 42 and 44. An invalidity application was filed pursuant to Article 52(1)(b) CTMR, Article 53(1)(c) CTMR and Article 53(2)(c) CTMR.

The invalidity applicant and the proprietor of the contested EUTM concluded a cooperation and distribution agreement in 2009. That agreement was terminated in 2013 following a deterioration of the business relationship. Under the agreement, the EUTM proprietor was the exclusive distributor of the goods developed and produced by the invalidity applicant. In this context, the EUTM proprietor applied for the contested mark in 2010.

The invalidity applicant argued, in particular, that the EUTM proprietor had applied for the contested mark (i) in bad faith and (ii) in breach of its copyright in the term 'viscover'. The Cancellation Division dismissed the invalidity application on both accounts.

The invalidity applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. With respect to the earlier copyright, the BoA found that the invalidity applicant had not established its existence. As regards bad faith, the BoA found that the EUTM proprietor had a right to file the contested mark in its own name under the cooperation and distribution agreement. It further stated that the facts subsequent to the filing of the

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contested mark did not indicate the existence of bad faith at the time of filing.

The invalidity applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 52(1)(b) CTMR and (ii) infringement of Article 53(2)(c) CTMR. The GC dismissed the action.

EUTM

viscover

Earlier right: copyright (DE)

viscover

SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 52(1)(b) CTMR

Neither the letter nor the spirit of the cooperation agreement required the EUTM proprietor to file the mark in the name of both parties or to inform the invalidity applicant that it had only been filed in the distributor's own name (§ 48-57). The filing of the contested mark cannot be constitutive of bad faith, considering the wording of the cooperation agreement. Rather, it followed commercial logic, stemming from the proprietor's contractual position

as exclusive distributor (§ 58-77). The invalidity applicant does not succeed in proving that, at time of filing of the contested trade mark in June 2010, the proprietor had the intention to prevent the invalidity applicant from selling its goods under the trade mark after the end of the term of the contract. Nor does the invalidity applicant submit any evidence that the proprietor could foresee that the cooperation between them would be terminated prematurely (§ 78-84).

(ii) INFRINGEMENT OF ARTICLE 53(2)(c) CTMR

The invalidity applicant does not succeed in proving the existence of its earlier copyright in the term 'viscover' (§ 88-106). The invalidity applicant merely referred to several provisions of German copyright law without providing any evidence that the designation 'viscover' could be considered a literary work under German law (§ 91).

15/10/2020, T 851/19, SAKKATTACK (fig.) / Body attack et al., EU:T:2020:485

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Dissimilarity of the goods and services, Identity of the goods and services, Phonetic similarity, Visual similarity

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NORMS: Article 8(1)(b) EUTMR, Article 94(1) EUTMR, Article 37(1) EUTMDR

KEY POINTS: Woven fabrics; knitted elastic fabrics for sportswear; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths in Class 24 are dissimilar to clothing in Class 25 (§ 40 and 44).

Woven fabrics; knitted elastic fabrics for sportswear (Class 24) are dissimilar to towels (Class 24) (§ 49).

FACTS: The applicant sought to register the figurative sign 'Sakkattack' as an EUTM for goods in Classes 24 (woven fabrics; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths; knitted elastic fabrics for sportswear), 25 (sweat bands for the wrist; hats; clothing; sportswear; shoes; tennis socks; tennis shorts; athletic shoes; tennis shoes; sports jerseys; moisture-wicking sports shirts; sweat-absorbent socks; sweatbands; tennis sweatbands) and 28 (rackets; tennis rackets; grip tape for racquets; protective covers for rackets; tennis racket covers; tennis bags shaped to contain a racket; shaped covers for tennis rackets; vibration dampeners for tennis rackets; grip bands for tennis rackets; sporting articles and equipment; arm guards for sports use; arm pads adapted for use in sporting activities).

An opposition was filed pursuant to Article 8(1)(b) CTMR. It was based on the earlier international registrations designating the EU of the word mark Attack, registered for, inter alia, goods in Class 25 (clothing, footwear, headgear; all the aforementioned goods also for use in sports, in particular gloves for gymnastics) and 28 (articles for gymnastics and sports), and the word mark Body Attack registered for, inter alia, goods in Classes 20 (garment covers [storage]), 24 (towels); and 25 (t-shirts, caps, trousers, shoes, headgear, jackets, shirts, overalls, rain coats, scarfs, stockings and socks, gloves, sportswear of any kind, fitness wear, casual wear), as well as the figurative mark 'Body Attack SPORTS NUTRITION', covering goods and services in Classes 3, 5, 7, 14, 18, 21, 24, 25, 28 to 30, 32, 35, 44 and 45.

The Opposition Division (OD) partially upheld the opposition and dismissed the application in respect of the goods in Classes 25 and 28. It rejected the opposition in respect of the goods in Class 24.

The opponent filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. As regards the earlier mark Attack, the BoA found that, insofar as the application for registration related to the goods in Class 24, there was no likelihood of confusion (LOC), since these goods were different from those in Class 25 covered by the earlier mark. As regards the earlier mark Body Attack, the BoA found that the earlier mark had a normal degree

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of distinctiveness and that there was no LOC, even for identical goods, considering the public's normal level of attention. As regards the earlier mark 'Body Attack SPORTS NUTRITION', the BoA found that there was no LOC and rejected the opposition based on that earlier mark.

The applicant filed an action before the General Court (GC) relying on four pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 37(1) EUTMDR, (iii) infringement of the principles of equal treatment and of sound administration and (iv) infringement of the obligation to state reasons set out in Article 94(1) EUTMR.

EUTM application



Earlier EUTMs

Attack
Body attack



SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR AND (iii) INFRINGEMENT OF THE PRINCIPLES OF EQUAL TREATMENT AND OF SOUND ADMINISTRATION

The relevant public consists of the general public with an average level of attention in the EU (§ 29).

a) AS TO THE EARLIER MARK ATTACK

Woven fabrics and knitted elastic fabrics for sportswear in Class 24 covered by the mark applied for and clothing in Class 25 covered by the earlier mark Attack are dissimilar on account of their different natures, purposes and methods of use (§ 32, 40). Moreover, textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths in Class 24 and the goods covered by the earlier mark Attack, in particular clothing in Class 25, are dissimilar (§ 44). Therefore, there is no LOC insofar as the application for registration pertains to the goods in Class 24 (§ 45).

b) AS TO THE EARLIER MARK BODY ATTACK

COMPARISON OF THE GOODS

Woven fabrics and knitted elastic fabrics for sportswear covered by the mark applied for are dissimilar to the goods covered by the earlier mark Body Attack since that mark covers various items

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of clothing in Class 25 and these goods are raw materials or semi-finished products meant for the manufacture of clothes or additional tailoring. Their nature, purpose and method of use are therefore different from those of the goods in Classes 5, 20, 24, 25, 28 to 30 and 32 covered by that earlier mark, including the towels in Class 24 (§ 47, 49-50).

Textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths covered by the mark applied for and the towels covered by the earlier mark Body Attack are identical (not disputed) (§ 46, 48). Consequently, the examination as to whether there is a LOC is continued solely with regard to these identical goods (§ 51).

COMPARISON OF THE SIGNS

Both parts of the word element in the mark applied for are equally distinctive. However, at least for the part of the relevant public that understands the term 'attack' (which is a common term to which that public will pay less attention), it is the sequence of letters 's', 'a', 'k' and 'k' that will be dominant. The distinctive character of the figurative element of that mark is average (and not weak as stated by the BoA) with regard to the goods whose primary intended purpose is not use in tennis or sports in general (§ 60-71).

The signs under consideration are visually similar to a low degree, since they have the term 'attack' in common, but differ in the presence of the sequence of letters 's', 'a', 'k' and 'k', the presence of a figurative element in the mark applied for, and the presence of the element 'body' in the earlier mark Body Attack (§ 72, 76).

The signs are phonetically similar to a low degree since their pronunciation corresponds in the presence of the term 'attack', but differs in the presence of the sequence of letters 's', 'a', 'k' and 'k' in the mark applied for and the presence of the element 'body' in the earlier mark Body Attack, which are placed at the beginning of the signs (§ 77, 79-80).

The signs are conceptually similar to at most a low degree for the English-speaking part of the relevant public and the part of the relevant public whose mother tongue has equivalent to the English term 'attack' (e.g. French or Spanish). For these parts of the relevant public, the mark applied for would refer to an undefined attack, whereas the earlier mark Body Attack would refer to the act of attacking a body (§ 81, 79, 93).

ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

As the signs are visually and phonetically similar to a low degree and conceptually similar to at most a low degree, and considering the average degree of

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distinctiveness of the earlier mark Body Attack and the average level of attention of the relevant public, there is no LOC concerning the identical goods (§ 98).

The legality of the BoA's decisions is to be assessed solely on the basis of the EUTMR, as interpreted by the Courts of the EU (§ 100-106).

The mark applied for does not contain the earlier mark Body Attack in its entirety, but only one of its elements, the term 'attack'. Consequently, the term 'attack' cannot retain an independent distinctive role in the mark applied for, as noted in the Medion judgment (06/10/2005, C 120/04, Thomson Life, EU:C:2005:594, § 37). Since the earlier mark does not consist solely of that term, the relevant public is not liable to perceive it as a sub-brand of the mark applied for (§ 108).

(ii) INFRINGEMENT OF ARTICLE 37(1) EUTMDR

A referral to the Grand Board, under Article 37(1) EUTMDR, is provided for in two cases: firstly, if a BoA considers that it must deviate from an interpretation of the relevant legislation given in an earlier decision of the Grand Board, or secondly, if it considers that the Boards of Appeal have issued diverging decisions on a point of law which is liable to affect the outcome of the case (§ 114). However, Article 37(1) EUTMDR does not apply to the case of a BoA deviating from the previous decision of

another BoA, as alleged by the applicant (§ 117, 119). Moreover, the alleged divergence concerns a question of fact (similarity of goods), not a question of law (§ 118).

(iv) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS

The applicant's claim relating to a contradiction in the BoA's reasoning regarding the distinctiveness of the term 'attack' is rejected as ineffective since it could not, in any event, lead to the annulment of that decision (§ 125). The BoA gave sufficient reasons for its view that there was a low degree of phonetic similarity between the signs (§ 126). The BoA did not have to provide any reasons for its decision to deviate from the global assessment of the LOC, as referred to in settled case-law, since it did not deviate from the case-law or from its previous practice (§ 127).

15/10/2020, T 788/19, Sakkattack (fig.) / Attack et al, EU:T:2020:484

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Dissimilarity of the goods and services, Identity of the goods and services, Phonetic similarity, Visual similarity

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NORMS: Article 8(1)(b) EUTMR, Article 94(1) EUTMR, Article 37(1) EUTMDR

KEY POINTS: Woven fabrics; knitted elastic fabrics for sportswear; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths in Class 24 are dissimilar to clothing in Class 25 (§ 46-50).

Woven fabrics; knitted elastic fabrics for sportswear (Class 24) are dissimilar to towels (Class 24) (§ 55).

FACTS: The applicant sought to register the figurative sign 'Sakkattack' as an EUTM for goods in Classes 24 (woven fabrics; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths; knitted elastic fabrics for sportswear), 25 (sweat bands for the wrist; hats; clothing; sportswear; shoes; tennis socks; tennis shorts; athletic shoes; tennis shoes; sports jerseys; moisture-wicking sports shirts; sweat-absorbent socks; sweatbands; tennis sweatbands) and 28 (rackets; tennis rackets; grip tape for racquets; protective covers for rackets; tennis racket covers; tennis bags shaped to contain a racket; shaped covers for tennis rackets; vibration dampeners for tennis rackets; grip bands for tennis rackets; sporting articles and equipment; arm guards for sports use; arm pads adapted for use in sporting activities).

An opposition was filed pursuant to Article 8(1)(b) CTMR. It was based on the earlier international registrations designating the EU of the word mark Attack, registered for, inter alia, goods in Class 25 (clothing, footwear, headgear; all the aforementioned goods also for use in sports, in particular gloves for gymnastics) and 28 (articles for gymnastics and sports), and the word mark Body Attack registered for, inter alia, goods in Classes 20 (garment covers [storage]), 24 (towels) and 25 (t-shirts, caps, trousers, shoes, headgear, jackets, shirts, overalls, rain coats, scarfs, stockings and socks, gloves, sportswear of any kind, fitness wear, casual wear), as well as the figurative mark 'Body Attack SPORTS NUTRITION', covering goods and services in Classes 3, 5, 7, 14, 18, 21, 24, 25, 28 to 30, 32, 35, 44 and 45.

The Opposition Division (OD) partially upheld the opposition and dismissed the application in respect of the goods in Classes 25 and 28. It rejected the opposition in respect of the goods in Class 24.

The opponent and the applicant filed appeals before the Board of Appeal (BoA). The BoA dismissed both appeals. As regards the earlier mark Attack, the BoA found that, insofar as the application for registration related to the goods in Classes 25 and 28, there was a likelihood of confusion (LOC). By contrast, insofar as that application related to the goods in Class 24, it found that there was no LOC, since the goods were different from those in Class 25 covered by

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the earlier mark. As regards the earlier mark Body Attack, the BoA found that the earlier mark had a normal degree of distinctiveness and that there was no LOC, even for the identical goods, considering the public's normal level of attention. As regards the earlier mark 'Body Attack SPORTS NUTRITION', the BoA found that there was no LOC and rejected the opposition based on that earlier mark.

The applicant filed an action before the General Court (GC) relying on four pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 37(1) EUTMDR, (iii) infringement of the principles of equal treatment and of sound administration and (iv) infringement of the obligation to state reasons set out in Article 94(1) EUTMR.

EUTM Application



Earlier EUTMs

**Attack
Body attack**



SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR AND (iii) INFRINGEMENT OF THE PRINCIPLES OF EQUAL TREATMENT AND OF SOUND ADMINISTRATION

The relevant public consists of the general public with an average level of attention in the EU (§ 35).

a) AS TO THE EARLIER MARK ATTACK

Woven fabrics and knitted elastic fabrics for sportswear in Class 24 covered by the mark applied for and clothing in Class 25 covered by the earlier mark Attack are dissimilar on account of their different natures, purposes and methods of use (§ 46). Moreover, textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths in Class 24 and the goods covered by the earlier mark Attack, in particular clothing in Class 25, are dissimilar (§ 50). Therefore, there is no LOC insofar as the application for registration pertains to the goods in Class 24 (§ 51).

b) AS TO THE EARLIER MARK BODY ATTACK

COMPARISON OF THE GOODS

Woven fabrics and knitted elastic fabrics for sportswear covered by the mark applied for are dissimilar to the goods covered by the earlier mark Body Attack since that mark covers various items

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of clothing in Class 25 and these goods are raw materials or semi-finished products meant for the manufacture of clothes or additional tailoring. Their nature, purpose and method of use are therefore different from those of the goods in Classes 5, 20, 24, 25, 28 to 30 and 32 covered by that earlier mark, including the towels in Class 24 (§ 53, 55-56).

Textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths covered by the mark applied for and the towels covered by the earlier mark Body Attack are identical (not disputed) (§ 52, 54). Consequently, the examination as to whether there is a LOC is continued solely with regard to these identical goods (§ 57).

COMPARISON OF THE SIGNS

Both parts of the word element in the mark applied for are equally distinctive. However, at least for the part of the relevant public that understands the term 'attack' (which is a common term to which that public will pay less attention), it is the sequence of letters 's', 'a', 'k' and 'k' that will be dominant. The distinctive character of the figurative element of that mark is average (and not weak as stated by the BoA) with regard to the goods whose primary intended purpose is not use in tennis or sports in general (§ 66-77, 75).

The signs under consideration are visually similar to a low degree, since they have the term 'attack' in common, but differ in the presence of the sequence of letters 's', 'a', 'k' and 'k', the presence of a figurative element in the mark applied for, and the presence of the element 'body' in the earlier mark Body Attack (§ 78, 82).

The signs are phonetically similar to a low degree since their pronunciation corresponds in the presence of the term 'attack', but differs in the presence of the sequence of letters 's', 'a', 'k' and 'k' in the mark applied for and the presence of the element 'body' in the earlier mark Body Attack, which are placed at the beginning of the signs (§ 83, 85-86).

The signs are conceptually similar to at most a low degree for the English-speaking part of the relevant public and the part of the relevant public whose mother tongue has an equivalent to the English term 'attack' (e.g. French or Spanish). For these parts of the relevant public, the mark applied for would refer to an undefined attack, whereas the earlier mark Body Attack would refer to the act of attacking a body (§ 87, 95, 99).

ASSESSMENT OF THE LIKELIHOOD OF CONFUSION

As the signs are visually and phonetically similar to a low degree and conceptually similar to at most a low degree, and considering the average degree of

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distinctiveness of the earlier mark Body Attack and the average level of attention of the relevant public, there is no LOC concerning the identical goods (§ 104).

The legality of the BoA's decisions is to be assessed solely on the basis of the EUTMR, as interpreted by the Courts of the EU (§ 106-112).

The mark applied for does not contain the earlier mark Body Attack in its entirety, but only one of its elements, the term 'attack'. Consequently, the term 'attack' cannot retain an independent distinctive role in the mark applied for, as noted in the Medion judgment (06/10/2005, C 120/04, Thomson Life, EU:C:2005:594, § 37). Since the earlier mark does not consist solely of that term, the relevant public is not liable to perceive it as a sub-brand of the mark applied for (§ 114).

(ii) INFRINGEMENT OF ARTICLE 37(1) EUTMDR

A referral to the Grand Board, under Article 37(1) EUTMDR, is provided for in two cases: firstly, if a BoA considers that it must deviate from an interpretation of the relevant legislation given in an earlier decision of the Grand Board, or secondly, if it considers that the Boards of Appeal have issued diverging decisions on a point of law which is liable to affect the outcome of the case (§ 120). However, Article 37(1) EUTMDR does not apply to the case of a BoA deviating from the previous decision of

another BoA, as alleged by the applicant (§ 123, 125). Moreover, the alleged divergence concerns a question of fact (similarity of goods), not a question of law (§ 124).

(iv) INFRINGEMENT OF THE OBLIGATION TO STATE REASONS

The applicant's claim relating to a contradiction in the BoA's reasoning regarding the distinctiveness of the term 'attack' is rejected as ineffective since it could not, in any event, lead to the annulment of that decision (§ 131). The BoA gave sufficient reasons for its view that there was a low degree of phonetic similarity between the signs (§ 132). The BoA did not have to provide any reasons for its decision to deviate from the global assessment of the LOC, as referred to in settled case-law, since it did not deviate from the case-law or from its previous practice (§ 133).

15/10/2020, T 48/19, smart:)things, EU:T:2020:483

RESULT: Action dismissed

KEYWORDS: Descriptive, Non-distinctive, Legal certainty, Principle of legality, Substantial procedural violation

NORMS: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 59(1)(a) EUTMR, Article 95(1) EUTMR

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FACTS: The proprietor registered the figurative mark 'smart:)things' as an EUTM for goods and services in Classes 9, 20 and 35 (such as scientific, nautical, surveying, photographic apparatus and instruments; furniture, mirrors; advertising; business management; business administration and office functions; retailing and wholesaling).

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

The invalidity applicant filed an appeal before the Board of Appeal (BoA). The BoA declared the contested mark invalid under Article 7(1)(c) EUTMR and Article 7(1)(b) EUTMR. It found that the word elements 'smart' and 'things' were descriptive because they referred to the intelligent technology or technological sophistication of the goods and services, or were a characteristic of the goods, namely that they were 'fashionable' or 'chic'. It further found that the figurative element of a 'positive smiley' reinforced the message of the positive and advanced features of the goods. The BoA also stated that the sign was devoid of distinctive character because of its descriptiveness and its laudatory connotation.

The proprietor filed an action before the General Court (GC), relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article

7(1)(b) EUTMR, (iii) infringement of the principles of equal treatment and of sound administration and (iv) infringement of the last sentence of Article 95(1) EUTMR. The GC dismissed the action.



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

The relevant public consists of the general public and specialists in the fields of information technology and business, in all the regions of the EU in which basic English words are understood (not disputed) (§ 18).

The word element 'smart' refers to intelligent technology which, in addition to artificial intelligence, also relates to 'any technological feature over and above the "traditional" features of products'. As such, it is descriptive of the electronic or technologically-sophisticated goods which can have intelligent functions in Class 9 (§ 21), and the goods in Class 20 which can be part of technologically sophisticated products (§ 22). It is also descriptive of the services in Class 35, the retail or wholesale services in respect of the goods in Classes 9 and 20, and other related services (§ 23). The word element 'smart' can

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also be understood in the sense of ‘fashionable’ or ‘chic’ and therefore has a descriptive meaning as regards the goods in Class 20, which do not have any technological function or feature (§ 25, 26). The combination of the terms ‘smart’ and ‘things’ complies with the rules of English grammar and is not sufficiently unusual to create a new and clearly different meaning. Therefore, the combination of descriptive elements does not create a distinctive mark (§ 29). The non-descriptive emoticon does not divert the relevant public’s attention away from the descriptive message of the word elements (§ 37-38). Consequently, there is a sufficiently direct and specific relationship between the contested mark and the goods and services to render the sign descriptive for the general public with an average level of attention, and for the specialist public with a higher level of attention (§ 41).

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

One absolute ground is sufficient to refuse the registration of a trade mark (§ 45). Moreover, the BoA was also correct to consider that the sign was also devoid of distinctive character because of its descriptiveness and its laudatory connotation (§ 46-50).

(iii) INFRINGEMENT OF THE PRINCIPLES OF EQUAL TREATMENT AND OF SOUND ADMINISTRATION

The BoA did not infringe the principles of equal treatment and of sound administration § 54 55). In particular, it cannot be criticised for not having taken into account the similar EUTM of which the invalidity applicant is the proprietor in stating the reasons for the invalidity of the contested mark (§ 58).

(iv) INFRINGEMENT OF THE LAST SENTENCE OF ARTICLE 95(1) EUTMR

Procedural rules are generally held to apply from the date on which they enter into force (06/06/2019, T 221/18, BATTISTINO / BATTISTA et al., EU:T:2019:382, § 19) (§ 63). Since Article 95 EUTMR is a procedural provision, it must apply from the date on which the EUTMR entered into force, 01/10/2017. The proceedings before the BoA were brought on 07/05/2018 (i.e. the date on which the proprietor filed an appeal against the CD’s decision). Therefore, Article 95 EUTMR is fully applicable in the present case.

According to the last sentence of Article 95(1) EUTMR, in invalidity proceedings, the Office must limit its examination to the grounds and arguments submitted by the parties. However, the Office may base its decisions on – in addition to the facts and evidence submitted by the parties – facts which are well known (22/06/2004, T 185/02,

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Picaro, EU:T:2004:189, § 29) (§ 68-69). Therefore, the BoA did not infringe Article 95 EUTMR when it determined the relevant public's perception of the word elements 'smart' and 'things' on the basis of well-known facts, considering an extract of the Collins online dictionary which predates the filing date of the application for registration of the contested mark and constitutes a general accessible source (§ 71-76).

15/10/2020, T 2/20, BIOPLAST BIOPLASTICS FOR A BETTER LIFE (fig.) / Bioplak, EU:T:2020:493

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Dissimilarity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity, Weak element

NORMS: Article 8(1)(b) EUTMR

KEY POINTS: The goods and services in Classes 1 (such as chemicals used in industry, in particular pre-processed products and auxiliary agents for the manufacture of plastics; chemicals used in form of thermoplastically processable granules for pharmaceutical purposes) and 42 (such as scientific and technological services and research and design relating thereto in particular in the field of biodegradable plastics) on one hand and pharmaceutical preparations in Class 5 on the other

are dissimilar (§ 25-30, 31-35). The mere fact that one product is used for the manufacture of another is not sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct (§ 27). The goods cannot be regarded as complementary on the sole ground that one is manufactured with the other (09/04/2014, T 288/12, Zytel, EU:T:2014:196, § 39) (§ 29). The services in Class 42 have a different nature and purpose to those of the goods in Class 5. They are neither complementary to nor in competition with each other and their respective distribution channels and methods of use are different (§ 31).

Sanitary products..., excluding pharmaceutical and veterinary products included in Class 5 and the pharmaceutical preparations are similar to a low degree. Capsules (filled) for medical purposes (included in Class 5), excluding pharmaceutical and veterinary products and pharmaceutical preparations are similar (§ 36).

FACTS: The international registration holder designated the EU for the figurative EUTM 'BIOPLAST' claiming goods and services in Class 1 (chemicals used in industry, in particular pre-processed products and auxiliary agents for the manufacture of plastics; foaming agents for plastics; unprocessed plastics, in particular biodegradable unprocessed plastics, chemicals used in form of thermoplastically processable granules for pharmaceutical purposes), Class 5 (sanitary products (included in this class),

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capsules (filled) for medical purposes (included in this class), excluding pharmaceutical and veterinary products) and Class 42 (scientific and technological services and research and design relating thereto; industrial analysis and research services; services of a chemico-physical laboratory for testing and development of biodegradable plastics; scientific and technological consultancy in the field of testing and development of biodegradable plastics; all the aforesaid services in particular in the field of biodegradable plastics).

An opposition based on the earlier Spanish word mark Bioplak, registered for pharmaceutical preparations in Class 5, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division rejected the opposition. It found that there was no likelihood of confusion (LOC).

The opponent filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal.

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

EUTM application


BIOPLAST
BIOPLASTICS FOR A BETTER LIFE

Earlier EUTM

Bioplak

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

The relevant public consists of both the general public and professionals in Spain with a level of attention that is relatively high regarding the goods in Class 5, as they have medical purposes and could have an impact on health and the human body (not disputed) (§ 17).

The goods and services in Classes 1 and 42 covered by the trade mark application and the pharmaceutical preparations in Class 5 covered by the earlier mark are dissimilar (§ 25-30, 31-35). The mere fact that one product is used for the manufacture of another is not sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct (§ 27).

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The goods cannot be regarded as complementary on the sole ground that one is manufactured with the other (09/04/2014, T 288/12, Zytel, EU:T:2014:196, § 39) (§ 29). The services in Class 42 have a different nature and purpose to those of the goods in Class 5. They are neither complementary to nor in competition with each other and their respective distribution channels and methods of use are different (§ 31). The sanitary products..., excluding pharmaceutical and veterinary products included in Class 5 covered by the trade mark application and the pharmaceutical preparations covered by the earlier mark are similar to a low degree. The capsules (filled) for medical purposes (included in this class), excluding pharmaceutical and veterinary products covered by the trade mark application and the pharmaceutical preparations covered by the earlier mark are similar (§ 36).

The signs are visually similar to a low degree. They have in common the sequence of six letters, the first three of which constitute a weakly distinctive or non-distinctive prefix, that will not catch the attention of the relevant public much. By contrast, they differ markedly in their respective endings, namely 'k' and 'st', and in the presence of figurative elements and the expression 'bioplastics for a better life' in the sign applied for, which are not negligible (§ 49).

The signs are phonetically similar to a low degree. They coincide phonetically in the first six letters. However, even though the common prefix 'bio' will

be pronounced in the same way, the relevant public, which is familiar with that non-distinctive or weakly-distinctive element, will pay more attention to the pronunciation of the next of the terms concerned, namely 'plak' and 'plast'. Moreover, the signs differ significantly due to the pronunciation of the expression 'bioplastics for a better life' (§ 55-56).

Additionally, the signs are conceptually similar only to a low degree, since they have only an allusion to the biological nature of the goods or services in common, and the prefix 'bio' is of weakly-distinctive character (§ 67-68).

Any LOC as regards the dissimilar goods and services is ruled out (§ 71). As regards the goods which are similar or similar to a low degree, considering the low degree of overall similarity of the signs and the average inherent distinctive character of the earlier sign, there is no LOC for the relevant public with a relatively high level of attention (§ 73-80).

28/10/2020, T 583/19, Frigidaire, EU:T:2020:511

RESULT: Action dismissed

KEYWORDS: Evidence of use, Extent of use, Nature of use, Place of use

NORMS: Article 15(1) CTMR [now Article 18(1) EUTMR], Article°51(1)(a) CTMR [now Article°58(1)(a)

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EUTMR], Rule 22 CTMIR [now Article 10(3) and (4) EUTMDR]

KEY POINTS: Sales of goods to the US Department of Defense and the US State Department for military bases located in Belgium and Germany, which are not impressive and are likely to merely reflect the needs of the soldiers living on those military bases, are not capable of establishing the proprietor's intention to create a commercial outlet in the EU for the goods in question (§ 37).

FACTS: The EUTM proprietor registered the word mark Frigidaire as an EUTM for goods in Classes 7 and 11.

An application for revocation was filed pursuant to Article 51(1)(a) and (b) CTMR. The Cancellation Division (CD) partially upheld the application for revocation, on the ground that the contested mark had not been put to genuine use for some of the goods in Classes 7 and 11.

The proprietor filed an appeal before the Board of Appeal (BoA) and the cancellation applicant filed a cross-appeal. The BoA annulled the CD's decision insofar as it had revoked the EUTM for certain goods (coffee grinders, meat grinders, electric knives, meat slicers, ice crushers, juice extractors, pasta making machines) in Class 7. It dismissed the proprietor's appeal for the remainder and the cross-appeal.

The proprietor filed an action before the General Court (GC), relying on a single plea in law, challenging the BoA's finding that the contested mark had not been put to genuine use for some of the goods for which it has been registered.

SUBSTANCE: INFRINGEMENT OF ARTICLE 51(1)(a) CTMR

(i) FAILURE TO TAKE INTO CONSIDERATION EVIDENCE CONCERNING AMERICAN MILITARY BASES LOCATED IN MEMBER STATES

The proprietor claims that, contrary to the BoA's findings, the submitted evidence was sufficient to establish use of the contested mark in the EU, as well as its intention to create a commercial outlet for the goods within the EU. In that regard, it criticises the BoA on the ground that it did not take into account the case-law arising from three national legal decisions as well as a decision of the BoA (§ 22, 23, 28).

However, national decisions are not capable of calling into question the findings of the contested decision. The EU trade mark regime is autonomous and that the legality of the BoA's decision is assessed solely on the basis of the EU trade mark regulation (§ 29 32).

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Furthermore, since the concept of genuine use in the EU necessitates the use of the mark in the EU, use of that mark in third states cannot be taken into account for the purposes of establishing genuine use of that mark (19/12/2012, C 149/11, Onel / Omel, EU:C:2012:816, § 38) (§ 34). Therefore, the BoA was correct in finding that sales of the goods to the US Department of Defense and the US State Department for military bases located in Belgium and Germany, which were not impressive and likely to merely reflect the needs of the soldiers living on those military bases, were not capable of establishing the proprietor's intention to create a commercial outlet in the EU for the goods in question (§ 37-38).

(ii) FAILURE TO TAKE INTO CONSIDERATION THE SALES OF GOODS TO JOHANN FOUQUET AND THE CONTRACTS ENTERED INTO WITH DARTY ET FILS AND EURONICS

The proprietor criticises the BoA on the ground that it failed to have regard to the case-law on the conditions of the territorial extent of the use of a mark by not finding that the sales of goods to a German retailer (Johann Fouquet) and certain contracts constituted use of a sufficient territorial intensity and extent to establish genuine use of the contested mark in the EU (§ 39).

The territorial borders of the Member States should be disregarded in the assessment of genuine use

in the EU within the meaning of Article 15(1) CTMR (19/12/2012, C 149/11, Onel / Omel, EU:C:2012:816, § 44) (§ 40-41). On the basis of invoices addressed to the German retailer Johann Fouquet concerning 138 washing machines and 42 dryers, the BoA found a lack of German sales outside the American base and the city in which Johann Fouquet is established, and a lack of Belgian sales outside the American base in Antwerp. As such, the proprietor had not established its intention to market the goods in question in the EU. As regards the contracts entered into with Darty et Fils and Euronic, they are irrelevant because they either contain no reference to the contested mark or do not concern the goods in question. Therefore, the BoA correctly concluded that use of the contested mark was insufficient, in terms of territorial extent and intensity, to find that the proprietor had maintained or created a share in the market for those goods (§ 42-48).

(iii) FAILURE TO TAKE INTO CONSIDERATION USE OF THE CONTESTED MARK ON SOCIAL MEDIA

The proprietor claims that the BoA failed to take into account the evidence of use of the contested mark on social media when considering the totality of use in relation to the goods (§ 50).

However, the BoA found that the visibility of the contested mark on certain social media platforms did not establish genuine use of that mark in the EU. In particular, it found that there was no objective

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proof that the pages on social media platforms had been visited by the public residing in the territory of the EU. It observed, on the contrary, that those pages appear to be addressed to the public in the United States, given that the telephone number indicated began with the international dialling code of that country (§ 51). Therefore, the BoA took into account the use of the contested mark on social media provided by proprietor in order to assess the genuine character of that use in the EU (§ 52).

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EUTM application



04/11/2020, [R 488/2020-1](#), Square fabric tab with the letter 'A' on it, attached to the lower edge of a pocket (position mark)

Position mark – Distinctive Character – Article 7(1)(b) EUTMR – Decision annulled – Application remitted for continuation of proceedings

The applicant sought to register a position mark consisting of a square fabric tab, with the letter 'A' on it, attached to the lower edge of a trouser pocket. The application was filed for articles of clothing in Class 25. The examiner refused the mark applied for pursuant to Article 7(1)(b) EUTMR for all the goods applied for on the grounds that the sign, bearing in mind its small size and that the goods concerned were targeted at the general public with an average level of attention, would merely be perceived as a

decorative element of the item of clothing. Thus, it was concluded that the sign lacked distinctive character.

The Board finds the appeal well founded. Firstly, the Board notes that the fact that the mark applied for is a position mark does not make the assessment of its distinctive character different from other types of marks. Secondly, the Board finds that the contested decision did not provide any specific arguments as to why the stylised letter 'A' which is located on a tab of a trouser pocket is not distinctive per se (all the more so as this stylised letter 'A' is registered as European Union trade mark) and why the sign containing this letter should be perceived by the relevant public exclusively as a decorative element.

The Board emphasises that the size in the representation of the otherwise eligible trade mark on the product cannot be a registration criterion. In the clothing sector the customer is accustomed to seeing trade marks that are small in size located on the back pocket of a pair of trousers. The Board concludes that the position mark applied for is capable of fulfilling the individualising function of a trade mark. It possesses a degree of distinctiveness that is sufficient to indicate its commercial origin in respect of the goods applied for.

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28/10/2020, R 662/2020-2, B C (fig.) / bc (fig.) et al.

Contested sign



Earlier trade mark



Figurative mark – Likelihood of Confusion – Article 8(1)(b) EUTMR – Dissimilarity of signs – Decision confirmed – Opposition rejected

The applicant sought to register the contested sign, after a limitation, for goods in Classes 3, 4, 7, 8, 9, 11, 12, 19, 25 and 28. The opponent filed an opposition based on Article 8(1)(b) EUTMR invoking several earlier registrations for the trade mark above in respect of goods and services in Classes 8, 9, 12, 18, 21, 25, 28, 35 and 37. The opposition was directed against all the goods applied for. A part of the goods and services concerned were specified as

relating to bicycles. The Opposition Division rejected the opposition in its entirety on the grounds that the signs at issue were dissimilar, thus a necessary condition of Article 8(1)(b) EUTMR was not fulfilled.

The Board confirms the decision and dismisses the appeal. The Board finds that there are goods that are identical in Classes 8, 9 and 12 and focuses on these goods in order to assess if there is a likelihood of confusion between the sign applied for and the earlier marks.

As regards the signs, the Board holds that the relevant consumer may not see the signs at stake as visually similar. In the contested sign the letters 'B' and 'C' are clearly recognisable in combination with a figurative element that alludes to a tool or a bicycle chain joint, whereas it is unlikely that the targeted public would identify a particular combination of letters within the dark hexagon, in the earlier marks. Even if the consumer were to interpret the earlier marks as containing letters, these would not necessarily be perceived as a 'b' and 'c'. Further, the Board finds that aurally the signs are not comparable or there is a degree of similarity assuming that the letters 'b' and 'c' are perceived in the earlier marks and pronounced accordingly. Conceptually, the Board holds that the relevant public may associate the figurative elements of the signs with bicycles and therefore the signs have a certain similarity. Nevertheless, the Board points out that according to the case-law the mere correspondence of a concept

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is not sufficient to establish a relevant degree of similarity between two signs (14/11/2019, T-149/19, DEVICE OF A HUMAN FIGURE CENTERED OVER A BLUE ESCUTCHEON (fig.) / DEVICE OF A HUMAN FIGURE WITH A SEMICIRCLE (fig.), EU:T:2019:789, § 47). The Board concludes that, as the signs are not similar overall, there is no likelihood of confusion even for the goods that have been found to be identical.

28/10/2020, R 329/2020-1, BANU / BANUS

Contested sign

BANUS

Earlier trade mark

BANU

Word mark – Likelihood of confusion – Article 8(1) (b) EUTMR – Similarity of goods – Partly upheld

The applicant sought to register the word mark 'BANUS' for, inter alia, goods and services in Classes 30, 32, 33 and 43, mainly dealing with coffee, tea, beer, other non-alcoholic drinks, fruit beverages, fruit juices, syrups and other preparations for making beverages, alcoholic beverages and

services for providing food and drink, bar services, restaurants and hotel and catering services. An opposition was filed on the grounds of Article 8(1) (b) EUTMR based on an earlier EUTM registration for the word mark above in respect of 'waters [beverages]' in Class 32. The Opposition Division partially refused the trade mark applied for on the grounds that there was a likelihood of confusion for all the goods and services applied for in Classes 32 and 43, except 'hotel services'.

The Board dismisses the appeal and confirms the contested decision, insofar as 'coffee; cocoa, and artificial coffee' in Class 30, 'alcoholic beverages (except beer)' in Class 33 and 'hotel services' in Class 43 are concerned, finding that these goods and services are not similar to 'waters [beverages]' in Class 32 for which the earlier mark is registered. Although the signs are visually and aurally highly similar, there is no likelihood of confusion in view of dissimilarity between the goods and services above.

However, the Board holds that the appeal is well-reasoned in respect of 'tea' in Class 30. The Board finds that tea is a basic ingredient for very popular ready-made water-based beverages (e.g. pre-canned ready-made ice-tea). Due to the well-known health and beneficial properties of tea, green tea in particular is commonly used as an essence or flavouring in infused or flavoured mineral waters, which are nowadays offered as healthier and purpose-focused alternatives to plain mineral waters, aiming not only to quench thirst, but also to improve relaxation and concentration. When

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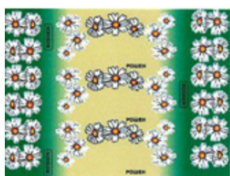
seeing, e.g. infused/flavoured 'water [beverages]' covered by the opponent's mark, on the one hand, and the applicant's 'tea', which includes, for instance, iced tea, consumers may perfectly assume that the goods may have a common commercial origin. Accordingly, there is a low degree of similarity between these goods.

Thus, in view of the high degree of similarity between the signs the Board finds that there is a likelihood of confusion in respect of 'tea' in Class 30.

30/09/2020, R 1109/2020-1, ПОШЕИ (fig.) / ПОМАШКИ (fig.)

Figurative Mark – Article 8(1)(b) EUTMR –

Contested sign



Earlier trade marks



Likelihood of Confusion – Decision Confirmed – Opposition Allowed

The applicant designated the European Union in its international registration ('IR') for the figurative mark above for goods in Class 30. The opponent filed an opposition against this designation on the grounds of Article 8(1)(b) EUTMR basing the opposition on an earlier international registration for the figurative mark above designating a number of European Union Member States in respect of goods in Class 30. The Opposition Division allowed the opposition and rejected the IR designating the European Union in its entirety.

The IR holder appealed this decision. The Second Board upheld the appeal, rejected the opposition and annulled the contested decision, considering that the level of attention of the relevant consumer was low, the goods were identical and that the similar elements of the signs were non-distinctive. The motif of daises or flowers in the signs was weak, while the camomile motif and the verbal element might denote the flavour of the confectionary. The Board held that even given the visual similarity between the signs there was no risk of confusion.

This decision was appealed and overturned in a judgment by the General Court (13/05/2020, T-63/19, ПОШЕИ (fig.) / ПОМАШКИ (fig.), EU:T:2020:195). The Court stated that the low level of attention of the relevant public, the identity between the

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goods and the fact that the marks, considered as whole, presented similar motifs, suggested the possibility of consumers wrongly believing that the goods originated from the same undertaking, or constituted variations of the same sign. The General Court concluded that the Second Board of Appeal wrongly found that there was no likelihood of confusion between the marks in conflict on the part of the relevant public. The case was reallocated to the First Board for further prosecution.

The First Board indicates in its decision that the signs have a similar structure and that there are visual, aural and conceptual resemblances between them, that the contested goods are identical and that the level of attention of the consumer of the goods at stake is lower than average. In both signs, the consumer's perception is attracted by the flowers and by the overall structure of the figurative motif that is the dominant element. The word components in the centre of the signs are small; they will not be overlooked, but they are of secondary importance.

The Board states that despite the inherently weak nature of the figurative motifs represented in the signs, it remains likely that a consumer having a lower than average degree of attention could be induced to believe that the goods concerned, bearing the signs, originate from the same undertaking. The contested sign may also bring the risk of an incorrect association with the earlier mark. In accordance with the similarities between

the patterns, the word written in Cyrillic letters, the flower motifs and green rectangles combined with the fact that the consumer has a lower than average level of attention, the Board finds that a likelihood of confusion is possible. Such finding is reinforced by the possibility that the contested sign is perceived as a mere variation of the earlier mark. Consequently, the Board confirms the decision and dismisses the appeal.

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