

# Alicante News

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Up to date information on IP and EUIPO-related matters



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### IP and the metaverse: new problems, new rules?

*By Eleonora Rosati*

What if one day it became possible for us to live and interact in a single, virtual world that was just like our physical one, save for it being – indeed – immaterial?

There is probably no need to look too far ahead. This is the concept behind something that is already very ‘real’: the metaverse.

#### **The metaverse: not so much of a novel concept**

A term first used in the 1992 science fiction novel *Snow Crash* by Neal Stephenson, the metaverse is now relevant to at least some parts of our lives.

Just think of the gaming sector. Launched in 2003, virtual world platform *Second Life* is one of the earliest applications of the metaverse. Through the use of avatars, players are able to live a virtual second life. Unlike traditional videogames, interactions on *Second Life* are not underpinned by any set objective: they are just about ‘existing’ on the platform and building relations with other players’ avatars.

Over the past couple of years or so, the concept of the metaverse has been significantly revamped and its development has undergone a substantial acceleration. All this has been prompted by the latest technological advancements, including blockchain, the widespread availability of cryptocurrencies, and the use of non-fungible tokens (NFTs) for digital assets. An NFT is best understood as a digital certificate that proves the provenance of a digital asset (e.g. a video clip) and is distinct from the digital asset itself.

Traditional and well-established brands have also explored the new opportunities offered by the metaverse to connect with existing and potentially new customers. For example, fashion brands like Gucci (through its Vault project) have been experimenting with NFTs and digital clothing, which have been also sold on the metaverse and gaming platform Roblox.

The metaverse is, of course, about entertainment too. Due to the lockdowns imposed during the COVID-19 pandemic and the impossibility of holding any in-person events (a major, if not the foremost, source of revenue for musicians and performers in the music sector), artists have sought new ways to

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connect with their fans. In 2020, rapper and singer Travis Scott was the first to hold a [concert](#) inside popular videogame Fortnite. Nearly 28 million unique players attended this event. This is a number that would be difficult, if at all possible, to achieve in any 'analogue' arena!

### IP in the metaverse: new strategies ... old problems

Of course, just as intellectual property (IP) is relevant to the offline world, it is to the metaverse too. Perhaps even more so!

In Europe, trade marks containing the word 'metaverse' have already been successfully registered, including [with the EUIPO](#). These registrations have had a particular emphasis on Class 9 goods, which include, among other things, computer software. In late 2021, Facebook famously underwent a rebranding operation and [changed its name to 'Meta'](#), with the aim of signalling that its core business moving forward would be to develop the metaverse even further. Registration of the new 'Meta' trade mark is being sought in several countries around the world, including in the [European Union](#).

Of course, the metaverse raises important questions relating to IP protection and whether certain activities can be controlled by IP owners. Recently, luxury brand Hermès took legal action against a digital artist for making and selling 'MetaBirkins'. These are a collection of virtual handbags authenticated by NFTs and developed without the authorisation of the famous maker of the iconic (and very real) Birkin handbags.

Another issue is what type of property one acquires when purchasing a virtual asset authenticated by an NFT. This is not a question of little significance considering that NFT-authenticated virtual assets can sell for several millions of US dollars (USD). Just think that Twitter's founder Jack Dorsey is said to have [sold his NFT-authenticated first tweet for nearly USD 3 million](#) and musician Grimes sold her digital art collection for USD 6 million.

From an IP perspective, does the purchaser of a digital artwork authenticated by an NFT acquire, by default, ownership of the copyright vesting in that minted artwork? And what happens if someone purchases an artwork authenticated by an NFT, which was generated without the copyright owner's permission and passed off as the 'real thing'? Can such a case be treated as it would be in the analogue world, where we would treat it as the purchase of forged art?

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### Will IP law need to come up with new solutions?

Considering all the questions that the metaverse has raised already, it is natural to wonder whether new solutions are warranted to answer them satisfactorily.

What is key to remember is that, by its very nature, IP law has been [constantly challenged](#) by technological developments. Just think of the advent of technologies like the printing press, the photocopying machine, the digital computer, and the internet, and all the complex issues that they have presented to courts and lawmakers. Also constant throughout the history of IP has been the overall ability of existing IP principles and legal provisions to accommodate such developments. Put differently, it has not been necessary to 'reinvent the wheel' each and every time.

Can we consider that the issues presented by the metaverse may be answered by looking into the existing legal framework? It may not be too optimistic to answer this with a (digital, of course) 'yes', while enjoying a sunny day sitting in a park in an old-fashioned, yet still quite pleasant, analogue manner.

*About Eleonora Rosati:*

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

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## DesignEuropa Awards: call for applications



Can you think of a client that has registered an innovative design? Do you know a designer with an extensive body of work protected by the registered Community design system? The next edition of the [DesignEuropa Awards](#) is now open for nominations and applications, and your help would be most welcome.

The DesignEuropa Awards have become a major event in the international design calendar. Organised every two years by the EUIPO, the Awards give recognition to outstanding designs and industry pioneers who have registered their ideas and products as registered Community designs. Applications for the Awards, now in their fourth edition, are open until **10 March 2023**.

The [DesignEuropa Awards categories](#) are:

- **The Industry Award:** For designs from large and medium-sized businesses.
- **The Small and Emerging Companies Award:** Aimed at designs from small companies as well as from recently established companies, regardless of their size.
- **The Lifetime Achievement Award:** Reserved for designers with a significant body of work, developed over the course of a career, who have had a considerable impact on the field of design.

Full details on how to apply for the DesignEuropa Awards 2023 or nominate a candidate are available on the [DesignEuropa Awards website](#). The nomination form enables you to nominate a design (for the Industry or Small and Emerging Companies Award) or a person (for the Lifetime Achievement Award).

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## IPR-intensive industries create more than 81 million jobs in the EU



The EUIPO, through the European Observatory on Infringements of Intellectual Property Rights, and the EPO have launched the 2022 edition of the report on [IPR-intensive industries and economic performance in the European Union](#).

This study shows that industries with a high number of intellectual property rights (IPRs) generate almost **4 in 10 jobs in the Member States and pay higher salaries**. Furthermore, the contribution of these industries to the EU's GDP amounts to **47 % of the total gross domestic product**, worth 6.4 trillion EUR.

These industries play a key role in the EU single market, as they are responsible for more than 75 % of trade within the EU as well as for most of the EU's trade with the rest of the world. The data from the 2022 edition shows that the contribution of IPR-intensive sectors to the EU economy is at its highest



level since the period 2008-2010 in all aspects: job creation, GDP and export of goods and services.

### Impact of climate change

This year, industries patenting climate change mitigation technologies (CCMT) and filing green trade marks were analysed for the first time. Among IPR-intensive industries, the weight of industries engaged in these activities has increased in the last few years. Sectors intensive in CCMT patents or green trade marks account for more than **14 % of the EU's GDP** and represent a source of competitive advantage for Europe in the global economy.

### Background

This is the fourth edition of the industry-level [IP-Contribution studies](#), carried out jointly by the EUIPO and the EPO, which assess the value of intellectual property for the EU economy. The 2022 edition looks at the period 2017-2019 and covers a broad range of IP rights – trade marks, designs, patents, copyright, geographical indications and plant variety rights – as well as a variety of economic indicators. This study uses a similar methodology to the previous three studies released in 2013, 2016 and 2019 to provide an updated assessment of the contribution of industries that use IP rights intensively.

[Access the full report](#)

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## New Case-law Research report

The Boards of Appeal of the EUIPO have released a new Case-law Research Report on [Similarity between beers and other beverages](#).

The report focuses on the comparison between 'beer' as contained in Class 32 and other beverages.

To date, the Boards of Appeal (BoA) have produced and published 6 reports in the context of the [BoA Action Plan 2021-2026](#), with the aim of enhancing **consistency**, coherence and **predictability** of their work, as well as increasing **knowledge, awareness and transparency** among the various stakeholders. These working documents reflect existing case-law up to the date of the report and have no binding effect on the BoA.

All reports are available [on the EUIPO website](#), under 'Boards of Appeal publications'.

## EUIPO's new corporate video



Our [new corporate video](#) showcases the mission, main activities and achievements of the EUIPO.

This five-minute film highlights the EUIPO's important role and demonstrates its expertise in protecting and promoting intellectual property. It achieves this by having strong ties with partners worldwide.

The video also emphasises the Office's customer-centred approach to projects and innovation. This has won the EUIPO recognition as the [most innovative IP office in the world](#) on numerous occasions. Key to this is the expertise of our employees and our focus on helping our customers unlock their potential.

The video presents who we are, what we do – and why. It gives some recent facts and figures and provides an overview of some of our projects, such as the [DesignEuropa Awards](#) and [Ideas Powered for Business](#). It also shines a spotlight on key takeaways from many of the [European Observatory on Infringements of Intellectual Property Rights](#) studies.

You'll find the new EUIPO corporate video on the [EUIPO YouTube Channel](#).

To keep up to date with all the EUIPO news, follow us on [Twitter](#), [LinkedIn](#), [Instagram](#) or [Facebook](#).

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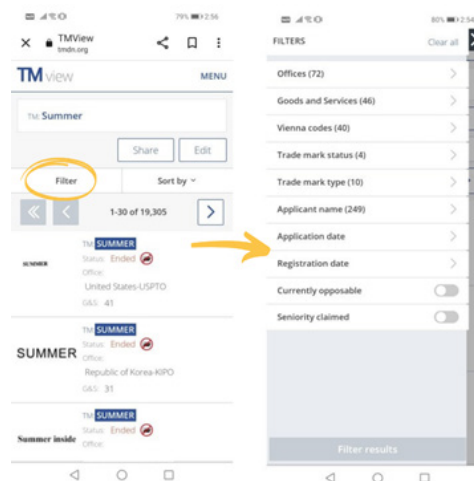
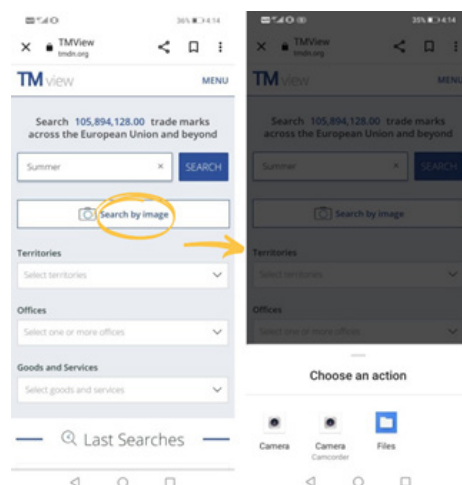
## Tool tip: Get TMview and DESIGNview on your phone

We are increasingly connected through our mobile devices. Whether in an airport or a taxi, or on your way to the next meeting, you might have to have access to information on trade marks and designs. You can now do a quick search on the mobile versions of [TMview](#) and [DesignView](#). They include most of the desktop version features in a more compact layout.

Make full use of your phone and improve the way you search. **Search by trade mark name** or simply **take a picture** with your phone and use that image as the search criteria. If you already have an image, just upload it and search. It is that simple!

In just a few taps you will get a list of results. You can then narrow these down even further. A few **filters** are common to both TMview and DesignView, such as offices, application date, registration date, applicant name and status, while other filters are specific to each platform.

For instance, if you are searching for designs you will be able to specifically filter on designer name or Locarno classification, but if you are searching for trade marks then filters such as goods and services, Vienna codes, currently opposable or seniority claimed, will definitely come in handy.



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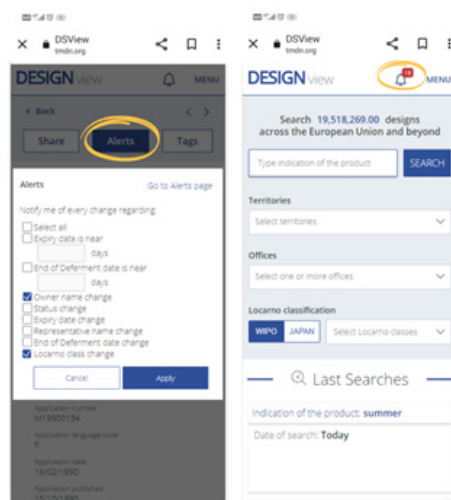
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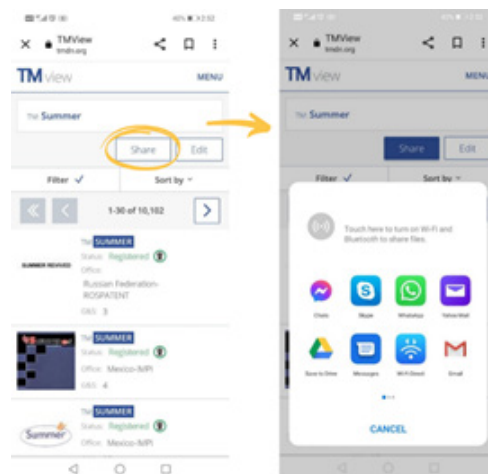
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strategic driver 03

If you never want to miss an update on the information that matters to you, sign into your account and start **creating alerts**. [TMview](#) and [DesignView](#) will act as your personal assistant, sending you notifications each time something relevant happens, like the change of a status for a trade mark or design.



Once you find the information that you need you can share it with others by email or SMS, or by using any social media apps of your choosing. They will receive a link that will redirect them to the relevant page in TMview or DesignView.



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## ACADEMY webinars

### Latest webinars

#### Classifying Trade Mark Services – steering clear of common pitfalls

Finding the correct wording and class can be tougher for services than for goods. Many deficiencies identified by the EUIPO trade mark examiners are precisely caused by the use of vague terms in service classes, or the misinterpretation of wording when selecting the class. Such deficiencies unnecessarily prolong the registration process of the mark.

In this webinar we go over:

- the most frequent deficiencies related to the classification of services, along with the EUIPO's practice as to vague terminology;
- the key principles for defining a service in line with the requirement of clarity and precision;
- how to determine the correct service class when using complex wording, as well as how to include goods in service classes; and how to remedy service-related deficiencies.

This webinar is for you if you are a current or future user of the European Union Trade Mark (EUTM) system with a minimum knowledge in the field of EUTMs classification.



#### Is my case suitable for mediation? Paving the road to a friendly settlement

The EUIPO through its Boards of Appeal [Alternative Dispute Resolution Service](#) (ADRS) promotes mediation as a viable, efficient and effective alternative to just about any dispute before the EUIPO that involves more than one party. However, many IP professionals and business owners often do not have sufficient elements to guide them in their decision on whether to consider mediation or directly jump into litigation.

During this webinar, members of the ADRS, who are also accredited mediators, walk you through the reasons why your IP dispute may be suitable for mediation. Our mediators also support their presentation with practical illustrations on the elements of an IP dispute that favour reaching a friendly settlement.

After this webinar, participants, whether students, practitioners or IP system users, will be able to:

- screen their IP disputes for mediation suitability,
- avoid long and costly litigation as well as
- increase the potential for finding a solution that is more satisfactory when compared to a formal decision or court judgement.

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## How to avoid procedural pitfalls related to GI protection at the EUIPO

This webinar addresses the EUIPO's practice in relation to the protection of Geographical Indications (GIs), namely the following:

- Classification: avoiding incorrect references to GIs in the list of goods and services.
- Absolute grounds: importance of checking, before filing a new trade mark, if it can be in conflict with a GI.
- Inter partes & relative grounds: impact of GI-related limitations and proof of entitlement in the actions based on Article 8(6) EUTMR.

After this webinar, participants will be able to:

- file and amend the list of goods and services in compliance with the EUIPO guidelines,
- know how to search for GIs in the relevant database, [Glview](#).
- understand the impact of GI-related limitations in the list of goods and services in the actions based on Article 8(6) EUTMR.



## Interactive webinar with EPO 'Playing with IP rights: Toys in the spot-light'

A new joint online seminar from the European Patent Academy and the EUIPO Academy shines a light on how IP can protect the broad field of toys. We all remember playing with toys when we were children, right? But have you ever stopped to think about the role played by IP rights in those very toys?

A toy combines both visual and functional aspects. But which aspects lead to a patent and which ones fall under the design? Or the trade marks? Are 3D shape trade marks suitable? What are the technical aspects behind a toy?

In this online seminar, two experts – Diego Tejada Biarge from the EPO and Christoph Bartos from the EUIPO – guide us in a lively discussion on how best to protect toys, using a variety of examples.

## Upcoming webinars

### Blockchain in the EU and the IP sector

Tuesday, 8 November 2022, 10.00 AM – 11.00 AM (CET)

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## The Metaverse – is it relevant for your (IP) strategy?

Tuesday, 15 November 2022, 10.00 AM – 11.00 AM (CET)



Many legal and technical issues have arisen (or will arise) in connection with the metaverse. Intellectual property issues are among the important ones. The metaverse is called to be the evolution of the Internet and will probably become one of your next communication channels in form of a virtual reality space for users to interact and spend time where brands and companies will have to be present. Consequently, the metaverse will probably become part of your company's strategy.

During this webinar you will receive an insight into what the metaverse is, some of its more technical aspects, current existing platforms and its connection to emerging technologies such as blockchain or NFTs.



This webinar is for you if you are a user or future user of the European Union Trade Mark and Registered Community Design systems with basic level knowledge in the field of EU trade marks and design.

## BOA Track on Case Law: Boards of Appeal decisions and GC/CJ judgments (2022 Q3 and Q4)

Tuesday, 29 November 2022, 10.00 AM – 12.00 AM (CET)

### On recent case-law

In [T-26/21](#) to T-28/21, the General Court confirmed the revocation of Apple's rights in the mark 'THINK DIFFERENT' for the peculiar way the sign was used on the packaging, that was not in accordance with its essential function of indicating the commercial origin of the goods.

On proof of use, the e-learning on [Proof of Use](#) aims at covering both procedural and substance issues in relation to Proof of Use and includes examples from real cases.

*For more on this or other developments in intellectual property law, take advantage of our extensive online learning offering in the EUIPO [Academy Learning Portal](#).*

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### Case-law comment: 'La Irlandesa'

By André Pohlmann, Member of the Boards of Appeal of the EUIPO



This article reflects the views and opinions of the author, and not the position of the EUIPO.

29/06/2022, T-306/20, La Irlandesa 1943 (fig.), EU:T:2022:404

**Bread-and-butter facts of deceptive trade marks: The General Court clarifies the scope of Article 7(1)(g) EUTMR**

#### Background

On 6 August 2013, the applicant filed the above figurative mark as an EUTM application for food products including butter. The mark was registered on 3 January 2014. On 7 January 2015, the intervener filed an application for a declaration of invalidity, claiming that the mark was deceptive (Article 59(1) (a) EUTMR in combination with 7(1)(g) EUTMR) and that the applicant had filed the mark in bad faith (Article 59(1)(b) EUTMR). The Cancellation Division rejected the invalidity request. The Grand Board annulled the decision of the Cancellation Division. The Grand Board found that the mark was of such a



nature as to deceive the public under Article 7(1)(g) EUTMR and was filed in bad faith. The General Court dismissed the action.

#### The judgement

The Spanish words 'La Irlandesa' mean 'of the country of Ireland' or 'Irish woman'. It is also a well-known fact that the green colour included in the label of the mark is used to represent Ireland. The Spanish public will therefore establish a direct connection between the meaning of the sign and the geographical origin of the food products and believe that those goods originate from Ireland. The relevant date for assessing the misleading character of the mark is the filing date. When the EUTM application was filed in August 2013, there was no inconsistency between the information conveyed by the mark and any characteristics of the goods. The list of goods covered by the mark does not include any indication of their geographical origin. In other words, the mark could cover goods from Ireland. Contrary to the findings of the Grand Board, the mark is not per se deceptive since there did not exist any inconsistency between the meaning of the mark and the goods on the filing date. Article 7(1) (g) EUTMR does not require the applicant to limit the list of goods to those originating from Ireland. Since the mark cannot be regarded as misleading on the filing date, any evidence relating to subsequent years could not confirm any misleading character of the mark.

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The fact that the applicant offered goods not of Irish origin under the contested mark is relevant for assessing bad faith. When filing the EUTM application in August 2013, the applicant intended unfairly to transfer the image of Irish dairy products to goods not having that origin and to take advantage of the former business relation with the intervener. The filing of the mark was thus contrary to honest commercial and business practices.

Although the Grand Board misinterpreted Article 7(1)(g) EUTMR it correctly found that the applicant acted in bad faith. The applicant's action was therefore dismissed.

### Practical significance

The judgment is important because it clarifies the scope of the absolute ground for invalidity under Article 59(1)(a) EUTMR in combination with 7(1)(g) EUTMR and distinguishes it from the ground for revocation under Article 58(1)(c) EUTMR. Article 7(1)(g) EUTMR refers to trade marks which are 'of such a nature' as to deceive the public as to certain characteristics of the goods. The provision requires the existence of actual deceit or a sufficiently serious risk that the public will be deceived (compare to 04/03/1999, C 87/97, Consorzio per la Tutela del Formaggio Gorgonzola, EU:C:1999:115, § 41; 18/11/2015, T 659/14, PORT CHARLOTTE, EU:T:2015:863, § 87). In the case at hand, the Spanish-speaking public assumes that the goods

originate from Ireland when being confronted with the sign 'La Irlandesa' on the packaging of those products. However, since the list of goods did not relate to any geographical origin it also included goods originating from Ireland. Since there is no contradiction between the meaning of the sign (as perceived by the relevant public) and the registered goods, Article 7(1)(g) EUTMR is not applicable (compare to 30/03/2006, C 259/04, EU:C:2006:215, Elizabeth Florence Emanuel, § 50; 08/06/2017, C 689/15, Gözze, EU:C:2017:434, § 55-56). The situation would be different if the mark had been applied for 'butter from Spain'. In that case, there would exist an inconsistency between the geographical origin indicated by the sign and the registered goods and Article 7(1)(g) EUTMR would apply.

On the other hand, Article 58(1)(c) EUTMR relates to the situation that a registered EUTM is liable to mislead the public as to certain characteristics of the registered goods such as their geographical origin in consequence of the use made of the trade mark by the proprietor in respect of those goods. Thus, if a company offers butter originating from Spain under the sign 'La Irlandesa' on the Spanish market the public will be deceived as regards the products' origin (see 12/02/2009, R 697/2008-1, MÖVENPICK OF SWITZERLAND). However, in the case at hand, the intervener did not rely on a revocation request based on Article 58(1)(c) EUTMR.

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As regards the bad faith claim, the specific circumstances of this case have to be considered. The judgment should not be interpreted in the sense that any misleading use of a mark as to characteristics of the product would automatically amount to bad faith under Article 59(1)(b) EUTMR. A relevant aspect for confirming a bad faith situation in this case was the fact that there existed a commercial agreement between the parties between 1967 and 2011, according to which the applicant was authorised to sell butter of Irish origin on the Spanish market as the intervener's exclusive agent. When the business relationship with the intervener terminated in 2011, the applicant continued to take advantage of that relationship by adopting a commercial strategy of association with the 'La Irlandesa' marks even though the products were no longer of Irish origin.

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### Luxembourg trade mark and design news

14/09/2022, T 737/21, e-tech, EU:T:2022:544

#### EUTM application

#### e-tech

#### Non-distinctive — Well-known facts — Decision confirmed — Application for EUTM rejected

The Board of Appeal (BoA) upheld the examiner's decision to refuse the EUTM application for the word mark 'e-tech' for services in Classes 37, 38 and 42 including services in installation, repair, maintenance, building, cleaning, demolition, research, development, quality control, testing, authentication as well as IT, scientific and technological consultancy and services and provision of technical reports, project planning and provision of information on the Internet. The BoA stated that the contested sign consists of the prefix 'e-', a widely used abbreviation for the word 'electronic', followed by the word 'tech', a common abbreviation for the word 'technology'. Taken in its entirety, the trade mark applied for will be understood as 'electronic technology' by the English-speaking public.

The BoA held that technological progress has led to electronic technologies being used in a wide variety



of sectors and that they play an important role in the context of the services at issue. Since the term 'electronic technology' and its abbreviation 'e-tech' are frequently used, the BoA concluded that they have lost any capacity to distinguish IT related goods and services and that consumers will not understand the sign applied for as an indication of the commercial origin of the services at issue. The General Court (GC) confirms the [BoA decision](#) and dismisses the action.

The GC affirms that the BoA provided sufficient reasoning for its findings. It adds that the BoA's findings are based on an understanding on the part of the relevant public which may be regarded as a well-known fact. This is a fact that everyone is aware of or which could be inferred from generally accessible sources. The GC then confirms that the terms 'electronic technology' and 'e-tech' are broad. They may serve as a basis for identifying a range of services which is so broad, that the relevant public will not be able to associate spontaneously the services provided under one of those terms with a particular undertaking. Therefore, neither of those terms is capable of indicating a commercial origin of the services at issue (§ 33).

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14/09/2022, T 498/21, Black Irish, EU:T:2022:543

### EUTM Application

#### BLACK IRISH

**Descriptive - 'Characteristic' under Article 7(1)(c) EUTMR - Colour of a product - Sufficient direct and concrete link with beverages - Decision confirmed - EUTM application partially rejected**

The [examiner](#), confirmed by the [Board of Appeal](#) (BoA), rejected the application for registration of the word mark 'BLACK IRISH' for various goods in Classes 30, 32 and 33, including 'hot chocolate, coffees, teas, beer and alcoholic beverages'. The BoA considered that the sign was descriptive as it simply informed the relevant public about the colour and the geographical origin of the goods. The General Court (GC) confirms the descriptiveness of the sign and dismisses the action.

The GC observes that it cannot be precluded that the colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR (§ 43). The assessment of whether the colour of a product is a characteristic of that product depends on the circumstances of the case, namely the colour described by the sign at issue, the nature of the goods at issue, and the specific manner in which reference is made to the colour in question (§ 44).



The GC notes that it is common knowledge that in the beverages sector the goods may be designated by terms referring to a colour. The colour concerned, which is very dark or black, is not particularly original in the beverages sector because there are many examples of beverages which have that characteristic (§ 45, 46). The colour designated by the word element 'black' will be understood as information regarding the chocolate content, as an indication of the colour of the coffee and of the lack of any additional substance in that coffee, as a type of tea (black tea) or even as an indication of the very dark colour of the alcoholic beverages – in particular because of the presence of coffee or chocolate in those beverages or because they are prepared using foodstuffs. Therefore, the term 'black' refers to a characteristic which is objective and inherent to the nature of the goods at issue and intrinsic and permanent with regard to those goods. Lastly, the manner in which reference is made to the colour 'black', namely in combination with another descriptive adjective, makes it more likely that the relevant public will perceive that element as a descriptive indication of the colour of the relevant goods (§ 47, 48).

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12/10/2022, T-222/21, Shoppi (fig.) / Shopify, EU:T:2022:633

### Earlier trade mark

SHOPIFY

### Contested sign



**No likelihood of confusion - Weak earlier mark - Common descriptive element - Post-Brexit EUIPO decision - Irrelevance of enhanced distinctiveness in the UK - Decision confirmed - Application for invalidity rejected**

On 18 February 2021, the [Board of Appeal](#) (BoA) rejected the application for invalidity of the contested sign, registered for goods and services in Classes 9, 35 and 38, including 'software, advertising and digital transmission of data', based on the earlier EU word mark 'SHOPIFY' registered for similar or identical goods and services. Due to the descriptiveness of the common element 'shop', it found no likelihood of confusion [Article 8(1)(b) EUTMR]. As the BoA took its decision after 1 January 2021, the date from which Brexit has been in full effect, it did not consider the evidence submitted to demonstrate the enhanced



distinctiveness of the earlier mark acquired through use in the United Kingdom. The General Court (GC) dismisses the action.

The GC confirms that, since the BoA decision was taken after 1 January 2021, the evidence related to use of the earlier mark in the UK could not be taken into account (§ 102). To be relevant for the application for a declaration of invalidity, that use must still be capable of being relied on at the date on which EUIPO rules on that application (§ 100). After 1 January 2021, no conflict can arise in the UK between the contested mark and the earlier mark, which are no longer protected in that territory. Moreover, the UK public was no longer part of the relevant public of the EU (§ 103). It is true that the date to assess the earlier mark's enhanced distinctiveness is the contested mark's filing date. However, the requirement of persistence of the prior right at the date on which EUIPO rules on the application for a declaration of invalidity is a matter of enforceability, previous to such a substantive assessment (§ 104).

Regarding the comparison of the signs, the GC underlines that, before assessing the similarity of the signs at issue, it is necessary to examine the distinctive and dominant elements of those signs (§ 41). As regards the descriptive character of the element 'shop' common to the marks at issue, the GC points out that it is well known that the word 'shop' is a basic English word. That word can be understood throughout the EU as the place where

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the goods or services at issue are sold or provided. It is therefore descriptive in nature (§ 47). The GC adds that it is only if that descriptive element were dominant in the mark that it could be considered on its own in the comparison between the marks (§ 53). In this case, the element 'shop' cannot be regarded as dominant in the marks at issue since the other elements are not negligible (§ 50-52).

The GC then states that the descriptiveness of an element which is common to two signs considerably reduces the relative weight of such an element in the comparison of those signs, including the visual and phonetic comparisons, even though its presence must be taken into account (§ 60). The common descriptive element 'shop' cannot dominate the overall impression. Therefore, the signs are visually and conceptually similar to a low degree and phonetically similar to an average degree (§ 64, 70, 74). Moreover, where a conceptual similarity is based on a weakly distinctive element, it plays a limited role and has less impact on the assessment of the likelihood of confusion (§ 73).

Having regard to the weak distinctive character of the earlier mark and to the relatively high level of attention of the relevant public, the GC finds no likelihood of confusion, despite the goods and services being similar or identical (§ 127).



**05/10/2022, T 696/21, LES BORDES (fig.) / DEVICE OF A STAG'S HEAD (fig.) et al., EU:T:2022:602**

### Earlier trade mark



### Contested sign



**Likelihood of confusion - Figurative marks - Decision confirmed - Opposition allowed**

In allowing the opposition, the Board of Appeal (BoA) noted that both signs display a black and white representation of a stag's head with antlers facing forward and that there is no evidence on file that the verbal elements 'LES BORDES' of the contested sign indicate a geographical origin for the relevant public in the EU, or that they relate to the figurative elements. Considering that both marks convey a message of a stag's head with antlers and

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that the average consumer retains only an imperfect recollection of a sign, the BoA concluded that there is a likelihood of confusion between the two signs, in relation to the goods and services in Classes 3, 14, 16, 18, 24, 25, 41 and 43. It added that due to the imperfect recollection factor, the relevant public would not be able to recall all figurative details of the signs in question, including the more or less realistic style of the stag's head or the circular background in which the animal's head in the earlier sign is placed. The General Court (GC) confirms the [BoA decision](#) and dismisses the action.

The GC agrees with the BoA that the average consumer is not likely to focus their attention on the differences that exist between the two signs. This is because the two signs contain the stylised representation of a stag's head with antlers, ears and a part of the neck facing forward while the proportions of these elements are almost identical (§ 32). The GC also notes that the double circle of the earlier trade mark will be perceived as a round frame which is rather a common in trade marks and that the cross and the black lines appear to be merely decorative elements (§ 35, 36). Therefore, all these elements will play a decorative role in the earlier trade mark (§ 39). The GC states that the signs cannot be compared phonetically. The earlier trade mark is a figurative sign which could be uttered by the word 'stag' or the word 'reindeer'. In addition, this sign contains other elements, such as a cross, a double circle and black lines, so that it may be



uttered in different ways. Therefore, it is impossible to attribute it a specific and concrete denomination (§ 51, 52). Considering that the contested sign's verbal elements 'LES BORDES' cannot influence the conceptual comparison between the signs, as they will be perceived by the majority of the relevant public as a meaningless term, the GC confirms that the signs are conceptually similar to an average degree since both signs will be understood as referring to a stag's head with antlers facing forward (§ 53, 60). Therefore, there is a likelihood of confusion [Article 8(1)(b) EUTMR] between the two signs (§ 80).

07/09/2022, T 353/21, R2R, EU:T:2022:527

### Contested sign

**R2R**

**No genuine use - Extent of use - Preparatory acts - No proper reasons for non-use - Decision confirmed - EUTM revoked**

The Board of Appeal (BoA) found that genuine use of the word mark 'R2R' has not been proved for 'vehicles and vehicle parts' in Class 12 and revoked the EUTM [Article 58(1)(a) EUTMR]. It noted that the EUTM proprietor had only submitted one order for 80 mountain bikes from one customer, which

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cannot be considered a serious attempt to maintain or create a share in the EU bicycle market, in which several million bikes are sold each year. The General Court (GC) confirms the [BoA decision](#) and dismisses the action.

The GC recalls that mere preparatory acts carried out within an undertaking cannot suffice to establish genuine use of a trade mark if they are not accompanied by sufficient marketing of the product concerned, under that trade mark, during the relevant period, carried out by external acts directed towards potential consumers. The design and development of models during the relevant period, without those internal preparatory acts being accompanied by external acts on the market (promotional campaigns and/or orders for goods) during that period, cannot, in themselves, be regarded as genuine use of the contested mark (§ 46).

Furthermore, the GC finds that there were no proper reasons for non-use. Only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use'. It is sufficient that there are proper reasons for non-use during a part of the relevant period to avoid revocation of the mark. However, the seasonal nature of the bicycle market and its alleged influence on the functioning of that



market has not been substantiated by the EUTM proprietor. Moreover, the general conditions of the relevant market, where demand and sales of the products concerned are significantly higher during certain periods of the year, apply to all operators in the sector and are normal market characteristics. Consequently, they do not have a sufficiently direct relationship to a registered trade mark so that they cannot be regarded as proper reasons for non-use during other periods of the year. Therefore, the commercial importance of the major bicycle shows during the summer does not demonstrate the existence of proper reasons for non-use of the contested mark during the preceding months (§ 57-61).

14/09/2022, T 609/21, Steam, EU:T:2022:563

### Contested sign

**STEAM**

**Genuine use - Affixing of trade mark on transport cases - Use as registered - Decision confirmed - Application for revocation rejected**

The Board of Appeal (BoA) found that genuine use of the word mark 'STEAM' has been proved for 'beers' in Class 32. The BoA noted that the evidence consisting of photographs of cardboard transport

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cases bearing the inscription 'steam beer' on one side of those cases could demonstrate the use of the contested mark. This inscription could be seen all along the distribution chain and in retail outlets and supermarkets. Moreover, the distributors who were in contact with the cases were also part of the relevant public. Therefore, the BoA rejected the application for revocation based on Article 58(1)(a) EUTMR. The General Court (GC) confirms the [BoA decision](#) and dismisses the action.

The GC recalls that the affixing of a mark on the packaging containing the goods covered by that mark may constitute proof of genuine use of that mark. Case-law does not distinguish between different types of packaging (§ 80, 82). The relevant public in this case consists not only of end users but also of distributors of the goods covered by that mark, who are among those in contact with those cases (§ 83).

Although genuine use of a mark requires it to be used publicly and outwardly, the outward use of a mark does not necessarily mean use directed at end users. Genuine use of the mark relates to the market where the proprietor of the EU trade mark pursues its commercial activities and where it hopes to put its mark to use. Accordingly, taking the view that outward use of a mark, within the meaning of the case-law, must consist of use directed at end users would effectively exclude marks used only in business-to-business relationships from the

protection of the EUTMR. The relevant public to which marks are addressed does not consist solely of end users but also of specialists, industrial clients and other professional users (§ 84).

In addition, the GC points out that the element added to the contested mark, namely 'beer', is purely descriptive of the goods at issue, that is to say devoid of any distinctive character. As a result, it cannot alter the distinctive character of the contested mark, pursuant to Article 18(1)(a) EUTMR, even if it were assumed that the latter mark has a weak distinctive character (§ 97).

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06/09/2022, R 1841/2021-5, OSCAR

#### Contested sign

OSCAR

**Genuine use - Place of use - Services provided outside the EU - Decision confirmed - Application for revocation rejected**

The Board of Appeal (BoA) finds that the word mark 'OSCAR' has been used in the EU for 'entertainment and educational services, namely, conducting an annual award ceremony recognizing exceptional achievement in the film industry' in Class 41. It confirms the [Cancellation Division](#) decision and rejects the application for revocation [Article 58(1) (a) EUTMR].

The BoA notes that although the evidence shows that the services at issue are physically conducted in the US, this is not sufficient to exclude that they can still be directed to the relevant consumers in the EU. It refers to the recent General Court judgment of [13/07/2022, T 768/20, The standard \(fig.\)](#), [EU:T:2022:458](#). It notes that taking account of the acts of use of a trade mark recognised by the EUTMR, such as the acts of advertising and of



offering for sale, those acts are relevant for the purposes of establishing genuine use of a trade mark insofar as they occur in the relevant territory.

The production of the entertainment programme, the 'OSCAR Awards', took place at a venue in Los Angeles, which was open to a relatively small number of invited guests or visitors. However, the majority of consumers, whose number far exceeds the number of guests, were not present at that location, but rather followed the ceremony on various media, mainly on television. It has been proved that the award ceremony was broadcast on many European television programmes at its full length of several hours via licencing agreements. This constitutes an act of use of the contested mark, seeking to promote and offer for sale the relevant services in the EU.

The BoA notes that the use of the mark in the EU is also demonstrated by advertising and merchandising material targeting EU consumers. The BoA further observes that the entire OSCAR Awards ceremony is undoubtedly entertaining in nature and the award is given for what the jury believes to be exceptional service to the film industry. Therefore, it considers that this activity falls into the scope of entertainment services and is directly related to the specific services for which the EUTM is protected.

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26/09/2022, R 1933/2021 4, R (fig.); 26/09/2022, R 1934/2021 4, R (fig.); 26/09/2022, R 1935/2021-4, R (fig.)

### Contested EUTM 1



### Contested EUTM 2



### Contested EUTM 3



**Use as registered - Single letter - Use in colour - Use without weak figurative elements - Decision partially annulled - Application for revocation partially rejected**

The above contested marks were registered for miscellaneous goods and services in Classes 16, 28, 35 and 45, which can be summarised as stationery, toys, advertising and retail services and gift registry services. The Cancellation Division (CD) considered that the contested marks were not used



as registered and revoked them in their entirety. The Board of Appeal (BoA) partially annuls the CD's decisions insofar as it revoked the contested marks for retail services of miscellaneous goods, including 'toys, games, books and clothing' (Class 35), and 'gift registry services' (Class 45).

The BoA finds that the contested marks have been used as registered. It notes that the reversed letter 'R' is perfectly legible and constitutes the most dominant and only distinctive element of the contested marks.

In the contested EUTM 1, the colour green and the green leaf do not add to the distinctiveness of the mark as they illustrate the idea of the ecological character of the goods and services. Therefore, the change of colour as well as the omission of the weak figurative element does not alter the distinctive character of the mark. The addition of a banal shape of a star is also an acceptable variation. Since contested EUTMs 2 and 3 were registered without any colour claim, their representation in colour does not alter their distinctive character, because the registration covers all possible colour combinations. Moreover, the omission of the banal shape of a star and the quotation marks, which are non-distinctive elements, is an acceptable variation.

The BoA then notes that the extent of use was sufficiently proved by numerous catalogues and printouts from online shops in the UK and Spain. However, genuine use is proven only for retail services of certain goods (Class 35) and gift registry services (Class 45).

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12/05/2022, C 49 031, Cspelroyal (fig.)

#### Contested EUTM

**cspelroyal** 


**Revocation grounds – Article 58(1)(a) EUTMR – Evidence of use – Time of use – Use as registered – Decision confirmed – EUTM partially cancelled.**

The EUTM, as shown above, was registered for goods and services in Classes 12, 25, 28 and 37. An application for a declaration of revocation of the EUTM was filed for all the goods and services registered on the grounds of article 58(1)(a) EUTMR, claiming that the EUTM had not been put to genuine use for a continuous five-year period.

In the present case, the focus of the genuine use assessment (including place, time, extent and nature of use) was on the nature of use criteria, in particular regarding the use of the mark as registered, and in relation to the registered goods.

The Cancellation Division considered that the EUTM in this case has two main elements, namely the verbal elements ‘cspelroyal’ and the figurative device of a bicycle rider. Where the evidence put forward by the proprietor showed a sign with those two main elements, it was deemed acceptable use of the mark as registered.



However, the use of only ‘Cspel,  or the two together was deemed an unacceptable variation of the mark and the evidence showing just those elements was not considered in the assessment of genuine use.

Furthermore, the contested EUTM was registered for various goods and services in Classes 12, 25, 28 and 37. However, the evidence filed by the EUTM proprietor did not show genuine use of the trade mark for all the goods and services for which it was registered.

According to Article 58(2) EUTMR, where there are grounds for revocation in respect of only some of the goods or services for which the contested mark is registered, the proprietor’s rights will be revoked only regarding those goods and services.

If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection. In this case, the Cancellation Division concluded that use had been proven for part of the goods registered in Class 12, namely bicycles, cycles and various goods related thereto. The genuine use of the goods and services in Classes 25, 28 and 37 was deemed not to have been proven. Therefore, the revocation was partially upheld.

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**The first part** features the most recent cases.

In September, the CJEU issued four decisions of interest:

- In case [C 716/20](#), RTL Television GmbH v Grupo Pestana, the Court ruled that [Directive 93/83/EEC](#) (the Satellite and Cable Directive) does not provide broadcasters, such as RTL Television, with an exclusive right to authorise or prohibit **cable retransmissions** of their programmes. It also clarified that the simultaneous and unaltered retransmission of television broadcast by satellite, in this case in hotel rooms, does not constitute cable retransmission, when such transmission is made by another person other than a cable operator.



- In case [C 263/21](#), concerning the Spanish system of **compensation for private copying**, the Court confirmed that national legislation that empowers an umbrella organisation, established and controlled by collective copyright management organisations with the management of (i) exemption from payment in respect of compensation for private copying and (ii) reimbursement thereof, is compatible with Article 5(2) [Directive 2001/29](#) or more generally with the principle of equal treatment. However, safeguards must exist: the certificates and reimbursements must be granted in good time, follow objective criteria and there must be a possibility to challenge decisions before an independent body.

- In case [C 112/21](#), X C.V. v Classic Coach Company, the CJEU ruled on the interpretation of Article 6(2) of Directive 2008/95 regarding the **coexistence of an unregistered local 'earlier rights'** (in this case, a trade name) with a later national registered trade mark.

- In Case [C 466/20](#), HEITEC AG v HEITECH Promotion Gmb, the CJEU interpreted the regime of limitation in cases of **acquiescence** under Article 9 of [Directive 2008/95](#). Notably, it ruled that an act, such as warning letter, by which the proprietor of an earlier mark opposes the use of a later mark, without taking the necessary steps to obtain a legally binding solution, does not stop acquiescence. Consequently, these acts do not interrupt the 5 years limitation period.

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Other European and national developments were also identified:

- The [European Court of Human Rights](#) (ECtHR) ruled that Azerbaijan's domestic courts had failed to provide reasons for establishing that national copyright rules (mainly exceptions and rules on exhaustion of rights to distribution) could constitute legal ground in a case of unauthorised reproduction of a book and its online publication. In the opinion of the Court, Azerbaijan has therefore failed to discharge its positive obligation under Article 1 of Protocol No.1 **to protect IP**, notably through effective remedial measures.

- In [France](#), the Judicial Court of Paris ruled that a politician could not benefit from the **quotation exception** for the unauthorised use of copyrighted materials in a presidential election campaign video. It held that, in the present case, copyright protection constituted a proportionate and necessary interference with freedom of expression. Furthermore, it noted that invoking freedom of expression as a defence was not capable of justifying beyond the exceptions (here, the quotation exception) a derogation from the author's exclusive rights.

- On the issue of **image rights**, the [Italian](#) Supreme Court ruled that, for the purposes of news, the use of photographs of Gianni Rivera (a famous Italian ex-footballer) with no connection



to his professional activity, and without his consent, could fall under the defence in [Article 97 of the Italian Copyright Act](#). The Court held that, in essence, it was not offensive, nor inappropriate and was not exposing his private life.

- In [Italy](#), in a dispute about the **copyright protection of fictional film characters**, the Court of Appeal of Rome sided with the first instance judge ruling that the 'Man with No Name' character from 'A Fistful of Dollars' (Sergio Leone – 1964), did not qualify for copyright protection and that the 'Spirit of the West' character from 'Rango' (Gore Verbinski – 2011) did not plagiarise it.

- Still in [Italy](#), finding that **website blocking orders** issued by [AGCOM](#) (the Italian communication authority) were bypassed by Italian users by switching to public DNS resolvers, some key music industry players brought a case to the Court of Milan. On 11 July 2022, the Milanese judge issued a preliminary injunction against **Cloudflare**, ordering the US company to stop users accessing identified copyright-infringing BitTorrent sites via its **DNS public servers**. This order also covers future domains (referred to as 'aliases') from which these sites may operate.

- Cloudflare services in [Austria](#) were also successfully targeted by a **blocking injunction** obtained by a collecting society. The Austrian court ordered several Austrian internet service

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providers (ISP) to block access to a list of copyright-infringing websites (DNS blocking). The order also included a [list IP addresses \(IP\)](#) to be blocked, belonging to the security and content network delivery provider Cloudflare, which were giving access to a wide variety of services, and being used for copyright-infringing purposes among others. Due to the risk of further legal actions, the affected ISPs have been complying with this specific blocking order, covering both a list of infringing domains (DNS blocking) and **IP addresses**, which is a new development in Austria.

• Then, interestingly, in [Switzerland](#), the Commercial Court of Zurich ended the judicial saga between FIFA (Federation Internationale de Football Association) and PUMA regarding the registration and use by the latter of the trade marks 'PUMA WORLD CUP QATAR 2022' and 'PUMA WORLD CUP 2022'. Addressing only the question of injunctive relief, the Court, considering that there was a risk of infringement by PUMA, ordered it to stop using the trade marks in connection with certain sporting goods, clothing and accessories, that it had been registered for, on the basis of **unfair competition and how it might mislead consumers**.

**The second part** covers decisions issued between 2018 and July 2022.

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

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

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