Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Alicante News
Up to date information on IP and EUIPO-related matters
September 2022

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

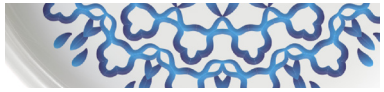
#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

First Page



GIs for craft and industrial products: Is the finish line in sight?

By Eleonora Rosati

When you think of Perpignan (France), your thoughts turn immediately to its stunning jewellery, which is the result of a well-established tradition of excellence. Similarly, when you go to Solingen (Germany) and see the famous cutlery on display in local shops, you soon realise that those objects embody centuries of craftmanship.

Something that you may perhaps not be aware of is that, like other craft and industrial products, both Garnet de Perpignan (jewellery) and Schneidwaren aus Solingen (cutlery) are protected as geographical indications (GIs).

GIs are a particular type of intellectual property (IP) that protects the name of products that have a specific geographical origin and possess a certain reputation or qualities, due to that place of origin. The use of the name protected by a GI is reserved for producers from that area and that manufacture a certain product in accordance with specified rules and standards. This means, for example, that a maker of garnet jewellery based outside of the Perpignan area will not be able to use the name 'Garnet de Perpignan' for their products. Most likely, aside from not being produced in Perpignan, such products will be also manufactured following different rules to those followed by Perpignan jewellers.

How craft and industrial products are protected today as GIs

In Europe, initially, the protection of GIs focused on agricultural products, including foods, wines and spirits. The European Union ('EU') has extensive legislation in place relating to the protection of agricultural products and foodstuffs, wines and spirit drinks. Names like *Hånnlamb* (lamb from the Gotland area in Sweden) and *Beurre d'Ardenne* (butter from the Ardennes in Belgium) are examples of registered agricultural GIs in the EU.

But what happens when the names to protect are those of craft and industrial products? Currently, the names of products such as knives and cutlery, jewellery, furniture, porcelain and ceramics, and lace may be protected across individual EU countries as GIs in accordance with national law.

After a court famously refused to grant the city of Laguiole the right to prevent the registration of 'LAGUIOLE' as a trade mark, in 2014 France passed a law that allows for the protection of craft and industrial products through an accreditation

First Page

procedure administered by the national IP office (INPI). As a result of this law, many craft and industrial GIs have already been registered in France, the first of these being for Siège de Liffol (chairs, registered in 2016), Granit de Bretagne (granite, registered in 2017), and Limoges Porcelain (porcelain, also registered in 2017).

What is happening in the EU?

While other countries have systems in place that are similar to the French one, the protection available varies significantly across the EU, and there is currently no legislative framework that specifically protects craft and industrial GIs at the EU level.

Since 2011 the European Commission has been considering the opportunity to extend GI protection so as to encompass both agricultural, craft, and industrial products. The discussion of an EU system for craft and industrial GIs has intensified over the past few years. This is also because GIs are not just 'rights'. They are tools that ensure local production is economically viable. These rights also strengthen the links between a product and other local activities such as promoting cultural activities, tourism, and art.

In 2020, a study commissioned by the European Commission did reveal that the protection of craft and industrial GIs would be beneficial overall to both consumers and producers, while also supporting regional development. It is clear that GIs can support sustainability goals and help further protect cultural heritage. In this sense, they could also contribute to setting circular economy objectives, which are at the heart of several EU policies.

The future ahead

Surveys reveal that, also as a result of the COVID-19 pandemic, consumers in Europe are increasingly concerned with sustainability and the importance of both making 'greener' choices and supporting local businesses. The protection of craft and industrial GIs can play a role in all this. In addition, the diversity of approaches across different EU countries may create frictions in the functioning of the EU internal market. Both aspects can support an even more intense discussion around the introduction of an EU framework to protect, as GIs, not just agricultural products but also craft and industrial products.

In 2020, the European Commission announced that it could propose legislation to introduce an EU-wide system for the protection of geographically-linked craft and industrial products. A legislative proposal was recently unveiled.

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

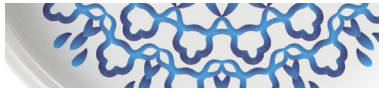
#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

First Page



So, how will the future of craft and industrial products look like? It is likely that there will be more involvement from the EU and a specific legislative framework to protect them as GIs at the EU level. Stay tuned!

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

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPnetwork
strategic driver 01

DesignEuropa Talks 2022

The EUIPO will host the first DesignEuropa Talks **on 20 October 2022** at its headquarters in Alicante.

This one-day event aims to expand the DesignEuropa Awards community and highlight the effective use of design and how its protection can help drive economic, social, cultural and environmental development.

The event is designed to encourage active discussion among participants, with various panel sessions covering different aspects related to design. Distinguished experts will discuss a wide range of topics, such as:

- Design Education and IP protection
- Challenges and opportunities in the design industry
- Impact of the design on the value of the business
- Successful stories of design management

The two working languages of the event will be English and Spanish, with interpretation services provided for all participants. DesignEuropa Talks 2022 will be held in a hybrid format, allowing registered participants to attend the event in-person or online.

Registration for the conference will be available shortly – stay tuned!

For any additional information, contact us at DesignEuropaAwards@euipo.europa.eu.

Observatory: Achievements and Perspectives

The European Observatory on Infringements of Intellectual Property Rights has published a special brochure to mark the 10th anniversary of its transfer from the European Commission to the European Union Intellectual Property Office in 2012.

The publication provides an overview of the Observatory's achievements and milestones of its first decade at the EUIPO and also looks forward to the future. The three main objectives of the Observatory are also presented: (1) provide evidence-based contributions and data to enable EU policymakers to shape effective IP enforcement

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPnetwork
strategic driver 01

policies and to support innovation and creativity; (2) provide data, tools and knowledge-building to support enforcement authorities in the fight against IP infringement; and (3) raise awareness of the value of IP and the negative consequences of IP infringement.

Go to the brochure

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPexcellence
strategic driver 02

Practice tip: Virtual goods, NFTs and the metaverse

The EUIPO is increasingly receiving applications containing terms relating to **virtual goods and non-fungible tokens** (NFTs). This is the approach that the Office is taking for classification purposes.

- Virtual goods are proper to Class 9 because they are treated as digital content or images. However, the term *virtual goods* on its own lacks clarity and precision so must be further specified by stating the content to which the virtual goods relate (e.g. *downloadable virtual goods, namely, virtual clothing*).

- The 12th Edition of the Nice Classification will incorporate the term downloadable *digital files authenticated by non-fungible tokens* in Class 9. NFTs are treated as unique digital certificates registered in a blockchain, which **authenticate** digital items but are distinct from those digital items. For the Office, the term non fungible tokens on its own is not acceptable. The type of digital item authenticated by the NFT must be specified.

Services relating to virtual goods and NFTs will be classified in line with the established principles of classification for services.

The EUIPO's approach is set out in the 2023 draft Guidelines, on which stakeholders have been asked to comment.

The Office will also be presenting a **webinar** on 'Trade marks and designs in the Metaverse: legal aspects/EUIPO practice' on 13 September 2022 at 10:00. Do not miss it!

First oral hearing before the Grand Board

The EUIPO's Grand Board will be holding its first ever oral hearing in Appeal cases on **9 September 2022** at 09:30:

R 1613/2019-G, Iceland and R 1238/2019-G, Iceland

The cases involve an invalidity request made inter alia by the Icelandic Ministry for Foreign Affairs against the British supermarket chain, Iceland, and deals principally with the alleged descriptiveness and non-distinctiveness of the figurative and word marks shown above in relation to a range of goods and services in Classes 7, 11, 16, 29, 30, 31, 32 and 35.

The Nice Classification assigns goods to Classes 1 to 34, and services to Classes 35 to 45. Each class is represented by a class heading, which gives general

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPexcellence
strategic driver 02

information about the type of goods or services covered. You can search for details using TMclass.

The language of these proceedings is English. The two cases will be heard together in a hybrid format and can register to follow it online.

A limited number of places will also be made available at the EUIPO's premises in Alicante for in-person attendees.

Register to follow it online by 6 September

The SME Fund reaches 15 000 applications

The Ideas Powered for business SME Fund has reached 15 000 applications in the first half of 2022, and more than 28 000 since the initiative began in January 2021.

Most applications come from Spain (2652), Italy (1855), Poland (1702) and France (1232) from the manufacturing sector, retail, science, technologies, information and communication industries, among others.

The SME Fund grants financial aid for IP matters and has provided support to SMEs across 27 EU countries. It is a European Commission initiative implemented by the EUIPO with the support of national IP offices.

SMEs can save up to EUR 2 250 if they choose to protect their IP rights through the SME Fund and it can also encourage them to act more competitively.

Its impact

The SME Fund had a significant educational impact on European companies. **Nearly 80 %** of them have **had their first** contact with the world of **IP through this initiative**.

As a result of the SME Fund's success, the European Commission and the EUIPO have recently **increased the Fund by €10 million**.

About the Fund

The SME Fund was set up in 2020, in the wake of COVID-19, to assist with IP rights to European small and medium-sized businesses. The aim was to provide financial support for trade mark and design applications as well as for the IP Scan service, a key tool for developing SMEs' IP strategy. In 2022, the Fund was expanded to accept national patent applications in EU countries. The initiative is set to run until **16 December 2022**.

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

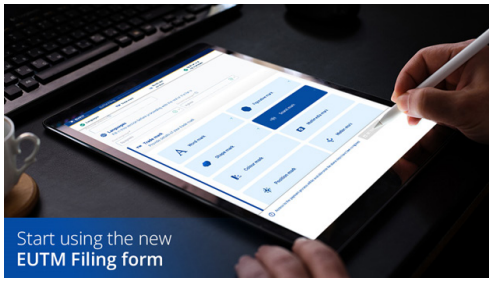
#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPinnovation

strategic driver 03

API platform and new EUTM filing form go live



The EUIPO receives around 250 000 trade mark and design applications per year, with almost all of these being submitted online.

From August 2022, a new application programming interface (API) platform as well as a new and improved EU trade mark (EUTM) filing form are available for all customers.

Both tools are key milestones in the ongoing modernisation of the EUIPO's digital services and take into consideration the input received from customers. The Office's Strategic Plan 2025 commits to developing innovative tools and services using new technologies.

API platform

The API as a connection between computers or between computer programs is a type of software interface, offering a business-to-business (B2B) service to other pieces of software.

The API connection allows filers to directly register an EU trade mark (EUTM) from their own systems, save time and reduce the risk of errors. Frequent filers of EUTMs can now integrate their own IP management solution with the EUIPO one through the API platform (Decision No EX-22-6). Learn how to get started.

The API platform opened in April 2022 in restrictive mode to six Key Users who expressed interest in testing the system. They participated in the pilot project and filed 27 EUTMs through the API. Their feedback served to further improve the platform.

New EUTM filing Form

The new online form is more intuitive, easier to use and has new features, including:

- customisation options, allowing you to tailor your filing experience;
- a new design with full guidance and contextual help;
- faster goods and services management;
- enhanced security

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPinnovation

strategic driver 03

Over the past months, 25 users in a pilot test filed their EU trade marks using the new filing system. Their feedback and suggestions have been incorporated to enhance the form. This detailed webinar explains the main improvements and features.

The EUIPO is gathering feedback and identifying possible issues before consolidating this new form and phasing out the existing e-filing systems, which meanwhile continue to run in parallel. You can **provide your views through the feedback option** that appears as soon as you have filed your application.

What is next?

The Office plans to completely replace the existing 5-Step Form and Advanced Form with the new EUTM filing form **by the end of November 2022**.

In 2023, the EUIPO expects a new Easy Filing form for designs to be available for customers; as well as new products for the API platform for designs. Users will also be invited to test it beforehand. Stay tuned!

Tool tip: Translate term in DesignClass

Do you know how to use the 'Translate term' option in DesignClass? Here are some useful tips.

The first thing you should do is select the language you would like to work in. DesignClass is available in 30 languages, so click on the one you want in the top right-hand corner of the page.

In this tutorial, you can find information on how to:

- enter words or phrases;
- find terms that belong to a specific Locarno class and subclass and contain a particular word or phrase;
- get the translation of those terms in the selected EU language.

To start, simply click on the tab 'Translate term' and then choose the languages you need to translate from and into.

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

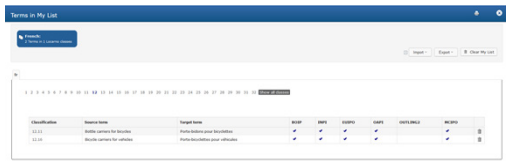
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPinnovation

strategic driver 03

For instance, you can try typing the term 'bicycle carriers' in the search bar and follow the instructions in the tutorial (you even get suggestions!)

If you are unsure of the Locarno class and subclass the term is in, no worries! It's not mandatory to include the class number (if you look closely, you will see there is no * next to the 'Class/Subclass' tab). But if you do know them, you can select them to narrow down the results of course!



Don't forget to click on the 'Translate' (Traduire/Traducir/Tradurre/Übersetzen) button on the right!

You can save, export or use the results directly when applying to register a Community design since you will need to choose a term that best describes the good(s) to which the design applies (and the Locarno class and subclass in which it would be classified).

ACADEMY webinars

Latest webinars

Webinar: **Power your business with the SME Fund**

Find out, through a practical business case, how the SME Fund can boost your SME by providing financial support for your intellectual property.

After this webinar, you will know how to obtain partial reimbursement of the fees for IP Scan, trade marks and designs at national, regional, EU and international levels. We will share some tips and tricks on the application process and answer your questions.

'Ideas Powered for business SME Fund' is a European Commission initiative implemented by the European Union Intellectual Property Office (EUIPO).

Watch the webinar.

Webinar: **Track Case-Law: GC/CJEU judgments and BoA decisions (Q2)**

This webinar provides an overview of the most relevant judgments of the GC/CJEU and decisions of the EUIPO Boards of Appeal.

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

IPinnovation

strategic driver 03

It will keep you updated on all the latest EUTM related case-law developments.

This webinar is part of a series that takes place every quarter.

Watch the webinar.

Upcoming webinars

Webinar: **How to use DesignClass: A key advantage when applying for design protection** Tuesday, 6 September 2022,10.00 AM – 11.00 AM (CEST)

Webinar: **Trade marks and designs in the metaverse: legal aspects/EUIPO practice** Tuesday, 13 September 2022, 10.00 AM – 11.00 AM (CEST)

Webinar: **Disclosure of earlier designs in RCD invalidity proceedings (Article 7 CDR)** Tuesday, 20 September 2022, 10.00 AM – 11.00 AM (CEST)

Webinar: **Conveying meaning – options and limits for protecting new forms of marks in collaboration with the Max Plank Institute** Tuesday, 27 September 2022, 10.00 AM – 11.00 AM (CEST)

On recent case-law

In the *Zdút v EUIPO*, T-250/21 (NEHRA) judgment, the GC ruled that the applicant's bad faith had not been established when they filed the contested mark. In invalidity proceedings, this is an interesting case that highlights the difficulties of proving the bad faith of an applicant who asks to protect a trade mark that is identical to a famous historical mark that has not been used in a long time. For those interested in the topic, do not hesitate to have a look at our webinar on the multifaceted notion of bad faith.

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

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

Case-law comment: Genuine use and Brexit under General Court's lens for the first time.

by Riccardo Raponi, Litigation Service, Boards of Appeal.

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

09/03/2022, T-766/20, STONES, EU:T:2022:123

Background

On 21 August 2018, PrenzMarien GmbH ('the revocation applicant'), whose company name was previously Stone Brewing GmbH, filed a revocation action with the EUIPO against the EUTM 'STONES' relying on Article 58(1)(a) of Regulation 2017/1001 ('EUTMR'). It claimed that the mark had not been put to genuine use in the EU for the goods in respect of which it was registered namely beer, bitter beer and lager in Class 32.

The Cancellation Division rejected the application for revocation in respect of beer, bitter beer. It considered that use shown in the United Kingdom ('UK') during the relevant period of use (from 21 August 2013 to 20 August 2018 inclusive) satisfied the requirement as to the place of use.

On 29 September 2020, the Board of Appeal dismissed the appeal. It emphasised that, although limited to the UK territory alone, the evidence showed sufficiently extensive use to be classified as genuine use 'in the EU'. The UK's withdrawal from the EU did not call that conclusion into question, given that, during the relevant period of use, the UK was still a Member State of the EU.

The revocation applicant filed an action before the General Court claiming, inter alia, that if the trade mark had been used only in the territory of the UK, there would be no economic reason after Brexit to allow trade mark conflicts in the EU. The EUTM registration should therefore be revoked in its entirety.

The Court dismissed the appeal.

Analysis

Firstly, the Court observed that the UK was a member of the EU throughout the relevant period. Consequently, the owner's proven use of the contested mark during that period did take place in the EU, as required by Article 58(1)(a) EUTMR (§ 21).

The Court also noted that no specific provision in the Withdrawal Agreement provides that the use of an EU trade mark in the UK before the its withdrawal from the EU on 1 February 2020, as well as during the subsequent transition period which lasted until

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

31 December 2020, is no longer to be regarded as use in the EU within the meaning of Article 58(1)(a) EUTMR.

In the absence of any express provision to the contrary and in light of the clarity of Article 58(1)(a) EUTMR, the Court confirmed that the EU legislature implicitly accepted that the protection of an EU trade mark should be maintained even where genuine use of that mark is demonstrated only in the territory of the UK, for as long as the latter remained a member of the EU (§ 25).

The date of the last decision in the proceedings (i.e. the decision of the General Court or, in the event of an appeal, of the Court of Justice) which fell after Brexit, is not decisive in that regard (§ 29).

The Court also warned that the new context will have to be taken into consideration in the future, namely for proceedings in which the relevant five-year period falls, in part or in whole, after 1 January 2021. In fact, the use made of the mark in the UK after that date would no longer be relevant.

Practical significance

The Court's ruling is of practical significance in that it confirms that the use of an EU trade mark made in the UK before the end of the transition period and its effective withdrawal from the EU constitutes use 'in the Union' for the purpose of establishing genuine use of that mark.

The judgment is an explicit endorsement of the EUIPO's practice, as spelt out in Communication No 2/20 of the EUIPO Executive Director on Brexit ('the Communication'). That document stated at § 14 that, as regards proof of use, 'evidence relating to the UK and to a period of time prior to 1 January 2021 will be relevant to maintain the rights in the EUTM and will be taken into account'.

You are also advised to take note of the Court's statement that the 'new context' of Brexit will play a role in future proceedings concerning genuine use where the relevant period falls in part or in whole after 1 January 2021 (§ 31).

In that regard, the Court seems to implicitly confirm the principle, also set out in § 14 of the Communication, that the significance of use in the UK will progressively decrease – from potentially sufficient to entirely irrelevant – depending on the extent to which it covers the period for which use has to be established.

Finally, on a separate note, the Court also clarified some aspects of low volumes of sales in the context of a mass consumption sector. In particular, the Court held that modest volumes of sales made under a mark in such a sector can qualify as genuine use if its commercial purpose is real in view of the trade mark proprietor's marketing strategy and the specific characteristics of the market at hand (§ 67).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

Luxembourg trade mark and design news

29/06/2022, T 306/20, LA IRLANDESA 1943 (fig.), EU:T:2022:404

EUTM

Invalidity proceedings – Mark of such nature as to deceive the public – Bad faith – Mark indicating a geographical origin – Action dismissed – EUTM cancelled

For decades, Hijos de Moisés Rodríguez González, S.A., purchased Irish butter from Ornua Co-operative Ltd and sold it in Spain under the mark 'LA IRLANDESA'. After this business relationship came to an end in 2011, they continued to sell foodstuffs under that trade mark, but those goods were not of Irish origin anymore. In 2013, they filed with the EUIPO the above depicted figurative mark for various foodstuffs in Class 29.

After registering the EUTM, Ireland and Ornua Co-operative Ltd applied for a declaration of invalidity on the grounds that it was deceptive [Article 7(1)(g) EUTMR] and that it had been applied for in bad faith [Article 59(1)(b) EUTMR]. The Cancellation Division rejected the invalidity application. The Grand Board of Appeal ('GBoA') annulled that decision and declared the mark invalid on both invoked grounds. The EUTM proprietor filed an action before the General Court (GC).

The GC confirmed the GBoA's decision regarding the contested mark being filed in bad faith.

First of all, the CG notes that, when seeing the figurative mark with the dominant word elements 'La Irlandesa' affixed to the goods at issue, Spanish-speaking consumers, who constitute the relevant public, would believe that those goods originate in Ireland (§ 36).

As regards the deceptive nature of that mark, the GC points out that the examination of an invalidity application based on the deceptive nature of the mark requires that it be established that the trade mark was, per se, of such a nature as to deceive the consumer at the time of filing the application for registration (§ 66). Since the list of goods did not contain any indication of their geographical origin and could therefore cover goods originating from Ireland, it was not possible to find that the contested mark was deceptive at the time of the application. The evidence subsequent to the filing could not confirm the misleading nature of the contested mark (§ 71-73).

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

As regards the bad faith of the applicant, the GC notes that the concept of bad faith cannot be confined to a limited category of specific circumstances. Thus, any claim of bad faith must be the subject of an overall assessment, taking into account all the factual circumstances relevant to the particular case (§ 82, 83). In order to decide whether the applicant acted in bad faith when it applied to register the contested mark in the case at issue, the GBoA could rely on evidence – and even on the use of that mark – subsequent to the filing, since that evidence was related to the situation on the relevant date (§ 94). First, a not insignificant part of the goods sold by the applicant under the contested mark was not of Irish origin. Since Spanish-speaking consumers had become accustomed over the course of several decades to the contested mark being affixed to butter from Ireland, they could be misled as to the geographical origin of those goods once the applicant had extended the use of the mark to goods other than butter of Irish origin. Secondly, the applicant was necessarily aware on the date of the application for registration that their mark could be perceived as indicating the Irish origin of goods, since similar marks had been declared invalid or refused by the EUIPO and Spanish authorities. Thirdly, the applicant had adopted a commercial strategy to take advantage of the past business relationship with Ornua Co-operative Ltd. Therefore, the registration of the contested mark was contrary to honest commercial and business practices (§ 96-102).

Go to the decision

T-250/21, 06/07/2022, nehera (fig.), EU:T:2022:430
Revival of a previously renowned former mark by a third party – Not an act of bad faith in specific circumstances – Decision annulled – Application for invalidity rejected

EUTM

'NEHERA' was a well-known fashion brand in Czechoslovakia in pre-war times, founded by Mr Jan Nehera, a renowned Czechoslovak businessman. It ceased to be used in Europe in 1946. In 2013, an applicant who has no family ties with Mr Jan Nehera or his family, applied for the above depicted figurative EUTM for the goods in Classes 18, 24 and 25 and began to use it in connection with womenswear the following year. The descendants of Mr Jan Nehera filed an application for a declaration of invalidity of that trade mark arguing that, by using and registering the EUTM, the applicant had acted in bad faith [Article 59(1)(b) EUTMR]. The Cancellation Division (CD) dismissed the invalidity application in its entirety. The Board of Appeal (BoA) reversed the CD's decision. The applicant brought an action before the General Court (GC).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

The GC annulled the BoA's decision and clarified the concept of bad faith in cases of a revival of a previously renowned trade mark.

It points out that when the contested mark was filed, the former Czechoslovak trade mark and Mr Jan Nehera's name were no longer either registered or protected, or used by a third party to market clothing, or even well known among the relevant public. Thus, in the absence of surviving reputation in respect of the former trade mark and of current celebrity status in respect of Mr Jan Nehera's name when the contested mark was filed, the subsequent use of that mark by the applicant was not, in principle, capable of constituting free-riding behaviour indicating bad faith on the part of the applicant. This finding is not called into question by the fact that the applicant was aware of the past existence and reputation of Mr Jan Nehera and of the former trade mark (§ 59, 60).

The GC then notes that it the case in question, the applicant himself devoted considerable effort, time and money to revive the former trade mark and to make the history of Mr Jan Nehera and his business known. Thus, far from merely exploiting the past reputation of the former trade mark and the name of Mr Jan Nehera in a parasitic way, the applicant made his own commercial efforts to revive the image of that mark and, at his own expense, to restore its reputation. The mere fact of having referred to that mark and to the historic image of Mr Jan Nehera's business for promotional purposes does not appear to be contrary to honest practices in industrial or commercial matters (§ 66).

Furthermore, the GC does not find that the applicant would deliberately seek to establish a false impression of continuity or inheritance between his undertaking and that of Mr Jan Nehera. In fact, by stating that he had revived and resurrected a mark that flourished in the 1930s, the applicant suggested rather an interruption and, therefore, a lack of continuity between the previous activity and his own (§ 70).

As to the claim that the applicant sought to defraud Mr Jan Nehera's descendants and heirs and to usurp their rights by not obtaining their agreement before applying to register the contested mark, the GC observes that at the date on which the contested mark was filed, Mr Jan Nehera's descendants and heirs did not hold any right that might be susceptible to fraud or to being usurped by the applicant (§ 72-74).

The concept of bad faith presupposes the presence of a dishonest state of mind or intention. Considering the circumstances of this case, the GC finds that it has not been established that that the applicant was driven by a dishonest state of mind when filing the contested mark (§ 78).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

The GC concludes that the applicant did not act in bad faith when filing the contested mark.

Go to the decision

13/07/2022, T-768/20, The standard (fig.), EU:T:2022:458

Contested EUTM

Genuine use – Place of use – Services provided outside the EU – Decision annulled

An application for revocation pursuant to Article 58(1)(a) EUTMR was filed against the above depicted contested EUTM , registered i.a. for hotel and catering services in Class 43. Pointing out that these services were provided in the United States, the Cancellation Division, confirmed by the Board of Appeal (BoA), revoked the EUTM. It found that genuine use had not been proven in the EU territory and considered that the fact that the advertisement and offers of service were intended for consumers in the EU was irrelevant. The General Court (GC) annulled the BoA's decision.

The GC considers that the BoA erred in finding that the contested mark could not immediately be put to genuine use in the EU, because the applicant's services are provided in the United States. According to the GC, a distinction must be made between the place where those services are provided and the place where the mark is used. Only the latter is relevant to examine the genuine use of an EUTM (§ 34). The GC points out that the acts of use of a trade mark recognised by the EUTMR are also the acts of advertising and of offering for sale, on which the applicant is relying in the present case. Those acts are therefore relevant for the purposes of establishing genuine use of the contested mark insofar as they occur in the relevant territory. Thus, the fact that the services at issue are provided outside the relevant territory of the EU does not necessarily imply that the acts of use of the contested mark seeking to promote and to offer for sale such services are taking place outside that territory. Even if the applicant were to supply goods or services outside the EU, it is conceivable that the applicant would make use of that mark in order to create or preserve an outlet for those goods and services in the EU. The GC stresses that such an interpretation is supported by EUIPO guidelines. These state, for example, that, where services of holiday accommodation are provided abroad, advertising alone may be sufficient to amount to genuine use (§ 35, 37-39).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

Thus, the GC confirms that advertisements and offers for sale constitute acts of use of a trade mark. Therefore, these are relevant in order to demonstrate use in respect of the services or goods for which the contested mark is registered, insofar as those services or goods are the subject of advertisements and offers for sale (§ 42).

Go to the decision

T-246/20, 06/07/2022, Spinning, EU:T:2022:428

Trade mark not becoming a common name – Action dismissed – Application for revocation rejected

The EUTM 'SPINNING' (word mark) is registered i.a. for 'exercise equipment' (Class 28) and 'exercise training' (Class 41). In 2012, an application for revocation was filed pursuant to Article 58(1)(b) EUTMR, according to which an EUTM is revoked if, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered. The revocation applicant claimed that 'SPINNING' had become the common name in the Czech Republic for a particular sporting activity practised on indoor cycles, in a group, generally in gyms, and under the guidance of a fitness instructor.

The Cancellation Division and the Board of Appeal (BoA) upheld the application for revocation. The General Court (GC), through judgment 08/11/2018, T-718/16, SPINNING, EU:T:2018:758, annulled the BoA's decision. It held that the BoA, by failing to take account of the perception of professional customers, such as gym operators, made an error of assessment. In a second decision, the BoA rejected the application for revocation. It found that the evidence submitted by the revocation applicant was insufficient to establish that 'SPINNING' had, at the time when the application for revocation in question was filed, became a common name in the Czech Republic. The GC confirms this BoA decision.

The GC points out that while the relevant circles include primarily consumers and end users, intermediaries playing a part in the assessment of the customary nature of the mark must also be taken into account. Thus, considering the characteristics of the market for the goods and services at issue, the relevant public consists of professionals, such as, i.a., operators of gyms, sports facilities and rehabilitation facilities, as they are playing a central role on the relevant market and exert a decisive influence over the end consumers' decisions to purchase (§ 37,47, 49).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

Consequently, the GC confirms that the revocation applicant has not proved that, at the date on which the application for revocation was filed, the trade mark 'SPINNING' had become, in the territory of the Czech Republic, the common name in the trade for 'exercise equipment or training' (§ 75).

Go to the decision

22/06/2022, T-739/20, Waterford, EU:T:2022:381

EUTM not becoming misleading as to the geographical origin of the goods – Res judicata – Action dismissed – Application for revocation rejected

In 2013, an application for revocation of the EUTM 'WATERFORD' (word mark) was filed in respect of 'articles of glassware, earthenware, chinaware and porcelain' in Class 21. The applicant for revocation claimed that, in consequence of its use, that mark is liable to mislead as to the geographical origin of the goods [Article 58(1)(c) EUTMR], since the city of Waterford (Ireland) was reputed for glass and crystal production. The Cancellation Division (CD) dismissed the application for revocation in 2014, on the grounds that the applicant had not provided evidence supporting their allegation. The decision became final.

In 2017, the applicant filed a new application for the revocation of the same EUTM in respect of the same goods, this time submitting an opinion poll with the title 'Waterford Study' from 2015. The CD and the Board of Appeal (BoA) found that the opinion poll provided did not prove that the contested mark was misleading as to the nature, quality or geographical origin of the goods in question. The General Court (GC) confirms that finding.

Regarding the admissibility of the action, the GC underlines that the possible inadmissibility, based on Article 63(3) EUTMR (res judicata), of the application for revocation does not render the action for annulment before the GC inadmissible. The GC examination of the admissibility of an application for revocation is part of the substantive examination and necessarily presupposes that the action brought against that decision is admissible (§ 26-28). Furthermore, the GC notes that the arguments that had already been rejected in the CD decision of 2014, which had become final, are inadmissible (§ 42).

As to the substance, the GC recalls that whether or not Article 58(1)(c) EUTMR provides that the rights of the proprietor of the EUTM are to be declared revoked if, in consequence of the use made of it by the proprietor or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

those goods or services. Whether or not this Article is applicable depends on the misleading use of the mark after its registration. This misleading use must be duly proved by the applicant (§ 45, 51).

The GC points out that in order to assess the probative value of a document, it is necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable. As far as surveys in particular are concerned, their probative value depends on the survey method used (§ 56, 57).

Thus, the GC confirms that the opinion poll lacked probative value, since it is not clear from the evidence submitted what methodology had been used in that poll and the participants selected themselves and did not constitute a representative sample of the population. The revocation of the applicant's argument that it is sufficient that the poll was conducted by an independent entity is ineffective, since it was not possible, because the methodology followed was not known, to assess whether the sample chosen was representative. Therefore, the revocation applicant did not prove that the city of Waterford had a reputation in relation to the production of crystal or glass (§ 60-67).

Go to the decision

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

New decisions from the Boards of Appeal

08/06/2022, R 142/2021-5, FORM EINER FLASCHE (3D)

EUTM

Invalidity – Three dimensional mark – Shape of the product – Outcome of the decision confirmed – Application for invalidity rejected

The above depicted 3D trade mark has been registered as an EUTM since 2009 for alcoholic and non-alcoholic beverages (Classes 32 and 33) and services in the field of hospitality (Class 43). After its renewal, an application for a declaration of invalidity against this trade mark in respect of all the goods and services has been filed on the grounds of Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) (lack of distinctive character), Article 7(1)(c) (descriptiveness) and Article 7(1)(e)(iii) EUTMR (the surface of the design gives it substantial value).

The Cancellation Division (CD) rejected the application for declaration of invalidity in its entirety. It stated that due to the size, contrast and actual position of the independently distinctive element of the contested sign, two crossed sabres

this element is sufficient to confer distinctive character to the sign as a whole, even if the shape is not distinctive per se or the mark contains descriptive elements. Therefore, neither of the Articles invoked, apply.

The BoA rejects the invalidity request. However, it disagrees with the CD findings that the figurative element of the two crossing sabres would be decisive in the assessment, as the shape mark must be assessed as a whole, and the role of this element is de minimis. According to the BoA, this element is very small in relation to the body of the bottle and is not emphasised in any way in terms of colour either. It refers, inter alia, to the judgment of 27/06/2017, T-580/15, SHAPE OF A Lighter WITH WORD DEVICE 'CLIPPER' (3D), EU:T:2017:433 and points out that the EUTM proprietor did not seek protection for the crossed sabres as a figurative or position mark, but for the shape of a bottle in which that element only constitutes a small subordinate part of the bottle. Furthermore, the BoA notes

Quick Links

First Page

- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork

- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence

- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation

- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law

- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

that the cylindrical shape of the bottle, which is customary on the alcoholic and non-alcoholic drinks market, the slim neck of the bottle and the opaque lid do not on its own lead to distinctive character either. What does contribute to the distinctive character of the contested mark is, according to the BoA, the very striking pattern of the bottle with the large four-sided facets divided into nine rows. It is neither technically necessary, for example to allow a better grip, nor is it purely decorative. Therefore, irrespective of the label, this bottle is capable of indicating a commercial origin. Thus, the BoA finds that all these features distinguish the contested trade mark from the usual shapes of products in the same category that are commonly found on the market and which generally have different designs. Accordingly, it concludes that the contested trade mark departs significantly from what is customary in the sector and is therefore distinctive. The BoA also confirms that the contested trade mark is not descriptive within the meaning of Article 7(1)(c) EUTMR and, as regards the Article 7(1)(e)(iii) EUTMR, it notes that it is not clear from the evidence submitted that the bottle will be bought because of its shape, in the sense that the shape of the product represents the essential value. Thus, the BoA notes that there is lack of sufficient evidence to be able to establish that the shape of the bottle in this case gives substantial value to the goods and services at issue.

Go to the decision

17/06/2022, R 748/2022-5, SAINT CONSTANTIN BRÂNCOVEANU

Trade mark not contrary to principles of morality – Decision annulled – EUTM application allowed

The EUTM 'SAINT CONSTANTIN BRÂNCOVEANU' (word mark) was applied for 'alcoholic beverages' in Class 33. The examiner refused it, stating that it was contrary to the accepted principles of morality [Article 7(1)(f) EUTMR]. The Board of Appeal (BoA) annulled that decision.

The BoA finds that the relevant public would understand the sign as referring to the famous figure of Saint Constantin Brâncoveanu, who is a symbol in the history and culture of Orthodox Christianity. It considers that the applicant provided several contextual elements capable of shedding light on how the relevant public perceives the sign in relation to the relevant goods. In particular, the fact that the Romanian trade mark office has granted national registration to other of the applicant's marks containing the name of saint Constantin Brâncoveanu, also for goods in Class 33, constitutes an indication that the trade mark office of the country where the public is most likely to be offended, namely Romania, considered that the sign in question was not likely to give rise to such offence. Moreover, the Patriarch of the Romanian Orthodox Church himself bestowed the Order and Medal of the Holy Martyrs of Brâncoveni on the president of

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

the applicant's group of companies. Furthermore, it is a well-known fact that the consumption of alcoholic beverages is not seen as offensive by the Orthodox Church. Such elements constitute a strong indication that the relevant public does not perceive the sign as morally unacceptable when used in relation to the claimed goods in Class 33.

Go to the decision

25/07/2022, R 1939/2021-5, Halime (fig.) / 'ΧΑΛΛΟΥΜΙ' (HALLOUMI)/'HELLIM'

Earlier PDO
HELLIM
Contested sign
Halime

Geographical indications – Persons entitled to file an opposition – Evocation of PDO Hellim – Decision annulled – Opposition allowed

The Protected Designation of Origin (PDO) 'Χαλλουμι' (Halloumi) / Hellim' was applied in relation to cheeses in 2015 and registered in 2021. The Group of processors and producers of sheepmilk and goatmilk (the opponent) filed an opposition invoking Article 8(6) EUTMR. It claimed that the above depicted contested sign, applied in 2020 for foodstuffs and wholesaling of foodstuffs (Classes 29-31, 35), evokes the earlier PDO. The Opposition Division found that the opponent was not entitled to file the opposition based on this PDO. It rejected the opposition. The BoA annuls this decision and upholds for the first time an opposition based on the PDO Hellim.

First of all, the BoA notes that the Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs enables any group of producers, irrespective of its legal form, to take actions to protect the PDO, to the extent that they produce the corresponding product. The opponent is a group of nine producers, which are mentioned as the 'Applicant group' in the PDO application. Thus, it is entitled to file the present opposition.

Regarding the evocation, since the two names that comprise the PDO, 'Χαλλουμι' (Halloumi)/'Hellim', may be used together or separately, the BoA assesses whether the contested sign evokes 'HELLIM'. First, it finds that the signs are visually and aurally similar. Secondly, the BoA points out, on the one hand, that 'Hellim' is the equivalent of 'HALLOUMI' in Turkish

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

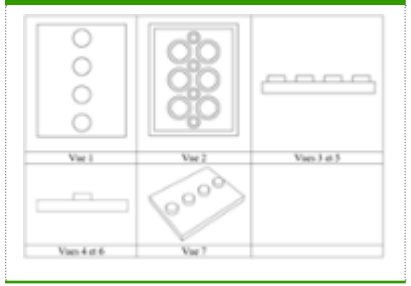
and designates a special cheese from Cyprus and, on the other hand, that 'Halime' is a popular Turkish female forename. However, for the majority of the relevant EU consumers, these terms do not have any meaning, rendering the conceptual comparison neutral. Thirdly, the BoA considers that the possible evocation of the earlier PDO by the contested sign should extend to all contested goods and services, since they pertain to the foodstuff or agricultural sector.

Consequently, the BoA concludes that the majority of the EU consumers who do not know the meanings of 'HELLIM' and 'Halime' will consider the contested sign as an evocation of the earlier PDO. The contested sign is rejected in its entirety.
It must be stressed that, in previous decisions of the General Court and the Court of Justice, oppositions and invalidity proceedings based on trade marks 'HALLOUMI' had been rejected due to the weak distinctive character of those trade marks. The present case differs from these decisions since the opposition is not based on a trade mark [Article 8(1)(b) EUTMR] but on a PDO [Article 8(6) EUTMR].

Go to the decision

30/05/2022, R 1524/2021-3, Building blocks from a toy building set

RCD



Technical function – Interconnection – Protection of modular systems – Appeal dismissed – Application for invalidity rejected

In 2010, Lego obtained registration of a design (RCD) representing a brick from a toy building set. An invalidity application was filed in 2016 on the grounds that the features of the product concerned by the design were solely dictated by the technical function of the product [Article 8(1) CDR]. Lego claimed that the design falls within the exception referred to in Article 8(3) CDR. According to this article, a design serving the purpose of allowing the connection of mutually interchangeable products within a modular system shall subsist if it is new (Article 5 CDR) and has individual character (Article 6 CDR).

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

In decision 10/04/2019, R 31/2018-3, Building blocks from a toy building set, the Board of Appeal (BoA) found that the RCD falls within Article 8(1) CDR and declared it invalid. Lego filed an action before the General Court (GC).

In judgment 24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, the GC stated that the exception provided in Article 8(3) CDR may be relied on for the benefit of features falling simultaneously within Article 8(1) (technical function) and Article 8(2) CDR (interconnections). The first BoA decision was annulled.

Following the remittal from GC, the BoA finds that all the features of appearance of the product in which the contested RCD is embodied are solely dictated by its technical function. Consequently, the contested RCD falls within both Article 8(1) and Article 8(2) CDR, since they are both solely dictated by the technical function of that product: to allow the connection and disconnection of that product, and constitute features of interconnection.

However, the contested RCD benefits from the exception protecting modular systems referred to in Article 8(3) CDR. First, the BoA notes that the RCD serves the purpose of allowing the connection of mutually interchangeable products within a modular system. Secondly, since the evidence submitted by the invalidity applicant was insufficient to prove the disclosure of the prior design, the other two conditions mentioned in Article 8(3) CDR, that is, the novelty and the individual character of the contested RCD, are fulfilled. Therefore, the appeal lodged by the invalidity applicant is dismissed and the RCD is valid.

Go to the decision

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

New cancellation decisions

Each edition of Alicante News includes a new summary in the series of interesting decisions from the EUIPO's cancellation division.

12/04/2022, C 47 379 (Invalidity), VUELING (word mark)

Invalidity – Article 59(1)(b) EUTMR – Proof of use – Assessment of bad faith – Cancellation rejected

A request for a declaration of invalidity of the EUTM registration was filed on the grounds of Article 59(1)(b) in respect of all the goods and services covered by the word mark 'VUELING', namely in Classes 9, 12 and 38.

The applicant argued that the proprietor filed the EUTM in bad faith, as evidenced by the fact that the proprietor filed three successive EUTMs all for the mark 'VUELING'. According to the applicant, the EUTM proprietor never intended to use the contested EUTM. Instead, its aim was to monopolise the word 'VUELING' in order to prevent others from registering it and to use the EUTM as a legal weapon against third parties.

The EUTM proprietor denied filing the EUTM in bad faith. It argued that the burden of proof to demonstrate bad faith lies with the applicant and that the applicant failed to discharge this burden as it had not proved that the EUTM proprietor had any dishonest intention when filing the EUTM.

Firstly, the decision highlighted that the filing dates of the subsequent marks were all more than five years after the date of registration of the initial mark. Therefore, although the Cancellation Division stated that repetitive conduct, such as the filing of successive EUTMs, could indicate an intention to circumvent the registration system, this argument is not applicable in the case at hand. In fact, if the EUTM proprietor filed the EUTM in order to avoid the obligation of use, it would have made more sense to have done so before the end of the grace period of the initial mark, rather than after it had ended (i.e. when the latter became subject to proof of use).

Moreover, the goods and services covered by each of the three marks are in different classes. If the proprietor had wanted to monopolise the word 'VUELING' for certain goods and services by filing successive applications to benefit from additional grace periods, the proprietor would have filed the subsequent marks for the same goods and services.

The Cancellation Division pointed out that whether or not the EUTM proprietor's intention at the date of filing the contested EUTM was dishonest cannot simply be inferred from the mere suppositions raised by the applicant.

Consequently, the applicant's arguments were rejected as unfounded and the application for a declaration of invalidity was rejected.

Go to the decision

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

Case-law on IPR Infringement and Enforcement

A new update of the **Recent European Case-law on the Infringement and Enforcement of Intellectual Property Rights** (IPR) is out now.

The 'recent case-law update' reports on the latest significant European decisions related to infringing and enforcing IP rights. The document contains **more than 200 summaries** of key judgments from national courts and preliminary rulings from the Court of Justice of the European Union (CJEU).

The first part features the most recent cases:

- The CJEU found **Denmark** liable for not preventing the use by companies operating in their territory of the **designation 'FETA'** intended for export to third countries outside the EU. It explicitly confirmed that the prohibition on using protected designations of origin (PDOs) under Regulation (EU) No. 1151/2012 applies to products using these designations regardless of whether they are to be sold in the EU or to countries outside the EU. As a result, the production alone in the Member State's territory is sufficient for that Member State to take action. The Court nevertheless ruled that Denmark, through this inaction, had not infringed its obligation under the principle of sincere cooperation referred to in Article 4(3) TEU.

- In **France**, the Tribunal Judiciaire de Paris issued another so called **dynamic blocking injunction** under the accelerated judicial procedure provided for by Article 333-10 of the Sports Code, in a dispute between broadcaster beIN Sports and several named internet service providers. The Court ordered the ISPs to block several domain names, finding that the free live streams of **Wimbledon** tennis matches made available on the websites via these domain names infringed the claimant's rights to broadcast the matches. ARCOM (Autorité de regulation de la Communication audiovisuelle et numérique) is tasked with updating the blocking order together with rights holders).

- Similar injunctions are being issued in **Greece**. Since 2018, the Greek Committee for the Notification of Copyright and Related Rights Infringement on the Internet (**EDPPI**) has been the public body responsible for dealing with online piracy, through an out-of-court (administrative) procedure. Rights holders may request that illegal use of their content be removed or blocked by Internet service providers (ISPs). The EDPPI publishes a list of the decisions issued and maintains a list of the blocked domains. In a recent **'dynamic blocking' decision** (92.2022), the EDPPI ordered the ISPs to block new domains used by the infringer to continue the already established violation of NOVA BROADCASTING S.A.'s rights.

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

• In **Spain**, in a dispute brought by LaLiga against Atresmedia S.A. and Mediaset S.A., the Spanish Supreme Court confirmed the right of the two media companies to have free access to football matches and other sporting events of high interest to the public, in order to record images (including images of what happened in the stadium beyond the playing field) and to broadcast short news reports. For the court, this right which derives from Article 19(3) General Law on Audiovisual Communication (implementing Article 15 Directive 2010/13/EU 'Audiovisual Media Services Directive') is compatible with the fact that media services providers exercise exclusive television broadcasting rights for the retransmission of the sporting event.

• Still in **Spain**, the Supreme Court ruled that the broadcasting of football matches in bars or restaurants without paying the corresponding fee to LaLiga is not an intellectual property (IP) crime (Article 270(1) of the Spanish Penal Code), but instead a market and consumer crime (Article 286(4) of the Spanish Penal Code). The judge ruled that under the criminal law principle of typicity, given that a football game as such cannot qualify as a 'literary, artistic or scientific work', it is particularly difficult to consider it as a 'performance' of such work. The ruling clarified the guidelines to delimit the scope of an IP crime under that provision (Article 270(1) of the Spanish Penal Code) and confirmed this had been a minor crime against the market and consumers.

• In **Malta**, La Liga Nacional de Fútbol Profesional who hold the right to broadcast live sporting events in Malta (the claimant), has sought a blocking injunction against several internet service providers (ISPs) (the defendants) before the Civil Court of Malta. The injunction covers the unauthorised transmission of the claimant' content from the IP addresses of some of the ISP's clients to Maltese internet users. The Court ordered the ISPs to block IP addresses under the terms of undisclosed agreements reached between the claimants and the defendants. The ISPs were also ordered to block access to IP addresses that fell under the agreements, at any time during the 2022/23 season, as long as the defendants are notified of them not less than 96 hours before a live sporting event. This decision marks the **first judicial dynamic blocking injunction** in Malta in relation to live sporting events.

• In **Finland**, in the wake of the CJEU case 'Mircom' (judgment of 17 June 2021, **Mircom**, C 597/19, EU:C:2021:492) the Supreme Court confirmed that internet service providers (ISPs) can be required to disclose subscribers' **identification data** to rights holders if they are suspected of copyright infringement in the context of a peer-to-peer network. In making its decision, the Court considered that a fair balance must be struck between all the rights/fundamental freedoms at stake. This decision overrules the

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement

Case law

ruling from the Market Court and is particularly relevant in the light of a common practice in Finland (sometimes referred to as 'copyright trolls') which consists in the large scale sending of letters to alleged copyright infringers demanding cash settlements for the alleged offenses.

• In **Germany**, in a case which involves **Ferrari and Mansory Design**, C 123/20 (EU:C:2021:889), CJEU was invited for the first time to rule on the conditions under which the appearance of part of a product or '**partial design**' could be protected as an unregistered Community design. Back at national level, confirming and clarifying the criteria set by the CJEU, the German Federal Supreme Court referred to the legal standards set by the CJEU, considering that design protection of a part of the product is possible even when only the entire product was disclosed. It also clarified that no 'certain autonomy and consistency of form' is required for a part of the product to meet the CJEU's standards. It will now be for the Court of Appeal to apply those criteria in concreto.

• In **Italy**, in a case of **defamation**, the Supreme Court ruled that when it comes to its search activities, a search engine can be considered as a **hosting provider** and therefore enjoys the liability exemption provided that certain conditions are fulfilled (Article 14(1)(a) D 2000/31/EC). However, in this case, given that Google had been notified about the specific defaming content, giving them actual knowledge about the illegal information and they had failed to restrict access to it, the Court ruled that the liability exemption did not apply.

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

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

More information about this activity and other Observatory initiatives in the field of case-law.

Quick Links

First Page
- GIs for craft and industrial products: Is the finish line in sight?

#IPnetwork
- DesignEuropa Talks 2022
- Observatory: Achievements and Perspectives

IPexcellence
- Practice tip: Virtual goods, NFTs and the metaverse
- First oral hearing before the Grand Board
- The SME Fund reaches 15 000 applications

#IPinnovation
- API platform and new EUTM filing form go live
- Tool tip: Translate term in DesignClass
- Academy webinars

Case Law
- Case-law comment: Genuine use and Brexit under General Court's lens for the first time
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal
- New cancellation decisions
- Case-law on IPR Infringement and Enforcement