



EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

ANNUAL REPORT
2015

CASE LAW



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In 2015, 297 cases were appealed before the General Court (GC) and 64 were appealed before the Court of Justice (CJEU). In the meantime, the GC handed down rulings in 386 cases and the CJEU ruled in 35 cases. The cumulative number of appeals before the GC and the CJEU, 361 cases in total, is higher than in 2014 (323 cases) and 2013 (329 cases).

While these cases concern the application of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (CTMR) and of its implementing Regulation No 2868/95 (CTMIR), 11 judgments/orders were handed down by the CJEU in preliminary ruling cases, giving an interpretation of Directive 2008/95/EC of 22 October 2008 (which replaced Directive 89/104) and of the CTMR.

The judgments that imply a change in the Office's practice in *ex parte* or *inter partes* proceedings are, or will soon be, referred to in the Office's 'Trade marks practice manual and guidelines'. Users of the CTM system are encouraged to check the Office's latest practice regularly by visiting our website at <https://euipo.europa.eu/ohimportal/en/practice>.



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I. PROCEDURAL ISSUES

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Rule 71(2) CTMIR: extension of time limits in inter partes proceedings

1 - Judgment of
13/02/2015, T 287/13,
HUSKY, EU:T:2015:99,
§ 34-43.

In accordance with the English version of Rule 71(2) CTMIR, 'Where there are two or more parties, the Office may extend a period subject to the agreement of the other parties'. This linguistic version contrasts with other versions. The English version should be interpreted as meaning that the Office may, but is not bound to, subject the extension of a period to the agreement of the other parties. An extension can thus be granted without consulting the other parties¹.

2 - Judgment of
04/03/2015, T 572/12,
CVTV, EU:T:2015:136,
§ 37-41.

Article 47 CTMR: renewal

3 - Judgment of
25/03/2015, T 378/13,
English pink / PINK
LADY, EU:T:2015:186,
§ 57-68.

Where the proprietor requests a renewal of the Community trade mark for only part of the goods and services within the initial period of protection, its acceptance by the Office has effect *erga omnes* (i.e. towards everyone). Consequently, the possibility of requesting a renewal within the 'grace period' for the remaining goods and services is barred².

4 - Judgments
of 07/10/2015,
T 534/13, Krispy
Kreme DOUGHNUTS
/ DONUT et al.,
EU:T:2015:751, §
23-25; 08/12/2015, T
583/14, FLAMINAIRE
/ FLAMINAIRE,
EU:T:2015:943, §
16-21.

Authority of res judicata

The decision of a Benelux court, which held that use of a national mark infringed a CTM registration, has no effect *res judicata vis-à-vis* subsequent opposition proceedings between the same parties and concerning a CTM application identical to the national mark that was found to be infringing. The subject matter and cause of action differ since the Benelux registration (the use of which is prohibited) cannot be assimilated to the contested CTM application³.

An opposition decision that has become final does not acquire the authority of a final decision for subsequent opposition or cancellation proceedings between the same parties and concerning the same trade marks⁴. Likewise, the decision that dismisses a request for revocation is not binding upon the opposition division when deciding whether the same CTM registration, relied on in support of an opposition, has been genuinely used. Both the relevant period for showing genuine use and the documentary evidence submitted by the CTM proprietor in the two distinct proceedings may differ⁵.

The opposition division is not bound by a previous decision that acknowledged the reputation of an earlier mark⁶.

Appeals against confirmatory decisions

It is inadmissible to appeal against a ‘confirmatory decision’, that is, a decision that confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier decision if the parties to the proceedings, their submissions, their pleas, their arguments and the relevant matters of law and fact characterising those proceedings and determining the operative parts of those decisions were identical.

For example, the trade mark ‘engineering for a better world’ was first applied for in 2012 for construction materials in Classes 6, 17 and 19 and refused by a decision of the Boards of Appeal in 2013 which, in the absence of an appeal lodged on time before the GC, became final. Later in 2013, an application for the same trade mark was filed for the same goods and services. The Boards of Appeal confirmed the refusal of the trade mark application in its entirety. The application for annulment of this decision was considered inadmissible by the GC. This approach prevents the time limit for bringing an action against the confirmed decision to recommence⁷.

Likewise, once the refusal of a trade mark application becomes final, the examiner’s decision to refuse a second application for the same mark cannot be appealed before the Boards of Appeal in the absence of any new factor that would justify a re-examination of the case⁸.

Article 75, first sentence, CTMR: duty to state reasons

Where the Office refuses a CTM application on account of absolute grounds for ‘a category or group of goods or services’, only general reasoning need be given for all the goods and services concerned, provided the goods and services form a homogenous category.

The Office is entitled to refuse the trade mark ‘INFOSECURITY’ on account of its descriptiveness in relation to the subject-matter and content of a large number of goods and services concerned in Classes 16, 35 and 41, since these all consist of media for the dissemination of information in writing (including in print or electronically) or orally (including the organisation of conferences, fairs and exhibitions)⁹. Likewise, the slogan ‘EXTRA’ can be refused for goods and services in Classes 12, 28, 35 and 37 by means of general reasoning because, for all of them, the sign applied for will be perceived as indicating a higher quality¹⁰. The broader the list of goods and services, the more general the reasoning can be without infringing the duty to state reasons¹¹. Where a trade mark applicant challenges before the GC the appropriateness of such general reasoning, it must identify in its appeal which goods and services are not affected by the absolute ground of refusal or explain why those goods and services do not form a homogeneous category¹².

7 - Order of 06/10/2015, T 545/14, GE A Group AG v OHIM, (engineering for a better world), EU:T:2015:789, § 14-24.

8 - OHIM Grand Board of Appeal, decision of 16/11/2015, R 1649/2011-G, SHAPE OF A BOTTLE (3D MARK), § 29-40.

9 - Judgments of 23/09/2015, T 633/13, INFOSECURITY, EU:T:2015:674, § 47-48; 23/09/2015, T 588/14, FlexValve, EU:T:2015:676, § 71-72; 10/09/2015, T 610/14, BIO organic, EU:T:2015:613, § 19; 30/01/2015, T 593/13, Winder Controls, EU:T:2015:58, § 41; 12/02/2015, T 318/13, LIFEDATA, EU:T:2015:96, § 51; 08/10/2015, T 336/14, NOURISHING PERSONAL HEALTH, EU:T:2015:770, § 18-19 and 32.

10 - Judgments of 28/04/2015, T 216/14, EXTRA, EU:T:2015:230, § 23-24; 04/06/2015, T 222/14, deluxe, EU:T:2015:364, § 20-27.

11 - Judgment of 10/09/2015, T 77/14, Device of a grey pattern (fig.), EU:T:2015:620, § 29 and 59-60.

Judgment of 09/09/2015, T 530/14, DARSTELLUNG EINER SCHLEIFE (fig.), EU:T:2015:603, § 25.

13 - Judgment of 25/03/2015,
T 378/13, English pink /
PINK LADY, EU:T:2015:186,
§ 32-50.

The Boards of Appeal do not comply with the duty to state reasons when failing to address the conclusiveness of a national decision rendered between the same parties and concerning identical signs. Such a national decision could have an impact even if the impact is neither automatic nor binding upon the Office¹³.

Article 76(1) CTMR: scope of the examination of facts

14 - Judgments of
21/04/2015, T 359/12,
Device of a chequered
pattern (maroon & beige)
EU:T:2015:215, § 60-65;
08/10/2015, T 547/13,
FORMA UNEI CUTII,
EU:T:2015:925, § 45-48;
29/06/2015, T 618/14,
Snacks con forma de taco,
EU:T:2015:440, § 31-33.

In proceedings relating to relative grounds for refusal, the Office is restricted in its examination by the facts, evidence and arguments provided by the parties (Article 76(1) CTMR). This principle also applies to inter partes cancellation proceedings based on absolute grounds. Even though the Office must limit the extent of its examination to the grounds for invalidity and facts relied on by the cancellation applicant, it may base its decision on well-known facts, using ‘common knowledge’, without having to prove the accuracy of these facts. This possibility is limited to facts that may only result from ‘practical experience generally acquired from marketing general consumer goods’, such as the fact that a chequerboard pattern is a basic and banal figurative feature composed of very simple elements used in the decorative arts sector¹⁴.

15 - Judgments of
23/09/2015, T 426/13,
AINHOA, ECLI:EU:T:2015:669,
§ 14-21; 09/07/2015, T
100/13, CAMOMILLA,
EU:T:2015:481, § 70-81;
04/06/2014, T 254/13,
STAYER, EU:T:2015:156,
§ 20-44; 18/11/2015, T
361/13, VIGOR / VIGAR,
ECLI:EU:T:2015:859, § 54-60.

Article 76(2) CTMR: the discretionary power

The Office ‘may disregard facts or evidence which are not submitted in due time by the parties concerned’ (Article 76(2) CTMR).

16 - Judgment of
09/12/2015, T 354/14,
ZuMEX (fig.) / JUMEX,
ECLI:EU:T:2015:947, § 70-73.

Article 76(2) CTMR can apply where proof submitted belatedly is additional evidence supporting or clarifying the initial proof, and where the additional evidence was made submitted within the time limit for the opponent to reply to the CTM applicant’s criticism¹⁵. Additional proof of use may, however, be inadmissible where no justification is given for its late submission¹⁶.

17 - Judgment of 15/07/2015,
T 24/13, CACTUS OF PEACE
CACTUS DE LA PAZ /
CACTUS, EU:T:2015:494, §
80-86.

New proof of use concerning goods or services other than those for which documentary evidence had already been submitted within the original time limit is inadmissible, as this proof constitutes the first and only evidence of use rather than ‘additional evidence’¹⁷.

18 - Judgment of 22/01/2015,
T 322/13, KENZO,
EU:T:2015:47, § 11-20.

Additional evidence of reputation submitted for the first time before the Boards of Appeal may be admissible where a proper justification explains their late submission, such as the fact that the opponent had already referred to the documents submitted in previous proceedings between the same parties¹⁸.

II. **ABSOLUTE GROUNDS FOR REFUSAL**

Article 7(1)(b) to (k) CTMR: the different absolute grounds for refusal

Article 7(1)(b) CTMR: distinctive character

Word marks and slogans

Signs that are commonly used for presenting and marketing goods or services are deemed to be non-distinctive. However, such a proposition cannot be interpreted a contrario as implying that a sign is distinctive where the applicant is the only operator to use the sign in question on the market for the goods and services concerned¹⁹.

The sign 'IDIRECT24' is non-distinctive for all goods and services that are liable to be sold or offered directly on the internet, including telecommunication and insurance services²⁰.

Figurative marks

The fact that in a given economic sector, such as clothing and fashion articles, the public is accustomed to seeing patterns covering the surface of leather articles or shoes does not have the effect of lowering the threshold for protection. The perception that these signs denote the origin of the goods may be the result of lengthy use rather than any inherent distinctiveness. A bicolour chequerboard pattern and a sign consisting of stripes on the side of shoes or pants for sports are too banal in themselves to be distinctive²¹.

18 - Judgments of 12/02/2015, T 318/13, LIFEDATA, EU:T:2015:96, § 24; 08/10/2015, T 547/13, FORMA UNEI CUTII, EU:T:2015:925, § 48-49.

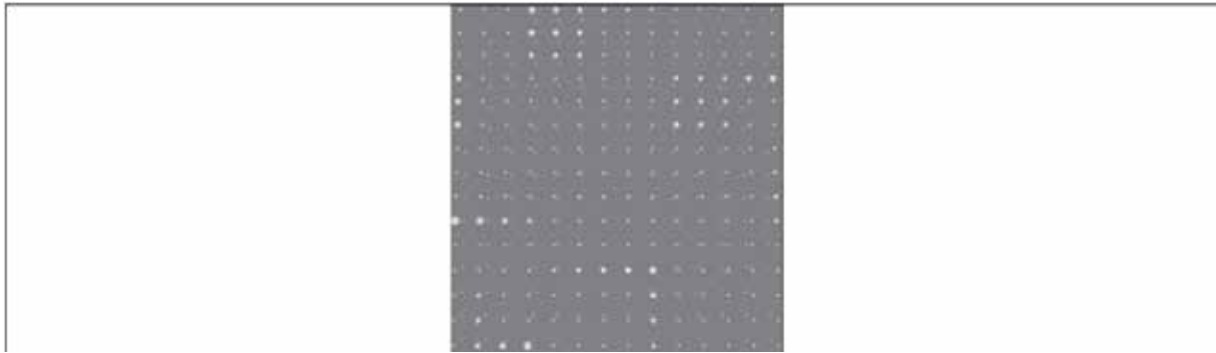
19 - Judgment of 03/09/2015, T 225/14, IDIRECT24, EU:T:2015:585, § 68-69.

20 - Judgments of 21/04/2015, T 359/12, Device of a chequered pattern (maroon & beige), EU:T:2015:215, § 33-41; 04/12/2015, T 3/15, Device of five stripes, EU:T:2015:937, § 27; 15/12/2015, T 64/15, Parallel stripes (position mark), EU:T:2015:973, § 17-22 and 27-29.

21 - Judgment of 10/09/2015, T 77/14, Device of a grey pattern (fig.), EU:T:2015:620, § 44-48.



The complexity of a figurative sign consisting of a pattern of white dots on a grey background does not warrant distinctiveness. 'Even complexity and fancifulness can be attributable to the ornamental and decorative nature of the design's finish, rather than indicating the commercial origin of the goods'²².



Complex marks

The presence of a figurative element may not suffice to render the sign distinctive as a whole if both the verbal element and the device are banal²³.

23 - Judgment of 24/06/2015, T 552/14, Extra, EU:T:2015:462, § 23-25. See also, in the context of Article 7(1)(c) CTMR, judgments of 17/12/2015, T 79/15, 3D, EU:T:2015:999, § 27-28; 10/09/2015, T 30/14, BIO – INGRÉDIENTS VÉGÉTAUX – PROPRE FABRICATION, ECLI:EU:T:2015:622, § 23; 03/12/2015, T 647/14, DUALTOOLS, EU:T:2015:930, § 28-31; 14/01/2015, T 69/14, MELT WATER Original, EU:T:2015:8, § 36.



The fact that the applicant is the proprietor of a series of trade marks having a similar construction does not impact the examination of distinctive character, given that the notion of 'families of trade marks' is only relevant in the context of relative grounds for refusal²⁴.

24 - Judgment of 24/11/2015, T 190/15, meet me (fig.), ECLI:EU:T:2015:874, § 30-36.

The complex trade mark that associates the laudatory word 'Splendid', written in an ordinary script with a figurative element used to dot the letter 'i', must be refused even if this figurative element is in itself registered as a Community trade mark. The registration of one of the elements making up the contested sign is not conclusive insofar as the complex mark, taken as a whole, is composed of other dominant elements which are decisive in the overall impression that it produces²⁵.

25 - Judgment of 21/05/2015, T 203/14, Splendid, EU:T:2015:301, § 30-33.

Colour and three-dimensional marks

The 2015 case-law is in line with that of previous years. A banal shape or combination of colours that does not significantly differ from the norms of the sector is non-distinctive²⁶.

26 - Judgments of 25/11/2015, T 629/14, Shape of a car, ECLI:EU:T:2015:878, § 35-43; 14/01/2015, T 70/14, Shape of a bottle, EU:T:2015:9, § 33-37; 28/01/2015, T 655/13, Grün, ECLI:EU:T:2015:49, § 35-38.

27 - Judgment of 07/10/2015, joined cases T 292/14 and T 293/14, HALLOUMI, EU:T:2015:752, § 41-45.

28 - Judgment of 15/01/2015, T 197/13, MONACO, EU:T:2015:16, § 20 and 58.



Article 7(1)(c) CTMR: descriptive signs

The sign 'HALLOUMI' is descriptive of the kind and geographic provenance of cheese and milk products. The fact that the applicant, the Republic of Cyprus, has used the mark since 1992 as a certification mark regarding the geographical origin of the product, its nature and characteristics, has no impact on the examination of the sign's capacity to identify a commercial origin²⁷.

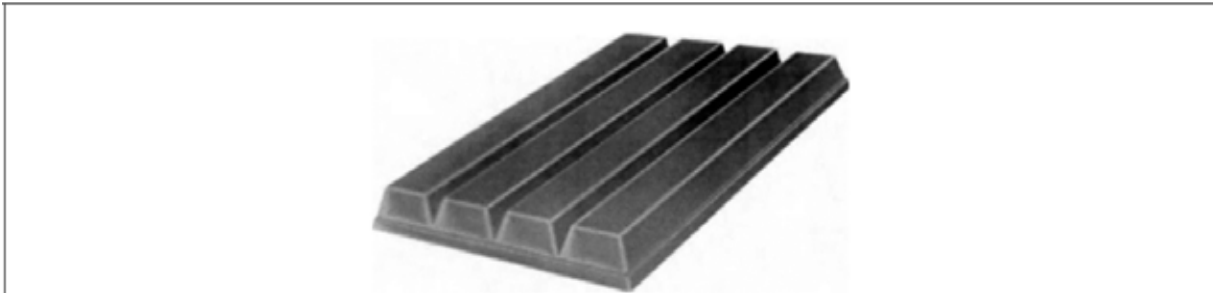
The sign 'MONACO' is descriptive of the geographical location in which hotel and travel arrangement services can be offered. Likewise, for magnetic data carriers and printed matters, the GC confirmed the Board's conclusion that the sign 'MONACO' gives information about the geographic provenance or subject-matter of these products²⁸.

Article 7(1)(e)(ii) CTMR: shape necessary to obtain a technical result

In the 'shape of a chocolate bar' case, the CJEU was asked in substance whether the shape of the 'Kit Kat' bar is functional on account of the fact that its essential characteristics allow for efficient

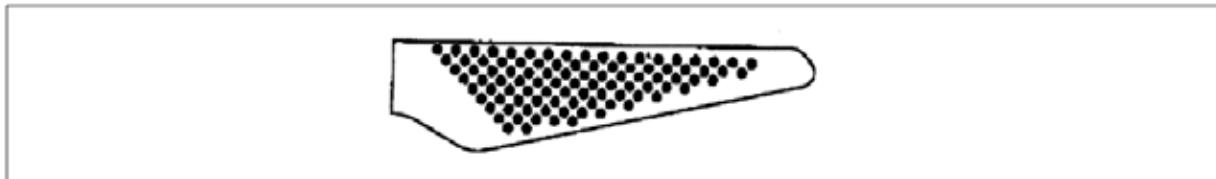
de-moulding, packaging and distribution and, more generally, for the optimisation of the mass production of the goods. The CJEU answered that the absolute ground for refusal applies where the shape allows a product to achieve a desired technical result when this product is in use but it does not apply to the manner in which the goods are manufactured²⁹.

29 - Judgment of 16 September 2015, C 215/14, Société des Produits Nestlé, EU:C:2015:604, § 57.



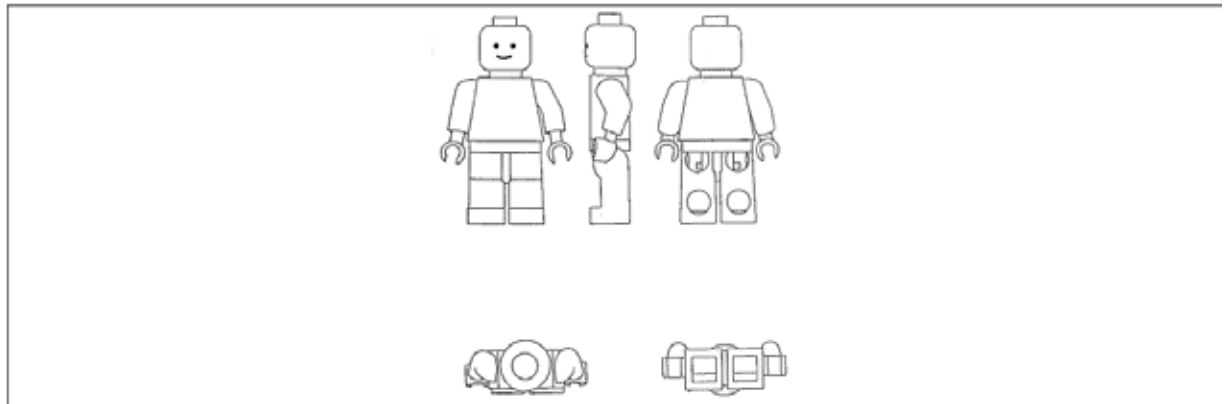
In the ‘shape of a knife handle’ case, the GC reiterated that Article 7(1)(e)(ii) CTMR applies to any sign, whether two- or three-dimensional, where all the essential characteristics of the sign perform a technical function. The various patents held by the contested mark’s proprietor illustrated that the dents displayed in arrays across the handle sought to incorporate a technical solution: a non-skid structure. Regarding the specific distribution of the dents, the GC did not rule out that it had an ornamental character, but since it ‘shows no significant characteristic’ this feature could not be regarded as essential to the shape and could not bar the application of Article 7(1)(e)(ii) CTMR³⁰.

30 - Judgment of 21/05/2015, T 331/10 RENV & T 416/10 RENV, A SURFACE COVERED WITH CIRCLES, EU:T:2015:302, § 39 and 58-64.



The shape of a toy robot with a stud on its head is not necessary to obtain a technical result. It was not established that the stud or the shape of the hands were dictated by an interlocking or assembling purpose and in any event these features were not ‘essential’ in the contested shape. Taken as a whole, the ‘result’ achieved by the contested shape was not functional but only served to confer human features on the character and to allow the toy to be played with³¹.

31 -



Article 7(1)(j) CTMR: trade marks for wines or spirits

Pursuant to Article 7(1)(j) CTMR, registration is refused for 'trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin'.

This absolute ground for refusal was applied to the word mark 'Lembergerland' for alcoholic beverages having a geographical origin other than 'Lemberg', that is, an 'estate' in South Africa whose name is protected in Europe by means of a bilateral agreement with the European Union. Protection of geographical indications is not limited to names of 'regions' or 'localities' established in accordance with their size or their administrative status. Article 7(1)(j) CTMR applies, irrespective of whether the reproduction of a protected geographical name or of part of that name is likely to mislead the public as to the genuine geographical origin of the wines. It is enough that the trade mark is made up of elements that can identify without ambiguity the protected geographical name³².

32 - Judgment of 14/07/2015,
T 55/14, Lembergerland,
EU:T:2015:486, § 15-26.

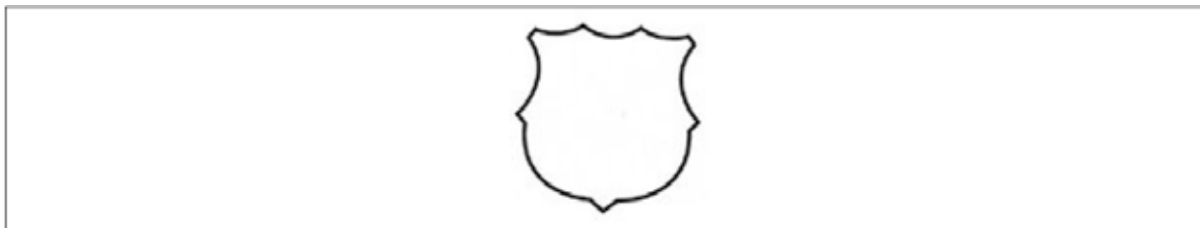
Article 7(3) CTMR: the acquisition of distinctiveness through use

Use in combination with other signs

In the 'shape of a chocolate bar' case, the CJEU was asked by the High Court whether the acquisition of distinctive character requires proof that a significant proportion of the relevant class of persons 'rely upon the mark' (as opposed to any other trade marks that may also be present) as indicating the origin of goods.

The CJEU answered that ‘for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate’³³.

Regarding the figurative sign consisting of the contours of an escutcheon, proof of use of the Barcelona Football Club crest was considered inconclusive. The contours of the escutcheon are not distinguishable from the escutcheon itself. Therefore, it was not established that the public would recognise the mark applied for independently of the crest taken as a whole³⁴.



Relative grounds for refusal

Article 8(1)(b) CTMR: likelihood of confusion

Comparison of goods and services

The fact that the opponent’s goods (*plant growth regulating preparations*) are expressly excluded from the list of goods covered by the contested mark (*chemicals used in agriculture, horticulture and forestry excluding growth regulator for plants and fertilizers*) has no bearing on their similarity since these goods have the same nature, intended purpose and can be produced by the same operators³⁵.

Comparison of signs: methodology

The following factors are relevant in the context of the overall assessment of likelihood of confusion but not in that of the comparison of signs: the degree of similarity between the goods or services, the reputation of the earlier mark, the existence of a family of trade marks³⁶, or the degree of attentiveness of the public³⁷.

Word marks

The use of upper and lower case letters, which tends to isolate the first letter in the word sign ‘iDrive’, does not bar the finding that this sign is identical to the earlier word mark ‘IDRIVE’. In

33 - Judgment of 16/09/2015, C 215/14, Société des Produits Nestlé, EU:C:2015:604, § 66.

34 - Judgment of 10/12/2015, T 615/14, Escudo (fig.), EU:T:2015:952, § 58-62.

35 - Judgment of 30/09/2015, T 720/13, KARIS / CARYX et al., EU:T:2015:735, § 40-43.

36 - Judgment of 12/11/2015, T 449/13, WISENT / ŻUBRÓWKA BISON BRAND VODKA, EU:T:2015:839, § 52-66.

37 - Judgment of 05/02/2015, T 33/13, bonus & more, EU:T:2015:77, § 24.

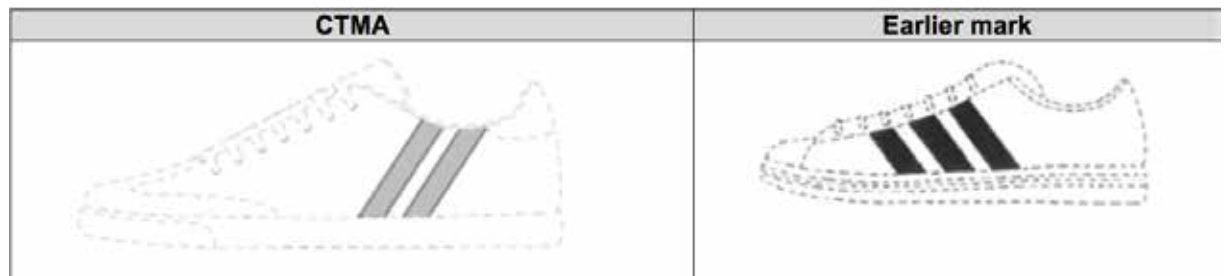
the absence of any claim on figurative aspects of the marks (which would have required their characterisation as figurative marks), no difference can be found between them visually, aurally or conceptually³⁸.

38 - Judgment of 03/12/2015,
T 105/14, iDrive / IDRIVE,
EU:T:2015:924, § 59-63 and
77-78.

Figurative marks

39 - Judgment of 21/05/2015,
T 145/14, DEVICE OF TWO
PARALLEL STRIPES (posit.)/
DEVICE OF THREE PARALLEL
STRIPES et al., EU:T:2015:303,
§ 39-43.

Two figurative signs consisting of parallel stripes placed vertically on the side of a shoe are visually similar in spite of differences regarding the number of stripes (two or three), their positioning on the shoe and their inclination³⁹.



40 - Judgments of
13/05/2015, T 608/13,
easyAir-tours (fig.)/
international airtours (fig.)
et al.,

Complex marks

The differences affecting the figurative elements of each of the compared complex signs may neutralise the similarity between the verbal elements⁴⁰.



Likelihood of confusion and geographical origin

In contrast to protected geographical indications, the essential function of collective marks consisting of geographical terms is to distinguish the commercial rather than geographical origin of goods and services. Whether the public might believe that the textile products, identified by

the sign 'Darjeeling', originate from India does not lead to likelihood of confusion with an earlier collective mark 'Darjeeling' registered for tea in view of the dissimilarity between the goods⁴¹.

Likelihood of confusion and weak marks

The need to recognise the validity of an earlier mark must be reconciled with the need to assess the extent to which the sign corresponding to this earlier mark is a distinctive element in the *mark applied for*. A term corresponding to an earlier mark may be perceived differently when it is used in a later complex mark in which it is associated with other elements. If this term is non-distinctive in the context of the mark applied for, it may lose its capacity to evoke the earlier mark and induce a risk of confusion.

Thus, the fact that the earlier mark 'Post' is adjoined to the sign 'TPG' (which will be perceived as a company name) in the contested sign 'TPG Post' did not lead to a finding of likelihood of confusion because the word 'Post' plays a descriptive role in the sign applied for. The public will understand the sign applied for as a reference to a postal service offered by the company 'TPG' rather than as a reference to the earlier mark's proprietor. The GC concluded that the element 'Post' does not play an 'independent distinctive role' in the sign applied for, within the meaning of the *Medion* ruling⁴², because this element does not have at least an average distinctive character⁴³.

Enhanced distinctiveness acquired through use

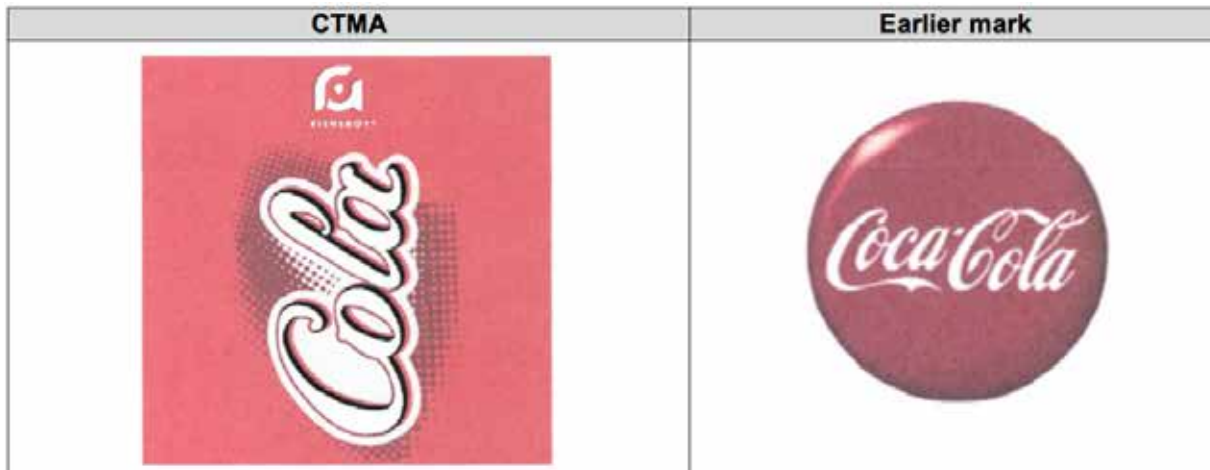
Recognition of an earlier mark on the market may facilitate the establishment of likelihood of confusion vis-à-vis a later mark that reproduces its least distinctive element (the word 'Cola' of the earlier mark 'Coca-Cola') but in association with the same colour (red) and characteristic (cursive) font⁴⁴.

41 - Judgment of 02/10/2015, T 624/13, Darjeeling / DARJEELING et al., EU:T:2015:743, § 41 and 61.

42 - Judgment of 06/10/2005, C 120/04, Thomson Life, EU:C:2005:594, § 30.

43 - Judgment of 13/05/2015, T 102/14, TPG POST / DP et al., EU:T:2015:279, § 78-79.

44 - Judgment of 18/03/2015, T 384/13, RIENERGY Cola, EU:T:2015:158, § 44.



Article 8(4) CTMR: non-registered marks and other signs used in the course of trade

Protection by national law of PGIs and PDOs

The GC ruled on a case concerning conflict between the trade mark application ‘PORT CHARLOTTE’ for whisky and the earlier geographical indication ‘Porto’ or, in its English translation, ‘Port’. Protection was claimed both under Council Regulation (EC) No 1234/2007 of 22 October 2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation)⁴⁵ and national Portuguese law. The GC annulled the decision which excluded that national legislation could supplement the protection conferred under the EU regulation. The GC confirmed that the aim of the EU systems of protection of PGIs and PDOs for foodstuff and wines is not to establish, alongside national rules that may continue to exist, an additional system of protection for qualified geographical indications, like, for example, that introduced by the CTMR, but to provide a ‘uniform and exhaustive system of protection for such indications’. The GC, however, concluded that the reference made in Article 8(4) CTMR to the ‘Community legislation or the law of the Member State’ governing the sign in question authorises the national law to grant ‘additional protection’⁴⁶.

On the facts of the case, the GC confirmed that use of ‘PORT CHARLOTTE’ for whisky was not caught by any of the situations envisaged under Article 118 *quaterdecies* of the Single CMO Regulation. In particular, the GC found that the contested sign formed a logical and conceptual unit that neither evoked nor imitated the earlier PGI⁴⁷.

Article 8(5) CTMR: marks with reputation

Reputation acquired as part of another mark

The reputation acquired by a figurative mark may, but does not automatically, benefit a word mark with which it is subsequently used. In order to establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play therein ‘a significant or even predominant role’. This is the case of the word mark ‘Spa’ that was used as part of another registration, and which associates this verbal element with the logo of a pantomime character. The verbal element occupies a central position in the complex sign in which it plays a ‘distinct and predominant’ role⁴⁹.

45 - Now replaced by regulation (EU) No 1308/2013 of 17 December 2013.

46 - Judgment of 18 November 2015, T 659/14, PORT CHARLOTTE, EU:T:2015:863, § 44-49.

47 - Judgment of 18 November 2015, T 659/14, PORT CHARLOTTE, EU:T:2015:863, § 71-76.

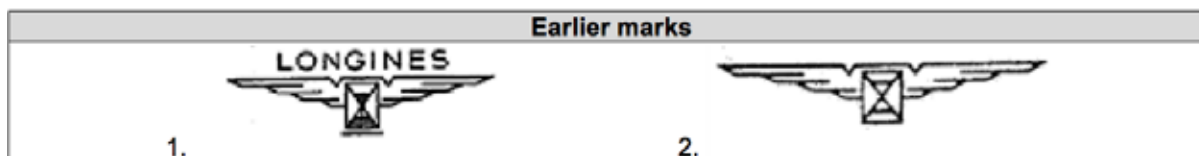
48 - Judgment of 17/07/2008, C 488/06 P, Aire Limpio, EU:C:2008:420, § 49 and 53.

49 - Judgment of 17/03/2015, T 611/11, Manea Spa, EU:T:2015:152, § 82-83.



On the contrary, the reputation with which a complex sign 'LONGINES' is associated does not benefit the graphic element representing a 'winged hourglass' alone. The figurative element remains clearly ancillary and in the background in the overall impression conveyed by the complex mark. The opponent failed to submit opinion polls showing the recognition of the 'winged hourglass' logo independently of the verbal element, and the use of this figurative element alone in a limited number of documents was found insufficient from both a quantitative and qualitative point of view⁵⁰.

50 - Judgment of 12/02/2015, T 76/13, QUARTODIMIGLIO QM, EU:T:2015:94, § 91-93 and 104-106.



51 - Judgments of 19/05/2015, T 71/14, SWATCHBALL / SWATCH et al., EU:T:2015:293, § 32-34; 29/10/2015, T 517/13, QUO VADIS / QUO VADIS, EU:T:2015:816, § 35-39.

The link

The existence of a 'link' between the marks is a preliminary requirement for Article 8(5) CTMR to apply. The GC ruled out the application of Article 8(5) CTMR in the absence of any link between the marks 'SWATCH', which has a reputation for watches, and 'SWATCHBALL', which covers goods and services targeting a specialised public and which are different in all respects (electronic publications and computer software relating to visual arts, retail services for films, etc.)⁵¹.

52 - Order of 14/03/2011, C 370/10 P, EDUCA Memory game, EU:C:2011:149, § 63.

Similarity between the signs

In accordance with the case-law, the factual assessment of similarity between the signs is carried out in accordance with the same criteria in the context of Article 8(5) CTMR as in that of Article 8(1)(b) CTMR⁵². Therefore, it was thought that the absence of similarity between the signs, for the purpose of applying Article 8(1)(b) CTMR, automatically ruled out the possibility of establishing a link between

them. However, the CJEU rejected this reasoning and held that a degree of conceptual similarity, albeit insufficient to lead to the conclusion that the signs are globally similar in the context of Article 8(1)(b) CTMR, may suffice for the establishment of a link in the context of Article 8(5) CTMR given the existence of other relevant factors, including the degree of reputation of the earlier mark. The fact that the conceptual connection between the sign 'The English Cut' and its Spanish equivalent 'El Corte Inglés' is not immediate is irrelevant, since Article 8(5) CTMR does not require the connection that consumers are capable of making between the signs to be immediate⁵³. It is only where dissimilarity between the signs results from notable differences on all three levels of perception that a condition for Article 8(5) CTMR to apply is missing.

Taking unfair advantage of reputation (free-riding)

The use of the trade mark 'KENZO' for wines is likely to take unfair advantage of the repute with which the earlier mark 'KENZO' is associated in the clothing and cosmetics sectors. A transfer of image is possible to the extent that the trade of wine may be part of the luxury sector⁵⁴.

Detriment caused to the repute of the earlier mark (tarnishment)

The risk of tarnishment requires antagonism between the goods or services for which the earlier mark has acquired reputation and those covered by the mark applied for. The GC found that use of the mark 'Mustang' for cigarettes will not necessarily cause undesired and negative associations with the earlier mark 'MUSTANG', which has acquired reputation in the field of clothing. Tobacco products may be hazardous to health but this on its own is insufficient to imply a loss of attractive force for the earlier mark due to its association with tobacco⁵⁵.

Use of the mark

Article 42 and 51 CTMR: genuine use

Use for export or import purposes

Affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes constitutes use of the mark (Article 15(1)(b) CTMR). Genuine use may result from the export to a single operator located outside Europe, who can be an intermediary, for the purpose of selling to the end consumer in a third country. Proof of putting the goods on the market in this third country of import is not required⁵⁶.

In contrast, the sole export of goods bearing a Community trade mark, from a third country (Mexico), to an operator located in the European Union does not substantiate genuine use in Europe in the

53 - Judgment of 10/12/2015, C 603/14P, *The English Cut*, EU:C:2015:807, § 45-50.

54 - Judgment of 22/01/2015, T 322/13, *KENZO*, EU:T:2015:47, § 42.

55 - Judgment of 18/11/2015, T 606/13, *Mustang / MUSTANG et al.*, EU:T:2015:862, § 62-65.
Judgment of 04/06/2014, T 254/13, *STAYER*, EU:T:2015:156, § 57-61.

absence of proof that the goods were released for free circulation after payment of the import duties. The mere import of goods into Europe for re-export to Africa (that is, an 'external transit') is not apt to create or maintain market shares in Europe and, therefore, cannot constitute genuine use in this territory⁵⁷.

Nature of the use

Affixing the trade mark 'TEFLON', which designates an anti-adhesive substance, on final products such as cooking apparatus is not a use that allows maintaining rights on the final products themselves. This mark is affixed to third parties' final products to indicate the presence of the raw material or of a coating originating from the trade mark proprietor, but the goods themselves are still identified by, and sold under, the manufacturer's own mark which is the only one to indicate the commercial origin of those goods. The use of 'TEFLON' does not denote a link either between the trade mark proprietor or the commercial origin of the final product⁵⁸.

Means of evidence

There is no limit to the methods and means of proving genuine use of a mark. Documentary evidence of genuine use can, therefore, be stored on a CD-ROM and submitted to the Office in this format. Rule 79 CTMIR ('Communication in writing or by other means') only governs the means of transmission of a communication to the Office, and not the format of the evidence which may accompany this communication⁵⁹.

Proper reasons for non-use

The notion of 'proper reasons for non-use' requires two conditions to be met: the obstacles must be beyond the control of the trade mark proprietor and they must have a direct relationship with the mark so as to make its use impossible or unreasonable. Circumstances associated with commercial difficulties do not as such fall within the notion of 'proper reasons'. The trade mark proprietor, therefore, has the burden of adapting its marketing strategy to the obstacles met. In this context, the interruption of the marketing of defective foodstuff products that were rendered improper for human consumption forms part of the normal commercial difficulties encountered by the trade mark proprietor. These difficulties do not justify a complete cessation of use beyond a reasonable period. Moreover, the fact that a third party lodged a request for revocation of the trade mark does not prevent the proprietor from using its mark⁶⁰.

Article 15(1)(a) CTMR: use in a form differing from the form of the registration

The change resulting from the simple addition or removal of elements with little or no distinctiveness and/or with marginal visual impact does not in principle alter the distinctive character of the mark.

57 - Judgment of 09/12/2015, T 354/14, ZuMEX (fig.) / JUMEX, ECLI:EU:T:2015:947, § 60-63.

58 - Judgment of 16/06/2015, T 660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 68-86.

59 - Judgment of 18/11/2015, T 361/13, VIGOR / VIGAR, ECLI:EU:T:2015:859, § 25-37.

60 - Judgment of 18/03/2015, T 250/13, SMART WATER, EU:T:2015:160, § 66-72.

However, simply reproducing a verbal element, albeit dominant, in a different figurative representation, may affect the distinctive character if the figurative elements contribute to the distinctive character of the complex sign overall. The specific cursive font that accompanies the forename 'Arthur' may be an element of secondary importance but it is not negligible. The modification of this graphic presentation is, therefore, liable to alter the distinctive character of the mark as registered⁶¹.

61 - Judgment of 15/12/2015, T 83/14, ARTHUR & ASTON / Arthur, EU:T:2015:974, § 21-35.

62 - Judgment of 15/09/2015, T 483/12, LOTTE (fig.) / KOALA SCHÖLLER (fig.), EU:T:2015:635, § 79-85 and 94.

Mark as registered	Mark as used
	

Where the distinctive character of a trade mark lies in the combination of three elements of equal importance (that is, hexagonal packaging, the word 'Koala' and the depiction of koalas with eucalyptus), minor graphical modifications may not alter the distinctive character of the complex mark if the combination of the three elements subsists as such. In turn, modifications that lead to the elimination of one of the three elements (such as the suppression of the koalas or the replacement of the hexagonal packaging by a pouch) are liable to alter the distinctive character of the mark as registered⁶².

Mark as registered	Mark as used
	<p>1. Distinctive character unaltered</p> 
	<p>2. Distinctive character altered</p> 



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