

# Alicante News

Up to date information on IP and EUIPO-related matters



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### DesignEuropa Awards 2020

The application and nomination period for the DesignEuropa Awards is now open, and runs until 20 April 2020.

Now in their third edition, the DesignEuropa Awards celebrate excellence in design and design management among [Registered Community Design \(RCD\)](#) holders.

Organised every two years by the EUIPO, the Awards have two categories open for applications and nominations: Small and Emerging Companies and Industry.

The Small and Emerging category is for RCDs owned by companies which comply with one of the following conditions: fewer than 50 employees and less than €10 million turnover/€10 million balance sheet total; or companies established after January 1 2016, regardless of their size.

Designs submitted in both categories will be judged by the DesignEuropa Awards Jury on: aesthetic value and visual appeal; demonstrable impact in the market; and the sound marketing and management of design and other intellectual property rights.

The DesignEuropa Awards Jury members are drawn from the fields of design, business and intellectual property rights. They are all recognised leaders in



their respective areas of specialisation, and bring a wealth of expertise gained over the course of their professional careers.

All designs submitted must be valid RCDs at the time of sending the application, with no pending invalidity proceedings. Finalist designs must retain their validity throughout the selection and award period.

Entries may be submitted either on the candidate's own initiative, at the behest of the Awards' promoters or by any other person, entity or institution that wishes to propose a candidate.

[Applications](#) can be submitted by the owners of the RCD themselves via the application form. RCDs entered for the competition must be marketed by the owner of the design or a design licensee. Applicants can submit up to five entries (one RCD per entry), provided that each RCD has been designed by a different designer or by a team of designers with at least one different member.

Candidates for both categories can also be proposed by any person, entity or institution by submitting a [nomination form](#).

The DesignEuropa Awards also feature a Lifetime Achievement Award category, which is reserved for individual designers with a significant body of work of aesthetic value, created over the course of

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a career, which has also had a demonstrable impact on the marketplace. This category is [nomination only](#).

All nominees for the Lifetime Achievement Award must currently use or have used the RCD system during their professional careers. Previous winners of the DesignEuropa Lifetime Achievement Award are legendary automobile designer [Giorgetto Giugiaro](#) (2016) and internationally recognised industrial designer [Harmut Esslinger](#) (2018).

The Awards Ceremony will be held in Eindhoven, The Netherlands, on 20 October 2020 in collaboration with the [Dutch Ministry of Economic Affairs and Climate Policy](#) and the [Benelux Office for Intellectual Property](#).

More details on the Awards, plus the rules of participation and details on the ceremony can be found at [www.designeuropawaards.eu](http://www.designeuropawaards.eu)



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## EUIPN Updates

### Consultation on CP11 – New Types of Trade Mark

The draft Common Practice of the project [CP11 'New Types of Trade Mark – Examination of formal requirements and absolute grounds for refusal and invalidity'](#) has been made available in English for comments. This publication refers only to the work-stream 1 of the project: Examination of formalities and absolute grounds for refusal and invalidity.

The CP11 Working Group, composed of representatives from nine intellectual property offices of the EU, four user associations and the EUIPO, made significant progress on developing the Common Practice during the course of three Working Group meetings and a workshop in which the representatives shared best practices and expertise to establish the common principles of the CP11 project.

As a result, the draft of the CP11 Common Practice is now available for review by all stakeholders. The Working Group members have included several sections in the document that are still under discussion, where it would be very appreciated to receive input or feedback.

In particular, the Working Group would like to gather input regarding consumer perception of each of the new types of trade mark in order to develop an individual rationale for each type (sound, motion, multimedia and hologram mark). For this reason, the receipt of information on consumer perception



would be highly appreciated (case-law, surveys, scientific articles, etc.) with regard to any of the new types of mark in order to further elaborate these sections of the Common Practice.

The EUIPO welcomes your comments, which should be addressed to [CommonPractices@euiipo.europa.eu](mailto:CommonPractices@euiipo.europa.eu) by Thursday, 14 November 2019.

The CP11 project is part of the [European Cooperation Projects](#) under the heading ECP4 Shared Services and Practices.

### OAPI AND Liechtenstein join TMview

The African Intellectual Property Organization (OAPI) and the Bureau of Intellectual Property within the Office of Economic Affairs of the Principality of Liechtenstein have made their trade mark data available to the TMview search tool.

These two latest implementations bring the total number of participating offices to 71. TMview now offers access to almost 55.1 million trade marks.

Since the introduction of TMview on 13 April 2010, the tool has served more than 61.5 million searches from 169 different countries, with Spain, China and Germany among the most frequent users.

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### IPR Enforcement Case-Law Collection on the Liability and Obligations of Intermediary Service Providers in the European Union

Online intermediaries bring together or facilitate transactions between third parties on the internet. They give access to, host, transmit and index content, products and services originated by third parties on the internet, or provide internet-based services to third parties.

As intermediaries are of great importance in the internet era, the EUIPO Knowledge Circle Enforcement has released a case-law collection report on the liability and obligations of intermediary service providers in the European Union.

This case-law collection gives an overview of relevant decisions of the Court of Justice of the European Union (CJEU) as well as of national courts in 14 selected EU Member States. More specifically, it presents relevant and important decisions issued between 2016 and the beginning of 2019. This time frame was selected due to substantial developments in this area at EU and national level. Important preliminary rulings from the CJEU before 2016 are also mentioned but not summarised.



The case-law collection does not analyse the decisions collected but provides a summary of them, as well as an overview of the criteria applied and conclusions reached by the courts.

The full report can be found [here](#).

### Third edition of the IP Case Law Conference

The IP Case Law Conference will take place in EUIPO's Alicante headquarters on 21 and 22 May 2020. The conference, now in its third edition, will gather international intellectual property experts for a two day forum of debate and discussion.

The conference will focus on some of the live issues currently engaging the IP community, such as:

- The multiple facets of bad faith
- The interaction between trade marks and human rights
- Analysing reputation at Member State and EU level
- How IP rights intersect with new technologies (video games, 3D printing and blockchain)
- The interplay between geographical indications, certification and collective marks.

More details on the IP Case Law Conference can be found [here](#).

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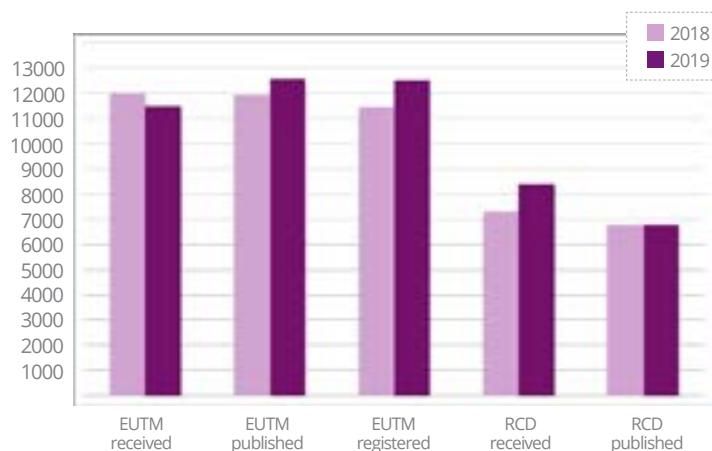


## Statistical Highlights



Monthly statistical highlights September*	2018	2019
European Union Trade Mark applications received	12 010	11 507
European Union Trade Mark applications published	11 917	12 571
European Union Trade Marks registered (certificates issued)	11 460	12 501
Registered Community Designs received	7 296	8 388
Registered Community Designs published	6 784	6 769

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



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### Luxembourg trade mark and design news

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

**C-104/18 P; Stylo & Koton (fig.); Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v EU IPO; Judgment of 12 September 2019; EU:C:2019:724; Language of the case: EN**

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

**KEYWORDS:** Bad faith, Dissimilarity of the goods and services

**FACTS:** The EUTM proprietor sought to register the figurative mark as an EUTM for goods and services in Classes 25, 35 and 39.

An opposition based on the earlier figurative marks, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition insofar as it related to goods and services in Classes 25 and 35. The decision was confirmed by the Board of Appeal (BoA).

An invalidity application was filed, pursuant to Article 52(1)(b) CTMR, against the EUTM that was registered in Class 39. The Cancellation Division (CD)



dismissed the invalidity application, finding that it had not been proven that the intervener had acted in bad faith.

The invalidity applicant appealed. The BoA dismissed the appeal, finding that there could be no bad faith within the meaning of Article 52(1)(b) CTMR since there was neither identity nor similarity between the goods or services.

The invalidity applicant filed an action before the General Court (GC), relying on a single plea in law: (i) infringement of Article 52(1)(b) CTMR. The GC dismissed the action. It found that the BoA was fully entitled to decide that bad faith had not been established by relying on the fact that the contested mark was registered for services dissimilar to those designated by the earlier marks, thus precluding any likelihood of confusion (LOC) between the marks at issue.

The invalidity applicant appealed to the Court of Justice of the European Union (CJ). The CJ upheld the appeal.

**SUBSTANCE:** The ground of bad faith applies where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark filed its application for registration, not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties (in a manner inconsistent with honest practices), or with

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EUTM

**STYLO**  
&  
**KOTON**

### Earlier trade marks



the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular, the essential function of indicating origin (para. 46).

There may be situations where the application for registration of a trade mark had been filed in bad faith notwithstanding the fact that, at the time of that application, there was no use by a third party on the internal market of an identical or similar sign for identical or similar goods. In applications for invalidity based on Article 52(1)(b) CTMR, there is no requirement whatsoever that the invalidity applicant be the proprietor of an earlier mark for identical or similar goods or services (paras 52 and 53).

In cases where, at the time of the application for the contested mark, a third party was using, in at least one Member State, a sign identical with, or similar to, that mark, the existence of LOC need not necessarily be established for Article 52(1)(b) CTMR to apply (para. 54).

In the absence of LOC, or if there has been no use by a third party of a sign identical with, or similar to, the contested mark, other factual circumstances may constitute relevant and consistent indicia establishing the bad faith of the applicant (para. 56).

The GC should have taken account of the fact that the EUTM proprietor had sought registration of a sign comprising the stylised word KOTON as an EUTM, not only for services in Class 39, but also for goods and services in Classes 25 and 35 (para. 60).

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

**T-575/18; The Inner Circle / InnerCircle; Shore Capital International v EUIPO; Judgment of 9 September 2019; EU:T:2019:580; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Dissimilarity of the goods and services

**FACTS:** The applicant designated the European Union in an international registration (IR) for the figurative mark 'The Inner Circle' for, inter alia, the services arranging and organization of leisure events and meetups at high-end venues, in order to bring people together for the sole purpose of matchmaking and dating in Class 41.

An opposition based on the earlier word mark InnerCircle registered for services in Classes 35-38 and 42 and in particular consultancy services in the field of advertising or commercial strategies aimed at other business entities in Class 35 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) rejected the opposition on the ground that the services were dissimilar.

The opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal. The services were held to be dissimilar as they had different purposes and



intended uses, used different distribution channels and could not be considered as complementary or in competition with each other.

The opponent filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. It claimed that, since the services were very similar and the marks 'almost identical', there was a likelihood of confusion. The GC dismissed the appeal.

### IR designating the EU

## The Inner Circle

### Earlier Right

InnerCircle

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 8(1)(b) EUTM.

The relevant public is the general public in the European Union with a higher-than-average level of attention (para. 28).

**COMPARISON OF THE SERVICES.** Notwithstanding the fact that the Nice Classification was adopted for exclusively administrative purposes, the explanatory

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notes on the different classes of that classification are relevant in determining the nature and purpose of the goods and services under comparison (para. 38).

Having regard to the explanatory notes on Classes 35 and 41, the services under comparison are of a different nature and purpose as the services for which the earlier mark is protected were principally consultancy services in the field of advertising or commercial strategies aimed at other business entities, whereas the services for which protection was sought have the sole purpose of dating and matchmaking and the very concrete aim of bringing people together. The services cannot be considered complementary or in competition with each other, since they involve different market segments, are provided by different undertakings and use different distribution channels (paras 35-42).

The services for which protection is sought in Class 41 and the services for which the earlier mark is protected in Class 35 are dissimilar as they have a different purpose and intended use, cannot be considered as complementary or in competition with each other, and use different distribution channels (para. 45).

**LIKELIHOOD OF CONFUSION.** In the absence of similarity between the services, one of the cumulative conditions required by Article 8(1)(b)



EUTMR is lacking. Accordingly, there is no likelihood of confusion.

**T-680/18; LUMIN8 (fig.) / LUMI et al.; SLL Service v EUIPO; Judgment of 9 September 2019; EU:T:2019:565; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant designated the European Union in an international registration (IR) for the figurative mark 'LUMIN8' for goods in, inter alia, Classes 6, 19 and 20.

An opposition based on the earlier EU word mark LUMI and the earlier EU figurative mark 'LUMI Endless possibilities', both registered for goods in Classes 6, 19 and 20, was filed pursuant to Article 8(1)(b) EUTM. The Opposition Division (OD), basing its decision solely on the earlier EU word mark LUMI, upheld the opposition.

The Board of Appeal (BoA) dismissed the appeal filed by the applicant. It held that there was a likelihood of confusion (LOC), in particular on account of the identity of the goods, the normal degree of distinctiveness of the earlier mark and the overall

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visual, phonetic and, at least for part of the relevant public, conceptual similarity of the signs.

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

### IR designating the EU

**LUMIN8**

### Earlier Rights

**LUMI**

**LUMI**  
Entertainment

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

The relevant public consists both of professionals from the building sector and in the field of home maintenance, improvement and renovation, and of the general public, namely do-it-yourself amateurs in the European Union, with an above-average level of attention (not disputed) (para. 18).

The goods are identical (not disputed) (para. 20-21).

### COMPARISON OF THE SIGNS.

Visual similarity. Where a figurative mark containing word elements is compared visually with a word mark, the marks are held to be visually similar if they have a significant number of letters in the same position in common and if the word element of the figurative sign is not highly stylised, notwithstanding the graphic representation of the letters in different fonts, in italics or bold, in lower case or upper case, or in colour (para. 32). The differences concerning the graphic elements are secondary and therefore not sufficient to outweigh the visual similarities (paras 33-34). The signs are visually similar to an average degree due to the presence of the element 'lumi', which is located at the beginning of the mark applied for and is the only element in the earlier mark at issue (paras 26, 34 and 35-36).

Phonetic similarity. The identical pronunciation of the common element 'lumi', which is located at the beginning of the mark applied for, will be more likely, precisely on account of its position, to attract the relevant public's attention than the sound made by the additional letter 'n' or number 8 that are located after the word element 'lumi', at the end of the mark. The presence of the number 8 may even make consumers more likely to identify, in the mark applied for, the element 'lumi', which is common to both marks, as a number is clearly distinct from a

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combination of letters (paras 35, 46-48). Therefore, the signs are phonetically similar to an average degree overall (para. 51).

**Conceptual similarity.** From the overall impression created by the signs, the signs are, at least for part of the relevant public, namely that part which is likely to perceive the concept of 'light' in the element 'lumi' of the earlier mark and in the element 'lumin' of the mark applied for (on account on the Latin word 'lumen'), conceptually similar to a low degree overall. The perception of only one part of the relevant public in the European Union may be relied on for the purposes of comparing the signs conceptually (paras 52-53, 57, 58 and 60-61).

### LIKELIHOOD OF CONFUSION.

In view of all the factors relevant in the context of a global assessment of the likelihood of confusion between the marks and, in particular, of the identity of the goods, the overall visual, phonetic and, at least for part of the relevant public, conceptual similarity of the signs and the normal degree of distinctiveness of the earlier mark (not disputed), there is LOC between the marks for part of the relevant public, even when a higher level of attention on the part of that public is taken into account (paras 70-72).

**T-689/18; EXECUTIVE SELLING (fig.); Executive Selling v EUIPO; Judgment of 9 September 2019; EU:T:2019:564; Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Descriptive

**FACTS:** The international registration (IR) holder designated the European Union (EU) in an IR for the figurative mark 'EXECUTIVE SELLING' for services in Classes 35 and 41, including, inter alia, business management, activities of training, education and organisation of congresses and the services of publication of books, periodicals and films. The Office refused the EU designation pursuant to Article 7(1)(b) and (c) EUTMR.

The Board of Appeal (BoA) dismissed the IR holder's appeal. The BoA found that the mark was descriptive and devoid of distinctive character to the extent that it consists of a description of the services concerned: 'selling at executive level'. Each of the terms are individually plain and non-distinctive for business management and providing training.

The IR holder filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

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### IR designating the EU

### EXECUTIVE SELLING

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

The relevant public is primarily composed of a professional English-speaking public with a high level of attention (not disputed) (para. 27).

The expression 'executive selling' conveys a meaning corresponding to the mere combination of meanings lent by the terms of which it is composed: the adjective 'executive', referring to company staff and to decision-making, and 'selling', a noun derived from the verb 'to sell', refers to sales activity (para. 35). There is nothing unusual or surprising in the juxtaposition of the word elements 'executive' and 'selling' (para. 37). Moreover, there is a sufficiently direct and specific relationship between the trade mark applied for and the services for which protection is sought (paras 38-43). Therefore, the relevant public will immediately and without further reflection perceive the sign applied for as describing the purpose and the function of the services (para. 44).

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

As it is sufficient that one of the absolute grounds for refusal be met, the GC does not need to examine the second plea (para. 61).

**T-744/18; Silueta en forma de elipse discontinua (fig.) / Silueta en forma de elipse (fig.); Oakley v EUIPO; Judgment of 10 September 2019; EU:T:2019:568; Language of the case: ES**

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

**KEYWORDS:** Enhanced distinctiveness, Figurative trade mark, Non-distinctive, Visual similarity, Weak trade mark

**FACTS:** The applicant sought to register the figurative mark as an EUTM for goods in Classes 9, 18 and 25.

An opposition based on the earlier figurative mark, registered for goods in Classes 9, 18 and 25, was filed pursuant to Article 8(1)(b) CTMR and Article 8(5) CTMR. The Opposition Division (OD) dismissed the opposition.

The opponent appealed. The Board of Appeal (BoA) dismissed the appeal.

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The opponent filed an action before the GC, who upheld the action insofar as it dismissed the opposition based on Article 8(1)(b) CTMR. However, it found that the BoA had wrongly considered that there was no similarity between the conflicting trade marks.

The BoA issued a new decision, again dismissing the appeal insofar as it was based on Article 8(1)(b) CTMR. It found that even though the goods are partially identical, the non-distinctive character of the earlier trade mark, the generalised practice of applying simple figurative signs to decorate goods, the absence of a concept in the signs that could capture the average consumer's attention and the inexistence of a higher degree of similarity between the signs, excluded any likelihood of confusion.

The opponent filed another action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 72(6) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR and Article 76(1) EUTMR.

### SUBSTANCE: COMPARISON OF SIGNS

The BoA considered that the difference between the maximum height and minimum height and the completely rectangular shape of the internal part of the ellipsis were only perceptible after a careful examination. The BoA, however, did not take this clarification into consideration in its assessment



(para. 43). The third particularity of the trade mark application, namely, the interruption of its longitudinal edges is hardly important and therefore the similarity between the signs is high (para. 44).

### LIKELIHOOD OF CONFUSION

The BoA based its reasoning on a well-known fact, namely, that in all markets of the goods concerned, there is a general practice of applying very simple figurative elements to decorate the goods (para. 49). Accuracy of well-known facts can be challenged before the GC (para. 59) and the Office is authorised to submit evidence to demonstrate the accuracy of well-known facts (para. 61).

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In view of the evidence submitted by the opponent, the accuracy of the alleged well-known fact cannot be confirmed for any of the goods. Furthermore, the fact does not seem plausible for some of the more technical goods, such as educational apparatuses and simulators, apparatuses and instruments for conducting electricity and correcting lenses (para. 63).

The distinctive character of the earlier mark cannot be questioned in opposition proceedings. It is presumed to have sufficient distinctive character to have been registered (para. 53). The assessment of the likelihood of confusion, in this case, should be based on the fact that the earlier mark has a low degree of inherent distinctiveness (para. 65), a fact which does not exclude the likelihood of confusion (para. 66).

The signs are visually highly similar, taking into account the overall impression given by them when recalled by the general public, whose degree of attention is average. This indirect comparison of the conflicting trade marks and their imperfect recollection is particularly important (para. 67). There is likelihood of confusion even though the degree of distinctiveness of the earlier trade mark is low (para. 68).



**T-649/18; transparent pairing; ruwido austria v EUIPO; Judgment of 11 September 2019; EU:T:2019:585; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Non-distinctive

**FACTS:** The applicant sought to register the word mark transparent pairing for goods and services in Classes 9 and 42.

The examiner refused the application pursuant to Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR. The applicant filed an appeal.

The Board of Appeal (BoA) dismissed the appeal. The word sign was held to be a laudatory and promotional message devoid of distinctive character. Insofar as all the goods for which protection was sought were electronic devices closely linked to a connecting process, 'transparent pairing' has a clear, unequivocal meaning for the relevant English-speaking public, namely that the coupling can be made on a comprehensible and easily verifiable basis.

The applicant filed an action before the General Court, relying on two pleas in law: (i) failure to state reasons and reversal of burden of proof and (ii) infringement of Article 7(1)(b) EUTMR.

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**SUBSTANCE:** (i) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR.

The relevant public is the professional and general public of the EU (not disputed) (para. 25).

The sign conveys a laudatory message, insofar as it designates a positive characteristic of the goods and services (not disputed) (paras 28-29). The advertising message is clear and devoid of any originality or resonance which could require at least some interpretation or set off a cognitive process in the minds of the relevant public. It is therefore not capable of distinguishing the goods and services of a particular supplier (paras 34-36). The fact that the sign can be understood in a different sense is irrelevant since a word sign must be refused for registration if at least one of its possible meanings is devoid of any distinctive character (para. 32).

(ii) FAILURE TO STATE REASONS AND REVERSAL OF BURDEN OF PROOF

The purpose of the obligation to state reasons is twofold: to enable the parties concerned to ascertain the reasons for the measure to defend their rights and to enable the courts to exercise their power of review of the legality of the decision. However, in stating the reasons for their decisions, the Boards of Appeal are not obliged to take a view on every argument which the parties have submitted to them. It is sufficient that they set out the facts and



legal considerations having decisive importance in the context of the decision (para. 41).

Since the applicant claims that the trade mark applied for is distinctive, it is for the applicant to provide specific and substantiated evidence that the trade mark applied for has an intrinsic distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 46).

**T-34/19; PRODUCED WITHOUT BOILING SCANDINAVIAN DELIGHTS ESTABLISHED 1834 FRUIT SPREAD (fig.); Orkla Foods Danmark v EUIPO; Judgment of 11 September 2019; EU:T:2019:576; Language of the case: DA**

**RESULT:** Action dismissed

**KEYWORDS:** Non-distinctive, Principle of legality

**FACTS:** The applicant sought to register the figurative sign for goods in Classes 29 and 30.

The examiner refused the application pursuant to Article 7(1)(b) and Article 7(2) EUTMR. However, they did not rule on the issue of whether the sign had acquired distinctive character through use within the meaning of Article 7(3) EUTMR. The applicant appealed against the decision.

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The Board of Appeal (BoA) dismissed the appeal. It held that the sign was devoid of distinctive character and referred the case back to the examiner insofar as it concerned the applicant's claim that the sign had acquired distinctive character through use.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(3) EUTMR.

### EUTM Application



**SUBSTANCE:** (i) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR.

The relevant public is the English-speaking general public of the EU (not disputed) (para. 21).

The mark applied for is devoid of distinctive character because, first, the word elements of the sign are descriptive (not disputed) and, second, figurative elements in the form of a label are commonly used for the marketing of the goods



and do not affect the consumer's perception of the message as descriptive (paras 22-27).

The legality of decisions is assessed solely on the basis of the EUTMR and not on the basis of previous decision-making practice (para. 31).

#### (ii) INFRINGEMENT OF ARTICLE 7(3) EUTMR.

As the BoA did not examine whether the mark applied for had acquired distinctive character through use (Article 7(3) EUTMR) it is not for the GC to assess it (paras 34-38).

**T-182/19; SOFTFOAM; Puma v EUIPO; Judgment of 12 September 2019; EU:T:2019:604; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Non-distinctive, Laudatory mark

**FACTS:** The applicant sought to register the figurative sign for footwear in Class 25.

The examiner refused the application pursuant to Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the appeal. The sign was held to be descriptive and devoid of

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distinctive character. The relevant public would immediately and without further reflection understand the sign 'SOFTFOAM' as a reference to the nature, quality and characteristics of the shoes, namely the fact that the shoe soles were made out of soft foam and that they were therefore well-cushioned and comfortable to wear. They moreover understand the sign as a purely laudatory term.

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

### EUTM Application

**SOFTFOAM**

**SUBSTANCE:** (i) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR.

The relevant public will not perceive the sign as an indication of the commercial origin of the goods in question, but as a purely laudatory or promotional message, stressing a positive quality for footwear. It is thus devoid of distinctive character (paras 17-22).

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

As it is sufficient that one of the absolute grounds for refusal be met for the sign to not be registrable



as an EU trade mark, the second plea is rejected as ineffective (para. 25).

**T-399/18; Theatre; TrekStor v EUIPO; Judgment of 17 September 2019; EU:T:2019:612; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive, Word mark

**FACTS:** The applicant sought to register the word mark Theatre for goods and services in Classes 9, 28, 35, 41 and 42. The Office refused registration pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal. The sign was held to be descriptive since it, first, described theatres and similar buildings, such as cinemas or auditoriums, and, second, referred to an art form and essentially to the theatre world. Therefore, the sign was understood in the light of the goods and services as a general term connected with various types of visual and acoustic performances for entertainment purposes, whether in a cinema or public theatre or at home (Article 7(1)(c) EUTMR). As a purely descriptive indication, the sign was also held to be devoid of distinctive character (Article 7(1)(b) EUTMR).

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

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

The relevant public consists of English-speaking consumers and specialised trade circles in the European Union. The level of attention of the trade circles is high while that of the consumers varies depending on the price of the goods and services (not disputed) (para. 21).

**DIRECT AND SPECIFIC LINK BETWEEN THE SIGN AND THE GOODS AND SERVICES.**

The term 'Theatre' may be understood by the relevant public beyond its traditional meaning, as a general reference to the experience of being the audience in a theatre, cinema or auditorium, and therefore as being connected with various types of visual and acoustic performances for entertainment purposes, whether in a cinema or public theatre or at home. The sign is therefore also descriptive for private installations, such as home cinema (paras 24, 25 and 26).

A global reasoning is enough for a group of goods or services that have such close, direct and specific links with each other that they form a sufficiently



homogenous category (paras 28 and 53). The sign is descriptive for the category of goods in Class 9, such as electric and electronic apparatus and parts thereof, that have in common the fact that they can be set up to provide entertainment for spectators, whether in a public cinema or theatre or at home. This includes user manuals and image files for downloading (paras 31-33 and 38). With regard to telephones, various types of communication hardware and devices, and the software for mobile telephones, the tendency to use a mobile phone to watch films, television and entertainment programmes must be taken into consideration, with the result that the mobile phone can serve as a theatre, cinema or auditorium (para. 34). Moreover, many of the goods listed in Class 9 are not restricted to passive use, but are intended to work online and thus allow users' interactive participation (para. 35). The other computer programs and software of Class 9 may control the electronic apparatus and devices associated with public or private cinema (para. 36).

There is also a direct connection between the sign and the services in Class 35 since the retail services concerned are directly linked to the goods in Class 9 (paras 40-41). The goods and services of Classes 28, 41 and 42 allow the dissemination of content and information about the theatre or can serve to develop and operate theatre systems (paras 46-52).

There is therefore a direct link between the sign and the goods and services (para. 53).

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

As one absolute ground of refusal is sufficient, the GC did not examine the second plea (para. 57).

**T-532/18; Washing sponges; Aroma Essence v EUIPO; Judgment of 17 September 2019; EU:T:2019:609; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Competence of the Boards, Disclosure within the EU

**FACTS:** The RCD proprietor registered a Community design representing a washing sponge for washing sponges, soaps in Class 28.03.

An invalidity application was filed pursuant to Article 25(1)(b) CDR in conjunction with Articles 5 and 6 CDR. The Invalidity Division (ID) upheld the invalidity application. It declared the contested design invalid on the basis of prior design No 1890492-0001 even though it had been disclosed during the grace period, because the ID could not overlook the fact that the holder of the prior contested design had been the holder of two designs which were declared invalid on the basis of previous disclosures made by the holder itself.

The RCD proprietor filed an appeal. The Board of Appeal (BoA) upheld the appeal, finding that the application for a declaration of invalidity was based on the fact that the contested design had to be declared invalid for the same reasons as those which led to the invalidity of designs No 1890492-0001 and No 1890492-0002, but the invalidity applicant had not made any reference to the reasoning in the previous decisions or the prior designs on which those decisions were based. The invalidity of the prior designs for lack of novelty was not a well-known fact to be taken into account ex officio.

The invalidity applicant filed an action with the General Court (GC), relying on two pleas in law: (i) infringement of the principle of sound administration and infringement of Article 53(1) and (2), and Article 60(1) CDR read in conjunction with Article 28(1)(b)(i), (v) and (vi), Article 30(1) and Article 36(1) CDIR insofar as those provisions were construed in an extremely restrictive manner, and (ii) infringement of the principles of legal certainty, equal treatment and sound administration, and infringement of Article 59, Article 60(1), Article 65(5) (b) and (c), and Article 75 CDR and Article 36(1) CDIR. The GC dismissed the action.

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RCD



**SUBSTANCE:** When the application for a declaration of invalidity is based on the lack of novelty and individual character of the RCD, it must contain, inter alia, the indication and reproduction of the prior designs that could form an obstacle to the novelty or individual character of the RCD and documents proving their existence (para. 24).

The application for a declaration of invalidity did not contain any reference to the reasoning, evidence and conclusions in the previous decisions or to the prior designs on which they were based (para. 26). The applicant identified only prior designs No 1890492-0001 and No 1890492-0002 as an obstacle to novelty or individual character of the RCD by indicating precisely their registration number and reproduction. The application contained a comparison of the contested design with those prior designs alone (para. 27).

Making reference to the previous decisions, without elaborating further, does not satisfy the



requirement to demonstrate the existence of a prior design identical to the contested design (para. 29). It is for the applicant to make sure that all prior designs relied on are clearly identified and reproduced, given that invalidity proceedings are inter partes proceedings (para. 30).

Moreover, the Office must invite the invalidity applicant to rectify the irregularities only where the application is inadmissible (para. 33). The application was admissible in that the applicant relied on prior designs No 1890492-0001 and No 1890492-0002 (para. 34) and the BoA was correct to take into consideration only those designs (para. 36).

**T-633/18; TON JONES / Jones (fig.); Rose Gesellschaft v EUipo; Judgment of 17 January 2019; EU:C:2019:608; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use

**FACTS:** The applicant sought to register the mark TON JONES as an EUTM for goods in Class 25.

An opposition based on the earlier figurative marks 'Jones', registered for goods in Class 25, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) dismissed the opposition, finding that no genuine use of earlier marks had been proved.

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The opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal. Its final overall assessment was that the evidence of use submitted did not establish sufficient use of the earlier marks for the relevant goods during the relevant period.

The opponent filed an action with the General Court (GC), relying on one plea in law: (i) infringement of Article 18 EUTMR. The GC dismissed the action.

### EUTM Application

TON JONES

### Earlier trade marks

Jones  
Jones

**SUBSTANCE:** Use of the sign 'Jones' to designate shops located in Austria is relevant for determining the place of use, but does not meet the requirements of nature of use for the relevant goods (para. 86). Although evidence providing indications of the time



of use of the sign 'Jones' was submitted, this use does not meet the relevant requirements as to the nature either since, in the catalogues and magazine submitted, the sign does not appear on the clothing, but in the page margins (para. 70), and is therefore open to multiple interpretations (para. 87).

The picture submitted by the opponent establishes use as a trade mark designating the commercial origin of clothing and thus meeting the requirements of nature of use, but does not provide any indication of the extent of use required to be relevant for the overall assessment of genuine use (para. 88).

**T-634/18; revolutionary air pulse technology; André Geske v EUIPO; Judgment of 17 September 2019; EU:T:2019:611; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive, Word mark

**FACTS:** By an international registration designating the European Union, the applicant requested protection of the word sign revolutionary air pulse technology for goods and services in Classes 10, 35 and 45 such as vibrators as sexual aids for adults and retailing services in relation to erotic products. The Office partially refused protection pursuant to Article 7(1)(b) and (c) EUTMR.

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The Board of Appeal (BoA) dismissed the applicant's appeal. The mark was found descriptive and devoid of distinctive character insofar as it indicates that the mark involves new technology that uses air pulses to stimulate certain parts of the body; the term 'revolutionary' indicates that this technology had not existed before.

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

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

The relevant public consists of general English-speaking consumers (para. 21). Even if, as claimed by the applicant, the relevant public should be extended to a specialised public, the latter's specific knowledge and professional experience would make it even easier to recognise the descriptive character of the sign for the goods (para. 24). This argument is thus rejected as invalid or at least unfounded (para. 26).

The goods are aimed at adult consumers within the erotic sector (para. 29). The trade mark applied for consists of four commonly used English terms, namely 'revolutionary', 'air', 'pulse' and 'technology', which combined refer to a revolutionary air pulse technology (not disputed) (para. 30). The sign



makes a clear and direct reference to one of the characteristics of the goods, namely that they use a new and revolutionary technology to stimulate the body parts concerned with pulses of air (para. 32); the same applies to the corresponding retail services (para. 33). The sign does not form a neologism with an unusual structure or meaning capable of creating an impression sufficiently far removed from that produced by the combination of its elements (paras 39-45) and is therefore descriptive for the goods and services (para. 47).

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

As one absolute ground of refusal is sufficient, the GC does not need to examine the second plea (paras 51-53).

**T-176/17: VeGa one (fig.) / Vegas et al; WhiteWave Services v EUIPO; Judgment of 19 September 2019; EU:T:2019:625; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Figurative element, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the figurative sign 'VeGa one' for goods in Classes 5, 29, 30 and 32.

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An opposition based on earlier German and international registrations, including the IR designating the European Union in respect of the word mark Vegas, was filed pursuant to Article 8(1) (b) EUTMR. The IR designates goods and services in Classes 5, 29, 30, 32, 35 and 44. The Opposition Division (OD) upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that there was likelihood of confusion (LOC) since there was visual similarity and a strong phonetic similarity. The conceptual comparison of the marks was qualified neutral since neither the word 'vega' nor the word 'vegas' had a clear meaning for the EU public. Although it could not be excluded that some consumers could perceive the earlier mark as a reference to the city of Las Vegas (Nevada, United States), there was no strong evidence that they would generally leave out the first word 'las' and refer to the city only by its last word 'vegas'. Furthermore, the conceptual comparison of the signs was found to be neutral because the word elements of the contested sign 'VeGa one' had no clear meaning.

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



### EUTM Application



### Earlier Right

## Vegas

### SUBSTANCE: REPLACEMENT OF A PARTY IN THE PROCEEDINGS BEFORE THE GC

The application to replace the initial party in the proceedings before the GC filed by the representative of the successor to the EUTM application — relying on its right in accordance with Articles 17 and 24 CTMR — was granted, Article 176 RPGC. As a result the new proprietor of the EUTM application is bound by the procedural documents lodged by the party which it has replaced, Article 176(5) RPGC.

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### INFRINGEMENT OF ARTICLE 8(1)(b) EUTM.

The relevant public is the general public and specialists in the European Union. The level of attention varies from average (for everyday consumer goods) to high (for goods which are intended to improve the consumer's health) (paras 28, 35-37 and 38). The goods are identical (not disputed) (para. 43).

The word element 'vega' of the mark applied for is the most distinctive element. It has no meaning in relation to the goods and it retains an independent distinctive role in the overall impression (paras 53, 54 and 59). The word element 'one' is less distinctive, due to its grey tone, its position under the first word and the fact that it is an English word understood throughout the European Union (paras 54-56). The figurative elements consist primarily of a representation of leaves and are thus perceived as an allusion to the natural ingredients or composition of the food products (para. 57).

The signs are visually similar since the most eye-catching visual element 'vega' is present in its entirety in the earlier mark (paras 63-66).

There is a strong phonetic similarity between the marks, since the element 'vega' which is placed at the beginning of the mark is practically identical to the element 'vegas' in the earlier mark (para. 72).



As regards, the conceptual comparison, the BoA did not sufficiently substantiate its finding that the term 'vegas' had no meaning for the relevant EU public. In particular, it did not specify whether the part of the relevant public that might perceive the earlier sign 'vegas' as a reference to the city of Las Vegas represented a significant number of the relevant public or not, despite the fact that the applicant submitted evidence to establish the meaning of that term in at least some EU countries (paras 81 and 83). If the term 'vegas' has a meaning for the relevant public, a conceptual comparison of the signs remains possible (paras 82 and 83).

However, these errors do not have any impact on the conclusion in the global assessment of LOC. In view of the strong phonetic similarity between the signs and their visual similarity, any conceptual differences that might be found between the signs are not capable of counteracting their similarities (paras 93-94).

**T-287/18; Nature's Variety Instinct (fig.) / Natural Instinct Dog and Cat food as nature intended (fig.); M.I. Industries v EUIPO; Judgment of 20 September 2019; EU:T:2019:641; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the figurative mark 'Nature's Variety Instinct' for goods in Class 31, namely animal foodstuffs; pet foods; pet treats.

An opposition based on the earlier figurative mark 'Natural Instinct Dog and Cat food as nature intended' registered for goods in Class 31, namely foodstuffs for dogs and cats; dog food; cat food; dog biscuits; bones and chewing bones for dogs; treats (foods) for dogs and cats; litter for dogs and cats was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) CTMR. The Opposition Division (OD) upheld the opposition based on Article 8(1)(b) CTMR.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that there was a likelihood of confusion (LOC) since the goods were identical, the relevant public consisted of the general public in the United Kingdom with an average level of attention, and the signs were visually and conceptually similar to an average degree and phonetically similar to at least a low degree. It found, in particular, that the dominant and most distinctive elements in the signs were 'instinct' in the mark applied for and 'natural instinct' in the earlier mark.

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 appeal.



### EUTM Application



### Earlier Right



**SUBSTANCE:** INFRINGEMENT OF ARTICLE 8(1)(b) EUTM.

The relevant public is the general public in the United Kingdom with an average level of attention (para. 28). As regards the level of attention, the applicant did not substantiate its claims that pet owners purchased food for their pets with significant care and brand loyalty (paras 29-30).

### COMPARISON OF THE SIGNS.

The distinctive and dominant elements of the signs are 'instinct' in the mark applied for and 'natural instinct' in the earlier mark (paras 47 and 58). The element 'dog and cat food as nature intended', which is contained in the earlier mark, is likely to be perceived as a slogan relating to the nature

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and properties of the goods. The element 'nature's variety' in the mark applied for has a laudatory connotation in relation to animal food. Therefore, these elements have a low degree of distinctiveness (paras 45-46).

The signs are visually similar to an average degree overall, on account of the coincidence in the element in common, 'instinct', which is dominant in the mark applied for and is one of the dominant elements in the earlier mark (paras 59 and 67). While it is true that the first part of the word elements of a mark is more likely to attract the consumer's attention than the following parts (para. 63), the public will focus its attention on the dominant elements of the signs and not on the element 'nature's variety', which, placed at the top of the mark applied for, is written in markedly smaller letters (para. 64).

The signs are phonetically similar to at least a low degree on account of the coincidence in the element 'instinct' (paras 68 and 70).

The signs are conceptually similar to an average degree since they both evoke the notion of instinct and allude to nature, but the latter concept is, however, laudatory in relation to the goods. The signs differ in the notion of 'variety' in the mark applied for, which is, however, also laudatory in relation to the goods at issue (paras 76 and 82)



### LIKELIHOOD OF CONFUSION.

The global assessment shows that signs are visually and conceptually similar to an average degree and phonetically similar to at least a low degree, the goods are identical and the relevant public's level of attention with regard to the goods is average. The degree of distinctiveness of the earlier mark is normal (not disputed). Therefore, there is LOC (paras 87 and 88).

**T-288/18; NATURE'S VARIETY INSTINCT / Natural Instinct Dog and Cat food as nature intended (fig.) et al; M.I. Industries v EUIPO; Judgment of 20 September 2019; EU:T:2019:640; Language of the case: EN**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the word mark NATURE'S VARIETY INSTINCT for goods in Class 31, namely animal foodstuffs; pet foods; pet treats.

An opposition based on the earlier figurative mark 'Natural Instinct Dog and Cat food as nature intended' registered for goods in Class 31, namely foodstuffs for dogs and cats; dog food; cat food; dog biscuits; bones and chewing bones for dogs; treats

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(foods) for dogs and cats; litter for dogs and cats was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) CTMR. The Opposition Division (OD) upheld the opposition based on Article 8(1)(b) CTMR.

The applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that there was a likelihood of confusion (LOC) since the goods were identical, the relevant public consisted of the general public in the United Kingdom with an average level of attention, and the signs were visually and conceptually similar to an average degree and phonetically similar to at least a low degree. It found, in particular, that the dominant and most distinctive elements in the signs were 'instinct' in the mark applied for and 'natural instinct' in the earlier mark.

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 appeal.

### EUTM application

**NATURE'S VARIETY INSTINCT**

### Earlier Right

**Natural Instinct**  
Dog and Cat food as nature intended

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 8(1)(b) EUTM.

The relevant public is the general public in the United Kingdom with an average level of attention (para. 28). As regards the level of attention, the applicant did not substantiate its claims that pet owners purchased food for their pets with significant care and brand loyalty (paras 28-30).

#### COMPARISON OF THE SIGNS.

The element 'natural instinct' constitutes the dominant and most distinctive element of the earlier mark. This element is represented in a significantly larger font and the element 'dog and cat food as nature intended' is likely to be perceived as a slogan relating to the nature and characteristics of the goods (paras 42 and 56).

The signs are visually similar to an average degree overall, on account of the coincidence in the element in common, 'instinct', which is dominant in the mark applied for and is one of the dominant elements in the earlier mark (paras 57 and 67).

The signs are phonetically similar to at least a low degree on account of the coincidence in the element 'instinct' (paras 68 and 74).

The signs are conceptually similar to an average degree since they both evoke the notion of instinct

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and allude to nature, but differ in the notion of 'variety' in the mark applied for (paras 75 and 81).

### LIKELIHOOD OF CONFUSION.

The global assessment shows that the goods are identical and the relevant public's level of attention with regard to the goods is average. The signs are visually and conceptually similar to an average degree and phonetically similar to at least a low degree. The degree of distinctiveness of the earlier mark is normal (not disputed). Therefore, there is LOC (paras 86-89).

**T-367/18; UKIO / IO (fig.); Sixsigma Networks Mexico v EUIPO; Judgment of 20 September 2019; EU:T:2019:645; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Likelihood of confusion, Phonetic similarity, Visual similarity

**FACTS:** The applicant sought to register the word mark UKIO as an EUTM for services in Classes 35, 41 and 42.

An opposition based on the earlier figurative mark '<IO', registered for services in Classes 41 and 42, was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) dismissed the opposition.

The opponent filed an appeal. The Board of Appeal (BoA) dismissed the appeal. It found that even if the services covered were identical, the degree of similarity between the marks at issue was insufficient to conclude that there was a likelihood of confusion (LOC).

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

### EUTM Application

UKIO

### Earlier trade mark



**SUBSTANCE:** The relevant public consists of both professionals and end consumers (para. 24) with a level of attention varying from average to high (para. 25).

For reasons of procedural economy, the OD and the BoA proceeded on the basis that the services

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were identical without carrying out an exhaustive comparison of those services (para. 28). It is not for the GC to deal with that question, which was not examined by the adjudicating body, but it will determine whether in the light of that assumption the BoA's global assessment of LOC is correct (para. 31).

The applicant's arguments are entirely based on the premise that the first element of the earlier mark will be perceived as a stylised representation of the letter 'K' (para. 36). The letter 'K' consists of a vertical line and two diagonal lines which go in opposite directions and meet in the middle of that vertical line (para. 37). The vertical line is an essential component of the normal graphic representation of the letter 'K'. It is missing in the earlier mark and there is nothing to encourage the relevant public to perceive an association between the first element of that mark and the letter 'K'. The relevant public would not perceive the earlier mark as containing the sequence of letters 'k' 'i' 'o' (paras 38 and 41).

The only common feature between the short signs under comparison lies in the last two elements of those signs, and they differ precisely in their beginnings where greater attention will be paid by consumers (paras 52-53 and 62). There is, at most, a low degree of visual and phonetic similarity and the signs are not conceptually similar (paras 52-56).

Even assuming that the services are identical, likelihood of confusion can be ruled out (para. 63).



**T-458/18; real nature; Multifit Tiernahrung v EUIPO; Judgment of 20 September 2019; EU:T:2019:634; Language of the case: DE**

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

**KEYWORDS:** Descriptive, Descriptive element, Distinctive element, Minimum degree of distinctiveness, Slogan mark, Word mark

**FACTS:** The applicant sought to register the word sign *real nature* for goods and services in Classes 5, 28, 31 and 35 such as food supplements, dietary foodstuffs for veterinary purposes, toys for pets, animal foodstuffs and business management of outlets selling products for animals. The Office refused protection pursuant to Article 7(1)(b) and (c) EUTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that '*real nature*' was understood by the relevant public as meaning that the goods were of genuine natural products or at least were made as far as possible out of natural ingredients or materials. It concluded that, given the sufficiently direct link between the sign and the goods and services concerned, the mark applied for was descriptive.

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The applicant filed an action for annulment before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The General Court (GC) partially upheld the action.

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

The relevant public consists of both the general and a specialist public, both with a good command of the English language. The level of attention varies from average to high (not disputed) (para. 21).

The sign is a combination of two common English words, namely the adjective 'real' and the noun 'nature'. There is nothing special or unusual about this combination (not disputed) (para. 22).

Regarding the goods in Classes 5, 28 and 31, the sign describes the characteristics of genuinely natural products, that is to say products that contain exclusively natural ingredients or materials (para. 25). In so far as the sign refers to artificial goods for which an exclusively natural origin is ruled out, it refers to the fact that these goods use natural ingredients or materials as far as possible, or constitute a genuine substitute for a natural product by realistically imitating the properties of that product (para. 26). The sign also refers to services in Class 35 that are related to such goods (para. 27).



However, the sign cannot be regarded as descriptive for certain services in Class 35, notably advertising, marketing, business advice and organisational consultancy for franchise concepts, and providing of business know-how (franchising), since these do not have any direct and specific link with nature or nature-related goods (paras 30-31).

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

As the services in Class 35, notably advertising, marketing, business advice and organisational consultancy for franchise concepts, providing of business know-how (franchising), are not directly connected with nature or nature-related goods, the sign cannot emphasise the naturalness of these services and thus be regarded as laudatory and devoid of distinctive character (paras 48-51). For these services, the sign even has a certain originality, since they have no direct and specific link with nature, and the sign could be perceived as surprising, unexpected and therefore memorable. The relevant public might have doubts about the logic of using this expression in such a context, and question whether the services can 'really be natural' (para. 52). Consequently, the sign is not devoid of distinctive character for these services (para. 52).

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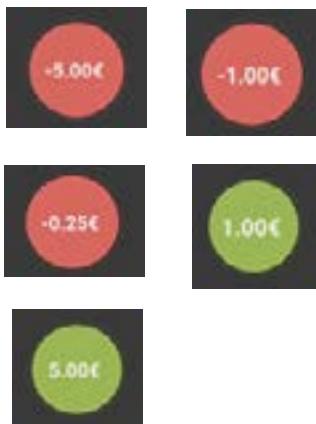
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**29/08/2019, R 2024/2018-5, EINE BLASE MIT EINEM FARBWECHSEL VON ROT ZU GRÜN**

#### EUTM application



**Outcome:** Decision confirmed.

**Norms:** Article 7(1)(b) EUTMR.

**Keywords:** Multimedia mark, Laudatory mark, Non-distinctive

**Summary:** The applicant sought to register a multimedia mark for goods and services in Classes 9, 36, 38, 41 and 42. The sign showed various sequences of monetary amounts and three short strokes of a bell rang at the end. In addition, the negative amounts were highlighted in red, whereas the positive amounts were highlighted in green. The sign applied for was rejected under Article 7(1) (b) EUTMR in respect of all the goods and services applied for as it would merely be perceived as an advertising message of a trading platform. There was a clear reference to financial services and goods which supported such services, such as apps. Nevertheless the amounts could also be used in connection with any goods and services. The sign applied for was also devoid of distinctive character in connection with the sound element.

The Board points out that, despite the fact that a public composed of experts generally pays an increased level of attention, this level of attention is liable to be relatively low when it comes to factual or promotional indications, which well-informed consumers do not see as decisive. Following the criteria laid down by the Court for sound marks (13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468) the Board

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indicates that the decisive factor is whether the sign applied for is capable of attracting the consumer's attention to the extent that the sign is not perceived as a banal, simple or purely informative or purely promotional combination of sounds, but as a distinctive sign.

The Board considers that the sign is a banal and obvious combination of elementary components which are not distinctive. The overall impression is nothing more than the simple sum of the individual components which can all be related to the goods and services at stake. The sign applied for will only be perceived as a statement in relation to goods and services linked to trade in financial products (with an insignificant change of profit and loss). In addition, the sign as a whole also has a purely laudatory character as the public will immediately understand the transformation of a loss into a profit within seconds. The sign possesses nothing striking so that it could convey any message which would remain in the consumer's memory in relation to the goods and services and so allow consumers to distinguish them from those of other competitors.

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



02/10/2019, R 1550/2019-4, WINDSURFER (fig.)

### EUTM application



**Outcome:** Decision confirmed.

**Norms:** Article 7(1)(c) EUTMR, Article 7(3) EUTMR.

**Keywords:** Figurative trade mark, Descriptive element, Descriptive (yes), Distinctiveness acquired by use (no).

**Summary:** The examiner refused the sign applied for on the basis of Article 7(1)(b), (c) and Article 7(3) EUTMR for goods in Classes 25 (athletic clothing) and 28 (sports equipment) as the average English-speaking consumer would understand the word 'WINDSURFER' as a long narrow board with a sail attached to it or a person who rode on a windsurfer. The figurative element of a windsurfer merely reinforced the semantic meaning of the word element. The word and figurative elements of the sign conveyed obvious and direct information that the goods applied for were clothing and sports equipment intended for windsurfers.

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The Board finds that in relation to the inherent distinctiveness of the sign applied for, no argument has been brought on appeal to challenge the examiner's finding that the sign applied for is descriptive and lacks distinctive character.

As regards acquired distinctiveness, the evidence provided consists of a product overview showing a sailboard, sails, components and accessories for windsurfing; advertisements for windsurfing events and competitions in particular in Italy, Poland, France, the Netherlands and Switzerland; links to videos on the applicant's YouTube channel, its website [www.windsurferclass.com](http://www.windsurferclass.com) and Facebook page; a printout from the UK association and an excerpt from the commercial register from the Chamber of Commerce of Rome. This evidence does not constitute proof that the relevant public in the English-speaking part of the European Union has been extensively exposed to the sign in relation to the goods in question. It fails to demonstrate to what extent the applicant sold the goods and to what extent it has gained market recognition in respect of them. No information has been provided concerning the investments made by the applicant to promote the trade mark, neither have any statements from chambers of commerce and industry or from other professional associations nor any surveys conducted with respect to the relevant public been furnished. The only evidence relating to the UK does not say anything about the acquired distinctiveness of the mark and does not even refer to the sign. In



general, the evidence does not even refer to the goods at stake but only concerns the organisation of windsurfing events and competitions.

Overall, the evidence is insufficient to conclude that acquired distinctiveness has been proven for the relevant territories where the mark was devoid of distinctive character, i.e. in the United Kingdom, Ireland and Malta as well as in the Member States where English is widely understood, such as in Germany, the Nordic countries or the Netherlands.

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

[26/08/2019, R 12/2019-2, 4Horses \(fig.\) / HORSE \(fig.\)](#)

### Contested EUTM



### Earlier trade mark



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## Case law

**Outcome:** Decision annulled.

**Norms:** Article 8(1)(b) EUTMR, Article 10(1) EUTMDR.

**Keywords:** Identity of the goods and services, Dissimilarity of signs, Complex mark, Common element, Descriptive element, Conceptual similarity, Phonetic dissimilarity, Visual dissimilarity, Weak element, Likelihood of confusion (no).

**Summary:** The Opposition Division partially upheld the opposition for all the contested goods in Class 18 and rejected the contested mark for these goods.

The Board notes that it is common ground that the goods are identical, essentially harnesses, saddlery and parts of saddles used for horse riding (equestrian sport). Such goods are not cheap and they play an important role in the safety and comfort of riders, therefore, they are expected to be selected with care; with an attention level that is above average.

In relation to the comparison of the signs the Board finds that both complex marks contain verbal and prominent figurative elements. Due to the arrangement of the signs and the size of their word and figurative elements, both the figurative elements and the word elements are co-dominant within the respective signs. Visually, the signs are similar only to a very low degree. Their visually significant figurative elements are entirely different; the word elements 'HORSE' and '4Horses' are also not identical, and the differentiating element, the



number '4' is at the beginning of the contested sign. The single common word 'HORSE' must not be overrated as it is descriptive in both signs and merely communicates to the relevant Portuguese public that the goods at issue are all horse accessories. Phonetically, the similarity is also low. The English pronunciation of the verbal elements will result in the coincidence of one syllable out of three, and the semi-Portuguese pronunciation leads to the coincidence of one syllable out of four. Conceptually, the marks refer to the concept of 'a horse' and 'four horses', respectively, which means that there is a certain degree of conceptual similarity. Nevertheless, that similarity is weak in the context of the overall impression created by the marks, having regard to the very weak distinctive character of the term 'horse' in question. Consequently, the impression created by the marks compared is different, as they do not display sufficient visual, phonetic or conceptual similarities to be regarded as being similar. The distinctive elements of the mark applied for are the ones that will be remembered by the relevant public.

Overall, the general impression, caused by the absence of common distinctive elements, will prevent consumers from perceiving one mark as a new line of the other. Despite the identity between the goods there can be no likelihood of confusion between the marks in dispute, recalling also the public's higher than average level of attention.

Consequently, the appeal is allowed and the opposition must be rejected in its entirety.

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[02/10/2019, R 701/2019-4, Marvel](#)

**Outcome:** Decision annulled.

**Norms:** Article 7(1)(b) EUTMR.

**Keywords:** Laudatory mark, Slogan mark, Minimum degree of distinctiveness.

**Summary:** The examiner refused the IR designating the European Union for the word mark 'MARVEL' in Classes 9 and 10 pursuant to Article 7(1)(b) EUTMR on the premise that it was devoid of distinctive character for the English-speaking public. Indeed, that public would attribute the meaning of a wonderful or surprising thing to the sign applied for, and would thus perceive it as a laudatory promotional slogan, the function of which was to communicate a value statement.

However, the Board considers that the expression 'MARVEL' is distinctive as it is unclear whether it relates to the goods themselves. A trade mark consisting of an advertising slogan must be regarded as being devoid of distinctive character if it is likely to be perceived by the relevant public as a mere promotional formula. On the other hand, such a sign must be recognised as having distinctive character if apart from its promotional function, it may be perceived immediately by the public as an indication of the commercial origin of the goods and services concerned. In the present case, the relevant public with a high level of attention will not immediately, without any mental effort, perceive



the inherent characteristic of the goods at issue as referring to the word 'MARVEL'. In fact there is no indication that 'MARVEL' is used on the market as a general advertising slogan, in the sense that it refers to any sort of product.

Consequently, the Board annuls the contested decision and the examiner's refusal of protection with regard to the designation of the European Union must be withdrawn.

[03/10/2019, R 279/2019-2, Simple](#)

**Outcome:** Decision confirmed.

**Norms:** Article 7(1)(b) EUTMR.

**Keywords:** Laudatory mark, Slogan mark, Non-distinctive.

**Summary:** The examiner refused the IR designating the European Union for the word mark 'Simple' in Classes 2, 3 and 19 pursuant to Article 7(1)(b), combined with Article 7(2), EUTMR. The mark would be perceived by the relevant public as a laudatory slogan, which merely served as an indication regarding positive aspects of the goods, and not their commercial origin.

The Board also finds that the mark is devoid of distinctive character as its significance serves as promotional information, rather than indicating commercial origin namely that the paints, varnishes, lacquers, preservatives, colorants, mordants, thinners, resins, etc. in Class 2; the bleaching, cleaning,

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polishing, scouring and abrasive preparations for painting and plastering, scouring solutions etc. in Class 3 and the building materials, mortars, plasters, etc. in Class 19 are easy to use or apply (for instance, they do not need mixing, pre-preparation, multiple coats i.e. paints) and/or, for some of the goods, that they are pure, unalloyed or non-mixed. The fact that the word 'Simple' neither describes any (typical) characteristics of the goods nor is a synonym for any of them is irrelevant in relation to Article 7(1) (b) EUTMR. Under this legal ground it suffices to note that the semantic content of the sign applied for indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific and not directly descriptive, will be seen as promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods. Furthermore, the fact that the word 'Simple' is not regularly used for building materials is not sufficient for providing distinctive character to the sign. Finally, the IR holder's claim that the mark 'Simple' is affiliated with art and not the goods applied for is dismissed as unfounded, on the premise that the assessment of the meaning of the sign should be in relation to the goods applied for and not in the abstract.

Consequently, the appeal is dismissed and the decision refusing protection with regard to the designation of the European Union must be confirmed.

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