

# Alicante News

Up to date information on IP and EUIPO-related matters

**TM** | view  
*beta*

September  
2019

**Improved TMview version  
launched in beta**



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### Improved TMview version launched in beta

In November 2009, TMview took its first steps into the digital world.

A trade mark search database, carrying five million trade marks from five national IP offices, the Benelux office, EUIPO and WIPO, was launched in a beta version. Users were kindly invited to browse the tool, test it, and send in comments.

And from those modest beginnings, a truly global database grew.

By the summer of 2010, the (by now no longer beta) TMview had data from nine offices, growing to 14 less than a year later. By 2013 TMview had leaped beyond the EU for the first time, integrating trade mark data from Mexico and Norway.

Over the next few years, TMview powered ahead with integrations of intellectual property office registers from across the globe. Data from [ARIPO](#) put TMview into Africa. Its search parameters range from the Arctic Circle ([CIPO](#) and [USPTO](#)) to Tierra del Fuego ([INAPI](#)). It covers trade mark registrations in the Far East ([KIPO](#), [JPO](#) and the [ASEAN](#) member states) and the Middle East ([IPLO](#), [IPPD](#)), as well as in all EU Member States.



As the tool expanded through the subsequent years, searches grew, more offices joined and, in the first quarter of 2018, TMview reached the 50 million milestone. Today, it contains more than 53 million trade marks, making it the largest free trade mark search database in the world.

So nearly ten years after its first launch, and after intensive user testing and feedback, an improved beta version of TMview (<https://www.euipo.org/tmview/beta/>) has been made available alongside the original interface, as part of a planned improvement to the world's biggest free trade mark search engine.

The improvements are a core part of EUIPO's European Cooperation activity in the framework of its Strategic Plan 2020, and have been developed in collaboration with the national and regional intellectual property offices of the EU.

The **interface has been completely redesigned**, allowing for a greatly enhanced navigation and search experience. In addition, the tool has a significantly improved search results display and categorisation system which **allows results to be shown in order of relevance to the search terms**.

The search also has a wide set of search criteria which can be personalised and segmented for a quicker and more efficient search. Previous searches can also be accessed directly from the home page.

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A new feature in the beta version allows two or more trade marks to be selected and placed side by side for comparison purposes. Users can also easily export search results to PDF, Excel and Word formats.

For legal purposes, the original version of TMview is still considered to be the valid source of information when extracting documentation to present before EUIPO for earlier trade mark substantiation.

TMview was launched in 2010, and with its current total of 53 million trade marks from 67 participating offices, it has received nearly 48 million search requests from 166 different countries to date, with the most frequent searches coming from the UK, Germany and China. Available in 36 different languages, it also contains a visual search facility which can be used when searching for trade marks from 15 participating offices, and which is continually being extended.

The beta version will run alongside the original version throughout 2020 and will be available in English, French, German, Spanish and Italian. All users are invited to send their feedback by clicking on the option **'Your feedback'** at the bottom of the page. Contributions will be greatly welcomed by the development team as they will help to further improve TMview for the benefit of users.

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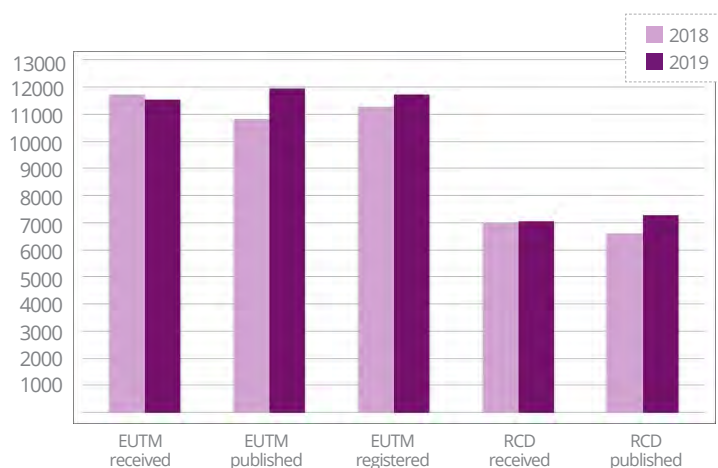


## Statistical Highlights



Monthly statistical highlights August*	2018	2019
European Union Trade Mark applications received	11 703	11 526
European Union Trade Mark applications published	10 805	11 937
European Union Trade Marks registered (certificates issued)	11 267	11 723
Registered Community Designs received	6 983	7 065
Registered Community Designs published	6 611	7 253

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



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## Thailand joins TMview

As of 27 September 2019, The Department of Intellectual Property under the Ministry of Commerce in Thailand (DIP) has made its trade mark data available to the TMview search tool.

With DIP on board, the tool now contains data from 69 participating offices.

With the addition of more than 960,000 trade marks from DIP, TMview provides information and access to more than 54.7 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 60.4 million searches from 169 different countries, with Spain, China and Germany among the most frequent users.

European Cooperation: faster, more efficient back office for Greece

The Hellenic Industrial Property Organisation (OBI), with the support of the EUIPO's European Cooperation projects, has implemented an enhanced back office system.

This release contains in particular a technological upgrade that is designed to increase the performance, security and maintenance of the back office system.

The back office tool helps OBI to manage multiple tasks related to the designs lifecycle, including examination and registration.

The implementation was carried out within the framework of the European Cooperation projects, in particular the project 'ECP2 Major improvements to back office'.

The project supports IP offices in their bid to make the main business processes for designs and trade marks more efficient, reliable and user-friendly.

In total, the EUIPO and its stakeholders are collaborating on five major European Cooperation projects. The main aim of the projects is to benefit users across the EU by providing modern, state-of-the-art tools and services for European IP offices.

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### Improved machine translation in eSearch Case Law

The European Commission, the [Translation Centre for the Bodies of the EU](#) and the EUIPO have been working closely together to improve the translations available on eSearch Case Law.

As a result, automatic translations are now better quality, available in more language combinations and available for more types of decisions. :

The translation engines have been specifically focused on IP case-law texts, meaning that more language combinations now meet the minimum quality requirements to be published.

The initial release of the machine translation improvements covered the EUIPO's Boards of Appeal decisions. The service now covers General Court and Court of Justice judgments as well as EUIPO opposition decisions, with more decision types due to follow.

Since the rollout of the improved machine translation, around 12 000 decisions have been translated, of which 9 000 are EUIPO Boards of Appeal decisions, 2 000 are EUIPO opposition decisions and 1 000 are judgements of the General Court and Court of Justice.



Currently more than 20 000 translations produced by the new machine translation engines have been published, as some decisions are translated into several languages.

All the machine translations can be found in [eSearch Case Law](#).

While searching for case-law to support a case before the court, these translations can be useful in gaining an immediate general understanding of the content of a particular judgment, before obtaining certified translations. Thus, they can save users time and money.

### Intellectual property rights strongly benefit the European economy, EPO-EUIPO study finds

Industries that make intensive use of intellectual property rights (IPRs) such as patents, trademarks, industrial designs and copyright generate 45% of GDP (EUR 6.6 trillion) in the EU annually and account for 63 million jobs (29% of all jobs).

A further 21 million people are employed in sectors that supply these industries with goods and services.

These are among the findings of a [joint report](#) released today by the European Patent Office (EPO) and the European Union Intellectual Property

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Office (EUIPO) which analyses the importance of IPRs for the EU economy between 2014 and 2016.

In the period under review, employment in IPR-intensive industries grew by 1.3 million jobs compared with 2011-13, while total employment in the EU declined slightly.

The value added per employee in these industries is higher than in the rest of the economy. Accordingly, IPR-intensive industries pay significantly higher wages: on average 47% more than other sectors, with the figure rising to 72% for patent-intensive industries.

The report is the third in a series that tracks the contribution of industries making an above-average use of trade marks, designs, patents, copyright, geographical indications and plant variety rights to economic growth and employment in the EU.

## New EUIPO report on the EU enforcement of intellectual property rights

One fake item was detained per adult EU citizen between 2013 and 2017 according to the new Report on the EU enforcement of intellectual property rights: results at the EU borders and in Member States 2013-2017 published today by the EUIPO.

The new report aims to shed light on enforcement trends within the EU. It is the first joint analysis of two different sources of data, namely, the detentions at EU borders and within national markets reported in the IP Enforcement Portal by the EU Commission (DG TAXUD) and by the national enforcement authorities, respectively.

This report is a first attempt at providing evidence-based analysis of prior detentions of fake products, in order to help EU enforcers combat counterfeiting and piracy. The report provides insight into the volume, categories and estimated value of the fake items detained in the EU, the connection between Member States and detentions and the nature of the infringed IPR, among other insights.

All Observatory publications, including this report, can be found on the report section of the EUIPO [website](#).

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### Luxembourg trade mark and design news

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

**C 124/18 P; Blue and Silver; Red Bull v EUIPO; Judgment of 29 July 2019; EU:C:2019:641; Language of the case: EN**

**RESULT:** Appeal dismissed

**KEYWORDS:** Colour mark, Equal treatment, Graphical representation, Legitimate expectations, Principle of legality, Principle of proportionality

**FACTS:** The applicant sought to register two colour marks as two EUTMs, both for 'Energy drinks' in Class 32. Each colour marks' representation is a combination of two colours accompanied by two different descriptions [blue (RAL 5002) and silver (RAL 9006)] juxtaposed in a ratio of 'approximately 50 %-50 %' in one case, and on the other, it reads that 'the two colours will be applied in equal proportions and juxtaposed to each other'.

An application for invalidity was filed pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1) (a) CTMR. The Cancellation Division (CD) declared the two marks invalid, inter alia on the ground that they were not sufficiently precise. They allowed



numerous different combinations that would not permit the consumer to perceive and recall a particular combination, thereby enabling him to make further purchases with certainty.

The applicant appealed against the CD's decision and the Board of Appeal (BoA) dismissed the appeals. It found that the graphic representation of the marks, evaluated in conjunction with the accompanying description, did not satisfy the requirements of precision and durability laid down in the judgment of 24/06/2004, C 49/02, Blau/Gelb, EU:C:2004:384, according to which, marks consisting of a combination of colours must be systematically arranged in such a way that the colours concerned are associated in a predetermined and uniform way. The marks allowed for the arrangement of the two colours in numerous different combinations, producing a very different overall impression.

The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 4 CTMR and Article 7(1)(a) CTMR and breach of the principles of proportionality and of equal treatment; and (ii) breach of the principle of protection of legitimate expectations. The GC dismissed the action.

The applicant appealed to the Court of Justice of the European Union (CJ), putting forward five grounds of appeal. The CJ dismissed the appeal.

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### EUTM Registrations



**SUBSTANCE:** (i) INFRINGEMENT OF ARTICLE 4 CTMR AND ARTICLE 7(1)(a) CTMR. The CJ recalls that a sign may be registered as a mark only if the applicant for the mark provides a graphic representation in accordance with Article 4 CTMR, to the effect that the subject matter and scope of the protection sought are clearly and precisely determined. Where the application is accompanied by a verbal description, it must serve to clarify the subject matter and scope of the protection sought and it cannot be inconsistent with the graphic representation of the trade mark, nor can it give rise to doubts as to the subject matter and scope of that graphic representation (27/03/2019, Hartwall, C-578/17, EU:C:2019:261, § 39-40) (paras 36-38).

A graphic representation of two or more colours, designated in the abstract and without contours, must be systematically arranged in such a way that the colours concerned are associated in a predetermined and uniform way. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', does not exhibit the

qualities of precision and uniformity required by Article 4 CTMR. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to make further purchases with certainty, any more than they would allow the competent authorities and economic operators to know the scope of the protection (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33-35) (para. 38).

The GC did not err in law in concluding that the registration of a mark that allows for a plurality of reproductions that are neither determined in advance nor uniform is incompatible with Article 4 CTMR and with the judgment of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384 (para. 47).

Moreover, and contrary to what had been claimed by the applicant, requiring a mark consisting of a combination of colours to exhibit a systematic arrangement associating the colours in a predetermined and uniform way, cannot transform that type of mark into a figurative mark, since that requirement does not mean that the colours must be defined by contours (para. 48). Nor can the applicant rely on the result adopted in the Apple judgment (10/07/2014, C-421/13, Apple Store, EU:C:2014:2070) as that case relates to a graphic representation of 'a collection of lines, curves and shapes', not applicable to this case (para. 49).

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The argument that the GC erroneously held, that the graphic representation of a mark consisting of a combination of colours must systematically be accompanied by a description relating to the arrangement of each of the colours is rejected as ineffective since the marks were each accompanied by a description (paras 52-54).

As the marks were registered on the basis of distinctive character acquired through use, the Office and the GC were entitled — within the examination of Article 4 CTMR — to take into account the various manifestations of use, in particular the actual use of those marks (paras 55-58).

(ii) BREACH OF THE PRINCIPLES OF EQUAL TREATMENT AND PROPORTIONALITY IN CONNECTION WITH ARTICLE 4 CTMR AND ARTICLE 7(1)(a) CTMR. To ensure the colours' availability in the course of the trade, the requirement to exhibit a systematic arrangement associating the colours in a predetermined and uniform way is necessary to meet the condition of clarity and precision of a trade mark (paras 65-66).

(iii) BREACH OF THE PRINCIPLE OF LEGITIMATE EXPECTATIONS. There is no breach of the principle of legitimate expectations by the Office or, consequently, no error of law on the part of the GC (paras 79-90).

(iv) BREACH OF THE PRINCIPLE OF PROPORTIONALITY. The fourth ground of the appeal being a new plea in law is rejected as inadmissible (paras 91-96).

(v) INFRINGEMENT OF ARTICLE 134(1) RPCG AND ARTICLE 135 RPCG. 'No appeal shall lie regarding only the amount of the costs or the party ordered to pay them' (Article 58(2) Statute). All the other grounds of appeal being rejected, the form of order sought concerning the alleged unlawfulness of the GC's decision on costs is rejected as inadmissible (Order of 15/10/2012, Internationaler Hilfsfonds v Commission, C-554/11 P, EU:C:2012:629, § 38-39).

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

**T-43/18; Fahrzeuge; Rietze v EUIPO; Judgment of 6 June 2019; EU:T:2019:376; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Informed user, Overall impression

**FACTS:** The RCD proprietor registered the design for vehicles (Locarno Classification 12-08).

An invalidity application was filed pursuant to Article 25(1)(b) CDR in conjunction with Article 6 and Article 5 CDR on the ground that earlier models of the same vehicle had been disclosed. The Invalidity

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Division (ID) upheld the invalidity application finding that the contested design lacked individual character.

The RCD proprietor appealed. The Board of Appeal (BoA) upheld the appeal finding that the contested RCD was new and had individual character.

The invalidity applicant filed an action before the General Court (GC), relying on one plea in law: infringement of Article 25(1)(b) CDR in conjunction with Article 4(1) and Article 6 CDR. The GC dismissed the action.

**SUBSTANCE:** informed user. The BoA was correct in describing the informed user as a person who: knows the existing designs in the automobile industry; has a certain degree of knowledge regarding the features of these vehicles; based on their interest in these products, has a high degree of attention when using them; is aware that manufacturers regularly submit their models to technical and visual restyling (para. 28). The informed user can perceive differences related to air intakes, shock absorbers, headlights, mud flaps, indicators and 'contour lines', even though they relate to technical elements, as these differences relate to the appearance and not to the technical details of these elements (para. 30).



### RCD



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### RCD



the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (para. 43). Even though air intakes, shock absorbers and headlights may have a mainly technical function, these features are not purely functional and their appearance can be modified; therefore, the difference in shape and position of these elements could have a bearing on the overall impression of the product (para. 44).

**FREEDOM OF THE DESIGNER.** The BoA considers that the freedom of the designer of motor vehicles is limited to the extent that a motor vehicle's purpose is to transport people or products and is legally obliged to include certain elements, such as headlights, stop lights, indicators and mirrors (para. 46). Potential market expectations or certain design trends do not constitute relevant limitations to the freedom of the designer (para. 50). The RCD proprietor does not explain what the BoA's error was in assessing the designer's degree of freedom (para. 51).

**OVERALL IMPRESSION.** The BoA identified the differences and analysed the overall impression produced by the conflicting designs from the front, side and back views before concluding that they produced a different overall impression (para. 39). If differences are sufficiently clear to conclude that

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**T-583/17; IOS FINANCE (fig.) / EOS (fig.); EOS Deutscher Inkasso-Dienst v EUIPO; Judgment of 12 June 2019; EU:T:2019:403; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Likelihood of confusion, Weak element

**FACTS:** The applicant sought to register the figurative mark IOS Finance below as an EUTM for, inter alia, financial affairs; monetary affairs; real estate affairs; all the aforesaid relating to the management and transfer of credit claims (bills) in Class 36.

An opposition based on the earlier German figurative mark below, registered for services in Class 36, was filed pursuant to Article 8(1)(b) CTMR in respect of services referred to above. The Opposition Division (OD) dismissed the opposition for all contested services.

The opponent filed an appeal against the rejection of the opposition in respect of financial affairs and monetary affairs. The Board of Appeal (BoA) dismissed the appeal. It found that the relevant public had a high level of attention and the services were identical. The signs were visually similar to a low degree and phonetically similar to at least an average degree. The visual aspect was predominant in respect of the services at issue and the signs



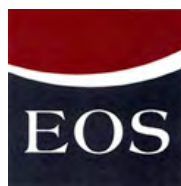
created very different impressions overall.

The opponent filed an action before the General Court (GC), relying on one plea in law: (i) infringement of Article 8(1)(b) CTMR. The GC dismissed the action.

### EUTM application



### Earlier trade mark



**SUBSTANCE:** RELEVANT PUBLIC AND COMPARISON OF SERVICES. It was undisputed that the public's level of attention was high and the services were identical (paras 20, 22).

COMPARISON OF SIGNS. The distinctive and dominant elements of the signs at issue. It is only if all the other components of those signs are negligible that the assessment of their similarity can be carried out solely on the basis of their dominant elements (para. 32). The word element 'finance' is not capable

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of being disregarded by the relevant public in the overall impression created by the mark applied for (para. 37). Moreover, the figurative elements of the signs contribute, in view of their colours, size and position, visually to the overall impression made by those signs, although they are less distinctive than 'eos' and 'ios' (para. 47). Where some elements of a trade mark are descriptive of the goods and services for which that mark is protected or of the contested goods and services, those elements are recognised as having only a weak, or even very weak, distinctive character. Therefore, the word 'finance' in the mark applied for is not devoid of any distinctive character (para. 48).

Visual, phonetic and conceptual similarity. The difference between the first letters of the dominant and most distinctive elements of the signs at issue was a significant distinguishing factor in particular because the word elements 'eos' and 'ios' are short and, in short signs, differences are more clearly perceived (paras 55, 57). The other elements of the signs, which cannot be regarded as negligible, reinforce the differences between the elements 'eos' and 'ios' (para. 65). The signs are visually different (para. 68). The relevant public will tend to pronounce the word elements in accordance with the rules of the German language. The signs are phonetically similar to at least an average degree (paras 82, 84). Only one of the signs conveys a concept ('finance'), therefore those signs are not conceptually similar (para. 88).

LIKELIHOOD OF CONFUSION. The clear visual differences will not escape the notice of the relevant public with a high the level of attention, particularly because, in view of the services in question, the visual differences will be more important than the phonetic similarities (para. 108).

**T-346/18; VOGUE / VOGA; Advance Magazine Publishers v EUIPO; Judgment of 12 June 2019; EU:T:2019:406; Language of the case: EN**

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

**KEYWORDS:** Suspension of the proceedings

**FACTS:** The applicant sought to register the word mark VOGUE as an EUTM for goods in Classes 32, 33 and 43. An opposition based on the EU word mark VOGA, registered in respect of, inter alia, goods in Class 33 was filed pursuant to Article 8(1)(b) CTMR.

The Opposition Division (OD) upheld the opposition for all the contested goods except for hotel services, nursery and crèche services, rental of equipment for preparing and dispensing drink in Class 43.

The applicant filed an appeal before the Board of Appeal (BoA). During the proceedings before the BoA, the applicant filed a request for the suspension of the opposition proceedings on the ground that it had applied for a declaration of invalidity of the

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earlier mark. The applicant argued that the opponent acted in bad faith when it filed the application of the earlier mark. The BoA rejected the request for suspension and upheld the OD's decision.

The applicant filed an action before the General Court (GC) based on a single plea in law, infringement of Rule 20(7)(c) CTMIR. The GC annulled the contested decision.

**SUBSTANCE:** The BoA has a broad discretion as to whether or not to suspend ongoing proceedings. However, the decision must follow upon a weighing of competing interests (paras 20-21).

The rejection of the request for suspension was incorrectly based, on one hand, on the fact that the applicant had not indicated the chances of success of the invalidity proceedings and, on the other, on the fact that the applicant had failed to justify why it was not able to initiate those proceedings before the OD's decision was adopted (paras 24, 26, 30).

Although the party requesting the suspension must provide the BoA with evidence enabling it to carry out a preliminary analysis of the prospects of success of the application for a declaration of invalidity, the BoA cannot claim that the same party, which has an interest in the outcome of the annulment proceedings, is able to provide a reliable

assessment of its prospects of success (para. 25).

The opportunity available to all to apply for a declaration of the invalidity of a mark is completely independent of any parallel opposition proceedings in which the earlier mark to which the application for a declaration for invalidity relates is involved (para. 28).

The BoA can refuse to grant a suspension solely on the basis that invalidity proceedings against the earlier mark had been brought while the opposition proceedings were still pending, if there are relevant and consistent indications that this is a delaying tactic (para. 29).

Even assuming that the BoA's rejection of the request for suspension was based, in part, on an assessment that that request was made as a delaying tactic, such an assessment cannot be based only on the fact that the applicant failed to justify why it was not able to bring the invalidity proceedings beforehand (para. 30).

The BoA failed to strike a balance between the parties' interests and committed a manifest error of assessment (para. 31).

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**T-569/18; Kordes' Rose Monique; W. Kordes' Söhne Rosenschulen v EUIPO; Judgment of 18 June 2019; EU:T:2019:421; Language of the case: DE**

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

**KEYWORDS:** Plant variety

**FACTS:** The applicant sought to register the word mark Kordes' Rose Monique as an EUTM for goods in Class 31: roses and rose plants, and rose-propagating stock.

The Office refused to register the EUTM application pursuant to Article 7(1)(m) EUTMR on the basis of the earlier plant variety denomination 'Monique' protected in the Netherlands in relation to roses.

The Board of Appeal (BoA) dismissed the appeal filed by the applicant, finding that Article 7(1)(m) EUTMR does not require the variety denomination to be the only essential element or the 'dominant element' of the trade mark. It found that all three elements carry the same weight from a visual and phonetic perspective. Conceptually, the word sequence would convey a clear content, at least in English or German, that is, a rose, which bears the name 'Monique' and is sold by Kordes. The BoA concluded that the word element 'Monique' is an essential element within the meaning of Article 7(1)(m) EUTMR.

The opponent filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 7(1)(m) EUTMR and (ii) infringement of Article 95 EUTMR. The GC upheld the action.

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 7(1)(m) EUTMR. Article 7(1)(m) EUTMR pursues a general interest in preserving the availability of a plant variety denomination to all traders offering these goods (para. 26). This objective is in line with Article 20(1)(b) UPOV Convention (para. 27). According to Article 20(1)(a) UPOV Convention, the plant variety denomination becomes, by definition, the generic designation of that variety. This generic designation may not be monopolised and must remain available for other undertakings to use to describe their goods (para. 28). Article 7(1)(m) EUTMR must be interpreted in light of this objective, which is to determine whether the registration of the trade mark applied for will hinder the free use of the variety denomination included in the trade mark (paras 29-30).

For this purpose, it must be established whether the variety denomination holds an essential position within the complex trade mark applied for. If so, the free use of the variety denomination would be hindered. In contrast, if its original essential function is not based on the variety denomination, but on other components of the trade mark, the

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requirement of availability for variety denominations is maintained (para. 31).

In order to determine whether the essential function of the mark applied for is based on the variety denomination or on other elements, the criteria to be assessed are, in particular, the distinctive character of the other elements, the message conveyed as a whole by the mark applied for, the visual dominance of the various elements by reason of their size and position, or the number of elements of which the mark is composed. According to these criteria, the denomination of the plant variety cannot constitute an 'essential element' of the mark applied for if the essential function of that mark as an indication of origin is to be confined to the other elements of the mark — the variety denomination being used simply as a generic reference for information purposes only. In this case, the designation remains freely usable (para. 32).

The word element 'Kordes' is the only distinctive element of the contested sign given its position (at the beginning of the mark) and the fact that it is the name of the undertaking from which the flowers originate. This conclusion is also supported by the use of the genitive case, which expresses precisely the idea that the rose with the variety name Monique is a variety marketed by different companies and, in this case, comes from the company Kordes (para. 33). The word 'Kordes' is central to the message conveyed by the contested

mark, namely that the products are distributed by a company doing business under the company name 'Kordes' (para. 34). Consequently, the contested mark does not reproduce in its essential elements, an earlier plant variety denomination within the meaning of Article 7(1)(m) EUTMR (paras 36-37).

The GC annulled the contested decision without analysing the second plea.

**T-307/17; DEVICE OF THREE PARALLEL STRIPES; Adidas v EUIPO; Judgment of 19 June 2019; EU:T:2019:427; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctiveness acquired by use, Evidence of use, Figurative trade mark, Place of use, Promotional material, Sales figures, Survey

**FACTS:** The proprietor registered this figurative mark as an EUTM for goods clothing; footwear; headgear in Class 25. The mark was identified as a figurative mark in the application for registration and the following description was included: The mark consists of three parallel equidistant stripes of identical width, applied on the product in any direction.

An invalidity application was filed pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1)

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(b) CTMR. The Cancellation Division (CD) upheld the invalidity application.

The proprietor filed an appeal. It did not dispute the lack of inherent distinctive character of the mark at issue, but claimed that it had acquired distinctive character through use within the meaning of Article 7(3) and Article 52(2) CTMR. The Board of Appeal (BoA) dismissed the appeal. It found that the mark had been validly registered as a figurative trade mark and that the proprietor failed to establish that the mark had acquired distinctive character through use.

The proprietor filed an action before the General Court (GC), relying on one plea in law: (i) infringement of Article 52(2) CTMR, read in conjunction with Article 7(3) CTMR, and with the principles of the protection of legitimate expectations and proportionality. The GC dismissed the action.

EUTM



**SUBSTANCE:** The proprietor claimed that the mark

represents a 'surface pattern' whose proportions are not fixed (paras 24, 42). It is not apparent either from the graphic representation or the description that it is composed of a series of regularly repetitive elements (para. 43). It is an ordinary figurative mark (para. 46).

The concept of use of a trade mark, within the meaning of Article 7(3) and Article 52(2) CTMR must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration and, where relevant, registered, but also to the use of the trade mark in forms differing from that form solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form (para. 62). BoA correctly described the mark at issue as 'extremely simple' and minor alterations to simple marks may constitute significant changes (paras 70, 72). The act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, is a significant variation as compared to the registered form of the mark at issue (para. 77). Numerous pieces of evidence were correctly dismissed on the grounds of showing forms of use not broadly equivalent to the registered form (sloping lines, reversed colour scheme) (paras 78, 97, 103).

Although the proprietor submitted extensive evidence of use, only market surveys concerning 5 Member States are actually relevant to some

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extent for establishing that the mark has acquired distinctive character through use (paras 117, 151, 152). The proprietor did not demonstrate that the markets of the remaining 23 Member States are comparable to domestic markets of those 5 Member States where the surveys were carried out. The results of the surveys cannot, consequently, be extrapolated to all Member States (paras 156-157).

**T-268/18; Luciano Sandrone/ DON LUCIANO; Luciano Sandrone v EUIPO; Judgment of 27 June 2019; EU:T:2019:452; Language of the case: EN**

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

**KEYWORDS:** Conceptual similarity, Distinctive element, Identity of the goods and services, Likelihood of confusion, Personal name mark, Phonetic similarity, Proof of use, Similarity of the goods and services, Similarity of the signs, Visual similarity

**FACTS:** The applicant sought to register the word mark Luciano Sandrone as an EUTM for inter alia, alcoholic beverages (except beer); preparations for making alcoholic beverages in Class 33.

An opposition based on the earlier EU word mark DON LUCIANO registered for alcoholic beverages (except beer) in Class 33 was filed based on Article 8(1)(b) EUTMR. The applicant asked the

opponent to produce evidence of genuine use of the earlier mark. The Opposition Division (OD) rejected the opposition, ruling out any likelihood of confusion (LOC).

The opponent filed an appeal. The Board of Appeal (BoA) annulled the OD's decision and upheld the opposition.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 42(2) and Article 42(3) EUTMR; and (ii) infringement of Article 8(1)(b). The GC annulled the BoA's decision.

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 42(2) EUTMR AND ARTICLE 42(3) EUTMR.

Place of use. The submitted invoices are related to a large part of the EU, namely 11 Member States (not disputed).

Duration of use. Consistency of use is established by the repetition of acts that contribute to it, the earlier mark being required to have been used, at the very least, (25/04/2018, T-312/16, CHATKA / CHATKA (fig.), EU:T:2018:221, § 113) for part of the period and not during the 5-year period without interruption. Therefore, more than 4 years represents almost all of the relevant time and enables the whole relevant period to be covered (paras 28-29).

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The inclusion of the earlier mark in a supermarket's catalogue during a wine festival, at the beginning of the relevant period, is an indication of the use of that mark during the relevant period. Although a catalogue is not evidence of sales, it is, however, proof that the goods in question have been placed on the market and that those goods have actually been offered for sale to consumers (para. 31).

Extent of use. The invoices submitted with a non-consecutive numbering can be regarded just as a sample of sales, and not as the amount of actual sales of goods bearing that mark (para. 38). Though the opponent's prices are very low, the total amounts are themselves non-negligible proving ample evidence of the extent of use (paras 36-39).

Nature of use. Any word mark must be capable of being represented in one way or another, in particular, as far as concerns wine, on labels. Since word marks are thus considered to be used as registered insofar as the graphic additions do not alter the general impression that they produce, the earlier mark has been used as it was registered (para. 42).

The BoA was entitled to find that the opponent had established genuine use of the earlier mark.

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

Relevant public. The relevant public consists of

consumers in the EU with an average level of attention as the registration of the mark was thought for wines in general, and not specifically for quality wines sold at relatively high prices (para. 51).

Comparison of goods. The price range is not a relevant criterion for the comparison of goods (para. 54). The designation of origin of a product could constitute a relevant consideration when purchased insofar as it was, for the consumer, an indication of its geographical origin and of the specific qualities inherent in it (30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 35). Nevertheless, the applicant did not restrict the goods to certain designations of origin or to certain grape varieties (paras 56-57). The BoA has rightly found that the goods for which protection was sought, namely alcoholic beverages (except beer), and the wines covered by the earlier mark, both in Class 33 were identical and that preparations for making alcoholic beverages and wines were of an average degree of similarity (para. 59).

Comparison of the signs. Distinctive and dominant elements of the signs. The BoA should have, before carrying out the visual, phonetic and conceptual comparison of the signs at issue, found the presence of a more distinctive element of each of the signs at issue, namely the element 'Luciano' in the earlier mark, which it was correct in finding, and the element 'Sandrone' in the mark applied for which it did not find with regard to part of the relevant public (para. 76).

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For the general public of the EU as a whole, the most distinctive sign of the mark applied for is the element 'Sandrone', a surname that is not perceived as common, but which does not render the element 'Luciano' negligible (para. 75).

The BoA's statement that the first name 'Luciano' would be perceived as a rare first name in Germany and Finland is not based on any specific evidence. The fact alone that it is not very common among the populations of these countries, does not mean it will be perceived as a rare first name in those Member States (paras 72-74).

Visual similarity. The BoA correctly found that since the signs at issue have the element 'Luciano' in common there is at least a low degree of visual similarity (para. 78).

Phonetic similarity. Since the common element 'Luciano' could be pronounced at the point of purchasing the goods at issue, this justifies the finding that they are phonetically similar at least to a low degree (para. 80).

Conceptual similarity. A conceptual comparison between two signs consisting solely of first names and surnames is possible where the first name and a surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear

and immediately recognisable semantic content (para. 86).

The GC overturned the BoA's finding of conceptual similarity to an average degree. It concluded that the conceptual comparison was not possible, since the first names and surname contained in the signs at issue do not convey any concept (para. 90).

Global assessment of the likelihood of confusion. The BoA wrongly found that there was LOC. Besides erring with regard to the similarity of the signs (i.e. the distinctive element of the mark applied for and the conceptual comparison), the BoA did not take into account the specific qualities of the goods.

In the wine-growing world, names carry great weight, whether names or surnames of vineyards, since they are used to reference and designate wines. In general, consumers usually describe and recognise wines by reference to the word element that identifies them and that this element designates, in particular, the grower or the estate on which a wine is produced (11/07/2018, T-707/16, ANTONIO RUBINI / RUTINI (fig.) et al., EU:T:2018:424, § 49). Thus, it is the distinctive element 'Sandrone' that will serve to identify the applicant's wines, or the name as a whole, that is to say, 'Luciano Sandrone', but not the element 'Luciano' alone (paras 98-99).

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The BoA also did not take into account the prevalence of real or assumed Spanish or Italian first names or surnames in the wine market, and the fact that consumers are used to trade marks that contain such names, so they will not assume that every time such a first name or surname occurs in a trade mark in conjunction with other elements the goods in question all emanate from the same source (para. 100) referring to 03/06/2015, T-559/13, GIOVANNI GALLI (fig.) / GIOVANNI, EU:T:2015:353, § 116).

The BoA also failed to take into consideration the low degree of distinctiveness of the common element 'Luciano' (para. 102).

It cannot always be held that there is a likelihood of confusion where an earlier mark consisting of a surname is included in another mark by adding a first name to it. That consideration is equally valid when the earlier trade mark consists, in particular, of a first name and the sign for which registration is sought consists of a combination of that first name and a surname (para. 103), referring to 03/06/2015, T-559/13, GIOVANNI GALLI (fig.) / GIOVANNI, EU:T:2015:353, § 125).



**T-334/18; ANA DE ALTUN (fig.) / ANNA (fig.) et al.; Bodegas Altún v EUIPO; Judgment of 27 June 2019; EU:T:2019:451; Language of the case: ES**

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

**KEYWORDS:** Common element, Complex mark, Conceptual dissimilarity, Figurative trade mark, Lack of reasoning, Phonetic similarity, Unfair advantage, Visual similarity

**FACTS:** The applicant sought to register the figurative sign as an EUTM for white wine from Rioja in Class 33.

An opposition based on several earlier rights — (i) Spanish figurative trade mark ANNA registered for alcoholic drinks (except beers) in Class 33, (ii) Spanish word mark ANNA DE CODORNIU registered for sparkling wine and, in general, spirits and liqueurs in Class 33, and (iii) EU word mark ANNA DE CODORNIU registered for alcoholic drinks (except beers) in Class 33 — was filed pursuant to Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The Opposition Division (OD) found there was likelihood of confusion (LOC) between the contested mark and the earlier Spanish figurative trade mark ANNA and entirely upheld the opposition based on Article 8(1)(b) EUTMR.

The applicant filed an appeal. The Board of Appeal (BoA) upheld the appeal. It found no LOC and

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dismissed also the ground based on Article 8(5) EUTMR considering that there was no identity or similarity between the contested mark and the earlier marks and that there was no link between them.

The opponent filed an action before the General Court (GC). The GC annulled the BoA's decision on the ground that there was a low degree of similarity between the conflicting signs and the BoA erred in ruling out the LOC based on the lack of any similarity between the signs. It considered that the BoA also erred in finding that one of the requirements of Article 8(5) EUTMR was missing, respectively the similarity between the signs. Finally, it stated that the reasoning regarding the lack of LOC between the contested sign and the two earlier word marks was insufficient (18/09/2017, T-86/16, ANA DE ALTUN (fig.) / ANNA (fig.) et al., EU:T:2017:627).

The case was referred back to the BoA where it was reallocated. The BoA dismissed the appeal after assessing the opposition on the sole basis of the Spanish figurative mark. It considered that all cumulative conditions under Article 8(5) EUTMR were met.

The opponent filed a new action before the GC against the second decision of the BoA, relying on a single plea in law: the infringement of Article 8(5) EUTMR. The GC annulled the BoA's decision.



### EUTM application



### Earlier trade mark



**SUBSTANCE:** Similarity of the signs. This requirement is met, as the GC held in the first judgment T-86/16 that globally there is a certain degree of similarity between the conflicting signs, even though it should be considered as being low (paras 28-29).

**Reputation.** The submitted documents essentially show the words ANNA DE CODORNIU, sometimes accompanied by the bust of a woman. The GC considered that the submitted evidence proved reputation of the earlier word mark ANNA DE CODORNIU, but it did not prove that the earlier figurative mark ANNA is reputed on its own, that is,

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independently from the expression 'DE CODORNIU' (paras 39, 40, 58).

The acquisition of reputation of a mark may also be as a result of its use under a different form, in particular under the form of another registered mark, provided that the relevant public continues to perceive the goods at issue as originating from the same undertaking (para. 45). The BoA concluded that the earlier figurative mark ANNA enjoyed a reputation based essentially on the evidence submitted in relation to another mark (i.e. ANNA DE CODORNIU) without assessing the hypothesis of the use under a different form, that is, without ascertaining that the presence of 'DE CODORNIU' in the mark used in trade does not prevent the relevant public from continuing to perceive the goods at issue as originating from a particular undertaking (paras 46-49).

Lack of reasoning. The BoA did not give reasons why it considered that the reputation of the earlier figurative mark ANNA was proved, while in the previous decisions of the Office involving this mark and based on the same documents this reputation was not found (paras 54, 55, 58).

The argument concerning the independent role of 'ANNA' and 'DE CODORNIU' in the sign is not sufficient to overcome the GC's finding (paras 43, 57, 58).



**T-276/17; Tropical (fig.) / TROPICAL; Tadeusz Ogrodnik v EUIPO; Judgment of 12 July 2019; EU:T:2019:525; Language of the case: EN**

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

**KEYWORDS:** Coexistence of trade marks, Identity of the goods and services, Likelihood of confusion, Nature of the goods and services, Proof of use, Similarity of the goods and services, Similarity of the signs

**FACTS:** The EUTM proprietor registered the figurative mark as an EUTM for goods in Classes 5 and 31.

An invalidity application was filed pursuant to Article 53(1)(a) CTMR in conjunction with Article 8(1) (b) CTMR, based on the earlier national word mark TROPICAL. The EUTM proprietor asked the invalidity applicant to produce evidence of genuine use of the earlier mark. The Cancellation Division (CD) dismissed the invalidity application, finding that the genuine use of the earlier mark was not proved.

The invalidity applicant appealed. The Board of Appeal (BoA) upheld the appeal, finding that the genuine use of the earlier mark was proved at least for food for fish in Class 31, and that it was unnecessary to examine it in respect of the other goods it covered. It also found that there was likelihood of confusion (LOC).

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The EUTM proprietor filed an action before the General Court (GC). The GC annulled the BoA's decision because, firstly, part of the contested goods in Class 31 were not identical and all the contested goods in Class 5 were not similar to an average degree to the EUTM proprietor's goods for which use was shown and, secondly, because the BoA had failed to examine the argument of the coexistence between the marks when assessing LOC (21/07/2016, T-804/14, Tropical, EU:T:2016:431).

The case was referred back to the BoA where it was reallocated. The BoA annulled the CD's decision and declared the invalidity of the contested mark. It held that the contested goods in Classes 5 and 31 were in part identical and in part similar to a low or to an average degree to food for fish covered by the earlier mark and confirmed LOC in respect of these goods. Moreover, it rejected the coexistence argument because the EUTM proprietor did not prove that the consumers of the goods covered by each of the marks did not confuse them.

The EUTM proprietor filed a new action before the GC against the second decision of the BoA, relying on a single plea in law: infringement of Article 53(1) (a) CTMR in conjunction with Article 8(1)(b) CTMR.



### EUTM applications



### Earlier mark

**TROPICAL**

**SUBSTANCE:** Comparison of the goods. Relevance of the criteria.

- *Products and preparations for the cultivation of plants and aquarium plants in Class 31, and veterinary, therapeutic, disinfecting and sanitary products and preparations for use in aquaristics [and] fauna breeding and disinfecting and sanitary products and preparations for flora cultivation in Class 5.*

The BoA did not err in finding that the goods have a low or average degree of similarity since they are complementary, may be manufactured and sold by the same undertakings and are aimed at the same consumers. Although the complementary nature of the goods at issue represents only one factor amongst several others in the light of which

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the similarity of the goods can be assessed, the fact remains that it is an autonomous criterion capable of being the sole basis for the existence of such a similarity (21/01/2016, C-50/15 P, Carrera / CARRERA, EU:C:2016:34, § 23) (paras 46-48).

Even though the goods differ in their nature and method of use, the BoA acted correctly in relying on several relevant factors determining the relationship between the goods and was able to find, without erring, that disinfecting and sanitary products and preparations for flora cultivation, including plants for aquariums, and food for fish were similar to a low degree (para. 53).

- *Products and preparations for the breeding of birds, reptiles and amphibians in Class 31 and veterinary, therapeutic, disinfecting and sanitary products and preparations for use in terraristics in Class 5.*

The BoA found that the contested goods have the same purpose as the earlier goods and target the same consumers, as it considered that they are used for taking care of small pets. By relying on the concept of 'small pets', the BoA applied these criteria too broadly and, therefore, they cannot play a role in the comparison (paras 56-60).

The BoA was wrong to find that products and preparations for the breeding of birds, reptiles and amphibians in Class 31 and veterinary, therapeutic,

disinfecting and sanitary products and preparations for use in terraristics in Class 5, on the one hand, and food for fish, on the other, are similar to an average degree. The mere fact that these goods fall within the same market segment and use the same distribution channels is insufficient for finding them similar (para. 61).

Comparison of the signs. The overall similarity of the marks has the force of *res judicata* being established through the judgment of 21/06/2016, T-804/14, Tropical, EU:T:2016:431.

The likelihood of confusion. Since the condition relating to similarity of the goods is not met as regards products and preparations for the breeding of birds, reptiles and amphibians in Class 31 and veterinary, therapeutic, disinfecting and sanitary products and preparations for use in terraristics in Class 5, on the one hand, and food for fish covered by the earlier mark, on the other, the BoA could not find that there was LOC between the signs in respect of these goods (para. 72).

The EUTM proprietor was obliged to prove (based on a body of evidence) that the peaceful coexistence of the marks he relied on was based on the absence of any LOC. The BoA correctly held that the fact that the marks coexisted without challenge over a long period is not sufficient proof that that coexistence was based on the absence of LOC (paras 80-83).

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The absence of any likelihood of confusion cannot be inferred from the mere fact that the applicant for a declaration of invalidity did not oppose the registration of the contested national mark or apply for a declaration that it was invalid, at an earlier stage, even where there has been significant use of the marks, 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 110, (para. 84).

**Conclusion** The BoA erred in finding that there is LOC as regards products and preparations for the breeding of birds, reptiles, amphibians in Class 31 and veterinary, therapeutic, disinfecting and sanitary products and preparations for use in terraristics in Class 5. The BoA's decision must therefore be annulled insofar as it upholds the application for a declaration of invalidity in respect of these goods (para. 87).

The power of the GC to alter decisions pursuant to Article 65(3) CTMR may be exercised in situations in which the Court, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of the law, as established, what decision the BoA was required to take (05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452, § 72). Thus, the Court decides, pursuant to Article 65(3) of Regulation No 207/2009, that the contested decision should be altered insofar as the application for alteration is admissible (except the findings upheld already by the Court in

relation to the proof of use of the earlier mark) and that the appeal brought by the invalidity applicant against the CD's decision must also be dismissed insofar as it seeks to have the contested mark annulled in respect of these goods (para. 88).

**T-698/17; MANDO / MAN; MAN Truck & Bus v EUIPO; Judgment of 12 July 2019; EU:T:2019:524; Language of the case: EN**

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

**KEYWORDS:** Common element, Conceptual dissimilarity, Conceptual similarity, Lack of reasoning, Likelihood of confusion, Phonetical similarity, Visual similarity

**FACTS:** The applicant sought to register the word mark MANDO for goods and services in Classes 7, 9, 11, 12, 35, 37 and 39 such as coaches, trucks, repair services. An opposition based on earlier international registrations and earlier national marks, registered for services in Classes 7, 9, 11, 12 and 37, was filed pursuant to Article 8(1)(b) CTMR and Article 8(5) CTMR.

The Opposition Division (OD) dismissed the opposition.

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The Board of Appeal (BoA) annulled the OD's decision for not taking reputation into account (Article 8(5) CTMR) and dismissed the appeal with regards to Article 8(1)(b) for no likelihood of confusion (LOC). It found that the marks had a low degree of visual similarity and average phonetic similarity, while not being comparable conceptually in the eyes of the professional, specialised public. This is because the term 'man' is short and the addition of 'do' gives a different impression, even if the contested mark contains the earlier mark, the public will not break down the term 'mando'.

The applicant filed an action before the General Court (GC), challenging the part of the BoA decision related to Article 8(1)(b) CTMR and relying on a single plea in law: (i) infringement of Article 8(1)(b) CTMR. The GC partially upheld the action.

### EUTM applications

MANDO

### Earlier trade marks

 **MAN**

 **MAN**

Man

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

Relevant public. The relevant public for goods in Classes 7 and 12 is made up of specialists and professionals only, while the relevant public for the services in Class 37 also includes the vehicle-owning general public (paras 25, 30-37). The level of attention of the relevant public is higher than average for all of the goods and services in Classes 7, 12 and 37 because of the technical and costly nature of these goods (paras 38, 41-48).

Comparisons of goods and services. The decision is based on the possibility that the goods and services might be identical (not disputed) (paras 49-50).

Comparison of the signs. The earlier international registrations, MAN, and the mark applied for, MANDO, display some degree of visual similarity to the extent that they have the word element 'man' in common. The term 'mando' forms a unique term that the relevant public has no reason to break down into two parts, namely 'man' and 'do'. (paras 57-71). The fact that the earlier registrations MAN were able to enjoy a reputation in Germany and Austria and, as a result, have a highly distinctive character, does not invalidate the finding, since the reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the LOC, but not for the purposes of assessing the similarity between the marks

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(para. 65). As regards the phonetic comparison of the marks, the marks have an average degree of similarity owing to the pronunciation of the syllable 'man' of the mark applied for, since the term 'man' corresponds to the earlier registrations (para. 72). With regard to the conceptual similarity, the term 'mando' is a fanciful word that does not have any meaning for the relevant public in Bulgaria, the Czech Republic, Germany, France, Hungary or Austria. For the relevant public in these states who speak German or who have a basic knowledge of English and will understand the term 'man' as meaning 'male human being', the marks are conceptually different. For the other members of that public, who will not associate any meaning, either with the mark applied for or with the earlier international registrations, it is not possible to make a conceptual comparison of the marks (para. 75). The enhanced distinctive character resulting from the reputation of the earlier registrations does not help to confer on the element 'man' a dominant character or independent distinctiveness, as the relevant public has no reason to break the mark applied for down into two parts, namely 'man' and 'do', instead being likely to perceive it as a whole (para. 87). Thus, there is no risk of confusion between the mark applied for and the earlier international registrations No 542 763 and No 542 762.

Duty to state reasons. Compliance with the duty to state reasons is a matter of public policy that must be raised, if necessary, of the Court's own motion

(para. 93). The BoA did not carry out any specific analysis of one of the earlier marks, international registration No 863 418, covering services in Class 35. It simply pointed out that the same assessment and the same conclusion applied for the other marks; though the services in Class 35 advertising of any kind using all available media are very different in nature and have a different public (paras 98-99). Thus, the contested decision is inadequately reasoned as regards, at the very least, the definition of the relevant public and its level of attention and the global assessment of the likelihood of confusion as regards earlier registration No 863 418. (paras 92-105).

Concerning the earlier national marks, the BoA correctly found that there is no likelihood of confusion with the mark applied for (paras 106-124).

The GC annulled the decision for one of the earlier marks and dismissed the action for the remainder.

**T-772/17; Café del Mar (fig.); Café del Mar and others v EUIPO; Judgment of 12 July 2019; EU:T:2019:538; Language of the case: ES**

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

**KEYWORDS:** Bad faith

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**FACTS:** The proprietor applied for the registration of the figurative mark 'Café del Mar' as an EUTM for services in Classes 35, 38 and 41 on 16 February 2001. The EUTM was registered on 25 June 2002.

An invalidity application was filed pursuant to Article 52(1)(b) CTMR and Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR. The Cancellation Division (CD) upheld the invalidity application based on Article 52(1)(b) CTMR.

The proprietor filed an appeal. The Board of Appeal (BoA) upheld the appeal: it found that bad faith had not been proven at the time of filing the application for registration; the ground based on Article 8(4) CTMR was rejected as unfounded.

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

### EUTM



**SUBSTANCE:** (i) infringement of Article 52(1)(b) CTMR. The GC found that the invalidity applicants and the proprietor had used the prior sign 'Café del Mar' since 1980 when they opened the music bar 'Café del Mar' in Ibiza (Spain). The sign was also used to distinguish goods and services provided by various companies that the individual invalidity applicants and the proprietor had incorporated since 1987 (paras 38-42), including services similar to those for which the contested trade mark was registered (para. 47). All the companies incorporated by the individual invalidity applicants and the proprietor belonged to them equally. One of these companies, Can Ganguil, S.L., incorporated in 1997, granted a power of attorney to the proprietor to act on behalf of the company and to represent it (para. 39). Contrary to the BoA's conclusion, the power of attorney granted to act on behalf of the company and to represent it cannot be considered as an acknowledgement of the supremacy of the representative as regards the other partners as to rights in the sign 'Café del Mar'. In any case, even if the company's representative plays an outstanding role in the promotion and development of the sign, he is not entitled to use its power in his own name (para. 53). In his position as attorney of Can Ganguil and partner in the other companies using the earlier sign 'Café del Mar', the proprietor could not ignore the detriment caused by the registration in his exclusive name of the sign 'Café del Mar' (para. 51). Contrary to the BoA's conclusion, there is no evidence on file showing that the invalidity

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applicants knew that the proprietor had registered the contested trade mark in his name (para. 52).

Since the proprietor registered a trade mark generating confusion with the earlier sign 'Café del Mar' while he was the representative of one of the companies exploiting the sign and paid the registration costs with funds from the company, he departed from accepted principles of ethical behaviour or honest commercial and business practices and therefore acted in bad faith (para. 54). In this regard, it is irrelevant that the proprietor had paid the profits obtained from the exploitation of the trade mark exploitation into the accounts of Can Ganguil until 2009, since bad faith must be proven at the time of filing the application and the profits were paid later. In addition, the proprietor ceased to share the profits of the trade mark exploitation as from 2009 and this shows the detrimental nature of the registration of the sign in his own and exclusive name (para. 55).

**T-773/17; Café del Mar (fig.); Café del Mar and others v EUIPO; Judgment of 12 July 2019; EU:T:2019:536; Language of the case: ES**

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

**KEYWORDS:** Bad faith

**FACTS:** The proprietor applied for the registration of the figurative mark 'Café del Mar' as an EUTM for goods and services in Classes 9, 25 and 42 on 26 January 1999. The EUTM was registered on 16 December 2003.

An invalidity application was filed pursuant to Article 52(1)(b) CTMR and Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR. The Cancellation Division (CD) upheld the invalidity application based on Article 52(1)(b) CTMR.

The proprietor filed an appeal. The Board of Appeal (BoA) upheld the appeal: it found that bad faith had not been proven at the time of filing the application for registration; the ground based on Article 8(4) CTMR was rejected as unfounded.

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

**SUBSTANCE:** (i) infringement of Article 52(1)(b) CTMR. The GC found that the invalidity applicants and the proprietor had used the prior sign 'Café del Mar' since 1980 when they opened the music bar 'Café del Mar' in Ibiza (Spain). The sign was also used to distinguish goods and services provided by various companies that the individual invalidity

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### EUTM

*Café del Mar*

applicants and the proprietor had incorporated since 1987 (paras 39-43), including goods and services similar to those for which the contested trade mark was registered (para. 47). All the companies incorporated by the individual invalidity applicants and the proprietor belonged to them equally. One of these companies, Can Ganguil, S.L., incorporated in 1997, granted a power of attorney to the proprietor to act on behalf of the company and to represent it (para. 40). Contrary to the BoA's conclusion, the power of attorney granted to act on behalf of the company and to represent it cannot be considered as an acknowledgement of the supremacy of the representative regards the other partners as to rights in the sign 'Café del Mar'. In any case, even if the company's representative plays an outstanding role in the promotion and development of the sign, he is not entitled to use its power in his own name (para. 54). In his position as attorney of Can Ganguil and partner in the rest of companies using the earlier sign 'Café del Mar', the proprietor could not ignore the detriment caused by the registration in his exclusive name of the sign 'Café del Mar' (para. 52). Contrary to the BoA's conclusion,



there is no evidence on file showing that the invalidity applicants knew that the proprietor had registered the contested trade mark in his name (para. 53).

Since the proprietor registered a trade mark generating confusion with the earlier sign 'Café del Mar' while he was the representative of one of the companies exploiting the sign and paid the registration costs with funds from the company, he departed from accepted principles of ethical behaviour or honest commercial and business practices and therefore acted in bad faith (para. 55). In this regard, it is irrelevant that the proprietor had paid the profits obtained from the exploitation of the trade mark into the accounts of Can Ganguil until 2009, since bad faith must be proven at the time of filing the application and the profits were paid later. In addition, the proprietor ceased to share the profits of the trade mark exploitation as from 2009 and this shows the detrimental nature of the registration of the sign in his own and exclusive name (para. 56).

**T-774/17; C del M (fig.); Café del Mar and others v EUIPO; Judgment of 12 July 2019; EU:T:2019:535; Language of the case: ES**

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

**KEYWORDS:** Bad faith

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**FACTS:** On 24 April 2007 the proprietor applied for registration of the figurative mark 'C del M' as an EUTM for goods in Classes 3, 4 and 18. The EUTM was registered on 27 March 2008.

An invalidity application was filed pursuant to Article 52(1)(b) CTMR. The Cancellation Division (CD) dismissed the invalidity application.

The invalidity applicants filed an appeal. The Board of Appeal (BoA) dismissed the appeal: it found that the registered goods were not related to the exploitation of a cafeteria or disco and were not merchandising goods usually sold in an establishment known for its music.

The invalidity applicants filed an action before the General Court (GC), relying on one plea in law: (i) infringement of Article 52(1)(b) CTMR. The GC upheld the action.

### EUTM



**SUBSTANCE:** (i) infringement of Article 52(1)(b) CTMR. The GC found that the invalidity applicants and the proprietor had used the figurative sign 'Café del Mar' since 1980 when they opened the music

bar 'Café del Mar' in Ibiza (Spain). The sign was also used to distinguish goods and services provided by various companies that the individual invalidity applicants and the proprietor had incorporated since 1987 (paras 35, 37).

The contested mark coincides in the letters 'c' and 'm' with the initial letters of the terms of the earlier sign, in the preposition 'del' and the typography is identical. The contested mark is the abbreviation of the earlier figurative sign and therefore the signs may produce the same overall impression (para. 49).

The bar 'Café del Mar' became well known over the course of the years and its activities expanded to include music products, clothing and merchandising bearing the figurative sign 'Café del Mar' (paras 43, 50). It cannot be excluded that leather goods are sold within the framework of the sale of clothing and fashion accessories and umbrellas and perfumes may be part of the merchandising goods of a cafeteria or may be offered as fashion accessories (para. 52).

Therefore, the contested mark is not completely different from the earlier figurative sign 'Café del Mar' and is registered for goods and services at least partly similar to those distinguished by the earlier sign (para. 53).

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**T-792/17; MANDO / MAN; MAN Truck & Bus v EUIPO; Judgment of 12 July 2019; EU:T:2019:533; Language of the case: EN**

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

**KEYWORDS:** Common element, Conceptual dissimilarity, Conceptual similarity, Lack of reasoning, Likelihood of confusion, Phonetical similarity, Visual similarity

**FACTS:** The applicant sought to register the figurative mark MANDO for goods and services in Classes 7, 9, 11, 12, 35, 37 and 39 such as coaches, trucks, repair services. An opposition based on earlier international registrations and earlier national marks, registered for services in Classes 7, 9, 11, 12 and 37, was filed pursuant to Article 8(1)(b) CTMR and Article 8(5) CTMR.

The Opposition Division (OD) dismissed the opposition.

The Board of Appeal (BoA) annulled the decision of the OD for not taking reputation into account Article 8(5) CTMR and dismissed the appeal with regards to Article 8(1)(b) for no likelihood of confusion (LOC). It found that the marks had a low degree of visual similarity and average phonetic similarity, while not being comparable conceptually in the eyes of the professional, specialised public.

This is because the term 'man' is short and the addition of 'do' gives a different impression, even if the contested mark contains the earlier mark, the public will not break down the term 'mando'.

The applicant filed an action before the General Court (GC), challenging the part of the BoA decision related to Article 8(1)(b) CTMR and relying on a single plea in law: (i) infringement of Article 8(1)(b) CTMR. The GC partially upheld the action.

### EUTM application

**MANDO**

### Earlier trade mark

**MAN**

**MAN**

Man

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

Relevant public. The relevant public for goods in Classes 7 and 12 is made up of specialists and professionals only, while the relevant public for

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the services in Class 37 also includes the vehicle-owning general public (paras 25, 30-37). The level of attention of the relevant public is higher than average for all of the goods and services in Classes 7, 12 and 37 because of the technical and costly nature of these goods (paras 38, 41-48).

Comparisons of goods and services. The decision is based on the possibility that the goods and services might be identical (not disputed) (paras 49-50).

Comparison of the signs. The earlier international registrations, MAN, and the mark applied for, MANDO, display some degree of visual similarity to the extent that they have the word element 'man' in common. The term 'mando' forms a unique term that the relevant public has no reason to break down into two parts, namely 'man' and 'do'. (paras 57-71). The fact that the earlier registrations, MAN, were able to enjoy a reputation in Germany and Austria and, as a result, have a highly distinctive character does not invalidate the finding, since the reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the LOC, but not for the purposes of assessing the similarity between the marks (para. 65). As regards the phonetic comparison of the marks, the marks have an average degree of similarity owing to the pronunciation of the syllable 'man' of the mark applied for, since the term 'man' corresponds to the earlier registrations (para. 72). With regard

to the conceptual similarity, the term 'mando' is a fanciful word that does not have any meaning for the relevant public in Bulgaria, the Czech Republic, Germany, France, Hungary or Austria. For the relevant public in these states who speak German or who have a basic knowledge of English and will understand the term 'man' as meaning 'male human being', the marks are conceptually different. For the other members of that public, who will not associate any meaning, either with the mark applied for or with the earlier international registrations, it is not possible to make a conceptual comparison of the marks (para. 75). The enhanced distinctive character resulting from the reputation of the earlier registrations does not help to confer on the element 'man' a dominant character or independent distinctiveness, as the relevant public has no reason to break the mark applied for down into two parts, namely 'man' and 'do', instead being likely to perceive it as a whole (para. 87). Thus, there is no risk of confusion between the mark applied for and the earlier international registrations No 542 763 and No 542 762.

Duty to state reasons. Compliance with the duty to state reasons is a matter of public policy that must be raised, if necessary, of the Court's own motion (para. 93). The BoA did not carry out any specific analysis of one of the earlier marks, international registration No 863 418, covering services in Class 35. It simply pointed out that the same assessment and the same conclusion applied as for the other marks;

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though the services in Class 35 advertising of any kind using all available media are very different in nature and have a different public (paras 98-99). Thus, the contested decision is inadequately reasoned as regards, at the very least, the definition of the relevant public and its level of attention and the global assessment of the likelihood of confusion as regards earlier registration No 863 418. (paras 92-105).

Concerning the earlier national marks, the BoA correctly found that there is no likelihood of confusion with the mark applied for (paras 106-124).

The GC annulled the decision for one of the earlier marks and dismissed the action for the remainder.

**T-54/18; 1st AMERICAN (fig.) / DEVICE OF A BIRD (fig.); Fashion Energy v EUIPO; Judgment of 12 July 2019; EU:T:2019:518; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled); Cross-claim dismissed

**KEYWORDS:** Descriptive element, Right to be heard, Weak element

**FACTS:** The applicant sought to register the figurative mark 1ST AMERICAN as an EUTM for goods in Classes 9, 24 and 25.

An opposition based on the earlier figurative mark, registered for goods and services in Classes 3, 18, 25 and 35 was filed pursuant to Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition in its entirety.

The applicant appealed. The Board of Appeal (BoA) dismissed the appeal finding that the verbal element of the mark applied for had a weak distinctive character and therefore there was a high degree of visual and conceptual similarity.

The applicant filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of Article 95(1) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The GC upheld the action.

**SUBSTANCE:** (i) infringement of Article 95(1) EUTMR

The applicant claims that it could not comment on the BoA's argument that the figurative element of an eagle has 'an imaginative content in relation to retail services of sunglasses' (para. 34). However, the observation regarding the degree of distinctiveness of the representation of the eagle was put forward by the OD in its decision (para. 39). Therefore, the applicant had had the opportunity of submitting its observations (para. 40).

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### EUTM application

1<sup>ST</sup> AMERICAN



### Earlier trade mark



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

The relevant public. If the BoA neither expressly defines the public's level of attention nor the contents of the OD's assessment, it must be held that it agreed with the OD (para. 53). The goods are directed at the public at large, which has a different level of attention according to the category of goods (undisputed); since the section of the public with the lowest level of attention is the one that should be taken into account, in this case, the level of attention must be considered average (para. 57).

Comparison of goods and services. Spectacles is a broad term including sunglasses, consequently

spectacles and retail store services for sunglasses have an average degree of similarity (paras 69, 71). Robes include bathrobes, which are often absorbent robes worn before or after bathing and household textiles and linen include towels used to absorb moisture; they also have an average degree of similarity (paras 72-73). The goods in Class 25 of the respective marks are identical (para. 74).

Comparison of the signs. The earlier mark consists of a representation, probably of an eagle, spreading its wings upwards and with the beak and claws open. The mark applied for is a figurative element representing a bird, which can be described in the same way as the earlier mark, together with the verbal element '1st AMERICAN' on a black rectangle above (para. 79). The BoA undertook a two-step analysis considering the element '1st' laudatory and considering 'AMERICAN' as descriptive (para. 98). The BoA did not undertake a global analysis of the verbal elements of the mark applied for. It should have based its assessment on the overall perception by the relevant public. The fact that those elements may have a weak distinctive character individually does not prejudice in any way their possible distinctive character when combined (para. 100) in particular, when the verbal element constitutes a whole in the mark applied for (para. 101). This error is liable to vitiate the entire assessment in the contested decision (para. 105).

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**T-753/18; #BESTDEAL (fig.); C&A AG v EUIPO;**  
**Judgment of 5 September 2019; EU:T:2019:560;**  
**Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Non-distinctive

**FACTS:** The applicant sought to register the figurative sign #BESTDEAL goods of in Classes 18 and 25. The Office refused to register the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that there was nothing unusual or surprising in the juxtaposition of the word elements to enable the relevant public to memorise it easily and instantly as a distinctive trade mark for the goods covered.

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

**SUBSTANCE:** (i) INFRINGEMENT OF ARTICLE 7(1)(b) EUTMR. The relevant public is composed of the average English-speaking consumer (not disputed) (para. 24).



### EUTM application



There is nothing unusual or surprising in the juxtaposition of the word elements BESTDEAL (paras 26-27). The message conveyed by the sign is not capable of indicating to the consumer the commercial origin of the goods. It is too simple to trigger a cognitive process in the consumer's mind (para. 28). The symbol '#' is devoid of distinctive character (paras 31-32). The applicant cannot rely on previous EUTM registrations. Decisions concerning registrations of a sign as an EUTM are adopted in the exercise of circumscribed powers and are not a matter of discretion (para. 35)

(ii) INFRINGEMENT OF THE PRINCIPLE OF EQUAL TREATMENT. The BoA cannot be required to explicitly state the reasons why it differs from a decision-making practice of the Office that has not been invoked before it (para. 48). In any event, none of the registrations relied upon by the applicant is relevant to the case because they concern different goods and services (para. 51).

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**24/07/2019, R 530/2019-2, KLANG EINES GERÄUSCHES, WELCHES MAN BEIM ÖFFNEN EINER GETRÄNKEDOSE HÖRT**

**Outcome:** Decision confirmed.

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

**Keywords:** Sound mark, Distinctiveness (no).

**Summary:** The applicant sought to register a sound mark for goods in Classes 6, 29, 30, 32 and 33. The sound is created when a beverage can of a carbonated drink is opened. The application was rejected under Article 7(1)(b) EUTMR in respect of all the goods applied for, notably containers of metal, milk products, coffee beverages, beer-based beverages and alcoholic beverages.

The sound mark will be perceived by consumers only after opening the goods in question and thus generally only after their purchase. Therefore it cannot serve as a reference for consumers when making a decision about the purchase. The

mark applied for does not differ sufficiently from comparable noises which arise when opening a can of a carbonated liquid, so as to be able to be perceived by consumers as an indication of commercial origin. All cans may contain active gas and liquids and, when they are opened, produce a similar sound to that of the sound applied for. Moreover, all the goods and beverages specified may be sold in doses that, when opened, have a similar sound to the sound applied for, namely the sound of opening a container followed by a sponge sound. Relevant consumers will regard the sound mark not as an indication of commercial origin, but as a functional element of the goods applied for. The sound mark applied for is non-distinctive; the appeal is unfounded.

**08/07/2019, R 889/2019-5, 1742**

#### EUTM application

1742

**Outcome:** Decision annulled.

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

**Keywords:** Numerical mark, Distinctiveness (yes).

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**Summary:** The examiner partially refused the EUTM applied for on the basis of Article 7(1)(b) and (c) EUTMR for goods and services in Classes 21 and 43 claiming that a normally informed consumer would believe that the goods and the premises, in which the services in question were provided, were antique and manufactured in the year 1742 and that the services related, for example, to hotel and restaurant services in an old building from 1742.

As regards the mark's descriptiveness, the Board considers that the sign cannot be regarded as descriptive, because (i) the year 1742 is almost three centuries ago; (ii) the relevant public, when confronted with '1742' for the goods in question will not immediately perceive it as an indication of the date of manufacture (iii) there is no history of historical events that would lead the relevant public to immediately perceive the mark as describing the style, quantity, size, price or any other characteristics of the goods.

In relation to Article 7(1)(b) EUTMR, the sign may be taken as the date '1742' however it would require a degree of interpretative effort in order to perceive the sign as an indication of the year in which the undertaking — which produces and supplies the goods and services at issue — was founded. Furthermore, the sign does not appear merely as information or promotional material which points out that the goods and services concerned are, or are offered with, a tradition that is almost three centuries old. The relevant public cannot therefore establish a clear and direct link with the goods and

services for which protection is sought. As regards Article 7(1)(g) EUTMR the Board considers that the mark is not misleading and that there is no serious risk of deception in relation to the relevant public. The appeal is upheld.

26/07/2019, R 791/2019-5, C=commodore (fig.)

### Contested EUTM



**Outcome(s):** Decision confirmed.

**Norms:** Article 58(1)(a) EUTMR.

**Keywords:** Used in the course of trade.

**Summary:** The Cancellation Division upheld the request for revocation against the mark represented above in respect of all the goods and services registered. The Fourth Board of Appeal annulled the contested decision (13/07/2016, R 2585/2015-4, C=commodore (fig.)) for certain goods in Class 9. The General Court annulled this first BoA decision (13/12/2018, T-672/16, C=commodore (fig.), EU:T:2018:926) as regards the dismissal of the IR holder's appeal in respect of the existence of proper reasons for non-use.

The case was remitted to the Fifth Board of Appeal.

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Following the findings of the Court, it is stipulated that the EUTM proprietor's business consists of trademark licensing. Due to a share capital transfer in 2011 the applicant was confronted by a series of manoeuvres (including litigation in the USA and claims made by third parties) seeking to claim ownership of the 'Commodore' trade marks. Some of the actions extended over a long period of time. The Board considers that these actions were of an unusual nature and cannot be described as mere interference with normal business activities. They were clearly beyond the control of the IR holder and made the use of the mark unreasonably difficult. Therefore, they amount to 'proper reasons for non-use'. The contested decision is annulled and the request for revocation is rejected.

**19/07/2019, R 2191/2018-2, Grana Padano**

**Outcome(s):** Decision confirmed.

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

**Keywords:** Descriptive.

**Summary:** The word mark 'GRANA PADANO' (filed by the Consorzio per la Tutela del Formaggio Grana Padano – Italian association for the protection of Grana Padano cheese) was partially refused for services in Classes 35, 41 and 43 because it described the subject matter of the services (referring to Grana Padano cheese) and it was not filed as a collective mark.

The Board agrees with the examiner that the designation 'GRANA PADANO' will immediately inform the relevant public, without further reflection on its part, that the services in respect of which the application relates detail activities which are directly linked to the 'GRANA PADANO' cheese (and to the relevant PDO). The sign applied for therefore conveys obvious and direct information as regards the subject of the services in question.

The fact that the applicant is an association for the protection of 'Grana Padano' cheese is irrelevant, especially considering that the sign was not filed as a collective mark.

The appeal is dismissed.

**11/07/2019, R 2557/2018-4, Kylie / Kylie et al.**

### Earlier signs

KYLIE  
KYLIE MINOGUE

### Contested EUTM

Kylie

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**Outcome(s):** Decision confirmed.

**Norms:** Article 8(1)(b) EUTMR, Article 8(5) EUTMR, Article 7(1) EUTMDR, Article 7(2) EUTMDR, Article 7(3) EUTMDR, Article 8(1) EUTMDR.

**Keywords:** Admissibility, Dissimilarity of the goods and services, Likelihood of confusion, Reputation, Substantiation of earlier right.

**Summary:** The Opposition Division partially upheld the opposition, namely for the goods 'watches' in Class 14 and rejected the contested mark for these goods.

The Board confirms the contested decision. The earlier international registrations and French mark were not substantiated. Article 7(2)(a)(ii) EUTMDR requires evidence of the registration in the form of a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate. The Board emphasises that nothing in the regulations relieves holders of international registrations from the obligation of substantiation from the competent administration (i.e. WIPO) by which the trade marks are registered or making reference to a source from which this evidence is accessible. The extracts from the WIPO's register submitted for the first time on appeal are rejected as belated and hence are inadmissible. In addition, none of the extracts indicates a specification of the goods and services which are protected by the registrations; the evidence is manifestly insufficient to prove the scope of protection of the earlier rights. On the basis of the earlier German trade mark and the earlier UK trade mark, the Board concludes that the opposition must fail on the ground of Article 8(1)



(b) EUTMR taking into account that the conflicting goods or services are dissimilar. Moreover the opposition on Article 8(5) EUTMR is unfounded as the opponent failed to submit a coherent line of reasoning demonstrating what the detriment or unfair advantage would consist of and how it would occur.

23/07/2019, R 911/2016-1, DANISH BY DANISH CROWN (fig.)

### IR designating EU



**Outcome:** Decision confirmed.

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(1)(f) EUTMR, Article 7(1)(g) EUTMR.

**Keywords:** Deceptive element, Geographical origin, Descriptive (yes).

**Summary:** In relation to distinctiveness the IR holder essentially argued that the four-tipped crown device was highly stylised, original and unique. It was also the main figurative element of several of

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the IR holder's EUTMs. This was sufficient, it claimed, to render the mark distinctive.

Given that geographical origin is amongst the most important pieces of information sought by consumers when purchasing foods, it is logical that consumers will understand the word 'DANISH' exclusively as an indication of geographic origin when used on food products, such as the contested goods in Classes 29 and 30. Moreover, in relation to services, the public generally perceives, or may perceive in the future, a geographical place known to it as the geographic origin of the services concerned, or as the place where these services are delivered. As regards the verbal element 'BY DANISH CROWN', this will be perceived as being laudatory. The white crown cannot alter this perception, being a depiction of the word 'crown'. As regards the other figurative elements of the sign, they are likewise insufficient to create an overall non-descriptive impression. None of the figurative elements, nor their combination with the word elements as depicted within the mark, contributes sufficiently to the overall impression to prevent the mark from being exclusively descriptive for, at most, average consumers.

Moreover, not only signs with 'negative' connotations can be objected to on public policy grounds. The use of symbols with strong positive connotations may also need to be regulated on public policy grounds. The regulation of their use in trade marks is justified in order to protect and preserve their positive connotations. By regulating the availability of these signs to traders, it can be ensured that these signs are not abused, that their positive connotations are not taken advantage of and that consumers are not misled into believing that a connection exists with

a particular institution or entity when it does not. The symbols and names of political institutions fall within the category of signs that can have strong positive connotations for a significant part of the public and which require protection on the basis of public policy. Intrinsically the contested mark makes reference to being of Danish origin and contains a reference to the Danish monarchy or government. The public will perceive the element 'BY DANISH CROWN' in its intrinsic meaning when it is used in relation to the goods and services claimed. The Board notes that avoiding disappointment or deception is not the goal of Article 7(1)(f) EUTMR. Rather, the provision aims to ensure, on the one hand, the avoidance of offense through the use of signs with strong negative connotations, and on the other hand, the regulated use, not restricted by trade marks, of certain signs with strong positive connotations, in order to protect and preserve those positive connotations. In addition, the element 'BY DANISH CROWN', and the white crown combined with 'DANISH', can imply that the goods sold under the mark would be provided by a company under the ownership of the Danish monarchy or government. The Board finds there is a serious risk that the element 'by Danish Crown' is of such a nature as to mislead a part of the relevant public to believe that the goods in question have been subjected to an authorisation, official approval, or quality control by the Danish monarchy or government. Consequently, the contested sign is deceptive within the meaning of Article 7(1)(g) EUTMR. The appeal is dismissed.

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