

Alicante News

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Up to date information on IP and EUIPO-related matters



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Use of IPR bundles by EU firms

A new study from the EUIPO investigates how EU firms simultaneously use different types of intellectual property rights (IPRs) for the same products. The study, released through the European Observatory on Infringements of Intellectual Property Rights, focuses on the period 2014-2015, with a sample of 63 286 firms, which together hold 76 202 European patents, 98 257 EU trade marks (EUTMs) and 21 676 registered Community designs (RCDs).

These IPRs represent 48.2% of the total IPRs filed in the EUIPO and the EPO by EU firms during the period. Of the firms in this sample, 8.3% have applied for more than one type of IPR, and the IPRs filed by these firms correspond to 35.7% of all IPRs in the sample.

Out of these firms, 1 % applied for all three IPRs, (patents, trade marks, and registered designs) during the period. This corresponds to 16.8% of all IPRs registered in the EUIPO and the EPO by firms in the sample.

Out of the total designs and patents registered, half belong to firms from the sample. Furthermore 45% of design filings come from firms also filing trade marks. However, trade mark filings show a different pattern, in that most trade marks (nearly 80%) are filed by firms that file only trade marks and do not file either designs or patents.



The research shows that patents are the IPR that is most often used together with other rights. Firms filing both trade marks and patents filed nearly four patents for every trade mark; firms filing both designs and patents filed 6.5 patents for every design. When it comes to designs and trade marks filed by the same firm, there are 1.5 trade marks per design.

The multi-IPR firms have a strong economic weight, representing 31.9% of employment and 35.5% of turnover in the sample. Firms filing all three types of IPR represent 14.1% of employment and 16% of turnover. The size of firms is of importance; the larger the firm, the more likely it is to be a multi-IPR business. More than 20% of large firms have filed more than one type of IPR, compared to only 7% of small and medium-sized enterprises (SMEs). More than 64% of the all IPRs filed by large firms are concurrent, compared to 20 % of IPRs filed by SMEs.

The study also shows significant differences among sectors. At one extreme, 15 % of firms in 'manufacturing and mining' are multi-IPR firms, while only 6% of firms active in 'services, commerce and utilities' use concurrent IPRs. This is not surprising given that those sectors file relatively few patents.

The full study is [available on the EUIPO website](#).

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European Cooperation: enhanced front and back office systems at the SPTO

On 15 October the Spanish Patent and Trademark Office (SPTO), with support from the EUIPO's European cooperation projects, completed its technical stack upgrade of the designs front office system. This followed a set of improvements to the back office system on 10 October.

The technical stack upgrade was designed to increase the security, performance and efficiency of the front office system used at the SPTO. As from now, general system maintenance will be simpler and users will experience reduced response times and improved data validation.

The back office improvements, meanwhile, will automate some parts of the examination process, which will reduce potential delays and avoid manual data entry errors.

This release also included the proof of use functionality, which was required in order to comply with the new trade mark regulations related to opposition to designs that are based in a trade mark.

Publication of CP8 Common Communication

The [CP8 Common Practice](#) on 'Use of a mark in a form differing from the one registered' was adopted by the Management Board by written procedure in May 2020, following official acknowledgement sent by all IPOs in April 2020.

It delivers a set of principles and examples on the use of a trade mark in a form differing from the one registered by taking into account the impact of additions, omissions, and modifications of characteristics on the distinctive character of registered word marks, purely figurative marks and composite marks (combination of verbal and figurative elements).

The Common Communication document, which includes the CP8 Common Practice and complementary information, such as the implementation dates for each implementing office was published simultaneously on the websites of the IP offices of the European Union on 15 October 2020.

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European Cooperation: new online service in Estonia

The Estonian Patent Office (EPA), with the support of the EUIPO's European Cooperation Projects, has improved the service it provides to its users with the launch of a new modern online feature for trade mark applications.

The EPA Front Office platform now includes a new interface for trade mark applications, a simplified and customer friendly tool to file fast track applications, which will allow a significant gain in efficiency and will help modernise the IP-related operations in Estonia. This digital service improvement became available on 12 of October 2020.

The launch at EPA is another successful implementation of front office tools developed and offered by the EUIPO to the national and regional intellectual property offices of the EU. This release is the result of the work carried out by the EUIPO and its partners in the European Cooperation Projects. These projects support the intellectual property offices in developing more efficient, reliable and user-friendly tools and services for trade marks and designs within the European Union Intellectual Property Network (EUIPN).

New misleading invoice alert - Fake EUTM Renewal Invoices

Users are warned to be especially alert due to a new misleading invoice in circulation, which takes the form of a fake EUTM renewal invoice.

The misleading invoice, which can be [viewed here](#), has very recently been reported to the Office by users.

This latest misleading invoice uses the EUIPO's logo, name, acronym and address, and purports to be an EUTM renewal invoice issued by the Office. It is mailed to users from Geneva, Switzerland, and includes a demand for a "registration and entry fee" to be transferred to a Polish bank account with a PL IBAN prefix.

The EUIPO would like to use this as opportunity to remind its users that they can protect themselves from this scam, and other misleading invoices, by taking careful note of the following:

1. The EUIPO never sends invoices or demands for payment of money to its users. If you receive a demand for money for anything to do with your trade mark by post or email, it does not come from us. Even if it uses our logo, and appears to be official, it does not come from us.

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2. Familiarise yourself with our fee structure (and make sure others in your firm or company are familiar with them too). All fees payable directly to the EUIPO in relation to EUTMs are laid down in the European Union Trade Mark Regulation (EU) No 2017/1001. A full list of these statutory fees can be found [here](#). Also, be aware that we only use **two Spanish bank accounts** for payments relating to trade mark and design fees. Any invoice which contains a bank account other than those two is fake.

3. Check everything you receive in relation to your trade mark application, registration or renewal very closely. If you have even the slightest doubt, contact us; we are committed to protecting our users against fraud, and we want you to let us know if you have received anything that looks suspicious. You can email us at information@euipo.europa.eu. We also maintain a searchable database of all misleading invoices that our users send us, which you can consult [here](#).

4. If you haven't already registered for our User Area to pay fees and receive communications from the Office, please consider doing so. It's a completely secure channel through which you can pay by credit card, bank transfer or through your EUIPO current account, and through which you can receive notifications from us safely. You can [sign up here](#), and it only takes a couple of minutes.

We are committed to protecting our users, especially at this time, when phishing emails and other fraud attempts remain on the rise. We take legal action whenever necessary to fight this issue, but the most important defence is awareness. Please check everything you receive in relation to your trade mark, and if you have any doubts, contact us.

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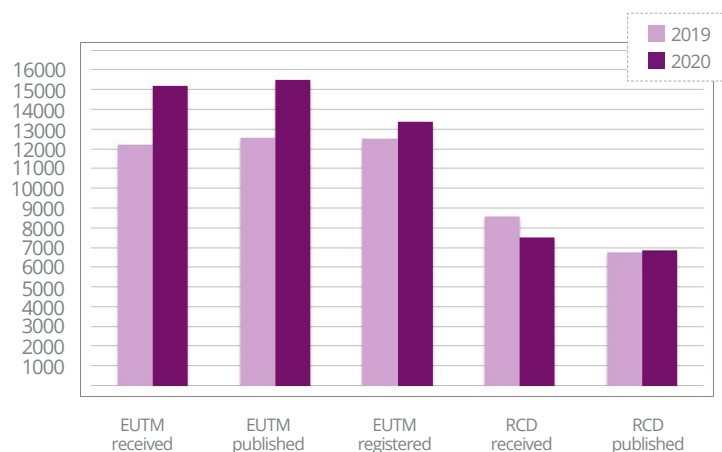
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Statistical Highlights

Monthly statistical highlights September*	2019	2020
European Union Trade Mark applications received	12 210	15 203
European Union Trade Mark applications published	12 582	15 502
European Union Trade Marks registered (certificates issued)	12 497	13 364
Registered Community Designs received	8 561	7 486
Registered Community Designs published	6 769	6 850

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



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Guidelines available in 23 official languages of the EU

The EUIPO guidelines, which were adopted by the Executive Director on 12 December 2019 (Decision No EX-19-4) and have been in force since 1 February 2020, are now available in 23 official languages of the European Union.

The guidelines were previously only available in the five working languages of the EUIPO (English, French, German, Italian and Spanish). The following languages have now been added: Bulgarian, Croatian, Czech, Danish, Dutch, Estonian, Finnish, Greek, Hungarian, Latvian, Lithuanian, Maltese, Polish, Portuguese, Romanian, Slovak, Slovene and Swedish.

A novelty is that the 'compare' functionality, which can be activated by switching on 'Show modifications' in the top left-hand corner of the web page, is now also available in 23 official EU languages. This enables the user to quickly view any changes compared to previous editions.

For more information on the functionalities of the Guidelines in HTML format, please consult this [tutorial](#) or [webinar](#).

New interactive interface for EUIPO's Service Charter

The Service Charter has a more user-friendly design and new interactive features.

In line with the [2025 Strategic Plan's](#) objective of improving user experience and evolving with the digital era, the Office has revamped the Service Charter web page. The Service Charter has a new visualisation that features simpler graphics, interactive categories and a quick summary.

Third quarter results

The results of the third quarter of 2020 continue showing the recovery resulting from the measures taken by the Office to improve the performance of the indicators and help customers cope with the difficult situation due to the COVID-19 pandemic (including the publication of [two time limit extension decisions](#) by the Executive Director).

Currently all the indicators are in the Excellence or Compliance categories. This also includes the Cancellation timeliness indicator which is now back in Compliance after a long period in Action Needed. All in all, 98.9% of the total amount of files processed by the Office were completed without any delay.

See the [new Service Charter page](#)

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Leading high-tech global IP offices meet virtually at EUIPO

From 14-16 October, 84 representatives from 37 leading high-tech global IP offices took part in the [Vancouver Group meeting](#), hosted by the EUIPO. The Vancouver Group meeting represents a joint initiative between IP offices to collaborate on the modernization of technological assets and to share knowledge on the latest IT developments.

Underpinning the work carried out at the meeting was the roadmap laid out in the EUIPO's Strategic Plan, which underlines IP innovation and cooperation with other leading high-tech offices, including the sharing of best practices and the development of joint initiatives.

The EUIPO's artificial intelligence (AI) Roadmap, and blockchain technologies used in the Blockchain IP Register Project were presented. The presentation highlighted the different areas of application within the Office and for the wider IP network.

The EUIPO is currently exploring solutions based on these technologies, as part of the Digital Evolution programme within its Strategic Plan 2025. Deliverables include enhancing user experience during the classification of goods and services, or increasing searchability in revamped TMview services.

Academy webinars

It's been a busy month at the EUIPO Academy, with more webinars and courses added to the Academy Learning Portal. Some of the highlights from October available to watch again include webinars aimed at SMEs and businesses, the new AFA forms and the EORI number, plus a selection of interesting topics about the latest judgments from the General Court and the Court of Justice. The following webinars have been recently added to the Learning Portal and are now available to watch again:

New application for action (AFA) forms and the economic operators registration and identification number (EORI)

On 15 September 2020, the new Commission Implementing Regulation (EU) 2020/1209 of 13 August 2020 amending Implementing Regulation (EU) No 1352/2013 establishing the forms provided for in Regulation (EU) No 608/2013 of the European Parliament and of the Council concerning customs enforcement of intellectual property rights entered into force. The EORI number is now mandatory for the submission, amendment and extension of customs AFAs. The IP Enforcement Portal has been adapted accordingly, with new fields being added to the company details and to the legal representative information. This webinar has been organised in cooperation with the European Commission.

[Watch the webinar here.](#)

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How to make the most of my business? Domain names and trade marks as business builders

How do domain names relate to trade marks and how important are they both to companies, especially small and medium-sized enterprises? This webinar will clarify all those hidden but crucial aspects of the brand building process.

[Watch the webinar here](#)

Filing of evidence according to Article 55(2) EUTMDR

How to file the evidence and Office practice with Article 55 EUTMDR. The background, legal provision and examples will be presented.

[Watch the webinar here](#)

Judgments of the trimester of the GC and the CJEU

This webinar provides an overview of the most relevant decisions of the General Court (GC) and the Court of Justice of the European Union (CJEU) during the third quarter of 2020.

[Watch the webinar here](#)

Case-Law Publications

The webinar aims to provide a brief overview of EUIPO publications on case-law from the Boards of Appeal and the GC or Court of Justice.

[Watch the webinar here](#)

Current case-law

In case T 696/19, the GC confirmed that the word mark 'Moins de migraine pour vivre mieux' is not unusual in terms of the rules of French syntax, grammar, phonetics or semantics and its message to the relevant public is not likely to confer any particular originality or resonance, which would require at least some interpretation or set off a cognitive process. It has a mere promotional character because it simply encourages the relevant public to discover the goods and services in question by promising to improve daily life. Therefore, the mark is not capable of indicating the commercial origin of the goods and services and consequently it is devoid of any distinctive character. For a closer look at slogan marks and more case-law, follow the recorded webinar ['The Impossible Slogan or How to Kill a Slogan?'](#). In this webinar you will see how slogans are part of our daily lives and what the criteria are to register them.

Coming up, next month promises to be very busy too, with the regular Tuesday Webinar series covering a series of varied and interesting topics:

Webinar: **Use of a trade mark in a form differing from the one registered - Convergence Programme 8 Tuesday, 3 November**, 10.00 AM - 11.00 AM

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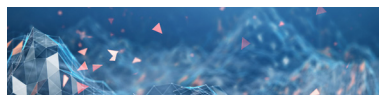
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Webinar: **eSearch case law and automatic translation** [Tuesday, 3 November](#), 11.30 AM – 12.00 AM

Webinar: **Crowdfunding** [Tuesday, 10 November](#), 10.00 AM – 11.00 AM

Webinar: **IP Tech Watch Webinar** [Tuesday, 10 November](#), 11.30 AM – 12.30 AM

Webinar: **Refiling of trade marks and bad faith** [Tuesday, 17 November](#), 10.00 AM – 11.00 AM

Webinar: **The right to be heard, the right of defence and the obligation to state reasons, exercising discretion and the notion of misuse of powers** [Tuesday, 17 November](#), 11.30 AM – 12.30 PM

Webinar: **Joint EUIPO-EPO interactive webinar: IP rights in the food industry** [Tuesday, 24 November](#), 10.00 AM – 11.30 AM

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

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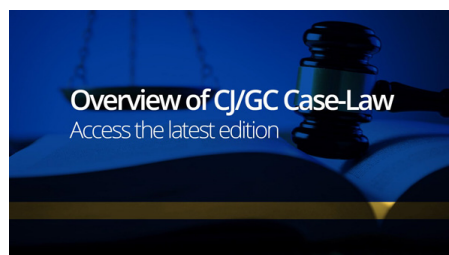
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Overview of CJ/GC Case-law (Status: 01/01/2019 – 31/08/2020)



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

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

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

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

Luxembourg trade mark and design news

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

16/09/2020, C 121/19 P, EDISON (fig.), EU:C:2020:714.

RESULT: Appeal dismissed

KEYWORDS: Admissibility, Lack of reasoning, Matters of fact appealed to CJ, Restriction of the list of goods and services

KEY POINTS: Pursuant to Article 169(2) ROPCJ, the appellant must precisely identify the specific points of the GC judgment against which its pleas in law and legal arguments are directed (07/06/2018, C-671/17 P, Gaki v Europol, EU:C:2018:416, § 36) (§ 37).

The GC has exclusive jurisdiction to assess the value of any items of evidence submitted to it, unless there has been a distortion of the facts or evidence (19/10/2018, C 198/16 P, Agriconsulting Europe v

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Commission, EU:C:2017:784, § 69 and the case-law cited) (§ 55).

FACTS: In 2003, the EUTM proprietor applied for the figurative mark 'EDISON' as an EUTM for all goods covered by the general indications in Class 4. The mark was registered in 2013. In 2015, the EUTM proprietor requested the Office to modify the previous list of goods by limiting it. The examiner accepted the limitation request except for electrical energy. This was because no such product existed in either the general indications or in the alphabetical list of goods in Class 4 of the 8th edition of the Nice Classification, which was in force at the date of the application for registration. The Board of Appeal (BoA) endorsed the examiner's conclusion, stating that the 8th edition of the Nice Classification did not use the expression 'electrical energy' either in the wording of the general indications or in the alphabetical list of the goods in Class 4. Further, if the Office had accepted electrical energy, the sign's scope of protection would have been unduly widened. The EUTM proprietor filed an action before the General Court (GC), relying on a single plea in law, alleging that the BoA decision unlawfully excluded electrical energy from the goods in Class 4 of the 8th edition of the Nice Classification. The GC dismissed the action in its entirety.

The applicant appealed to the Court of Justice (CJ), relying on two grounds of appeal, alleging: (i) that the interpretation of the terms illuminants, fuels



(including motor spirit) and carburants/motor fuel, within the meaning of the 8th edition of the Nice Classification, was incorrect, insofar as it excluded electrical energy from coming within those terms, and (ii) infringement of its procedural rights and of Article 75 CTMR.

EUTM



SUBSTANCE: ALLEGED ERRONEOUS EXCLUSION OF ELECTRICAL ENERGY FROM CLASS 4 OF THE 8TH EDITION OF THE NICE CLASSIFICATION

The EUTM proprietor does not identify the specific points of the judgment against which its argument is directed, whereas, under Article 169(2) of the Rules of Procedure of the Court of Justice (ROP CJ), the pleas in law and legal arguments relied on must identify precisely those points in the grounds of the decision of the GC which are contested (07/06/2018, C 671/17 P, Gaki v Europol, EU:C:2018:416, § 36) (§ 37).

In any event, the GC assessed the scope of the terms illuminants, fuels (including motor spirit) and carburants/motor fuel in Class 4 in accordance with

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their customary and ordinary meaning and on the basis of a literal appraisal, the content and scope of which it provided in accordance with the case-law of the CJ. The EUTM proprietor does not demonstrate that the approach adopted by the GC is vitiated by an error of law (§ 38 39).

The EUTM proprietor argues that the GC failed to take into account some items of evidence or erred in holding others as irrelevant to the interpretations of the terms in Class 4. These arguments are inadmissible (§ 48-50, 55-57). The GC has exclusive jurisdiction to assess the value of any evidence submitted to it, unless there has been a distortion of the facts or evidence (19/10/2018, C 198/16 P, Agriconsulting Europe v Commission, EU:C:2017:784, § 69 and the case-law cited) (§ 55).

INFRINGEMENT OF EUTM PROPRIETOR'S PROCEDURAL RIGHTS AND OF ARTICLE 75 CTMR

The EUTM proprietor merely reproduces verbatim the arguments that it had already raised before the GC concerning infringement of its procedural rights, without identifying the specific error of law. That argument is inadmissible. It amounts to a request to re-examine the application submitted to the GC, which the CJ does not have jurisdiction to undertake on appeal (26/01/2017, C 619/13 P, Mamoli Robinetteria v Commission, EU:C:2017:50, § 43 and the case-law cited) (§ 64-65).

The EUTM proprietor argues that the GC judgment is vitiated by lack of reasoning or is contradictory. These arguments are unfounded. The GC extensively laid out its reasons and there were no contradictions therein (§ 66).

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

09/09/2020, T 187/19, Colour Purple -2587C (col), EU:T:2020:405

RESULT: Action dismissed

KEYWORDS: Advertising, Colour mark, Distinctiveness acquired by use, Function of trade mark, Non-distinctive, Sales figures, Survey

KEY POINTS: In the case of a colour per se, distinctive character without any prior use is inconceivable except in exceptional circumstances, and particularly where the number of goods or services is very restricted and the relevant market very specific (21/10/2004, C 447/02 P, shade of orange, EU:C:2004:649, § 79) (§ 51).

The surveys to demonstrate that a sign consisting of a colour per se had acquired distinctive character through use must provide information that makes it possible to assess how representative the sample chosen was. Small samples (100-200 people) are not reliable. In addition, the colour samples should

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include the Pantone code used. The interviewees should be asked to choose from several images or even shades which one could spontaneously be associated with a particular undertaking (§ 101-102). Sales figures and advertising material may support surveys but, as such, they do not demonstrate that the public targeted by the goods perceives the mark as an indication of commercial origin (§ 107).

FACTS: The applicant sought to register the colour sign with the description 'Purple – Pantone: 2587C' as an EUTM for inhalers and pharmaceutical preparations for the treatment of asthma and/or chronic obstructive pulmonary disease in Classes 5 and 10.

The examiner refused the application pursuant to Article 7(1)(b) CTMR and Article 7(3) CTMR as being devoid of distinctive character.

The Board of Appeal (BoA) dismissed the appeal. The BoA found that, in view of the goods, the choice of colours referred to the main active ingredients, the use for which the medicinal product is intended and its characteristics. It also found that the relevant public had a specific interest in having colours kept available for competitors in the market of pharmaceuticals, since patients are inclined to take a generic pharmaceutical product more regularly, and even more so if the presentation of the medicinal product is similar to that of the original product. It concluded that the sign was devoid of any distinctive

character. The BoA further found that the evidence provided was insufficient to show that the contested mark 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, (ii) infringement of Article 7(3) EUTMR. The GC dismissed the action.

EUTM application



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

Colours and abstract combinations thereof cannot be regarded as being inherently distinctive except in exceptional circumstances, since they are indistinguishable from the appearance of the goods designated and are not, in principle, used as a means of identifying commercial origin (06/05/2003, C 104/01, Libertel, EU:C:2003:244, § 65, 66; 24/06/2004, C 49/02, Blau/Gelb, EU:C:2004:384, § 39) (§ 31-35, 38, 39).

As regards the colour of the inhalers, in general there are no legislative or regulatory provisions

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imposing a specific use of colours; manufacturers in that market sell their products in a variety of colours (§ 44). However, the 'Good practice guide on risk minimisation and prevention of medication errors', drawn up by the European Medicines Agency (EMA) recommends, that the choice of colour should be considered in product design to ensure that it does not introduce any risk of confusion with other established products where informally agreed colour conventions exist. The example given in that regard in the guide is precisely that of inhalers for respiratory ailments (§ 45-46).

The shade Pantone 2587C is used as the predominant colour on inhalers for the medicinal product Seretide and the use of several shades of purple is also highlighted by the marketing documentation (§ 49-50). The applicant did not establish that the relevant public will necessarily associate the goods concerned with that specific shade and not with a lighter or darker shade of purple also used by the applicant in connection with those goods to indicate weaker or higher strengths of the medical product (§ 50).

In the case of a colour per se, distinctive character without any prior use is inconceivable except in exceptional circumstances, and particularly where the number of goods or services is very restricted and the relevant market very specific (21/10/2004, C 447/02 P, shade of orange, EU:C:2004:649, § 79) (§ 51). In the relevant market, colours can be used

to convey to the public information relating to the characteristics of the goods. The applicant's arguments are not capable of showing that the goods constitute, within the restrictive market, a specific category that escapes the rules and practice, even informal, applicable on that market (§ 52). Thus, it is not in the public interest for the availability of a colour to be restricted for other traders selling goods of the same kind. Such an extensive monopoly would imply an unjustified competitive advantage for a single trader (13/09/2010, T 97/08, shade of orange II, EU:T:2010:396, § 35) (§ 53).

(ii) INFRINGEMENT OF ARTICLE 7(3) EUTMR

The relevant public is composed not only of professionals, namely doctors who prescribe the medicinal product and pharmacists who sell that product but also patients who are the end users of the medicinal product (§ 88). Thus, even if the choice of those goods was influenced or determined by intermediaries, the existence of distinctive character acquired through use also had to be demonstrated for patients (§ 90).

In the present case, in order to demonstrate that the contested mark had acquired distinctive character as a consequence of the use, the applicant produced, inter alia, opinion surveys, statements from its own employees and healthcare professionals, extracts from blogs and websites, advertising materials and figures relating to sales of the goods, marketing expenditure and market shares (§ 98).

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The patient surveys were carried out in only 10 EU Member States, namely Belgium, Denmark, Ireland, Greece, France, Italy, Luxembourg, the Netherlands, Poland and Sweden (§ 100). The applicant has not provided any information that makes it possible to assess how representative the sample chosen in each of those Member States was and, therefore, to determine the probative value of the surveys. Small samples (100-200 people) are not reliable (§ 101). The interviewees, whether healthcare professionals or patients, were shown only one image representing a shade of the colour purple. They were therefore not asked to choose from several images or even shades which one could spontaneously be associated with a particular undertaking (§ 102).

The surveys, with the exception of those carried out for Denmark and Sweden, do not specify the Pantone code of the colour purple used, but merely indicate that the colour sample, the original of which is annexed to the survey report, was provided by the customer (§ 103). The originals of the colour samples annexed to the surveys carried out in certain Member States include a shade of purple different to that of the other samples, or even represent a certain type of inhaler and not a colour (§ 104).

In the light of the shortcomings above, the surveys are not capable of demonstrating that the mark applied for had acquired distinctive character through use in the Member States concerned. A fortiori, the results of those surveys cannot be extrapolated to other Member States (§ 86, 105).

Sales figures and the advertising material are only secondary evidence, which may support, where relevant, direct evidence of distinctive character acquired through use, such as that provided by the surveys. As such, they do not demonstrate that the public targeted by the goods perceives the mark applied for as an indication of commercial origin (§ 107).

09/09/2020, T 589/19, Fair Zone / FAIR (fig.), EU:T:2020:397

RESULT: Action dismissed

KEYWORDS: Common element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity, Weak trade mark

KEY POINTS: When the signs are conceptually similar due to a common element that only has a weak distinctive character (insofar as it describes certain characteristics of the goods covered), then conceptual similarity only plays a limited role in the assessment of LOC (26/11/2015, T 262/14, BIONECS / BIONECT, EU:T:2015:888, § 67 and case-law cited) (§ 62).

FACTS: The applicants sought to register the word mark FAIR ZONE as an EUTM for goods in Classes 21, 25 and 28, including gloves for household purposes, sneakers, balls and toys.

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An opposition was filed based on the earlier EU figurative mark 'FAIR', registered for goods including clothing, footwear and games in Classes 25 and 28, pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition.

The applicants appealed before the Board of Appeal (BoA). The BoA partly annulled the OD's decision, namely with regard to the contested goods in Class 21, which were found dissimilar to the opponent's goods. For the remainder, the BoA confirmed the OD's decision and dismissed the appeal. The BoA based its analysis of LOC on the averagely attentive German-speaking public and found a below average visual similarity, an average phonetic similarity and a conceptual similarity between the signs. In light of the identical goods, the degree of similarity of the signs was found sufficient for LOC, despite the 'slightly weakened' distinctiveness of the earlier mark owing to the descriptive allusions of the common verbal element 'fair'.

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

SUBSTANCE: (i) PRELIMINARY ISSUE.

The applicants' head of claim seeking annulment of the contested decision is interpreted as seeking the annulment of the contested decision insofar as the BoA rejected their appeals concerning the goods in Classes 25 and 28 (§ 21-24).



EUTM application

FAIR ZONE

Earlier trade mark



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

The relevant public consists of the general public displaying an average level of attention (not disputed) (§ 34). The BoA rightly considered the perception of the German public when assessing LOC (§ 35).

The goods are identical (not disputed) (§ 37).

The word 'fair' can be understood by the relevant public as a component of the commonly known expression 'fair trade' which describes the fair trade with producers of third-world products and thus has weak distinctive character (§ 46-47). However, despite its weak distinctive character, in comparison to the other elements of the sign (which are no more distinctive), the verbal element 'fair' attracts the consumer's attention the most because of its position, size and presentation (§ 49-52, 54).

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Due to the differences between the signs – the figurative elements of the earlier mark and the presence of the word ‘zone’ in the trade mark applied for – they have an average degree rather than a below-average degree of visual similarity (§ 57-59).

The signs are phonetically similar to an average degree because of the common word ‘fair’ and the different pronunciation of the element ‘zone’ (§ 60).

As to the conceptual comparison, the BoA correctly concluded that the trade mark applied for has no clear meaning (§ 61). The BoA found the signs to be conceptually similar, but, as the element ‘fair’ only has a weak distinctive character (insofar as it describes certain characteristics of the goods), the conceptual similarity plays a limited role in the assessment of LOC (26/11/2015, T 262/14, BIONECS / BIONECT, EU:T:2015:888, § 67 and case-law cited) (§ 62).

Even in a case involving an earlier mark of weak distinctive character, there may be LOC on account, in particular, of a similarity between the signs and between the goods or services (§ 64). The earlier mark cannot be deprived of any of its distinctive character (§ 71) In view of the identity of the goods and the average degree of visual and phonetic similarity, there is LOC at least for the relevant German-speaking public, in spite of the weak inherent distinctive character of the earlier trade mark (§ 67, 78).

09/09/2020, T 625/19, SOS Innenfarbe, EU:T:2020:398

RESULT: Action dismissed

KEYWORDS: Descriptive, Principle of legality, Word mark

FACTS: The applicant sought to register the word mark SOS Innenfarbe as an EUTM for goods in Class 2 such as paints, lacquers and stains. The examiner refused the EUTM application pursuant to Article 7(1)(b) and Article 7(1)(c) EUTMR.

The Board of Appeal (BoA) dismissed the appeal. The BoA found that, according to the Duden (www.duden.de), the abbreviation SOS as an international [maritime] request for help was not an emergency signal used exclusively in maritime circles, but had been extended to all cases of emergency. It stated that the further component ‘Innenfarbe’ was understood by the German-speaking public as a generic designation for paints used in interior spaces. The BoA concluded that the sign was descriptive for indoor paints destined for emergency repair works, and for goods which were closely connected with indoor paints. As a purely descriptive indication, the sign was also held to be devoid of distinctive character.

The applicant filed an action before the General Court (GC), relying on a single plea in law of two

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parts: infringement of Article 7(1)(c) and Article 7(1)(b) EUTMR.

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

The relevant public consists of both end consumers and professional painters and artisans (not disputed). The assessment is based on the German-speaking public in Germany and Austria (not disputed) (§ 28-29).

The GC confirms the BoA's assessment regarding the meaning of the verbal elements of the sign (§ 33-43). The BoA correctly concluded that the relevant public perceives the sign as descriptive for the goods concerned (§ 45-49).

As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the principles of equal treatment and sound administration and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with respect for the principle of legality. The BoA provided explicit reasoning in accordance with its previous decisions (§ 53-55).

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

Since one of the absolute grounds for refusal listed in Article 7(1) EUTMR is sufficient to refuse an

application, the arguments related to Article 7(1)(b) EUTMR are not examined (§ 61-62).

09/09/2020, T 669/19, Primus / Primus et al., EU:T:2020:408

RESULT: Action dismissed

KEYWORDS: Due cause, Reputation, Unfair advantage, Use not as registered

KEY POINTS: Although goods in Class 28 and beers in Class 32 have a different nature and are not similar in the context of Article 8(1)(b) EUTMR, there is a certain link between them according to Article 8(5) EUTMR. In establishments where beer is offered, such as pubs, it is not unusual to find terminals, machines or equipment for playing games of chance, including if they are likely to provide the player with a financial gain (§ 99, 104).

In view of the identity of the signs, the average degree of reputation of the earlier mark and the fact that there is some connection between the goods (in spite of their different nature), the relevant public, for both marks composed of professionals, could make a link between the earlier marks and the mark applied within the meaning of Article 8(5) EUTMR (§ 107 108).

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FACTS: The applicant sought to register the word sign Primus as an EUTM for goods in Class 28, such as casino fittings, namely roulette tables, roulette wheels; casino games with or without prize payouts.

An opposition based on the earlier Benelux word mark Primus, registered for lemonades, drinking waters and beers and wines in Classes 32 and 33, and the EU word mark Primus, registered for beers in Class 32 was filed pursuant to Article 8(1) (b) and Article 8(5) CTMR. The Opposition Division (OD) rejected the opposition in its entirety on the grounds that there was no likelihood of confusion (LOC) between the marks and that the reputation of the earlier marks had not been established.

The opponent filed an appeal before the Board of Appeal (BoA). The BoA annulled the OD's decision. It found, as did the OD, that there was no LOC between the marks since the goods covered by the earlier marks and those covered by the contested mark were different. However, it found, contrary to the OD, that the evidence submitted by the opponent established the reputation of the earlier word marks.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of essential procedural requirements and (ii) infringement of Article 8(5) EUTMR and Article 7(2) EUTMDR. The GC dismissed the action.

SUBSTANCE: INFRINGEMENT OF ESSENTIAL PROCEDURAL REQUIREMENTS AND INFRINGEMENT OF ARTICLE 8(5) EUTMR.

The signs are identical (not disputed) (§ 23-24).

The use of the word mark 'Primus Pils' in the evidence of reputation does not alter the distinctive character of the earlier marks in their registered form (not disputed) (§ 38). The overall impression of the other forms in which the earlier marks are used are dominated by the verbal element 'primus'; the elements added, such as 'haacht' (name of the manufacturer's company) and a figurative element representing a knight do not alter the distinctive character of the earlier marks in their registered form (§ 40-43, 45-47, 48).

In the assessment of the reputation of the earlier marks, certain documents dated after the application's filing date may retain probative value and an undated document may be taken into account in support of other documents (§ 57-60).

The evidence sufficiently establishes that the earlier marks enjoy a certain reputation for lager beers in Belgium for the relevant public consisting of the general public and professionals providing bar services (§ 57-60, 68, 71-77).

The publics overlap since the goods of the contested mark were intended for professionals operating

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bars, casinos or other establishments where it was possible to install gaming machines. The analysis whether the relevant public is likely to make a link between the marks must be carried out on the basis of the specialised public displaying a high degree of attention (§ 90-93).

The relevant public establishes a link between the earlier marks and the contested mark (§ 107-108). The signs are identical (§ 97). Despite the differences in the nature of the goods (lager beers convey the idea of refreshment and relaxation and are not directly and immediately related to the goods of the contested mark, intended to encourage the player to play, including for financial gain), there is nevertheless a certain link between them. In fact, case-law has already recognised a certain similarity between entertainment services and beer because of their complementarity (06/07/2012, T 60/10, Royal Shakespeare, EU:T:2012:348, § 59). In establishments where beer is offered, such as pubs, it is not unusual to find terminals, machines or equipment for playing games of chance, including if they are likely to provide the player with a financial gain (§ 99).

In view of the reputation of the earlier marks for lager, the relevant public, namely professionals, could make a link between those marks and the contested mark in the event of the purchase of a gaming machine sold under the latter mark (§ 100).

The applicant's arguments that, firstly, the term 'primus' has a laudatory character and is understood to refer to a premium quality product and, secondly, that the earlier marks are understood to refer to the first black knight, cannot justify the existence of due cause. Moreover, it has not been established that that public had sufficient knowledge of Latin to recognise that meaning of 'primus' (§ 41, 106, 111-116).

09/09/2020, T 879/19, Dr. Jacob's essentials (fig.) / Compal Essencial et al., EU:T:2020:401

RESULT: Action dismissed

KEYWORDS: Similarity of the signs, Visual similarity, Weak element

KEY POINTS: The fact that the common elements of the conflicting signs are written in an almost identical font is not decisive, but must be taken into account in the overall assessment of visual similarity. If those elements are also represented in commonly used typefaces, without any particular stylisation or decoration, this factor is unlikely to be relevant (§ 48).

FACTS: The applicant sought to register the figurative mark Dr. Jacob's essentials as an EUTM for goods in Classes 5, 29, 30 and 32.

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Pursuant to Article 8(1)(b) CTMR, an opposition was filed based on several trade marks (international registration designating the EU, international registrations designating the UK, Portuguese marks) containing, inter alia, the element 'essential' for goods in Classes 5, 29 and 32. The Opposition Division (OD) dismissed the opposition.

The Board of Appeal (BoA) confirmed the OD's decision. Despite a low degree of similarity between the signs, their differences were sufficient to exclude any likelihood of confusion (LOC), even for identical goods. The opponent appealed to the General Court (GC) which upheld the action, as the BoA did not compare the marks in their entirety. The case was remitted back to the BoA. The second BoA decision dismissed the opposition, excluding any LOC. The signs were similar to a low degree overall and, due to the differences in their distinctive elements, consumers would not confuse their origin, even for identical goods. The opponent appealed again to the GC, relying on a single plea in law alleging infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE: ON THE INFRINGEMENT OF ARTICLE 8(1)(b) EUTMR.



The conflicting goods in Classes 29 and 32 are identical or highly similar (not contested, § 35).

EUTM application

Dr. Jacob's
essentials

Earlier trade marks

COMPAL ESSENCIAL

essential ^{FRUTA}


essential ^{FRUTA}



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The element 'essential' or 'essential' of the earlier marks and the element 'essentials' of the contested mark have a very low degree of inherent distinctiveness. This is because they are laudatory in nature, since they inform the consumer of a desirable effect of the goods. Those elements therefore have a lesser capacity to identify the commercial origin of the goods (15/12/2009, T 412/08, TRUBION/TriBion Harmonis (fig.), EU:T:2009:507, § 39 and 41-43) (§ 44).

Although the elements 'compal' and 'Dr. Jacob's' are smaller, they are clearly legible and appear in the initial part of the marks, to which the consumer generally pays greater attention. The element 'Dr. Jacob's' of the contested mark will be perceived as an arbitrary and fanciful word, with average distinctiveness (13/09/2010, T 366/07, P&G Prestige beauté, EU:T:2010:394, § 66) (§ 47).

The fact that the element 'essential'/'essential' of the earlier figurative marks and the element 'essentials' of the contested mark are written in an almost identical font is not decisive, but must be taken into account in the overall assessment of visual similarity. Those elements are represented in commonly used typefaces, without any particular stylisation or decoration, so this coincidence is not particularly relevant (§ 48). Considering also the different colours, the degree of visual similarity between the signs is low (§ 50).

Any LOC is excluded even for identical goods. This is because the similarities relating to the weakly distinctive elements 'essential' or 'essential' and 'essentials' are insufficient to offset the differences resulting from the additional elements in the signs (§ 52).

09/09/2020, T 81/20, DARSTELLUNG EINES RECHTECKS MIT DREI FARBIGEN SEGMENTEN (fig.), EU:T:2020:403

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Non-distinctive

KEY POINTS: Circumstances outside of the right conferred by the EU trade mark, such as the price of the products that the mark is applied for, are not subject to registration and consequently cannot be taken into account in the course of the assessment of the distinctive character of a mark (12/09/2007, T 358/04, Mikrophon, EU:T:2007:263, § 34 and case-law cited) (§ 34).

FACTS: The applicant sought to register a figurative mark consisting of a representation of three coloured segments in a rectangle as an EUTM for goods in Classes 9, 18, 20, 25 and 31. The examiner refused the application pursuant to Article 7(1)(b) EUTMR.

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The Board of Appeal (BoA) dismissed the appeal: the relevant public had a higher-than-average level of attention; in neither of the two categories in which the goods can be divided did the sign indicate their business origin. Therefore, the sign was considered devoid of any distinctive character.

The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 7 (1)(b) EUTMR. The GC dismissed the action.

EUTM Application



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

The definition of the relevant public, displaying a higher than average level of attention, is confirmed by the Court (not contested).

Coloured stripes placed within a rectangle are simple shapes very commonly used in the design

of clothing, furniture and frames. Additionally, the simplicity of the rectangular shape, the distribution in three vertical stripes of the same size and height and the colours themselves of such stripes, will entail that the sign is perceived as a simple element commonly used in the presentation of the products and not as an indication of commercial origin (§ 28-29).

The high-end nature and high prices of the goods are not factors that are apparent from the description of the products covered by the application (§ 32-33). Circumstances outside of the right conferred by the EU trade mark, such as the the price of the products, are not subject to registration and consequently cannot be taken into account in the course of the assessment of the distinctive character of a mark (12/09/2007, T 358/04, Mikrophon, EU:T:2007:263, § 34 and case law cited) (§ 34).

The GC is not bound by the circumstance that an identical sign has been registered in Germany. The EU trade mark regime is an autonomous system with its own set of objectives and rules, as acknowledged by consistent case law (27/02/2002, T 106/00, Streamserve, EU:T:2002:43, § 47) (§ 38).

In its review of legality, the GC is also not bound by previous decisions of the Office to register as an EUTM figurative signs allegedly similar to the mark applied for, as acknowledged by consistent case-law (26/04/2007, C 412/05 P, Travatan, EU:C:2007:252, § 65) (§ 40).

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Moreover, the applicant has not put forward any argument such as to establish that the BoA committed an error in the assessment of the distinctive character of the mark (§ 41).

23/09/2020, T 36/19, ElitePartner, EU:T:2020:425

RESULT: Action dismissed

KEYWORDS: Lack of reasoning, Non-distinctive

FACTS: The proprietor registered the figurative sign ElitePartner as an EUTM for services in Classes 35, 42 and 45 such as advertising, business management, scientific and technological services and legal services. It claimed the colours blue and red, and added the description 'red beam - Elite Partner highlighted in blue'.

An application for declaration of invalidity was filed, pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and Article 7(1)(c) CTMR. The Cancellation Division (CD) declared the contested mark invalid since it found that it was devoid of distinctive character.

The proprietor filed an appeal before the Board of Appeal (BoA). The BoA found that the word 'elite' evoked an idea of superiority, designating a group of highly qualified people associated with the idea of privileges, selectivity, or even exclusivity. It also

found that that the word combination 'Elite Partner' can be understood to mean 'a partner that forms part of the elite'. It took the view that the consumers would understand the word combination as an indication that the services were provided by a qualified person (of the elite). The relevant public would therefore perceive the sign as a laudatory reference to the service provider for, inter alia, the scientific and technological services, analysis and research services, design and development of computer hardware and software, legal services and security services. The figurative and graphic elements were held to be minimal and not capable of adding any distinctive character within the meaning of Article 7(1)(b) EUTMR. It added that the applicant failed to prove that the contested trade mark for Austria had acquired distinctive character through use according to Article 7(3) EUTMR.

The proprietor filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) lack of reasoning of the contested decision. The GC dismissed the action.

EUTM



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

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The relevant public consists of average consumers displaying an average level of attention and professionals, with specific technical knowledge, displaying a high level of attention. The relevant public, in particular the German-speaking public, understands the term 'elite partner' (not disputed) (§ 42-43).

The word 'partner', written in the plural or the singular, has descriptive meaning since it describes relationships of association or partnership with positive connotations of reliability and continuity (14/06/2018, T 310/17, LION'S HEAD global partners (fig.) / LION CAPITAL et al., EU:T:2018:344, § 26 and case-law cited) (§ 53). The BoA correctly found that the word sequence 'ElitePartner' will be understood as a merely laudatory indication of the quality of the services and that the contested sign describes, in respect of each of the services concerned, at least one of its characteristics (§ 56-59). The coloured figurative and graphical elements, and the colour of the font are not capable of adding any distinctive character (§ 76-78).

The only relevant date for the purpose of assessing an application for a declaration of invalidity is the date of the filing of the application for registration of the contested mark (§ 89-90). Therefore, the applicant's arguments related to a change in the consumer's level of attention between the filing date in 2007 and 2018 cannot succeed (§ 87, 91-98).

(ii) LACK OF REASONING OF THE CONTESTED DECISION

The alleged lack of reasoning is based on a misunderstanding of the contested decision. In particular, the BoA gives a principled line of reasoning for all the services, stating that they are all rendered by a qualified person (by the elite) in the relevant territory, to demonstrate that the sign is devoid of distinctive character (§ 104-108).

23/09/2020, T 401/19, Freude an Farbe (fig.) / Glemadur Freude an Farbe (fig.), EU:T:2020:427

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative element, Likelihood of confusion, Relevant territory

KEY POINTS: In the absence of evidence provided by the parties, the knowledge of the German language in Spain, Italy and France does not have the character of a well-known fact, as is the case for English in the Scandinavian countries, the Netherlands and Finland, for example (§ 29-30).

A word sequence in a foreign language may still be remembered even though it is not easy to pronounce for the majority of the relevant public in the EU, who do not understand the language. The average consumer, perceiving a word sign,

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will break it down into word elements that have a concrete meaning for them, or that resemble words known to them (19/05/2011, T 580/08, *Pepequillo*, EU:T:2011:227, § 74) (§ 61).

FACTS: The applicant sought to register the international figurative mark *Freude an Farbe*, designating the EU, and claiming the colours yellow, orange, red, pink, purple, blue, turquoise, dark green, light green and anthracite for goods and services in Classes 2, 16, 19, 35 and 37.

An opposition was filed based on the earlier EU figurative mark *Glemadur Freude an Farbe*, with the colour indication red, white, yellow, orange, dark blue, light blue and green, registered for goods and services in Classes 2, 16, 19, 35 and 37 pursuant to Article 156 CTMR in conjunction with Article 8(1)(b) CTMR. The Opposition Division upheld the opposition on the ground that there was a likelihood of confusion (LOC).

The opponent appealed to the Board of Appeal (BoA). The BoA dismissed the appeal. It considered the perception of the signs by the relevant public in the EU for which the German words 'Freude an Farbe' and the word element 'Glemadur' have no meaning and therefore a normal degree of distinctive character. The figurative elements of the opposing trade marks were held to be purely decorative and playing a minor role in the comparison. The BoA found that the visual similarity of the signs was

below average and the phonetic similarity average. It ruled out the conceptual comparison because of the lack of meaning for the non-German-speaking part of the relevant public. The BoA concluded that there was a LOC between the signs.

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.

IR application



Earlier trade mark



SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 8(1)(b) CTMR

The relevant public consists of the general public and professional consumers in the EU, with a level of attention which varies from average to high (not

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disputed) (§ 22). The goods and services under comparison are identical or similar (not disputed) (§ 21).

ON THE RELEVANCE OF THE PUBLIC'S UNDERSTANDING OF GERMAN

For an EU trade mark to be refused registration the LOC does not have to exist in all Member States and in all linguistic areas. Where a LOC exists for a non-negligible part of the relevant public, because it fails to perceive the conceptual differences between the marks due to a lack of understanding of a certain language, this will justify a refusal to register the mark (§ 26-27).

It may be assumed that a sign will be understood in a territory in which the language of the sign is the native language of the population. Otherwise it has to be proved that the sign is understood, unless a sufficient knowledge of the language of the sign on the part of the relevant public in the territory constitutes a well-known fact (§ 28). Knowledge of the German language in Spain, Italy and France does not have the character of a well-known fact. The applicant did not prove that German is understood, not only by professionals in the sector concerned but also by the general public, with an average level of attention within the EU (§ 29-30).

As to the earlier mark, the word elements 'Glemadur' and 'Freude an Farbe' have the same importance,

and the figurative elements are purely decorative (§ 46).

The overall impression of the contested mark is determined by three German words 'Freude an Farbe' in light grey, which are emphasised by the contrast between a clear lettering and the coloured and unordered particles in the background. Even if the figurative element draws a certain attention due to its size, position, use of colours and the arrangement of the particles, the applicant did not demonstrate that this element dominates the overall impression of the contested trade mark (§ 51-52).

ON THE COMPARISON OF THE SIGNS

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Moreover, a consumer only rarely has the chance to make a direct comparison between the different marks, relying instead on their imperfect recollection of them. This is also true for consumers having a high level of attention (§ 58).

Where a trade mark is composed of verbal and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more readily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (§ 60). The German word element 'Freude an

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Farbe' is of average distinctive character. Although this word sequence consists of three words of a foreign language that are not easy to pronounce for the majority of the non-German-speaking relevant public in the EU, they may still be remembered by this public who tend to relate unknown words with similar words of their own language. The average consumer, perceiving a word sign, will break it down into word elements that have a concrete meaning for them, or that resemble words known to them (19/05/2011, T 580/08, Pepequillo, EU:T:2011:227, § 74) (§ 61).

Moreover, the fact that the mark consists exclusively of the earlier mark, to which another word ('Glemadur') has been added, is an indication that the two trade marks are similar (§ 64). Accordingly, the BoA correctly stated that the visual similarity of the signs was below average and the phonetic similarity average, and therefore there was a LOC between the marks (§ 53, 71).

Because of their unitary character, EU trade marks enjoy uniform protection throughout the EU, without any geographical restriction. Therefore, there is no need to determine the territory in which there is a LOC; it is sufficient to identify a significant proportion of EU consumers for whom such risk exists. This can be determined by language skills or other criteria apart from the territory (§ 76-81).

23/09/2020, T 522/19, BBQ BARBECUE SEASON (fig.), EU:T:2020:443

RESULT: Action dismissed

KEYWORDS: Descriptive, Non-distinctive

FACTS: The applicant sought to register the figurative mark BBQ BARBECUE SEASON as an EUTM for goods in Classes 4, 6, 8, 9, 11, 21 and 34, such as barbecue briquettes; firelighters for grills and disposable tableware [cutlery] made of plastics; barbecues, non-electric griddles; tableware, cookware and containers; bowls [basins]. The examiner partially refused the application for certain goods in each of those classes, pursuant to Article 7(1)(b) and (c) EUTMR, due to the sign's descriptive character.

The Board of Appeal (BoA) dismissed the applicant's appeal and confirmed the examiner's decision.

The applicant filed an action 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.

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EUTM Application



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

The relevant public consists of the English-speaking general public and professional public in the field of catering and alimentation (not disputed) (§ 19).

The letters 'BBQ', as an abbreviation of the word 'barbecue', and the English word 'season' correspond to the rules of English grammar and are immediately understood by the relevant public as linked to 'barbecue season' (§ 21-23). The graphic elements are simple and customary without any special feature. The relevant public associates the colours black, orange and red with blazing charcoal and are therefore capable of reinforcing the meaning of the word components (§ 25). Therefore the BoA correctly found that the sign was descriptive of goods which are used when barbecuing, during the time of the year apt for barbecuing (§ 28-29, 36).

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

As to the other goods that are not directly related to 'barbecue' or the 'barbecue season', such as tableware or containers, the great majority of the relevant public will not perceive the sign as an indication of the commercial origin. They will instead associate it with goods which are merely intended to be used in the ideal time for having meals outdoors. Indeed, every year, approaching the summer period, shops promote certain products which evoke summer and barbecues to encourage consumers to buy them (§ 45-46). Consequently, the BoA correctly found that the sign is devoid of distinctive character for those goods (§ 48).

23/09/2020, T 601/19, in.fi.ni.tu.de (fig.) / infinite, EU:T:2020:422

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Phonetic similarity, Principle of legality, Proof of use, Similarity of the goods and services, Visual similarity

KEY POINTS: When perceiving a word sign, the average consumer will recognise word elements which suggest a specific meaning or which resemble familiar words (08/07/2015, T 548/12, REDROCK, EU:T:2015:478, § 37). For signs composed of several word elements reproduced separately, the relevant

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public understands the meaning by regrouping these elements to form expressions that convey a precise meaning or resemble recognised words, especially when that understanding requires no particular intellectual effort (06/09/2013, T 599/10, Eurocool, EU:T:2013:399, § 101-109).

Beer and brewery products in Class 32 and wines in Class 33 are similar only to a low degree, not to an average degree (18/06/2008, T 175/06, Mezzopane, EU:T:2008:212, § 63-70) (§ 102-103).

FACTS: The applicant sought to register the figurative sign in.fi.ni.tu.de for beer and brewery products in Class 32 and for goods in Class 33 such as cider; preparations for making alcoholic beverages; wine. An opposition based on the earlier Spanish and international registration for the word mark Infinite, registered for alcoholic beverages, except beers in Class 33, was filed pursuant to Article 8(1)(b) CTMR.

Upon the applicant's request, the opponent produced various documents to prove genuine use of the earlier marks. The Opposition Division (OD) upheld the opposition. It held that the evidence only related to proof of genuine use of the earlier Spanish word mark during the relevant period in Spain, for wines in Class 33. The OD stated that the goods designated by the mark applied for, with the exception of the alcoholic preparations for making beverages in Class 33, were in part identical and in part similar to wines in Class 33, covered by the

earlier Spanish word mark. It upheld the opposition in part, on the ground that there was a likelihood of confusion (LOC).

The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal, upholding the OD's decision.

The applicant filed an action before the General Court (GC), relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 47(2) and (3) EUTMR and (iii) infringement of Article 94(1), first and second sentences EUTMR, of Article 95(1) EUTMR and of Article 97(1) EUTMR. The GC dismissed the action.

EUTM application

in · fi · ni · tu · de

Earlier trade mark

Infinite

SUBSTANCE: (i) INFRINGEMENT OF ARTICLE 47(2) AND (3) EUTMR AND (ii) INFRINGEMENT OF ARTICLE 94(1), ARTICLE 95(1) EUTMR AND OF ARTICLE 97(1) EUTMR

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The relevant period of 5 years for proof of use runs from 28 October 2011 to 27 October 2016 and the relevant territory is Spain (not disputed) (§ 48-49).

The BoA was entitled to conclude that genuine use of the earlier Spanish word mark was proven for wines through export sales to North America in accordance with Article 18(1) EUTMR, second subparagraph point (b). The trade mark 'INFINITE' was affixed to the bottles of red wine bearing the designation of origin 'Catalonia (Spain)', bottled in Spain and destined for export to Canada or the United States. Considering the size and significance of the Canadian and American wine markets, that activity (exporting to importer-distributors operating in those markets) was sufficiently extensive, as regards territory, to maintain or to create market shares for Spanish red wines exported under the earlier Spanish word mark (§ 53-54). The 18 invoices (addressed to six different customers and showing sales totalling hundreds of thousands of American or Canadian dollars) and the label designs are sufficient to prove that the earlier Spanish word mark had not been put purely to token use, in the context of commercial export activity (§ 61-65, 75).

The rule prescribed by Article 95(1) EUTMR, that the Office is to examine facts of its own motion, does not apply to the question of proof of genuine use of the mark in opposition proceedings, as stated in Article 47(2) and Article 64(2) EUTMR (26/09/2013, C 610/11 P, Centrotherm, EU:C:2013:912, § 55, 65) (§ 70-73).

However, the applicant's complaint, reproaching the BoA for not having restricted its examination to the evidence produced by the opponent, is rejected as ineffective. This is because it was possible to prove genuine use solely on the basis of the evidence produced by the opponent, without considering the possible existence of promotional material for wine exported under the earlier Spanish mark or the supposed existence of invoices other than those produced by the opponent (§ 74, 75).

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

The relevant public consists of the general public in Spain whose level of attention when purchasing alcohol is average (§ 96-98). The goods in question are identical in part and similar in part, to an average degree (§ 101), with the exception of the applicant's beer and brewery products in Class 32 and wines in Class 33 of the earlier mark, which are similar only to a low degree, not to an average degree (18/06/2008, T 175/06, Mezzopane, EU:T:2008:212, § 63-70) (§ 102-103).

When perceiving a word sign, the average consumer will recognise word elements which suggest a specific meaning or which resemble familiar words (08/07/2015, T 548/12, REDROCK, EU:T:2015:478, § 37). For signs composed of several word elements reproduced separately, the relevant public understands the meaning by regrouping those elements to form expressions that convey

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a precise meaning or resemble recognised words, especially when that understanding requires no particular intellectual effort (06/09/2013, T 599/10, Eurocool, EU:T:2013:399, § 101-109). The word element 'infinitude' has a very strong resemblance to the Spanish word 'infinitud', a feminine noun used to describe the state or quality of being infinite or without limits (not disputed). Despite the separation by dots and spaces, the relevant public will immediately identify that meaning (§ 108-112).

The marks do not contain any elements which are dominant or more distinctive than others (not disputed), therefore they must be compared in their entirety (§ 113).

The signs are visually similar, at least to a low degree, and phonetically similar to a higher-than-average degree. They differ only in the two extra letters, 'u' and 'd' in the mark applied for, and visually in the syllables being separated by the insertion of dots and spaces. Otherwise they match, in particular their initial part, 'infini', to which the consumer normally attaches the most importance (§ 114-115).

The signs are conceptually similar to a high degree because they are associated with the same concept of infinity (§ 116).

The BoA correctly found that the earlier mark was neither descriptive for wines nor laudatory but had an inherent distinctiveness to an average degree (§

119-124, 136). In particular, it is not obvious that the word 'infinite' is part of a basic English vocabulary, (§ 119) and a trade mark registered in a Member State is to be accorded a certain inherent distinctiveness (§ 123).

As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must consider the decisions already taken on similar applications, the application of those principles must be reconciled with the principle of legality (§ 126-129). In any event, the decisions mentioned by the applicant do not concern wines, but totally different goods and services (§ 131).

Following a global assessment, the BoA considered the principles of imperfect recollection and of interdependence of all the factors. The BoA also considered the higher relative significance of the phonetical similarity as regards beer and brewery products and wines (§ 141; 20/04/2018, T 15/17, YAMAS (fig.) / LLAMA, EU:T:2018:198, § 61-62). Based on these considerations, the BoA correctly found that there was a LOC by the relevant public displaying an average level of attention, even in relation to the goods found similar only to a low degree (§ 141-142).

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23/09/2020, T 677/19, SYRENA, EU:T:2020:424

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Claim for alteration of EUIPO decision, Extent of use, Proof of use, Right of defence

KEY POINTS: In the market for high-end sports cars with technical specifications the provision of sales figures or invoices is not necessary for establishing genuine use of the mark (15/07/2015, T 398/13, TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57) (§ 70). The existence of various preparatory tasks and advertising efforts (various Polish and international press articles) showing not only that the car was about to be marketed, but also that it was available to order, may be sufficient (§ 71).

Inadequate reasoning of a decision constitutes an infringement of essential procedural requirements that the Court may raise of its own motion (16/06/2015, T 660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 19 and case-law cited, (§ 84).

Racing cars constitutes a coherent subcategory, which is capable of being viewed independently, in that the purpose of that category is different from that of other types of cars (§ 116, 129).

FACTS: The proprietor registered the word mark SYRENA as an EUTM for goods in Classes 9, 12

(Motor vehicles for locomotion by land and parts therefor) and 28. An application for revocation was filed pursuant to Article 51(1)(a) CTMR in respect of all the goods covered by the EUTM. The Cancellation Division (CD) revoked the EUTM entirely, except in respect of 'cars' in Class 12 (as use was only shown for sports cars and electric cars). The Board of Appeal (BoA) dismissed the appeals filed by both the EUTM proprietor and the revocation applicant.

The revocation applicant filed an action before the General Court (GC), relying on five pleas in law alleging infringement of: (i) Articles 94(1) and 95(1) EUTMR and Article 55(1) EUTMDR, (ii) Article 58(1)(a) EUTMR, (iii) Articles 18(1), 58(1)(a), 58(2), 94(1), 95(1) EUTMR and Article 55(1) of EUTMDR, (iv) Articles 58(2) and 64(5) EUTMR, (v) Articles 94(1) and 64(1) EUTMR. The GC partially upheld the action.

SUBSTANCE: (v) ALLEGED INFRINGEMENT OF THE APPLICANT'S RIGHTS OF DEFENCE

The applicant's claim concerning infringement of its right to be heard before the CD, does not impact the validity of the contested decision. Pursuant to Article 72(1) EUTMR, actions may be brought before the GC against decisions of the BoA, and in any event, the applicant was able to present its comments on the evidence disputed before the BoA (05/03/2019, T 263/18, MEBLO (fig.), EU:T:2019:134, § 30-31) (§ 25-27).

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(i)-(ii) INSUFFICIENT EVIDENCE TO PROVE GENUINE USE OF THE CONTESTED EUTM

(1) Proof of genuine use in respect of racing cars

In the market for high-end sports cars with technical specifications, the provision of sales figures or invoices is not necessary for establishing genuine use of the mark (15/07/2015, T 398/13, TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57) (§70). Although the evidence submitted did not show that the sale of racing cars took place, it did show the existence of various preparatory tasks and advertising efforts (various Polish and international press articles) in relation to a 'SYRENA' model. Those items of evidence showed not only that the car was about to be marketed, but also that it was available to order (§ 71).

Accordingly, the Board of Appeal was fully entitled to consider that genuine use of the EUTM had been shown in respect of racing cars (§ 73).

(2) Proof of genuine use in relation to sports cars

The BoA concluded that genuine use of the EUTM had been shown in relation to, inter alia, sports cars. However, the BoA did not assess genuine use in respect of sports cars individually, and did not explain why the findings relating to racing cars were applicable to sports cars (§ 82). Therefore, the BoA decision is vitiated by inadequate reasoning (an

infringement of essential procedural requirements that the Court may raise of its own motion, 16/06/2015, T 660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 19 and case-law cited) (§ 84). It does not enable the GC to understand the extent to which the evidence produced by the EUTM proprietor showed genuine use of the EUTM in respect of sports cars (§ 90).

(3) Proof of genuine use in respect of electric cars

Genuine use had not been shown as regards 'electric cars'. The evidence does not show that they were about to be marketed (§ 102, 104).

Therefore it is in respect of 'racing cars' only that the BoA was correct to hold that genuine use of the contested mark had been shown (§ 105).

(iii)-(iv) WHETHER USE OF THE MARK FOR THE GENERAL CATEGORY 'CARS' CAN BE ESTABLISHED

The EUTM was not used for all of the goods in respect of which it was registered (e.g. the category motor vehicles for locomotion by land in Class 12 in particular (§ 117)) but only for racing cars (§ 125).

Racing cars constitutes a coherent subcategory, which is capable of being viewed independently, in that the purpose of that category is different from that of other types of cars (§ 116, 129). Accordingly, the BoA was wrong to find that genuine use of the

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EUTM had been shown in respect of cars in Class 12 and not only for racing cars (§ 129).

APPLICATION FOR ALTERATION OF THE CONTESTED DECISION

The conditions for the alteration of the contested BoA decision are not fulfilled. Some of the BoA findings are vitiated by inadequate reasoning, so the GC does not have all the elements to take the decision that the BoA should have taken (§ 131-132).

23/09/2020, T 738/19, Wi-Fi Powered by The Cloud (fig.), EU:T:2020:441

RESULT: Action dismissed

KEYWORDS: Database, Figurative trade mark

KEY POINTS: References to online databases (e.g. Wikipedia), in order to demonstrate the descriptiveness of a sign, can only be accepted if they have confirmatory value and simply corroborate information from other sources, such as scientific studies, extracts from technical publications, press articles, and statements from professionals, traders and consumers (25/09/2018, T 180/17, EM, EU:T:2018:591, § 79) (§ 38).

The descriptiveness of a trade mark which consists of several elements may be assessed, in part, in

relation to each of those elements taken separately, but must also be established in relation to the whole which they comprise (19/12/2019, T 69/19, Bad Reichenhaller Alpensaline (fig.), EU:T:2019:895, § 22) (§ 43).

FACTS: The proprietor registered the figurative mark Wi-Fi Powered by The Cloud as an EUTM for goods and services in Classes 9, 28, 38 and 41 such as electronic games, gambling apparatus and instruments, telecommunications and entertainment services.

An application for declaration of invalidity was filed, based on Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and (c) CTMR, for all of the goods and services covered by the mark. The Cancellation Division (CD) dismissed the application.

The invalidity applicant filed an appeal before the Board of Appeal (BoA). The BoA upheld the CD's decision and dismissed the appeal. It found that the applicant had not provided sufficient evidence to show that the contested mark, taken as a whole, was descriptive on the date of filing the application for registration (24/09/2010). Accordingly, it stated that the contested mark was not devoid of distinctive character on account of its descriptive character.

The invalidity applicant filed an action 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.

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EUTM Application



SUBSTANCE: INTERPRETATION OF HEAD OF CLAIM AND THE RATIONE TEMPORIS APPLICATION OF THE EUTMR

The head of claim requesting the alteration of the contested decision may be interpreted, in the light of the contents of the application, as including a claim for annulment even though it is not explicitly expressed in the head of claim itself (§ 11).

Procedural rules are generally taken to apply from the date on which they enter into force. Substantive rules, by contrast, are usually interpreted as applying to situations established before their entry into force only insofar as it clearly follows from their terms, objectives or general scheme, that such an effect must be given to them (06/06/2019, T 221/18, BATTISTINO / BATTISTA et al., EU:T:2019:382, § 19). The determinative date for the purposes of identifying the applicable substantive law is the date on which the application for registration was made (23/04/2020, C 736/18 P, GUGLER (fig.) / GUGLER FRANCE, EU:C:2020:308 § 3). The present dispute is governed by the provisions of the CTMR

(§ 14). However, the references to the EUTMR can be understood as referring to the corresponding provisions of Regulation CTMR as amended, without affecting the legality of the contested decision, since the content of those provisions has not been affected by the entry into force of the EUTMR (§ 15).

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

The relevant public is composed of the English-speaking public at large, as well as professionals, including professionals in the field of computer technology, with a level of attention that may vary from average to high, depending on the price and sophistication of the goods and services offered (§ 34).

The mark consists of the word elements 'wi-fi powered by' and 'the cloud', arranged on two lines and the figurative element in the shape of a cloud (§ 35). In order to substantiate its argument as to the descriptiveness of the element 'the cloud' of the contested mark, the applicant produced an extract from the online encyclopaedia 'Wikipedia', dated 01/03/ 2016, on cloud computing. The essence of that extract was that the expression 'the cloud' has been used since the 1970s to refer to a model of the use of IT resources on the internet which makes it possible to share data on demand over a network of computers and other devices (§ 37). That extract from Wikipedia is the only evidence provided by the applicant. As such, it has no confirmatory value, nor

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is it intended to corroborate information from other sources. Therefore, even supposing that the element 'the cloud' is an expression which has become increasingly well known in the field of computer technology and telecommunications since the 1970s when referring to goods or services provided on the internet, such a claim cannot be regarded as having been duly substantiated (25/09/2018, T 180/17, EM, EU:T:2018:591, § 79) (§ 38-39).

Moreover, the applicant claims that the two elements of the contested mark are both individually descriptive (first, the element 'wi-fi powered by' as a reference to wireless networks, and second, the figurative element of the mark representing a cloud, as a reference to cloud computing). However, it does not submit any evidence to demonstrate that the mark, taken as a whole, was perceived by the relevant public as descriptive of the characteristics of the goods and services at the time of filing the application for registration (19/12/2019, T 69/19, Bad Reichenhaller Alpensaline (fig.), EU:T:2019:895, § 22) (§ 43-46).

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

Insofar as the descriptiveness of the contested mark had not been duly demonstrated, the BoA did not err in law in not finding that the contested mark lacked distinctive character (§ 57).

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Cases referred to the Grand Board

22/06/2020, [R 0400/2018-G, RECIJITO / RECIOTO DI SOAVE et al.](#)

Outcome: No decision on opposition

Norms: Article 8(1)(b), 8(4) and 8(5) EUTMR

Keywords: Collective mark, Likelihood of confusion

Summary:

On 22 June 2020, the Second Board of Appeal decided to refer case R 0400/2018-2, RECIJITO / RECIOTO DI SOAVE et al. to the Grand Board.

This case concerns the sensitive issue of genuine use of an earlier collective mark coinciding with a Protected Denomination of Origin for wines (inter alia, RECIOTO DI SOAVE). The decision is expected to touch upon the legal issues of scope of protection and functions of those distinct IP rights in light of the recent case-law of the Court of Justice.

In the light of the importance of the legal issues concerned, the case was remitted to the Grand Board which should take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of

services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the interim decision of the Second Board in the EUIPO OJ on 1 October 2020 (language of the proceedings: Italian).

02/07/2020, [BoA Presidium decision \(referral of case EIN KREIS MIT ZWEI PFEILEN \(fig.\) to the Grand Board\)](#)

Outcome: EUTM cancelled

Norms: Article 18(1) EUTMR, Article 58(1)(a) EUTMR, Article 74 EUTMR

Keywords: Revocation action, Non-use, Collective mark

Summary:

On 2 July 2020, the Presidium of the Boards of Appeal decided to refer R 1357/2015-5, EIN KREIS MIT ZWEI PFEILEN (fig.) to the Grand Board as case number R 1304/2020-G.

This case concerns the requirements applicable for proving use of an EU collective mark. Furthermore, it concerns the link between, on the one hand, the indication of a producer's membership in an

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association that owns a collective mark and, on the other hand, the ensuing consumer's choice for purchasing the goods and/or services bearing the collective trade mark.

In light of the novelty and importance of the legal issues concerned, it was deemed appropriate to refer the above-mentioned case to the Grand Board for it to take a decision on the substance and in order to establish a harmonised approach of the Boards of Appeal in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case may submit written observations within two months following the publication of the Decision of the Presidium in the [EUIPO OJ - October 2020](#) (language of the proceedings: German).



New Decisions from the Boards of Appeal

15/09/2020, R 777/2020-1, [Infor plm accelerate / accelerate](#) (fig.)

Earlier trade mark

INFOR PLM ACCELERATE

Contested sign

accelerate 

Word mark – Opposition – *Restitutio in integrum* – Article 8(1)(b) EUTMR – Article 68 EUTMR – Article 104 EUTMR – *Restitutio in integrum* rejected – Appeal inadmissible – Application rejected

The applicant sought to register the word mark claiming the priority of a US trade mark application for goods and services in Classes 7 and 9. The opponent filed an opposition against the registration of the published trade mark application for all the goods and services. The grounds of opposition were those laid down in Article 8(1)(b) EUTMR. The Opposition Division refused the trade mark applied for, for all the contested goods and services, on the grounds that there was a likelihood of confusion.

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The applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The Registry of the Boards of Appeal notified the applicant that no statement of grounds had been filed before the deadline for filing a written statement pursuant to Article 68 EUTMR which could lead to the inadmissibility of the appeal. The applicant requested restitutio in integrum arguing that (i) there were operational difficulties arising from measures taken by public authorities against the pandemic (the applicant is a company based in New York City) (ii) the request was submitted within two months from the removal of the cause of non-compliance within the time limits of Article 104 EUTMR.

In accordance with Article 104 EUTMR, one of the conditions for a successful request for restitutio in integrum is that the time limit was missed contrary to all due care required by the circumstances. The applicant argues that operational difficulties arising from measures taken by public authorities against the pandemic, or due to instances of sickness of the party or its representative could constitute exceptional circumstances in the sense required to exercise the right to restitutio in integrum. The EU representative argues that the applicant is a company based in New York City and that is renowned that New York City was, at that time, the US epicentre for the coronavirus pandemic. According to the EU representative, the applicant used to send instruction to its US representative which

then forwarded them to the EU representative. The Board notes that the applicant has not justified any unforeseeable measures taken by the authorities that would have made the filing of its statement of grounds impossible, nor has it been alleged that any of the reference people were sick – it is not enough to invoke general organisational difficulties or a silent corresponding US representative to justify restitutio in integrum.

05/10/2020, R 491/2020-1, SAFEAIR

Word mark – Descriptive element – Non-distinctive – Article 7(1)(b) and (c) EUTMR – Appeal dismissed – Application partially rejected

The applicant sought to register the word mark above for several goods in Classes 7 and 10, mainly dealing with electrical generators for providing power to medical and surgical apparatuses, medical grade smoke and gas removal devices and medical and surgical kits; the goods belonging to a highly specialised market sector.

The Board notes that the sign consists of two words 'SAFE' and 'AIR'. The word 'SAFE' is defined as 'something that does not cause physical harm or danger', while 'AIR' is 'the mixture of gases from which the Earth's atmosphere is constituted and of which we breathe'. The relevant consumer would perceive the sign as an indication of its nature or its

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intended purpose, namely for devices that remove smoke and other gases from surgical sites and parts and filters for such devices. With this consideration in mind, the sign describes the kinds of goods offered, which falls under Article 7(1)(c) EUTMR. The Board concludes that the descriptive meaning of the sign 'SAFEAIR' in relation to all the goods at issue would be immediately perceived by the relevant public. Even if the relevant public were to display a high level of attention, the mark applied for would be no less subject to the absolute grounds of refusal. The sign applied for is devoid of distinctive character, for the same goods, within the context of Article 7(1)(b) EUTMR.

Consequently, the examiner's decision is confirmed and the appeal is dismissed.

10/05/2020, R 1270/2020 -1, Treasure Hunter

Word Mark - Descriptive element - Non-distinctive - Article 7(1)(b) and (c) EUTMR - Appeal dismissed - Application rejected

The applicant sought to register the words 'Treasure Hunter' for several goods and services in Classes 9 and 41. The examiner rejected the mark applied for on the basis of Article 7(1)(b) and (c) EUTMR, in conjunction with Article 7(2) EUTMR, for the goods and services in Classes 9 and 41.

As the sign applied for consists of the words 'TREASURE HUNTER', the Board indicates that according to case-law, the general meaning of a term is a well-known fact. The examiner referred to dictionary meanings and concluded that the relevant English-speaking consumer would understand the sign as: 'a person or thing that goes on a search for objects of value following certain clues'.

The Board takes the view that the combination of words 'TREASURE HUNTER' does not have any unusual or ambiguous character, in light of English grammar rules, which would lead the relevant public into making a different kind of association. The expression 'TREASURE HUNTER' will not require any mental steps to set off a cognitive process on the relevant public's part. The goods and services in this case are addressed to the public at large, in the entire territory of the European Union, whose degree of attention will be average. The relevant consumer would perceive the expression 'TREASURE HUNTER' as a direct and immediate description of the kind of games played by people (hunters) in search of treasure. Moreover, this combination of words is devoid of originality, imaginability and resonance. It is descriptive of these kinds of games.

The conceptual content conveyed by the contested mark only carries an informational and factual message relating to the relevant characteristics of the goods and services. It cannot guarantee the identity of the origin of the marked goods and

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services to the consumer or end-user by enabling him or her, without any possibility of confusion, to distinguish the said goods and services from others which have a different origin. It follows that, the sign applied for falls within the grounds of refusal stated in Article 7(1)(b) and (c) EUTMR.

Consequently, the examiner's decision is confirmed and the appeal is dismissed.

24/09/2020, R 589/2020-5, Triangular Shaped Notches In Three Double Chains (3D)

Shape mark - Well-known facts need no evidence - Article 7(1)(b) EUTMR - Non-distinctive - Technical result - Article 7(1)(e)(ii) EUTMR - Decision partially annulled - Application partially allowed



The applicant sought to register the 3D shape mark above for connectors in Classes 6, 7, 8, 9, 17 and 20. The examiner refused the application on the grounds of Article 7(1)(b) and 7(1)(e)(ii) EUTMR. The

contested decision stated that the mark did not differ substantially from various shapes commonly used in trade and was therefore not distinctive. In addition, the triangular notches upon the surface of the goods performed a technical function of providing an improved grip.

The applicant filed an appeal arguing that the mark did not consist exclusively of a shape with a technical function and stated that such patterns upon connectors were generally recognised by relevant consumers as trade marks. It was argued that a mere company logo would not be legible on such a small connector and that a patterned sleeve was therefore a convenient way to identify the manufacturer. The applicant pointed to the previous acceptance for registration by the Office of various 3D marks including other shapes of connectors. Furthermore, the applicant asserted that the shape did not improve grip, and that grip was not an essential function for these types of goods. In this regard the applicant relied upon the evidence of experts in the field of industrial design, who attested to the mark's uniqueness and stated that the mark provided no significant increase in friction or grip, possibly even having the opposite effect.

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The Board notes the experts' statements on the functionality question and concludes that the grip is not in fact an essential function of a connector. Consequently, the Board therefore annuls the objections raised to the extent they were based on Article 7(1)(e)(ii) EUTMR. Nevertheless, having given careful consideration to the variety of patterns used on the goods on the market, the Board maintains that the sign applied for does not depart significantly from the norms and customs of the particular market sector and that relevant consumers in this sector would not be capable of perceiving it as an origin-indicating sign for the goods at hand.

Consequently, the examiner did not commit an error when he found the mark to be devoid of inherent distinctive character, within the meaning of Article 7(1)(b) EUTMR.

07/09/2020, R 1589/2019-2, Vichy Barcelona

07/09/2020, R 1588/2019-2, Vichy d'or

Geographical origin - Common element - Relevant territory - Article 7(1)(g) EUTMR - Article 59(1)(a) EUTMR - Deceptive element - Decision Annulled

The word mark 'VICHY BARCELONA' was registered for foodstuffs, drinks and beverages in Classes 5 and 32. The French Republic and the Compagnie de Vichy filed an application for a declaration of invalidity on the basis of Article 59(1)(a) EUTMR, in conjunction with Article 7(1)(g) EUTMR, arguing that the EUTM would lead consumers to believe that the contested goods came from the town of Vichy, located in central France, when in fact they did not. The town of Vichy was famous as a spa town containing thermal spring water that was naturally rich in minerals and trace elements, which had long been considered to have therapeutic effects. The Cancellation Division rejected the application for a declaration of invalidity in its entirety.

The Board notes that the term 'VICHY' would, in connection with water, be understood by relevant French consumers as indicating that the water in question originates from the town of Vichy, France, and that they would expect such 'VICHY' water to possess the same therapeutic qualities generally associated with water originating from the town of Vichy. Taking into account that French consumers would not associate Barcelona with the relevant products, the additional presence of 'BARCELONA' or 'D'OR' is not capable of altering this conclusion.

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The cancellation applicants successfully argued on the basis of the renown in France of the town of Vichy as a thermal resort as well as French dictionary definitions. Since there is a serious risk that relevant French consumers will believe that the goods bearing the marks 'VICHY BARCELONA' or 'VICHY D'OR' possess certain characteristics – namely, that they originate from Vichy, France and feature the therapeutic qualities generally associated with mineral water from Vichy – which they do not in fact possess, the Board considers that the contested EUTM must be declared invalid on the grounds of it being deceptive within the meaning of Article 7(1) (g) EUTMR.

The decisions also follow many of the principles set out in [R 1499/2016-G](#), [La Irlandesa](#) (under appeal T-306/20) and cites [T-86/19](#), [Bio Insect Shocker](#).

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